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Article

**PROPOSAL FOR A UNIFORM FEDERAL COMMON LAW OF ATTORNEY-CLIENT PRIVILEGE FOR  
COMMUNICATIONS WITH U.S. AND FOREIGN PATENT PRACTITIONERS**

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Imagine you are the corporate patent counsel for a U.S. corporation. You retained a U.S. patent law firm to prosecute your corporation's patent applications worldwide. The U.S. law firm retained foreign patent law firms to prosecute the patent applications in their respective countries. You and the law firm's U.S. patent attorneys or agents communicated with each other regularly regarding patent prosecution strategy, both in the U.S. and in the foreign countries. Similarly, the U.S. patent attorneys and agents communicated with their foreign counterparts regarding patent prosecution strategy in their respective countries. Your corporation's domestic and foreign patent applications were granted, thereby protecting your corporation's inventions. You received copies of all correspondence for your files. Are those confidential communications, which were made for the purpose of obtaining or providing legal assistance, protected by the attorney-client privilege?<sup>1</sup>

Should the answer to the question in the above scenario be different if you are the corporate patent counsel for a foreign corporation, who has retained a foreign patent law firm to prosecute your corporation's patent applications worldwide, and the foreign patent law firm has retained a U.S. patent law firm to prosecute the client's U.S. patent applications?<sup>2</sup>

Now imagine that your corporation's U.S. and foreign patents are being infringed. Your corporation asserts its patent rights by filing patent infringement lawsuits in the U.S. and in several foreign countries. You communicate regularly with U.S. and foreign patent litigation counsel regarding litigation strategy. The U.S. and foreign patent litigation counsel communicate with each other regularly to coordinate your corporation's worldwide patent litigation strategy. You receive copies of all correspondence for your files. Are those confidential communications, \*<sup>282</sup> which were made for the purpose of obtaining or providing legal assistance, protected by the attorney-client privilege?<sup>3</sup>

Finally, imagine you are the corporation's outside litigation counsel for U.S. patent litigation. You are required to protect your client's privileged documents from disclosure in U.S. patent litigation.<sup>4</sup> How do you decide which confidential communications, which were made for the purpose of obtaining or providing legal assistance, are protected by the attorney-client privilege?

These questions commonly arise in U.S. patent litigation. A party may seek production of confidential documents and communications associated not only with the prosecution of the U.S. patent in suit, but also with all priority U.S. patent applications related to the U.S. patent in suit, all communications with foreign practitioners related to all foreign counterpart patents to the U.S. patent in suit, and all priority patent applications related to the foreign counterpart patents to the U.S. patent in suit.<sup>5</sup> In situations in which patent holders have asserted their patent rights in both the United States and in a foreign country, parties in U.S. patent litigation also seek production of all communications between clients and foreign counsel generated during litigation related to foreign counterpart patents to the U.S. patent in suit.<sup>6</sup>

It is well settled that the federal common law of attorney-client privilege protects communications between clients and U.S. patent attorneys in U.S. patent litigation.<sup>7</sup> Yet the case law regarding whether the attorney-client privilege protects confidential communications made between U.S. patent agents<sup>8</sup> or foreign patent \*<sup>283</sup> practitioners and their clients for the purpose of obtaining or providing legal assistance is largely unsettled and confusing. All of the case law has been created by U.S. district courts, and the issue has not reached a U.S. court of appeals. As a consequence, several different approaches have evolved over time, which have provided highly unpredictable results. This is unacceptable because “[a]n uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.”<sup>9</sup>

This article proposes a uniform federal common law of attorney-client privilege in U.S. patent litigation, so that the same federal common law of attorney-client privilege applies regardless of whether the client is foreign or domestic, whether the patent practitioner is foreign or domestic, and whether the patent is foreign or domestic. An expanded privilege, which protects confidential communications between clients and U.S. and foreign patent practitioners, including U.S. and foreign patent agents, made for the purpose of obtaining or providing legal advice in the field of patent law is supported by the Supreme Court's analysis in *Jaffee v. Redmond*.<sup>10</sup> It is further supported by the Rules of Evidence for United States Courts and Magistrates that the U.S. Supreme Court recommended to Congress in 1972,<sup>11</sup> the Uniform Rules of Evidence since 1974,<sup>12</sup> the American Law Institute's Restatement (Third) of The Law Governing Lawyers promulgated in 2000,<sup>13</sup> the Rules of Evidence of many states,<sup>14</sup> and Dean Wigmore's Evidence treatise.<sup>15</sup> The proposed uniform federal common law of attorney-client privilege is a logical extension of the Supreme Court's holding in *Sperry v. Florida*<sup>16</sup> providing that patent agents are authorized to practice patent law.<sup>17</sup>

Part II of this article provides an overview of the attorney-client privilege. Part III examines the development of the attorney-client privilege as applied to communications between clients and U.S. patent attorneys and agents. Part IV explores

the various approaches used by various U.S. district courts and the resulting unpredictability in determining whether the attorney-client privilege applies to confidential communications between clients and foreign patent attorneys and agents. \*284 Part V is my proposal for a uniform federal common law of attorney-client privilege in U.S. patent litigation.

## I. Overview of the Attorney-Client Privilege

The attorney-client privilege is the oldest of the testimonial privileges protecting confidential communications known to the common law.<sup>18</sup> It developed in England and served as a means of fostering confidence and trust by the client in his legal advisor so that the legal advisor could provide effective legal advice.<sup>19</sup> Today, the privilege protects communications between an attorney and a client made in confidence for the purpose of obtaining or rendering legal assistance.<sup>20</sup> However, since the attorney-client privilege protects potential evidence against disclosure that otherwise would have been relevant to the finder of fact, the privilege protects only those communications necessary to obtain or provide legal advice that might not have been made absent the privilege.<sup>21</sup>

### A. Definition of Attorney-Client Privilege

Courts and commentators have attempted to define the elements of the attorney-client privilege.

#### 1. Dean Wigmore's Definition

The most common articulation of the attorney-client privilege was first set forth by Dean Wigmore in his 1904 treatise *Evidence in Trials at Common Law*:

(1) Where legal advice of any kind is sought (2) from a professional legal advisor in his capacity as such, (3) the communications relating to that purpose, (4) made in confidence (5) by the client, (6) are at his instance permanently protected (7) from disclosure by himself or by the legal advisor, (8) except the protection be waived.<sup>22</sup> \*285 While Dean Wigmore's formulation does not appear to include confidential communications by the attorney to the client, Dean Wigmore believed that such communications were also protected by the attorney-client privilege,<sup>23</sup> and this understanding has been confirmed by the Supreme Court.<sup>24</sup> Dean Wigmore's formulation is used by the Courts of Appeals for the First,<sup>25</sup> Second,<sup>26</sup> Sixth,<sup>27</sup> Seventh,<sup>28</sup> Eighth,<sup>29</sup> and Ninth Circuits.<sup>30</sup> Although the Supreme Court has not specifically adopted the Wigmore definition, it has been cited favorably.<sup>31</sup>

#### 2. United Shoe Definition

Another common formulation of the attorney-client privilege was presented in 1950 by Judge Wyzanski of the District Court of Massachusetts in *United States v. United Shoe Machinery Corp.*<sup>32</sup>

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 was made (a) is a member of the bar of a court, or his subordinate and (b) in connection with this communication is acting as a lawyer; (3) the communication relates 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) legal services or (iii) assistance in \*286 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>33</sup>

Judge Wyzanski did not cite to any authority in developing the definition in *United Shoe*,<sup>34</sup> although he was aware of the Wigmore definition and deferred to Dean Wigmore on evidentiary issues.<sup>35</sup> Like the Wigmore definition, the United Shoe definition does not appear to protect confidential communications from the attorney to the client made for the purpose of providing legal services. As discussed above, this ambiguity has been resolved by the Supreme Court.<sup>36</sup> The United Shoe definition further incorporates the common law rule that the attorney-client privilege cannot apply to communications to or from legal advisors who are not admitted to a bar of a court, unless the legal advisor is a subordinate of such bar member.<sup>37</sup> The United Shoe definition is used by the Courts of Appeals for the Third,<sup>38</sup> Fourth,<sup>39</sup> Fifth,<sup>40</sup> and Eleventh<sup>41</sup> Circuits and the District of Columbia.<sup>42</sup>

### \*287 3. Proposed Federal Rule of Evidence 503

In 1972, the Chief Justice of the Supreme Court transmitted to Congress proposed Rules of Evidence for United States Courts and Magistrates [hereinafter Proposed Rules].<sup>43</sup> The Proposed Rules were formulated by the Judicial Conference Advisory Committee on Rules of Evidence and approved by the Judicial Conference of the United States and by the Supreme Court.<sup>44</sup> The Proposed Rules defined nine specific testimonial privileges, including the attorney-client privilege, “and indicated that these were to be the exclusive privileges absent constitutional mandate, Act of Congress, or revision of the Rules.”<sup>45</sup>

Proposed Rule 503(b) defined the general rule of attorney-client privilege as follows:

A client has a privilege to refuse to disclose and to prevent any other person from disclosing confidential communications made for the purpose of facilitating the rendition of professional legal services to the client, (1) between himself or his representative and his lawyer or his lawyer’s representative, or (2) between his lawyer and the lawyer’s representative, or (3) by him or his lawyer to a lawyer representing another in a matter of common interest, or (4) between representatives of the client or between the client and a representative of the client, or (5) between lawyers representing the client.<sup>46</sup>

Unlike the Wigmore and United Shoe definitions, Proposed Rule 503(b) expressly recognizes that the attorney-client privilege protects confidential communications, not only made by the client, but to the client. Further, Proposed Rule 503(b) clarifies that the attorney-client privilege protects confidential communications, not only between lawyer and client, but also among various other individuals who need to know the content of the confidential communications to further the rendition of legal services to the client.

Proposed Rule 503(a) expressly defines the terms “client,” “lawyer,” “representative of the lawyer,” and “confidential.”<sup>47</sup> Important for purposes of this thesis, \*288 Proposed Rule 503(a) expanded the scope of “lawyer” to include individuals authorized to practice law anywhere.<sup>48</sup> The Supreme Court’s proposed definition of “lawyer” changed the definition suggested by previous model codes and rules of evidence, which required the lawyer’s home jurisdiction to recognize the attorney-client privilege.<sup>49</sup>

The Proposed Rules were rejected by Congress in favor of Rule 501’s general mandate to “provide the courts with the flexibility to develop rules of privilege on a case-by-case basis,” and “to leave the door open to change.”<sup>50</sup> Nevertheless, the Supreme Court’s proposed rule has continued to be influential as an accurate statement of the federal common law of privilege.<sup>51</sup> Proposed Rule 503 is also the model closely followed by the corresponding Rule 502 of the Uniform Rules of Evidence.<sup>52</sup>

Proposed Rule 503’s formulation of the attorney-client privilege appears to be used by the Supreme Court,<sup>53</sup> and the rule has been cited as authority by the Courts of Appeals for the Fourth<sup>54</sup> and Eighth<sup>55</sup> Circuits.

### \*289 4. Restatement (Third) of the Law Governing Lawyers

The Restatement (Third) of the Law Governing Lawyers<sup>56</sup> provides a brief definition of the attorney-client privilege. According to Section 68 of the Restatement, the attorney-client privilege may be invoked with respect to: (1) a communication; (2) made between privileged persons; (3) in confidence; (4) for the purpose of obtaining or providing legal assistance to the client.<sup>57</sup> This general formulation must be read in the context of later sections that further define its four elements.<sup>58</sup> For example, Section 70 defines “privileged persons” as the client (including a prospective client), the client’s lawyer, agents of either who facilitate communications between them, and agents of the lawyer who facilitate the representation.<sup>59</sup> While not expressly citing to the Restatement, the Court of Appeals for the Second Circuit has used a similar definition of the attorney-client privilege.<sup>60</sup> Further, a Southern District of New York district court has treated the Wigmore and Restatement definitions as sufficiently similar to be somewhat interchangeable.<sup>61</sup>

## B. Federal Common Law of Privilege Applies in U.S. Patent Litigation

Federal district courts have exclusive jurisdiction over cases arising under the patent laws of the United States.<sup>62</sup> While each state has its own privilege rules, \*290 claims of privilege in federal cases are governed by Federal Rule Evidence 501, which provides that “the privilege of a witness . . . shall be governed by the principles of the common law as they may be

interpreted by the courts of the United States in light of reason and experience.”<sup>63</sup> As a result, state privileges are honored in federal litigation when subject matter jurisdiction is based solely upon diversity of citizenship; when subject matter jurisdiction is based upon a federal question, even if other pendent state law claims are involved in the case, “only privileges recognized by the national government matter.”<sup>64</sup>

### **C. Choice of Law in U.S. Patent Litigation: Regional or Federal Circuit Law?**

Federal Circuit law applies to causes of action within the exclusive jurisdiction of the Federal Circuit.<sup>65</sup> The Federal Circuit has exclusive jurisdiction of appeals from final decisions of district courts of the United States if the subject matter jurisdiction of the district court was based, in whole or in part, on 28 U.S.C. Section 1338, and at least one claim in the district court case arose under the patent laws of the United States.<sup>66</sup> Given that the federal common law of attorney-client privilege \*291 is applied in U.S. patent litigation arising under 28 U.S.C. Section 1338(a), district courts must then determine whether to apply the law of the Federal Circuit or of the regional circuit in which the district court sits.

The general rule in patent litigation is that district courts apply the law of the Federal Circuit with respect to issues of substantive patent law, but as to nonpatent substantive and procedural issues, district courts apply the law of the circuit in which the district court sits.<sup>67</sup> Under this rule, questions of privilege, confidentiality, and waiver are generally governed by the law of the regional circuit.<sup>68</sup> However, “a procedural issue that is not itself a substantive patent law issue is nonetheless governed by Federal Circuit law if the issue pertains to patent law, if it bears an essential relationship to matters committed to [the exclusive control of the Federal Circuit] by statute, or if it clearly implicates the jurisdictional responsibilities of [the Federal Circuit] in a field within its exclusive jurisdiction.”<sup>69</sup>

Applying these standards, the Federal Circuit has held “that Federal Circuit law applies when deciding whether particular written or other materials are discoverable in a patent case, because they relate to an issue of substantive patent law.”<sup>70</sup> For example, in *In re Spalding Worldwide, Inc.*,<sup>71</sup> the Federal Circuit held that whether an invention record was protected by the attorney-client privilege was unique to patent law, because, at the very least, it implicated the substantive issue of inequitable conduct.<sup>72</sup> On this basis, the Federal Circuit applied Federal Circuit law and held that an invention record, prepared by an employee inventor and submitted to the company’s patent legal department for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application, was protected by the attorney-client privilege.<sup>73</sup>

By the same analysis, whether a communication with a U.S. or foreign patent practitioner is protected by the federal common law of attorney-client privilege will always have a potential bearing on substantive issues of patent law in U.S. patent litigation. In the event a district court refuses to recognize the privileged nature of \*292 such communications, the issue is properly brought before the Federal Circuit by a writ of mandamus.<sup>74</sup>

### **D. Tension between Open Discovery and the Attorney-Client Privilege**

Discovery in U.S. patent litigation is governed by the Federal Rules of Civil Procedure, which provide that “[p]arties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party.”<sup>75</sup> A primary assumption underlying the discovery process is that there is a duty to provide whatever testimony one is capable of giving.<sup>76</sup> However, testimonial exclusionary rules and privileges, including the attorney-client privilege, run counter to the fundamental principle that “the public . . . has a right to every man’s evidence.”<sup>77</sup> Since the attorney-client privilege can frustrate the fact-finding or investigative process, “it creates an inherent tension with society’s need for full and complete disclosure of all relevant evidence.”<sup>78</sup>

In *United States v. Nixon*,<sup>79</sup> the Supreme Court stated that privilege exceptions are “not lightly created nor expansively construed, for they are in derogation of the search for truth.”<sup>80</sup> In *Trammel v. United States*,<sup>81</sup> the Supreme Court stated that testimonial exclusionary rules and privileges “must be strictly construed and accepted ‘only to the very limited extent that permitting a refusal to testify or excluding relevant evidence has a public good transcending the normally predominant principle of utilizing all rational means for ascertaining truth.’”<sup>82</sup> Specifically addressing the attorney-client privilege, in *Fisher v. United States*,<sup>83</sup> the Supreme Court stated that the attorney-client privilege “applies only where necessary to achieve its purpose.”<sup>84</sup> Because of the social harm that may be caused by applying the privilege, courts have used the Supreme Court’s dictum that the attorney-client privilege should be strictly construed as justification for denying the privilege to confidential communications between clients and their U.S. patent agents or foreign \*293 patent practitioners.<sup>85</sup> On the other

hand, “[t]he attorney-client privilege serves a critical function in the operation of the law and may not be disregarded lightly.”<sup>86</sup>

#### **E. Purpose of the Attorney-Client Privilege**

The Supreme Court justifies the existence of the attorney-client privilege on the basis that it serves both important private interests and public ends. With regard to private interests, the attorney-client privilege is “rooted in the imperative need for confidence and trust.”<sup>87</sup> Effective representation “rests on the need for the advocate and counselor to know all that relates to the client’s reasons for seeking representation if the professional mission is to be carried out.”<sup>88</sup> In *Fisher v. United States*,<sup>89</sup> the Supreme Court observed that “[a]s a practical matter, if the client knows that damaging information could more readily be obtained from the attorney following disclosure than from himself in the absence of disclosure, the client would be reluctant to confide in his lawyer and it would be difficult to obtain fully informed legal advice.”<sup>90</sup> In *Upjohn Co. v. United States*,<sup>91</sup> the Supreme Court stated that “[t]he privilege recognizes that sound legal advice or advocacy depends upon the lawyer’s being fully informed by the client.”<sup>92</sup> The attorney-client privilege also serves public ends.<sup>93</sup> By encouraging “full and frank communication between attorneys and their clients[,]” the attorney-client privilege “promotes broader public interests in the observance of law and administration of justice.”<sup>94</sup> Since the attorney-client privilege promotes sufficiently important private interests and public \*294 ends, protection of the attorney-client relationship outweighs the need for probative evidence.<sup>95</sup>

### **II. Development of Federal Common Law of Attorney-Client Privilege Relating to Communications with U.S. Patent Practitioners**

In the past, communications between domestic patent attorneys and patent agents and their clients were not protected by the attorney-client privilege.<sup>96</sup> In *United States v. United Shoe Machinery Corp.*,<sup>97</sup> Judge Wyznaski, the author of United Shoe’s formulation of the attorney-client privilege, stated that patent attorneys working in legal departments were not considered as in-house counsel, nor were they acting as lawyers.<sup>98</sup> This was based on his view that patent prosecution is entirely technical or scientific, rather than legal in nature.<sup>99</sup> Similarly, since patent agents are not members of the bar of any state court, he dismissed patent agents as “mere solicitors of patents who fall outside the privilege.”<sup>100</sup> According to Judge Wyzanski, both patent attorneys and patent agents working in a patent department were “comparable to the employees with legal training who serve in the mortgage or trust departments of a bank or in the claims department of an insurance company.”<sup>101</sup>

The United Shoe view of patent practice was expanded upon in *Zenith Radio Corp. v. Radio Corp. of America*,<sup>102</sup> where a Delaware district court held that a patent attorney was not “acting as a lawyer” for purposes of the United Shoe definition of the attorney-client privilege:

when not primarily engaged in legal activities; when largely concerned with technical aspects of a business or engineering character, or competitive considerations in their companies’ constant race for patent proficiency, or the scope of public patents, or even the general application of patent law to developments of their companies and competitors; when making initial office preparatory determinations of patentability based on inventor’s information, prior art, or legal tests for invention and novelty; when drafting or comparing patent specifications and claims; when preparing the application for letters \*295 patent or amendments thereto and prosecuting same in the Patent Office; [or] when handling interference proceedings in the Patent Office concerning patent applications.<sup>103</sup>

Since these common activities associated with patent practice could be handled by non-attorneys, the court did not consider them to be “hallmark activities of attorneys” and refused to recognize the attorney-client privilege to protect confidential communications to or from them.<sup>104</sup> In *Georgia-Pacific Plywood Co. v. United States Plywood Corp.*,<sup>105</sup> the holding in Zenith was interpreted broadly to mean: “Communications dealing exclusively with the solicitation or giving of business advice, or with the technical engineering aspects of patent procurement or with any other matters which may as easily be handled by laymen are not privileged.”<sup>106</sup> As a result, in cases in which an in-house patent attorney participated actively in corporate litigation, the attorney-client privilege was upheld on the basis that he was “house counsel,” rather than a patent lawyer.<sup>107</sup> However, when the patent attorney was involved in patent prosecution on behalf of the corporation, the privilege would not be recognized.<sup>108</sup>

Not all courts agreed with Zenith’s broad holding that the admission of non-attorneys in the field of patent practice was

dispositive on the issue of attorney client privilege.<sup>109</sup> For example, in *Ellis-Foster Co. v. Union Carbide & Carbon Corp.*,<sup>110</sup> a New Jersey district court upheld the privileged status of communications between a patent attorney and his client concerning the breadth of claims to be made under a patent application, the changes necessary to make the claims acceptable \*296 to the patent examiner, and the advisability of pursuing an appeal from the examiner's decision.<sup>111</sup> In so doing, the court stated:

I find myself unable to agree with the implied contention that because an attorney happens to be engaged in the field of patents, in which field nonattorneys are authorized to practice, he is ipso facto deprived of his status as a lawyer in every activity in which he operates so long as patent prosecution is involved. There is enough confusion, sometimes thrice confounded, resulting from derogation from the functions of attorneys, and trespass on their proper sphere of activity.<sup>112</sup> *Ellis-Foster* illustrates the confusion that existed as to whether the attorney-client privilege should be applied to communications between clients and patent attorneys involved in patent prosecution.

The shift toward eliminating this confusion began in 1963, when the Supreme Court ruled that patent practice is the practice of law. In *Sperry v. Florida*,<sup>113</sup> the Florida Bar attempted to enjoin a registered U.S. patent agent from advising clients within Florida and argued that common activities associated with patent practice, such as representing clients before the USPTO, rendering opinions as to patentability, and preparation of patent applications and amendments to patent applications, constituted the unauthorized practice of law.<sup>114</sup> The Supreme Court of Florida enjoined the patent agent from practicing patent law in Florida until he became a member of the Florida Bar.<sup>115</sup> In a landmark ruling, the Supreme Court reversed and held that in light of federal statutes and regulations authorizing patent agents to practice before the USPTO and to perform services which are "reasonably necessary and incident to the preparation and prosecution of patent applications[.]" states were prohibited under the Supremacy Clause from restricting such conduct even though it constituted the practice of law.<sup>116</sup> In so holding, the Court stated:

We do not question the determination that . . . the preparation and prosecution of patent applications for others constitutes the practice of law. Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria, 35 U.S.C. §§ 101-103, 161, 171, as well as to consider the advisability of relying upon alternative forms of protection which may be available under statute law. It also involves his participation in the drafting of the specification and claims of the patent application, 35 U.S.C. § 112, 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, 37 C.F.R. §§ 1.117-1.126, which frequently requires written argument to \*297 establish the patentability of the claimed invention under the applicable rules of law and in light of the prior art[.] 37 C.F.R. § 1.119.<sup>117</sup>

*Sperry* did not directly address the issue of attorney-client privilege for U.S. patent attorneys and patent agents, but instead concerned state control over the federally preempted practice of patent law. As a result, *Sperry* did not settle the issue of whether the attorney-client privilege applied to confidential communications between clients and their U.S. patent attorneys or U.S. patent agents for the purpose of obtaining or providing legal services.

#### **A. Sperry v. Florida's Effect upon Communications with U.S. Patent Attorneys**

Some courts were slow to recognize the attorney-client privilege for patent attorneys due to the notion in *Zenith* that they were not acting as lawyers when engaged in patent prosecution activities.<sup>118</sup> However, the effect of *Sperry* upon the *Zenith* case was recognized by a Southern District of California district court in *Garrison v. General Motors Corp.*,<sup>119</sup> which noted:

The *Sperry* and Chicago Bar Association cases are poles apart from the *Zenith* case . . . on the question of whether the work of patent attorneys generally constitutes the practice of law. It is, of course, true that the positions from which the question is viewed by the courts in the above cases are also far apart. It is the opinion of this court that such work does constitute practicing law when patent attorneys act as legal advisors and engage primarily in legal activities. . . .<sup>120</sup>

By 1972, the U.S. Court of Claims noted that the question of whether the activities of a patent attorney constituted the practice of law seemed well settled.<sup>121</sup> In 1977, a Delaware district court stated:

[C]ourts have consistently held that confidential communications between attorney and client for the purpose of securing legal advice concerning preparation or prosecution of a patent application are

protected, whether the attorney is employed as outside counsel, house counsel, or as a member of a Patent Department. The holding of early cases such as *Zenith* . . . is consequently of little weight.<sup>122</sup> \*298 Today, it is beyond doubt that the attorney-client privilege protects confidential communications made between clients and U.S. patent attorneys for the purpose of obtaining or providing legal assistance.<sup>123</sup> Instead, the battleground has shifted to the proper scope of the attorney-client privilege to be applied to confidential communications between clients and patent attorneys made for the purpose of obtaining or rendering patent law advice.<sup>124</sup>

## B. Sperry v. Florida's Effect upon Communications with U.S. Patent Agents

Even though *Sperry* held that U.S. patent agents were authorized by Congress to practice law,<sup>125</sup> courts are divided on whether the attorney-client privilege protects confidential communications between clients and U.S. patent agents.

### 1. Some Courts Do Not Recognize a Privilege for Communications with U.S. Patent Agents

One of the first courts to consider the issue after the *Sperry* case was a New Jersey district court. In *Joh. A. Benckiser G.m.b.H., Chemische Fabrik v. Hygrade Food Products Corp.*,<sup>126</sup> the plaintiff argued that *Sperry* recognized a federal Patent Bar of patent attorneys and patent agents who were authorized to practice law before the USPTO, and therefore, patent agents fell within the scope of the attorney-client privilege.<sup>127</sup> The court repeated *United Shoe*'s requirement that the person to \*299 whom the communication was made “is a member of the bar of a court, or his subordinate.”<sup>128</sup> Seizing on the portion of the requirement “of a court,” the Benckiser opinion created a new theory that the purpose of the attorney-client privilege is limited to the facilitation of an adversary system of litigation; protecting only communications made to “one who may someday represent his client in such litigation before the courts.”<sup>129</sup> Even while recognizing that patent agents are performing “a lawyer’s work” when engaged in patent practice,<sup>130</sup> the court ruled that the attorney-client privilege could not be extended to communications between clients and patent agents “who engage in representation short of actual litigation in the courts.”<sup>131</sup> Patent prosecution and contested hearings within the USPTO were not included in the court’s definition of “actual litigation.”<sup>132</sup> The court cited no authority for this new proposition of law, because there was none. The analysis was also contrary to well-established precedent from the U.S. Supreme Court. In *Schwimmer v. United States*,<sup>133</sup> the Eighth Circuit noted that the attorney-client privilege applies regardless of “whether the matter is one of consultation or of litigation.”<sup>134</sup> The proposition that the confidences of a client are “respected only when given for the purpose of securing aid in litigation” has not been the law since the early nineteenth century.<sup>135</sup>

The Benckiser opinion further found it irrelevant for purposes of the attorney-client privilege that U.S. patent agents were bound to protect a client’s confidences.<sup>136</sup> “While the lawyer’s oath and code of ethics, which are also required of \*300 patent agents, provided an added reason for the client’s trust, they are not the source of the privilege.”<sup>137</sup> “[T]he attorney-client privilege exists for the benefit of the client and not the attorney.”<sup>138</sup> The court did not address whether the client may have had an expectation of confidentiality and privilege based upon the fact that patent agents are authorized to represent patent applicants before the USPTO by Congress and that the Supreme Court recognizes such representation as the practice of patent law.<sup>139</sup>

In effect, Benckiser limited the attorney-client privilege to confidential communications between clients and only those patent practitioners who potentially could represent clients before Article III courts, i.e., attorneys.<sup>139</sup> The rule that the confidential communications between clients and U.S. patent agents made for the purpose of obtaining or providing legal assistance are not protected by the attorney-client privilege has been repeated by the courts over the years and continues to be the rule in many U.S. district courts.<sup>140</sup>

More recently, in *Agfa Corp. v. Creo Products, Inc.*,<sup>141</sup> a Massachusetts district court rejected the logic of cases that have extended the attorney-client privilege to registered U.S. patent agents representing clients before the USPTO under the rationale that patent agents are not qualified to provide competent legal advice to their clients.

I am not persuaded by these reasons. At a strictly literal level, a patent agent could in some sense be thought to be a “professional legal adviser,” because some part of the agent’s work would include applying in practice on behalf of an inventor what she understood to be the requirements of the law. The same could be said, however, for any number of non-lawyer advocates who formally undertake to “represent” “clients” before some tribunal and who advise the clients about how the law might apply to or affect the clients’ interests. The “looks like a duck, walks like a duck” analysis relied on by

cases such as those cited above works only if it regards as insignificant the fact that privilege \*301 is rooted, both historically and philosophically, in the special role that lawyers have, by dint of their qualifications and license, to give legal advice. The courts have consistently refused to recognize a common law privilege of confidentiality for accountants, for example, unless they are shown to be working under the direction of an attorney and thus may be thought to be agents of the attorney, who is the necessary “professional legal adviser.”<sup>142</sup>

The court ignored the role patent agents serve to clients and to society by virtue of the fact that patent agents are authorized to practice patent law by Congress and the Supreme Court. Since the purpose of the attorney-client privilege is to create an environment that fosters the fullest freedom and honesty of communications so that a patent attorney is in a position to provide competent legal advice, it defeats the purpose of the attorney-client privilege to deny the privilege to patent agents who are authorized to provide the same legal advice.<sup>143</sup>

## 2. Some Courts Recognize a Privilege for Communications with U.S. Patent Agents Only When Acting as Immediate Subordinates of an Attorney

Perhaps to ameliorate the harsh effects of the rule excluding confidential communications with patent agents from protection, other courts seized upon United Shoe’s definition which provided that the attorney-client privilege extends to a “subordinate” of a member of the bar of a court.<sup>144</sup> In Zenith, the court further limited the phrase to include only an “immediate subordinate” of an attorney, which were defined as “general office clerks and help, law clerks, junior attorneys, and the like who habitually report to and are under the personal supervision of the attorney through whom the privilege passes.”<sup>145</sup> The court further provided that the privilege available to the head of a legal department does not automatically extend to everyone below within the department: the privilege was available to immediate subordinates only.<sup>146</sup>

In Congoleum Industries, Inc. v. GAF Corp.,<sup>147</sup> a corporation consulted with an outside attorney and an outside patent agent employed by the attorney for advice and opinions regarding possible patent infringement.<sup>148</sup> Citing Zenith for the rule that the attorney-client privilege extends to “the agents or immediate subordinates \*302 of the attorney [,]” the court found that the patent agent was an agent of the attorney who employed him and from whom the corporation was seeking legal advice.<sup>149</sup> Thus, the court held that the communications were protected by the attorney-client privilege, because the patent agent was employed by and under the direct personal supervision of the attorney, and the patent agent represented the attorney during the communications with the corporation.<sup>150</sup> In so holding, the court never considered the Supreme Court’s remarks in Sperry that patent agents are authorized to practice law.<sup>151</sup>

The limited privilege recognized in Congoleum is not restricted to outside patent agents or employees of U.S. attorneys. In Cargill Inc. v. Sears Petroleum & Transport Corp.,<sup>152</sup> a Northern District of New York district court further extended the agency theory by recognizing that confidential communications with an independent patent agent retained by a U.S. patent attorney to perform patent searches were privileged.<sup>153</sup> In Hercules Inc. v. Exxon Corp.,<sup>154</sup> a Delaware district court held that the limited privilege also extended to patent agents working in a corporate legal department, as long as the patent agent is “working at the direction of and under the supervision of an attorney.”<sup>155</sup> Thus, in many U.S. district courts a limited attorney-client privilege applies to confidential communications between clients and patent agents acting under the authority and control of an attorney when the communications relate to the prosecution of a U.S. patent application.<sup>156</sup>

## \*303 3. Some Courts Recognize a Privilege for Communications with U.S. Patent Agents

A New Jersey district court, the same judicial district that issued the Benckiser opinion, was the first court to extend the attorney-client privilege to U.S. patent agents. In Vernitron Medical Products, Inc. v. Baxter Laboratories, Inc.,<sup>157</sup> the court reasoned that the substance of the function, rather than the label given to the person registered with the USPTO controlled the determination of whether the attorney-client privilege should be applied.<sup>158</sup> The court came to its conclusion without reference to Sperry.

In Vernitron, the court examined Section 1.31 of the Rules of Practice in Patent Cases, which permits a patent applicant to be represented by a registered patent attorney or registered patent agent.<sup>159</sup> The court observed that the only difference between patent attorneys and patent agents was the fact that patent attorneys are admitted to practice before the highest court of a State or territory, while patent agents are not.<sup>160</sup> In its analysis the court noted that the requirements for registration before the USPTO are the same for both attorneys and agents.<sup>161</sup> The applicant must be of good moral character and reputation; the applicant must possess legal, scientific, and technical qualifications necessary to enable him or her to render valuable service

to applicants; the applicant must be otherwise competent to advise and assist applicants for patents in the presentation and prosecution of their applications before the USPTO; and the applicant must take and pass the same examination.<sup>162</sup>

The court further observed that registered patent practitioners are required to conform to the standards of ethical and professional conduct set forth in the Patent and Trademark Office Code of Professional Responsibility.<sup>163</sup> In particular, Canon 4 of the Code requires a patent practitioner to “preserve the confidences and secrets of a client.”<sup>164</sup>

**\*304** The court extended the attorney-client privilege to protect confidential communications between clients and patent agents observing:

Patent matters are in a unique field of the law. General practitioners are allowed to prepare and argue cases in any court to which they are admitted, all the way up to the Supreme Court of the United States, but may not process a patent application before the Patent Office. Conversely, registered patent attorneys and agents may process such applications, but the patent attorneys are often not allowed to handle patent litigation in the courts of their own State, or even the District Court of their own district.

....

.... In the special field of patents, there can be no question that all of the considerations which support the basis for the privilege between a client and a general practitioner handling an automobile accident claim apply with equal force to an inventor or other applicant for a patent and the representative engaged to handle the matter for him, whether he be a “patent attorney” or a “patent agent”, so long as he is registered by the Patent Office.<sup>165</sup>

*In re Ampicillin Antitrust Litigation*<sup>166</sup> also extended the attorney-client privilege to protect confidential communications between clients and U.S. patent agents.<sup>167</sup> In a case that Wright & Graham referred to as the “first well-reasoned opinion on the subject[,]”<sup>168</sup> a District of Columbia district court analyzed the Supreme Court’s holding in Sperry that U.S. patent attorneys and U.S. patent agents stand on equal footing when representing clients in patent proceedings before the Patent Office.<sup>169</sup> The court concluded that the attorney-client privilege should be extended to protect confidential communications between clients and U.S. patent agents to fulfill the congressional intent of allowing clients to choose freely between a patent attorney and a registered patent agent for representation in patent proceedings.<sup>170</sup>

That freedom of selection, protected by the Supreme Court in Sperry, would, however, be substantially impaired if as basic a protection as the attorney-client privilege were [sic] afforded to communications involving patent attorneys but not to those involving patent agents. As a result, in order not to frustrate this congressional scheme, the attorney-client privilege must be available to communications of registered patent agents.<sup>171</sup> **\*305** The court specifically limited its holding to patent agents who were registered with the USPTO for three reasons.<sup>172</sup> First, Congress intended that registered U.S. patent attorneys and registered U.S. patent agents be treated equally. Second, limiting the privilege to U.S. patent agents would insure that the patent agents were subject to professional and ethical standards promulgated by the USPTO. Third, “the limitation results in a clearly-defined test so that all parties will know beforehand whether the privilege is available.”<sup>173</sup>

Further, the court limited the scope of the attorney-client privilege applicable to U.S. patent agents to include only communications necessary for the patent agent to provide patent law services. The court stated:

Therefore, 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 legal representative so that the representation may be effective, the privilege will be available.<sup>174</sup>

In other words, the court held that “the communication to the patent agent must involve a response that requires knowledge, analysis, or application of patent law to particular information.”<sup>175</sup> Thus, the scope of the privilege is limited to the extent that the patent agent is legally authorized to provide advice to clients. If a patent agent exceeds the scope of that authority, the communications are not privileged. The exact contours of the privilege remain to be developed.

Suppose, for example, that a registered U.S. patent agent advises a client regarding trademark, rather than patent matters.<sup>176</sup> Applying the limitations discussed in the Ampicillin case, the communications are not protected by the attorney-client privilege because patent agents are not authorized to practice trademark law.<sup>177</sup> Less clear, though, is whether a client may

consult with a registered U.S. patent \*306 agent regarding patent infringement and invalidity issues after the patent has issued. One district court noted in dicta that the post-issuance communications would not be protected by the attorney-client privilege on the basis that registered U.S. patent agents “cannot defend or enforce patent rights in federal courts.”<sup>178</sup> The better view would be that expressed in *Dow Chemical Co. v. Atlantic Richfield Co.*<sup>179</sup> There the court stated that it is illogical to extend the attorney-client privilege to pre-approval communications with an agent but to deny it in litigation involving the patent.<sup>180</sup> Under this view, a client does not lose the attorney-client privilege “simply because one phase of legal advice has ended and another begun.”<sup>181</sup> The fact that a patent agent would not be able to represent the client in federal court in the event that litigation ensued should not strip clients under the threat of litigation from the ability to consult with the patent agent of their choice regarding important post-issuance patent issues. Further, the patent agent is likely to be in a better position to refer the client to an appropriate patent attorney if litigation ensues.

In a recent case, *Mold Masters Ltd. v. Husky Injection Molding Systems, Ltd.*,<sup>182</sup> a Northern District of Illinois district court held that the attorney-privilege protects confidential communications between clients and U.S. patent agents made for the purpose of obtaining or providing patent law advice.<sup>183</sup> In so holding, the court acknowledged that many courts in the past have denied the privilege to patent agents on the basis of bar membership.<sup>184</sup> However, after reviewing *Sperry*<sup>185</sup> and 37 C.F.R. Part 10, the rules regarding representation of others before the USPTO, the court concluded that registered patent agents are “professional legal advisors” under the Wigmore attorney-client privilege definition.<sup>186</sup> The court stated:

Reason and experience, however, require that courts take a fresh look at whether bar membership should determine the outcome of an assertion of attorney-client privilege where the legal advisor is practicing before a federal agency. . . . A label of lawyer or nonlawyer should not take on too much significance, the substance of the legal advisor’s function and the prerequisites he overcame to perform that function should take on more significance. . . . As long as the federal agency requires the legal advisor to possess specific qualifications, to take an oath of office, to conform his conduct with an ethical code, and to pass a test to practice law before it, then there is no logical and appropriate basis for drawing a distinction between a lawyer and nonlawyer in terms of applying the attorney-client privilege, especially where, as here, the federal agency itself draws no \*307 such distinction, thereby making the label of lawyer or nonlawyer practically irrelevant anyway.<sup>187</sup>

As a result, Mold Masters adopted the reasoning of *Dow Chemical*, *Ampicillin*, and *Vernitron*, and restated the Wigmore definition relating to patent agents as follows:

[W]here legal advice is sought from a patent agent in his capacity as such, the communications relating to that purpose, made in confidence by the client, are at his instance permanently protected from disclosure by himself or by the patent agent, except the protection be waived.<sup>188</sup>

Thus, many U.S. district courts have extended *Sperry v. Florida* to its logical conclusion that the federal common law of attorney-client privilege protects confidential communications between clients and U.S. patent agents made for the purpose of obtaining or providing legal advice in the field of patent law.<sup>189</sup>

### **III. Development of Federal Common Law of Attorney-Client Privilege Relating to Communications with Foreign Patent Practitioners**

The issue of whether the federal common law of attorney-client privilege should protect confidential communications between clients and patent practitioners of their choice made for the purpose of obtaining or rendering patent law advice becomes even more complex when foreign patent practitioners are involved. This portion of the article explores the various approaches used and the resulting unpredictability in determining whether the attorney-client privilege applies to confidential communications between foreign patent attorneys and/or agents and their clients.

#### **A. Non-Choice of Law Approaches**

##### **1. “Bright Line” Approach - No Privilege for Communications with Foreign Patent Practitioners**

In the past, several courts have followed the “bright line” approach established in *Rayette-Faberge, Inc. v. John Oster*

Manufacturing Co.<sup>190</sup> that communications with foreign patent agents regarding foreign patent applications are not protected by the attorney-client privilege.<sup>191</sup> In Rayette-Faberge, a U.S. client was \*308 represented by a U.S. patent attorney, who communicated with British patent agents regarding foreign counterpart patent applications to the client's U.S. patent application.<sup>192</sup> An Eastern District of Wisconsin district court ordered production of the documents and stated:

In my opinion, the attorney-client privilege does not apply to the correspondence in question for the reason that the communications are with a group of agents who, apparently, are not attorneys at law. Accordingly, the aforesaid documents should be produced in response to the defendant's motion.<sup>193</sup>

In other words, the court denied the protection of the attorney-client privilege on the sole basis that foreign patent agents are not attorneys. A Maryland district court was faced with a similar issue in Burlington Industries v. Exxon Corp.<sup>194</sup> There the court held that the attorney-client privilege extends only to attorneys and their agents and immediate subordinates, who are essential to the attorney's performance of legal services.<sup>195</sup> The court did not find that the foreign agents were subordinates of the attorney, as this class included general office clerks, law clerks, legal secretaries, and junior attorneys.<sup>196</sup> Similarly, the court was unwilling to find that the foreign agents were agents of the U.S. attorney, because "it is certainly true that the privilege was not intended to permit the attorney to dub all persons with whom he has contact as his agents, thereby cloaking all such communications with protection."<sup>197</sup> Thus, the court denied the protections of the attorney-client privilege on the basis that foreign patent agents are not agents or immediate subordinates of an attorney.<sup>198</sup>

The most commonly cited case illustrating the "bright line" approach is Status Time Corp. v. Sharp Electronics Corp.<sup>199</sup> In Status Time, a U.S. client was represented by a U.S. patent law firm whose U.S. patent attorneys communicated with various foreign patent agents regarding foreign counterpart patent applications to the client's U.S. patent application.<sup>200</sup> A Southern District of New York district court acknowledged that, in light of the Supreme Court's holding in Sperry v. Florida, many documents arising from preparation and prosecution of the U.S. patent application might be protected by the federal common law of attorney-client privilege. \*309<sup>201</sup> Regarding the foreign documents, however, the court applied the United Shoe definition of the attorney-client privilege which required the person to whom the communication was made to be a member of the bar of a court or his subordinate.<sup>202</sup> The court cited Rayette-Faberge and Burlington Industries as authority for the proposition that the attorney-client privilege does not apply to foreign patent agents, since they are neither attorneys at law nor agents of the attorney.<sup>203</sup> Next the court reviewed several cases based upon a variety of rationales that have held that the attorney-client privilege applied to foreign patent agents.<sup>204</sup> However, none of these cases persuaded the court to "deviate from the fundamental principle" established by Rayette-Faberge and Burlington Industries. According to the court in Status Time:

Some measure of confidence may be appropriate between a client and a foreign patent agent just as it might be appropriate, as noted above, between a client and his accountant, or for that matter, between a client and his banker or his investment adviser. However, the necessity for "unrestricted and unbounded confidence" between a client and his attorney which justifies the uniquely restrictive attorney-client privilege simply does not exist in the other relationships. Expanding the privilege to treat foreign patent agents as if they are lawyers improperly expands the privilege beyond its proper bounds.<sup>205</sup>

"Accordingly, since the plaintiff failed to show that the foreign patent agents were either members of a bar of the United States, or their agents," the court found the foreign documents were not privileged and ordered them to be produced.<sup>206</sup> In light of the Supreme Court's holding in Sperry that patent agents are engaged in the practice of law,<sup>207</sup> it is difficult to reconcile the court's view of patent agents functioning as accountants with the reality of patent agents functioning as attorneys.<sup>208</sup> However, the basic reasoning in Status Time was followed by a few other opinions \*310 in the Southern District of New York,<sup>209</sup> except that in Novamont North America Inc. v. Warner-Lambert Co.,<sup>210</sup> the court relaxed the bright line approach to recognize that the attorney-client privilege protects communications with foreign attorneys admitted to the bar of their own countries and agents of such foreign attorneys.<sup>211</sup> Eventually, the bright line approach was abandoned by a Southern District of New York district court in favor of the choice of law approach articulated in Golden Trade, S.r.L. v. Lee Apparel Co.<sup>212</sup>

## 2. "Immediate Subordinate" Approach - Attorney-Client Privilege Extends to Communications with Foreign Patent Agents Only When Acting as the Agents or Immediate Subordinates of an Attorney

The attorney-client privilege is premised on, at the least, an inchoate or attempted attorney-client relationship.<sup>213</sup> It is well established that the attorney-client privilege may be extended to patent agents who are acting as agents or immediate

subordinates of an attorney.<sup>214</sup> As discussed in the previous part, *Status Time* held that communications with foreign patent agents could only be privileged if the foreign patent agents were acting as agents of U.S. attorneys.<sup>215</sup> However, the Novamont court's interpretation of *Status Time* suggests that the attorney-client privilege \*311 may include foreign patent agents who worked for foreign attorneys admitted to practice in their own countries.<sup>216</sup>

Courts seem to require varying levels of servitude by patent agents before they are deemed to be immediate subordinates of attorneys. Some cases state that an agent must be “acting at the direction and under the control of an attorney.”<sup>217</sup> Others state that an immediate subordinate is one who “is working at the direction of and under the supervision of an attorney.”<sup>218</sup> In *Golden Trade, S.r.L. v. Lee Apparel Co.*,<sup>219</sup> the court seemed to lower the level of servitude required by explaining that “[i]f the patent agent is acting to assist an attorney to provide legal services, the communications with him by the attorney or the client should come within the ambit of the privilege.”<sup>220</sup> As summarized by Judge Weinstein:

Communications to an administrative practitioner or to a patent agent who is not a lawyer, though not in themselves privileged[,] should be protected if they were made in confidence at the direction of a lawyer who is employing the practitioner to assist him in the rendition of legal services. For instance, communications to patent agents will qualify, provided it can be shown that the responsibility for the work being done for the client rested with the attorney, and that the patent agent worked under his direction and performed tasks relevant to the client's obtaining legal advice.<sup>221</sup>

A simple example of such a subordinate relationship is illustrated in *Golden Trade*, where an Italian corporation communicated with a Norwegian patent agent regarding the preparation and prosecution of a patent application in Norway.<sup>222</sup> The patent agent was employed by a Norwegian law firm.<sup>223</sup> A Norwegian barrister employed by the firm swore in an affidavit that he participated in the prosecution of the Norwegian patent “in cooperation with a patent agent employed by his law firm.”<sup>224</sup> According to the Norwegian barrister, his role ““was to provide advice \*312 and instructions”” to the patent agent ““regarding the legal issues associated with prosecution.””<sup>225</sup> Perhaps a fortunate fact in support of the Norwegian barrister's claim was that communications to the firm from the Italian corporation were addressed to the law firm itself, rather than to a specific individual.<sup>226</sup> According to the Norwegian barrister, communications from the members of the firm were ““meant to represent the advice of our firm, which include both patent agents and registered barristers.””<sup>227</sup> The *Golden Trade* court concluded that the patent agent was acting as the subordinate of the attorney “since she was serving to assist the attorney in providing legal services.”<sup>228</sup>

*Golden Trade* also states “there is no justification for treating independent contractors as beyond the protective scope of the attorney-client privilege if they are in fact serving to assist an attorney to provide legal services to a client.”<sup>229</sup> Regardless of the fact that the patent agent is an independent contractor, rather than an employee of the attorney, the controlling issue remains whether the ““patent agent is working on behalf of and under the direction of the attorney.””<sup>230</sup>

It is rare to find a case in which a foreign patent agent assisting a U.S. attorney in providing legal services to their client is deemed to be an agent of the attorney.<sup>231</sup> However, one such case was *Willemijn Houdstermaatschaapij BV v. Apollo Computer Inc.*,<sup>232</sup> in which a British patent agent assisted a Dutch corporation's outside U.S. patent attorney in reissue patent proceedings and in the formulation of licensing and enforcement policies for use in the United States.<sup>233</sup> These activities required frequent communications between the U.S. patent attorney and the British patent agent.<sup>234</sup> The court held that the communications would be privileged if the British patent agent was acting under the direction of the U.S. attorney.<sup>235</sup> In *Apollo Computer*, a few other documents involved foreign patent agents, but did \*313 not relate to foreign patent applications.<sup>236</sup> For those documents relating to U.S. activities, the court held that where the foreign patent agent was acting as a mere functionary, with the “real lawyering” being done by the U.S. patent attorney, the communications would be “like that between a lawyer and any non-lawyer who serves under the lawyer's supervision.”<sup>237</sup>

Independent foreign patent agents who are retained by attorneys to prepare and prosecute patent applications in their foreign countries are generally not treated as immediate subordinates of attorneys. In *Novamont North America Inc. v. Warner-Lambert Co.*,<sup>238</sup> a U.S. corporation's U.S. and Swiss attorneys communicated with patent agents in approximately fifteen countries relating to foreign counterpart patent applications to the U.S. patent in suit. The court declined to extend the attorney-client privilege to cover the communications at issue because the foreign patent agents were not attorneys.<sup>239</sup> Implicit in the court's holding is that the foreign patent agents were not acting under the direction and control of the U.S. and Swiss attorneys.<sup>240</sup> By way of contrast, in *Mitts & Merrill, Inc. v. Shred Pax Corp.*,<sup>241</sup> a German patent agent communicated with a U.S. corporation's outside U.S. patent attorney regarding a German patent application, apparently in response to a request from the U.S. patent attorney.<sup>242</sup> A Northern District of Illinois district court, recognizing that various courts have treated such

reports in different ways, stated:

The better rule, where, as in the present case, “substantive” information regarding foreign law is communicated to the United States lawyer, is that the communication is privileged either because the foreign patent agent is acting as the agent of the United States lawyer or the foreign patent agent is engaged in substantive lawyering which would be held privileged by the foreign country.<sup>243</sup> \*314 The court made no attempt to determine German law on the issue of privilege, but it determined that the communication itself shows that the patent agent was acting, at a minimum, as the U.S. patent attorney’s agent.<sup>244</sup>

Independent foreign patent agents who are retained by their foreign client to coordinate prosecution of a U.S. patent application using U.S. patent attorneys are generally not treated as agents or immediate subordinates of the U.S. attorneys. In Glaxo, Inc. v. Novopharm Ltd.,<sup>245</sup> a British corporation’s outside British patent agent communicated with a U.S. patent attorney regarding a U.S. patent application.<sup>246</sup> The court held that “communications between a foreign patent agent and a U.S. attorney concerning a U.S. patent application are not privileged unless the agent either registered with the U.S. patent office or is acting at the direction and under the control of an attorney.”<sup>2247</sup> Since the British patent agent did not meet any of these criteria, the attorney-client privilege did not protect communications between the British patent agent and the U.S. patent attorneys, even though both were working on the client’s behalf.<sup>248</sup> Arguably, the foreign patent agent was “acting to assist an attorney to provide legal services.”<sup>2249</sup> However, since the foreign patent agent was not “acting at the direction and under the control of an attorney,”<sup>2250</sup> the foreign patent agent was not the immediate subordinate of the attorney.<sup>251</sup>

### 3. “Functional” Approach - Privilege Recognized for Communications with Foreign Patent Practitioners Functioning as Attorneys

In Vernitron Medical Products, Inc. v. Baxter Laboratories, Inc.,<sup>252</sup> a New Jersey district court was the first court to advocate a “functional” approach to determine whether communications with a foreign patent agent are protected by the federal common law of privilege. As discussed in Part III.B.3. above, Vernitron extended the attorney-client privilege to U.S. patent agents based on the “substance of the function, rather than the label given to the individual registered with the Patent \*315 Office[.]”<sup>253</sup> Regarding the issue of whether communications with a foreign patent are protected by the federal common law of privilege, the court stated:

The same situation obviously exists in connection with the processing of patent claims in other countries, and the nature of the subject is such that patterns essentially the same as those which exist in the United States are found there. And where a specially authorized representative of one country conveys information to his counterpart in another country in connection with the processing of a patent application, such communications would also be privileged. Whenever applicable law limits the performance of essentially legal functions to individuals specifically authorized to that end, the underlying basis for the privilege, i.e., the right to communicate on a basis of full disclosure to the end that the professional service may be effectively provided, must be given its natural effect.<sup>254</sup>

Under the “functional” approach advocated by Vernitron, confidential communications between a foreign patent agent and a client or the client’s attorney made for the purpose of obtaining or providing legal advice to the client would be protected by the federal common law of privilege if the foreign patent agent performed a function equivalent to a legal practitioner in the field of patent law and the foreign agent was authorized to perform the functions of a patent agent by applicable foreign law.<sup>255</sup> No further inquiry into the foreign law would be necessary.<sup>256</sup>

In Renfield Corp. v. E. Remy Martin & Co.,<sup>257</sup> a Delaware district court expanded the attorney-client privilege to include communications with French “in-house counsel” although the employees were arguably not members of the organized French bar.<sup>258</sup>

Because there is no clear French equivalent to the American “bar,” in this context membership in a “bar” cannot be the relevant criterion for whether the attorney-client privilege is available. Rather, the requirement is a functional one of whether the individual is competent to render legal advice and is permitted by law to do so. French “in-house counsel” certainly meet this test; like their American counterparts, they have legal training and are employed to give legal advice to corporate officials on matters of legal significance to the corporation.<sup>259</sup> \*316 Thus, the “functional” approach used in Remy to determine whether the attorney-client privilege was available depended not on whether a privilege existed under French law, but rather on whether the individual was competent to render legal advice and was permitted by law to do so.<sup>260</sup> In patent law,

such competence and authority are demonstrated by evidence that patent agents are registered in the patent office of their respective countries.<sup>261</sup>

In Heidelberg Harris, Inc. v. Mitsubishi Heavy Industries, Ltd.,<sup>262</sup> a Northern District of Illinois district court applied the “functional” approach to conclude that the federal common law of attorney-client privilege protected communications between a corporation and German patent agents.<sup>263</sup> The court observed that German patent agents provide legal advice to their clients on issues such as patentability, patent infringement, and validity.<sup>264</sup> Further, they are qualified to conduct any activities before the German Patent Office, such as the appeal of examiner’s decisions on patent applications, and the filing and litigating of opposition proceedings.<sup>265</sup> Since the purpose of the attorney-client privilege is to encourage the free flow of communications between the professional qualified to give legal advice and the client seeking that advice,<sup>266</sup> the court stated:

A mechanical application of this principle which focuses on labels rather than reasoning defeats the purpose of the privilege. It is therefore essential to look to the substance of the roles assumed by the parties, rather than merely ending the analysis with the titles attached to the parties involved.<sup>267</sup>

Rather than basing its decision on labels, the court based its decision upon evidence that “the German patent agents were engaged in the substantive lawyering process and were authorized under the law of their country to act, in essence, as attorneys.”<sup>268</sup>

In this case, [the German patent agent and his subordinates] were all qualified to give legal advice and were in fact often relied upon by [the client] in this capacity. Courts have held that, where a foreign patent agent is engaged in the “substantive lawyering process” and communicates with a United States attorney, the communication is privileged \*317 to the same extent as a communication between American co-counsel on the subject of their joint representation. By parity of reasoning, where a party who may arguably be termed a foreign patent agent is engaged in the substantive lawyering process and communicates with his client, the communication is privileged to the same extent as a communication between an American attorney and his client.<sup>269</sup>

## **B. Choice of Law Approaches**

In deciding whether to extend the attorney-client privilege to include communications with foreign patent practitioners, most U.S. district courts apply a choice of law approach.<sup>270</sup>

### 1. “Touching Base” Approach

In Duplan Corp. v. Deering Milliken, Inc.,<sup>271</sup> a South Carolina district court was the first court to apply a choice of law approach to decide the issue of whether the federal common law of attorney-client privilege should protect communications with foreign patent practitioners.<sup>272</sup> Duplan was a complex anti-trust and patent case involving domestic and foreign corporations, who employed and/or consulted with domestic and foreign patent practitioners.<sup>273</sup> Domestic patent attorneys working in corporate patent departments had been consulted for legal advice regarding prosecution of U.S. patent applications. Foreign patent agents had been contacted by some of the corporations’ U.S. and foreign employees, American attorneys, and foreign attorneys for four different purposes: (1) assistance in preparation of U.S. patent applications; (2) assistance in prosecuting patent applications in their own countries; (3) legal advice of foreign patent law; and (4) development of trial preparation materials.<sup>274</sup>

Initially, the court determined that the attorney-client privilege applied to U.S. patent attorneys working in corporate patent departments.<sup>275</sup> When providing legal advice to employees of the corporation, the patent attorney was the attorney for purposes of the attorney-client privilege.<sup>276</sup> However, when the patent attorney sought legal advice on behalf of the corporation from outside counsel, the patent \*318 attorney was the client for purposes of the attorney-client privilege.<sup>277</sup> Unfortunately, the court applied the now-discredited “conduit theory” of patent prosecution<sup>278</sup> and ordered production of all documents generated by agents, attorneys, and inventors in the course of applying for a U.S. patent.<sup>279</sup> This, of course, stripped the client of the protections of the attorney-client privilege in its communications with U.S. patent attorneys regarding patent prosecution before the USPTO.

Regarding whether the attorney-client privilege should apply to communications with the foreign patent practitioners, the

Duplan court first observed that they were not members of the bar of a court, as required under United Shoe's formulation of the attorney-client privilege.<sup>280</sup> Since they were not attorneys, they were clearly foreign patent agents.<sup>281</sup> Then, without considering the implications of the Supreme Court's determination in Sperry that patent agents were authorized to practice patent law before the USPTO,<sup>282</sup> the court adopted the view that the attorney-client privilege does not protect confidential communications between clients and U.S. patent agents.<sup>283</sup> After taking that position, the court labeled as "ludicrous" the outcome other courts apparently had reached in expanding the federal common law of attorney-client privilege to include communications with foreign patent agents, but not U.S. patent agents.<sup>284</sup> As a result, the court developed the often-repeated federal common law rule that "no communications from patent agents, whether American or foreign, are subject to an attorney-client privilege in the United States."<sup>285</sup>

However, the court then acknowledged that the laws of Great Britain and France provide a "cloak of privilege" to communications between clients and British or French patent agents respectively.<sup>286</sup> Reasoning that these statutes contravened the public policy of the United States in promoting discovery, the court applied \*319 principles of comity to develop the "touching base" approach which in general terms states: "[A]ny communications touching base with the United States will be governed by the federal discovery rules while any communications related to matters solely involving [a foreign country] will be governed by the applicable foreign statute."<sup>287</sup> As summarized in Duplan, no attorney-client privilege can attach to communications with foreign patent agents "relating to assistance in prosecuting patent applications in the United States" or "relating to development of trial preparation materials . . . for litigation in the United States."<sup>288</sup> However, communications between foreign patent agents and foreign corporate employees and foreign attorneys "relating to assistance in prosecuting patent applications in their own foreign country" or "rendering legal advice . . . on the patent law of their own country" or relating to "litigation in 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 or the law of the foreign country in which the patent agent was representing the client.<sup>289</sup> Thus, Duplan incorporated foreign law into the federal common law of attorney-client privilege.<sup>290</sup>

Some courts following Duplan have added the requirement that the principle of comity applies only if the foreign law is not contrary to the public policy of the forum.<sup>291</sup> This is a fundamental premise of Duplan's use of principles of comity, and was explained by a Southern District of New York district court in Golden Trade, S.r.L. v. Lee Apparel Co.,<sup>292</sup> as follows:

[R]ecognizing foreign-law protection for [a] foreign patent agent's communications with their foreign clients concerning the prosecution of foreign patents will not undermine any compelling policy interest[s] reflected in domestic law governing privilege claims.<sup>293</sup> \*320 To determine whether communications involving foreign patent practitioners should be protected by the attorney-client privilege, courts and litigants have struggled with the question of whether a communication touches base with the United States. This became especially relevant since the Duplan "touching base" analysis did not address the common situation of U.S. inventors seeking to protect their inventions by obtaining patent protection in foreign countries. This scenario can take two forms. First, a U.S. inventor contacts and communicates directly with foreign patent practitioners regarding foreign law to obtain foreign patent protection. Second, a U.S. inventor hires a U.S. patent practitioner to obtain patent protection in the U.S. and assist in doing so in specific foreign countries. The U.S. patent practitioner locates, contacts, and communicates directly with the foreign patent practitioners regarding foreign law to obtain the foreign patents on behalf of the inventor.

In Mendenhall v. Barber-Greene Co.,<sup>294</sup> a Northern District of Illinois district court resolved this uncertainty by interpreting the holding of Duplan as follows:

There is a privilege protecting communications between a lawyer and a foreign patent agent only if the communications relate to a foreign application and the law under which the patent would be issued grants a privilege to communications between clients and non-lawyer patent agents.<sup>295</sup>

Under this view, communications do not touch base with the United States when they relate to assistance in prosecuting foreign patent applications in their own country or rendering legal advice on the patent law of their own country.<sup>296</sup> However, where the communications relate to U.S. patent applications or U.S. patent law, the communications touch base with the United States.<sup>297</sup>

In Odone v. Croda International, PLC,<sup>298</sup> a District of Columbia district court took a much different view of the "touching

base” approach. Odone dealt with a foreign corporation’s communications with its British patent agent regarding whether to name the plaintiff as a co-inventor in a British patent application.<sup>299</sup> The plaintiff was a U.S. citizen at the time of the filing of the British patent application. \*321<sup>300</sup> A U.S. patent application, which became the patent in suit, was filed later claiming priority based upon the earlier British patent application pursuant to the International Patent Cooperation Treaty.<sup>301</sup> The court reviewed several cases relating to communications with foreign patent agents and determined that the “common denominator” of the cases applying principles of comity to extend the attorney-client privilege to communications with foreign patent agents is that “the communications related solely to activities outside the United States.”<sup>302</sup> As a result, the court interpreted Duplan to mean that communications touch base with the United States “where the patent application involves persons and activities related to the United States.”<sup>303</sup> With this novel interpretation of Duplan, the court stated that it would be “nonsensical” for the court to find that the documents at issue did not touch base with the United States, since a U.S. citizen was the subject of the communications.<sup>304</sup> In other words, confidential communications between foreign patent practitioners and foreign clients in U.S. patent litigation that refer in any way to a U.S. citizen are not protected by the attorney-client privilege. As an alternative ground for ordering production of the foreign client’s confidential requests for legal advice from its foreign patent agent, the court further misinterpreted Duplan’s statement that “comity will not be extended to foreign law or rights based thereon if it opposes settled public policy of the forum nation.”<sup>305</sup> The court held that it would be against public policy to limit the plaintiff’s discovery by granting comity to the “restrictive discovery laws of Great Britain[.]” yet permit the defendant open discovery under the Federal Rules of Civil Procedure, since the defendants later “availed themselves” of the “protections of U.S. patent and trademark laws pursuant to the Patent Cooperation Treaty.”<sup>306</sup> In other words, even if the privilege laws of a foreign country protected confidential communications between foreign clients and foreign patent practitioners regarding foreign patent applications, the Odone court would not recognize the privilege if the foreign client had also obtained a U.S. patent, which was the patent in suit in U.S. patent litigation.<sup>307</sup> This analysis \*322 illustrates how confusing and result-oriented Duplan’s “touching base” approach can be.<sup>308</sup> Odone’s holding has not been followed by other courts.

Odone’s interpretation of the “touching base” approach places U.S. inventors at a competitive disadvantage to similarly situated foreign inventors when both attempt to protect their inventions in foreign countries by communicating confidentially with foreign patent practitioners. Further, Odone tends to discourage foreign inventors from disclosing their inventions to the United States public, since the privileged status of their communications is stripped away by filing a U.S. patent application, i.e., availing themselves of the protections of U.S. patent law. Both of these results must be against the public policy of the United States.<sup>309</sup> In *VLT Corp. v. Unitrode Corp.*,<sup>310</sup> the District Court of Massachusetts recognized the incorrectness of Odone’s interpretation:

As a result, a United States domiciliary could hardly engage in privileged communications with foreign patent agents. Similarly, the mere mention of a United States patent in a communication could cause a communication to be non-privileged, even if the mention is incidental to the foreign inquiry.<sup>311</sup>

Thus, the “touching base” approach may be summarized as follows: communications with foreign patent agents regarding assistance in prosecuting foreign patent applications may be privileged if the privilege would apply under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States.<sup>312</sup> Further, communications with foreign patent agents relating to legal advice on the patent law of the patent agent’s country or relating to litigation in the patent agent’s country may be privileged if the privilege would apply under the law of the foreign country in which the patent agent was representing the client and that law is not contrary to the public policy of the United States.<sup>313</sup> However, where communications with foreign patent agents relate to assistance in prosecuting U.S. patent applications, legal advice on the patent law of the United States, or litigation in the United States, courts do not look to foreign \*323 law to decide whether communications with foreign patent agents are protected by the federal common law of attorney-client privilege.<sup>314</sup>

One of the problems with Duplan’s “touching base” approach is that it does not address the common situation of foreign clients seeking to protect their inventions in the United States by having their foreign patent law firms or practitioners communicate directly with U.S. patent practitioners to obtain U.S. patents. In *Foseco International Ltd. v. Fireline, Inc.*,<sup>315</sup> a British corporation used a British patent agent to process patent applications on its behalf in countries outside Great Britain, including the United States.<sup>316</sup> The defendant in the patent infringement litigation filed a motion to compel the communications between the U.S. patent attorney and the British patent agent.<sup>317</sup> The court determined that the communications were in essence communications between the British corporation and the U.S. patent attorney, with the British patent agent acting under the direction and control of the British corporation.<sup>318</sup> The court further recognized that, if the communications had been between the British corporation and the U.S. patent attorney, the communications would be

privileged.<sup>319</sup> Under these circumstances, the court held that the communications between the British patent agent and the U.S. patent attorney relating to prosecution of a U.S. patent application were protected by the attorney-client privilege, just as if they had come from the British corporation itself.<sup>320</sup>

In Chubb Integrated Systems, Ltd. v. National Bank of Washington,<sup>321</sup> a District of Columbia district court disagreed with the holding in Foseco. In Chubb, the British corporation's British patent agent communicated with a U.S. patent attorney regarding a U.S. patent application.<sup>322</sup> Citing Duplan, the court held that the British patent agent's communications relating to the U.S. are never privileged.<sup>323</sup> In the alternative, the corporation argued that the court should consider the British patent agent to be an employee of the corporation, who happened to be a patent agent, and as an employee, his communications with the U.S. patent attorney were privileged. \*324<sup>324</sup> The court refused to do so, finding that "a patent agent is akin to an independent contractor, as opposed to an employee."<sup>325</sup> As a result, the communications between the U.S. attorney and the British patent agent were held to not be protected by the attorney-client privilege.<sup>326</sup>

Finally, in Glaxo, Inc. v. Novopharm Ltd.,<sup>327</sup> an Eastern District of North Carolina district court agreed with Chubb and held that "communications between a foreign patent agent and a U.S. attorney concerning a U.S. patent application are not privileged unless the agent either registered with the U.S. patent office or is acting at the direction and under the control of an attorney."<sup>328</sup> Since the British patent agents did not meet any of these criteria, the attorney-client privilege did not protect communications between British patent agents and U.S. patent attorneys working on the client's behalf.<sup>329</sup> None of these approaches treat British patent agents and U.S. attorneys as co-counsel, nor do they acknowledge the expectation of confidentiality held by foreign clients who find themselves in U.S. patent litigation at some time in the future. In effect, the "touching base" approach denies the attorney-client privilege to foreign clients who, quite naturally, hire foreign patent practitioners to act as their representatives or agents to communicate with U.S. patent practitioners on the foreign client's behalf.

## 2. "Comity Plus Function" Approach

The district courts for the Northern District of Illinois developed a slightly different approach, which I refer to as the "comity plus function" approach, to determine whether the attorney-client privilege protects communications with foreign patent agents.<sup>330</sup> In Mendenhall v. Barber-Greene Co.,<sup>331</sup> a U.S. inventor's U.S. patent attorneys communicated with foreign patent agents to coordinate prosecution of the U.S. inventor's foreign patent applications.<sup>332</sup> The court criticized the rule that the attorney-client privilege does not apply to any communications between lawyers and patent agents, foreign or domestic, as unduly formalistic and applying \*325 labels rather than reasoning.<sup>333</sup> The court reviewed two other rules developed by the courts and stated that these two rules needed "some leavening in functional terms."<sup>334</sup> One of the two rules was Duplan's "touching base" approach extending the federal common law of attorney-client privilege to protect communications between a lawyer and a foreign patent agent only if the communications relate to a foreign patent application and the law under which the patent would be issued grants a privilege to communications between clients and non-lawyer patent agents.<sup>335</sup> The other rule was that all communications between lawyers and foreign patent agents "assisting them with patent applications" are privileged.<sup>336</sup>

To determine whether the attorney-client privilege should protect communications with a foreign patent agent, the Mendenhall court determined that it was important to determine the roles that the U.S. patent attorney and the foreign patent agent assumed in the foreign patent prosecution process. The rule developed by the court is as follows:

[I]f the communication is actually between the client and the foreign patent agent, and the attorney merely serves as a conduit for the information, the communication is not privileged unless under the foreign law communications between patent agents and clients are privileged. . . . Similarly, if the communication is actually between the attorney and the foreign patent office, and the foreign patent agent merely serves as a conduit, the communication is not privileged unless direct communication between the attorney and the foreign patent office is confidential.

Where the communication consists not merely of information to be passed on to the foreign patent office, but is substantive, the result is different. If the foreign patent agent was primarily a functionary of the attorney, the communication is privileged to the same extent as any communication between an attorney and a non-lawyer working under his supervision. If the foreign patent agent is engaged in the lawyering process, the communication is privileged to the same extent as any communication between co-counsel.<sup>337</sup>

In essence, the "comity plus function" approach used by the Mendenhall court is a two-step approach to determine whether

the attorney-client privilege protects communications with foreign patent agents.<sup>338</sup> The first inquiry involves a determination \*326 of whether the law of the foreign country extends the attorney-client privilege to its patent agents.<sup>339</sup> If such a privilege exists, the second inquiry assesses the specific capacity in which the agent was functioning with respect to the communications.<sup>340</sup> If the foreign patent agents were “more or less” functioning as attorneys with respect to the communications, the attorney-client privilege will be recognized under the “comity plus function” approach.<sup>341</sup>

### 3. “Most Direct and Compelling Interest” Approach

In *Golden Trade, S.r.L. v. Lee Apparel Co.*,<sup>342</sup> the “most direct and compelling interest” approach was first used by a Southern District of New York district court to determine whether the attorney-client privilege protects communications with foreign patent agents. In *Golden Trade*, an Italian corporation communicated with its patent agents in Norway, Germany, and Israel regarding prosecution of patents in their respective countries.<sup>343</sup> Although the court cited the “touching base” approach from *Duplan*, it actually applied a traditional choice of law “contacts” analysis which considered the subject matter at issue, the parties to the communication, and whether those entities were parties to the lawsuit to determine which country’s privilege law should be applied. With those factors in mind, the *Golden Trade* court focused on those countries with the “dominant interest” in determining whether the communications should be treated as privileged and concluded that it should “as a matter of comity look to the law of those jurisdictions unless that law is clearly inconsistent with important policies embodied in federal law.”<sup>344</sup> In reaching its conclusion, the court reiterated that Rule 501 of the Federal Rules of Evidence controlled the issue.<sup>345</sup> However, the court found “no reason . . . to read this rule as referring solely to substantive federal common law as distinguished from such choice-of-law rules as may otherwise be applicable” or “as inflexibly precluding a federal court from looking to the substantive law of [foreign] jurisdictions that, by virtue of the circumstances in which the disputed communication was made, have the most direct and compelling interest in whether those communications are to be publicly disclosed.”<sup>346</sup> Thus, although *Golden Trade* mentions the “touching base” approach, it uses the choice of law approach that looks to the nation \*327 with the “most direct and compelling interest.”<sup>347</sup> After balancing the relevant interests, the court concluded that it was “apparent that the countries in which the patent agents represented [the Italian corporation] have the dominant interest in determining whether the communications in question should be treated as confidential.”<sup>348</sup> As a result, the court looked to the laws of Norway, Germany, and Israel to determine whether the federal common law of attorney-client privilege should protect the communications.<sup>349</sup>

Courts and commentators have recognized that *Golden Trade*’s “direct and compelling interest” approach is similar to that taken by the Restatement (Second) Conflict of Laws.<sup>350</sup> Section 139(2) of the Restatement provides that, when the nation with the “most significant relationship with the communication” recognizes a privilege not recognized in the forum nation, the communications should be admitted into evidence unless the foreign state’s interest outweighs the forum nation’s policy interests.<sup>351</sup> The comments to Section 139(2) recommend several factors that the forum nation should consider in determining whether to admit the evidence: “(1) the number and nature of the contacts that the state of the forum has with the parties and with the transaction involved, (2) the relative materiality of the evidence that is sought to be excluded, (3) the kind of privilege involved, and (4) fairness to the parties.”<sup>352</sup> With regard to the first factor, the comments to Section 139(2) suggest that the interests of the foreign state having the greatest interest in having the evidence excluded should prevail when contacts with the forum nation are “few and insignificant”.<sup>353</sup> For the second factor, the comments suggest the forum nation should be more inclined to apply the foreign nation’s law and exclude the evidence “if the facts that would be established by this evidence would be unlikely to affect the result of the case or could be proved in some other way.”<sup>354</sup> Regarding the third factor, the forum nation should be more inclined to uphold a foreign privilege that is “generally similar” to a privilege recognized in the forum nation.<sup>355</sup> Finally, for the fourth factor, a foreign privilege should be given effect if \*328 it was relied upon by the parties.<sup>356</sup> Even if the parties were unaware of the existence of the privilege, the court may find reliance if the parties made the communication in reliance upon the fact that similar communications are treated in strict confidence in the foreign nation.<sup>357</sup> Further, the comments suggest that the forum nation should be more inclined to recognize a foreign privilege and exclude the evidence when the privilege is claimed by a non-party to the litigation.<sup>358</sup>

Applying the Restatement to achieve consistent and predictable results can prove difficult.<sup>359</sup> The comments to Section 139(2) provide that the state with “most significant relationship” with a communication will usually be the state “where the communication took place, which as used in [Section 139] is the state where an oral interchange between persons occurred [or] where a written statement was received.”<sup>360</sup> However, these guidelines simply do not reflect the realities of international patent practice. First, a foreign patent practitioner might be communicating internationally using teleconferencing equipment. Second, the nation with the “most significant relationship” would change depending on whether the foreign patent practitioner was sending or receiving communications relating to patent law advice. In *Bayer AG v. Barr Laboratories, Inc.*,<sup>361</sup> a Southern District of New York district court suggested that the nation with the “most significant relationship” would be

either: (1) where the patent agent-client relationship was entered into; or (2) where the patent agent-client relationship was centered at the time of the communication.<sup>362</sup> Under any of these recommendations for determining which nation has the “most significant relationship” to the communication, the results are unpredictable because they do not reflect the realities of international patent practice.

In *VLT Corp. v. Unitrode Corp.*,<sup>363</sup> a U.S. corporation sued for infringement of its U.S. patent.<sup>364</sup> The corporation also owned Japanese, British, and German counterpart patents to the U.S. patent in suit.<sup>365</sup> A U.S. patent attorney representing the plaintiff communicated with a Japanese patent agent (“benrishi”) requesting analysis and advice regarding the effect of newly discovered prior art on the validity \*329 of the plaintiff’s Japanese patent.<sup>366</sup> Later, an officer of the U.S. corporation sent one letter addressed to three different addressees, a U.S. patent attorney, a British patent agent, and a German attorney, regarding the effect of a prior art German patent on the validity of each of the U.S., British, and German patents.<sup>367</sup> Evidence showed that the officer expected each patent practitioner to provide legal advice regarding the patent law of their respective countries.<sup>368</sup> A Massachusetts district court applied the “direct and compelling interest” approach as follows:

If, as the parties appear to agree, a communication has nothing to do with the United States or, in the court’s view, only an incidental connection to this country, the privilege issue will be determined by the law of the foreign nation. If, however, the communication has more than an incidental connection to the United States, the court will undertake a more traditional analysis and defer to the law of privilege of the nation having the most direct and compelling interest in the communication or, at least, that part of the communication which mentions the United States. Such interest will be determined after considering the parties to and the 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>369</sup>

Based upon this approach, the court determined that the letter from the U.S. patent attorney to the Japanese patent agent had only an incidental connection with the United States “hardly amount[ing] to a justification for the application of anything but Japanese law on privilege.”<sup>370</sup> And even if the connection was more than incidental, the court would still determine that Japan had the “direct and compelling interest” in the communication since the letter was clearly limited to Japanese legal issues.<sup>371</sup> The court concluded that Japanese privilege law would protect confidential communications with Japanese patent agents, and application of Japanese law would not violate the public policy of the United States.<sup>372</sup> Regarding the letter from the corporation’s officer to the U.S. patent attorney, British patent agent, and German attorney, the defendant did not contest that the privilege would apply to the \*330 U.S. and German attorneys.<sup>373</sup> However, the defendant asserted that the attorney-client privilege did not apply to the letter because it requested legal advice from a non-attorney British patent agent.<sup>374</sup> Applying its own version of the “direct and compelling interest” approach, the court determined that the privilege law of the United Kingdom should apply because the communication concerned British patent law and proceeding before the British patent office.<sup>375</sup> The court concluded that the laws of the United Kingdom would protect confidential communications with the British patent agent.<sup>376</sup>

While the “most direct and compelling” approach purports to provide a more comprehensive choice of law analysis than the “touching base” approach, the determination of which nation’s privilege law to apply is the same. When communications with foreign patent practitioners relate to the assistance in filing foreign patent applications, courts look to the law of the foreign nation in which the foreign patent application is filed.<sup>377</sup> The exception to the rule involves patent applications filed in the European Patent Office, where courts have looked to the country where the patent agent was located.<sup>378</sup> Further, when communications with foreign patent practitioners relate to legal advice on the patent law of the patent agent’s country or relate to litigation in the patent agent’s country, courts look to the law of the foreign nation in which the foreign patent practitioner is authorized to practice patent law.<sup>379</sup>

\*331 In *Aktiebolag v. Andrx Pharmaceuticals, Inc.*,<sup>380</sup> a Southern District of New York district court had to delve deep into substantive foreign law to apply the “most direct and compelling interest” approach. The court protected communications between a foreign client and its Korean attorneys, even though the laws of Korea did not provide for an attorney-client privilege analogous to the privilege recognized in the United States.<sup>381</sup> In Andrx, a Swedish corporation’s in-house counsel and employees communicated with Korean attorneys regarding patent litigation pending in the Korean courts and patent proceedings before the Korean Intellectual Property Office (“KIPO”).<sup>382</sup> The litigation documents contained advice and requests for advice regarding Korean court procedure, KIPO procedure, discussions of strategy regarding Korean legal proceedings, confidential communications between Swedish employees and consulting experts in the Korean litigation, and other confidential information prepared for the purpose of providing or soliciting legal advice.<sup>383</sup> The defendant sought production of all of these documents for use against the plaintiff in U.S. patent litigation.<sup>384</sup> The court observed that principles

of comity limited the court's inquiry to a determination of whether Korean law provided an attorney-client privilege protecting the documents at issue from disclosure in Korean legal proceedings.<sup>385</sup> The court further noted that if no privilege was provided by Korean law, none could be implied.<sup>386</sup> While Korean statutes excused attorneys from revealing secrets and confidences of their clients while testifying in court, the court recognized that the “‘fact that a [foreign] statute requires a party to keep a client’s affairs secret does not mean that a privilege exists,’ and that, even in the United States, there are confidentiality requirements in the law that ‘do not create a privilege equivalent to the attorney/client privilege.’”<sup>387</sup> Since Korean law did not provide for any kind of attorney-client privilege covering the documents at issue, the documents could not be shielded from production on that basis.<sup>388</sup>

However, this did not end the court's inquiry. Continuing with its analysis, the court observed that the lack of a Korean attorney-client privilege rested on the \*332 erroneous assumption that parties to a Korean lawsuit can be compelled by a Korean court to testify or produce documents concerning confidential communications.<sup>389</sup> While Korean courts may compel production of documents under specific limited circumstances, the communication at issue in Andrx could not be ordered produced under Korean law in Korean legal proceedings.<sup>390</sup> Thus, the court stated that if it were to apply both aspects of Korean law - lack of privilege and limited discovery - to the question of whether the documents should be produced in this case, the court would not require production of any of the challenged documents.<sup>391</sup>

The defendant apparently wanted it both ways. While arguing that substantive Korean privilege law, or the lack thereof, should be applied under choice-of-law principles, the defendant argued that it would be improper to apply Korean discovery law, since law regarding document disclosure is procedural.<sup>392</sup> The Court agreed with the defendant that discovery of the Korean documents was governed by the Federal Rules of Civil Procedure, but it did not agree “that the absence of Korean attorney-client privilege . . . require[d] this court to order the wholesale production of all of the Korean documents in their entirety.”<sup>393</sup>

To do so would violate principles of comity and would offend the public policy of this forum. The fact is that vastly different discovery practices, which permit only minimal discovery, are applicable to civil suits conducted in Korea. Indeed, none of the documents at issue here would be discoverable in a Korean civil suit. Under these circumstances, where virtually no disclosure is contemplated, it is hardly surprising that Korea has not developed a substantive law relating to attorney-client privilege and work product that is co-extensive with our own law. It also seems clear that to apply Korean privilege law, or the lack thereof, in a vacuum-without taking account of the very limited discovery provided in Korean civil cases-would offend the very principles of comity that choice-of-law rules were intended to protect.<sup>394</sup>

The court rejected such “mechanical or overbroad rules of thumb” that did not balance the interests involved and failed to consider the facts and circumstances of the particular case.<sup>395</sup>

Further, ordering discovery without any protection also offends the public policy of this forum, which promotes full discovery but, at the same time, prevents disclosure of privileged documents. If the court were to rule without taking Korea’s discovery practices into account, the court would be required to order complete disclosure of all of the Korean documents, many of which would be protected under either the attorney-client \*333 privilege or work product doctrine as applied in this jurisdiction. Contrary to the policies of upholding or expanding privilege to protect documents whenever they would be protected in other countries, . . . application of foreign privilege law in this case would require disclosure of many documents (1) that are protected from disclosure under American law and (2) that would not be discoverable under Korean law.<sup>396</sup>

Since application of Korean privilege law would violate the public policy of the United States, the court concluded that it would apply U.S. privilege law to the Korean documents, even though the communications did not “touch base” with the United States.<sup>397</sup> As a result, the court held that the communications were protected by the attorney-client privilege.<sup>398</sup>

Andrx is the latest case reflecting the evolution of the “most direct and compelling interest” approach. Andrx’s “direct and compelling interest” approach is not quite the same as the approach applied in *Golden Trade*.<sup>399</sup> The Andrx court appears to have applied Section 139(1), rather than Section 139(2), of the Restatement. Section 139(1) of the Restatement provides that evidence that is not privileged under the law of the foreign nation with the “most significant relationship with the communication” should be admitted, even though the evidence would be privileged under the law of the forum nation, unless the forum nation’s interest outweighs the foreign nation’s policy interests.<sup>400</sup> The comments to Section 139(1) suggest that when the nation that does not have the “most significant relationship” with the communication does have “a substantial relationship to the parties and the transaction and a real interest in the outcome of the case[,]” then the application of Section 139(1) may be justified.<sup>401</sup> Further, on “still rarer occasions,” the forum nation might consider a given privilege “sacrosanct”

and therefore not permit introduction of the evidence even though the forum nation “has no relationship to the transaction and the privilege was not recognized in the [foreign nation] of most significant relationship.”<sup>402</sup>

However, even if one agreed that the attorney-client privilege was “sacrosanct,” and that the Andrx court was applying Section 139(1), this does not account for the court’s statement that the U.S. attorney-client privilege, by itself, protects confidential communications between a client and a Korean attorney made for the \*334 purpose of obtaining or providing patent law advice.<sup>403</sup> Further, the application of Section 139(1) alone does not account for the Andrx court’s additional statement that confidential communications between clients and German patent attorneys and patent agents are privileged when made for the purpose of obtaining or providing patent law advice.<sup>404</sup> Neither of these statements could be true unless the Andrx court considered Korean attorneys, German patent attorneys, and German patent agents to be full equivalents of U.S. attorneys for purposes of the federal common law of attorney-client privilege.<sup>405</sup>

### **C. Burden of Proof Associated with Choice of Law Approaches**

Normally, the party seeking to withhold confidential materials from discovery bears the burden of proof as to each element of the attorney-client privilege.<sup>406</sup> “Meeting that burden requires the submission of affidavits or other competent evidence to establish sufficient facts to prove the applicability of the privilege,”<sup>407</sup> since conclusory assertions will not suffice.<sup>408</sup> Choice of law approaches require the party asserting the attorney-client privilege to provide the court with the applicable foreign law and to demonstrate that the privilege applies to the documents that the party seeks to exclude from discovery.<sup>409</sup> This normally requires U.S. litigation counsel to not only locate competent foreign law experts, but communicate with them regarding a legal concept to which there is often no foreign counterpart.<sup>410</sup> Also, U.S. litigation counsel must provide English translations for every \*335 foreign document for which a privilege is asserted.<sup>411</sup> In complex patent litigation, this burden is enormously expensive and often insurmountable.<sup>412</sup> Further, discovery disputes can consume a great amount of a district court’s time, since the court must sift through document after document to determine whether the privilege applies, as well as to prepare written findings regarding specific document categories.<sup>413</sup> As a result, opponents of the attorney-client privilege in U.S. patent litigation are encouraged to require proof that the attorney-client privilege applies to each and every document related to foreign legal practitioners, since the present law allows them to increase the other party’s attorney’s fees and expenses at a comparatively low cost to their clients.

## **IV. Proposal for a Uniform Federal Common Law of Attorney-Client Privilege Relating to Communications with U.S. and Foreign Patent Practitioners**

Rule 501 of the Federal Rules of Evidence provides little guidance to courts and practitioners faced with the issue of whether the federal attorney-client privilege should apply to communications with U.S. patent agents and foreign patent practitioners, since it provides that “the privilege of a witness . . . shall be governed by the principles of the common law as they may be interpreted by the courts of the United States in the light of reason and experience.”<sup>414</sup> As a result, most district courts take one of two courses of action. Many courts treat the common law of attorney-client privilege as stagnant and unyielding to new circumstances.<sup>415</sup> Other courts expand the attorney-client privilege by attempting to incorporate foreign law into the federal common law.<sup>416</sup> Neither of these approaches recognize that the federal common law of privilege has evolved and should continue to evolve to provide just and predictable results.<sup>417</sup>

**\*336** A uniform federal common law of attorney-client privilege should be adopted so that in U.S. patent litigation, the same attorney-client privilege law applies regardless of whether the client is foreign or domestic, the patent practitioner is foreign or domestic, or whether the patent is foreign or domestic. When determining whether confidential communications made in furtherance of the rendition of legal services are protected by the attorney-client privilege in U.S. patent litigation, no conflict of laws analysis should be required. The adoption of a uniform federal common law of attorney-client privilege will require the expansion of the privilege to include: (1) confidential communications between clients and persons authorized to practice patent law by the United States Patent and Trademark Office (U.S. patent attorneys and agents); and (2) confidential communications between clients and persons authorized to practice patent law by the patent office of any nation (foreign patent attorneys and agents).

### **A. Analysis of Jaffee v. Redmond Supports the Expansion of the Attorney-Client Privilege to Include U.S. Patent Agents and Foreign Patent Practitioners**

In the landmark case of *Jaffee v. Redmond*,<sup>418</sup> the Supreme Court extended the federal privilege associated with psychiatrists and psychologists to include confidential communications with licensed social workers in the course of psychotherapy.<sup>419</sup> The Supreme Court made it clear that Rule 501's general mandate "authorizes federal courts to define new privileges by interpreting 'common law principles . . . in the light of reason and experience.'"<sup>420</sup> In other words, Congress manifested an affirmative intention that Rule 501 "did not freeze the law governing the privileges of witnesses in federal trials at a particular point in our history, but rather directed federal courts to 'continue the evolutionary development of testimonial privileges.'"<sup>421</sup>

Guided by these principles, the proper question for the courts to address is whether an extension of the attorney-client privilege to include confidential communications between clients and U.S. patent agents, foreign patent attorneys, and foreign patent agents "promotes sufficiently important interests to outweigh the need for probative evidence."<sup>422</sup> The Supreme Court established a three-part test to determine whether "reason and experience" would support an expanded privilege. \*337 First, the proposed privilege should serve "important private interests."<sup>423</sup> Second, the proposed privilege should also "serv[e] public ends."<sup>424</sup> Third, the likely evidentiary benefit that would result from the denial of the privilege should be modest.<sup>425</sup> If the three requirements can be met, an expanded privilege may be warranted.

It is well established that the attorney-client privilege protects important private interests. In *Jaffee*, the Supreme Court used the attorney-client privilege as an example of the important private interests served by exclusionary privileges.<sup>426</sup> The same rationale applies with equal force to U.S. patent agents and foreign patent practitioners.

U.S. patent agents are registered to practice patent law before the United States Patent and Trademark Office.<sup>427</sup> Registration in the USPTO does not authorize the general practice of law, but sanctions only the performance of those services which are reasonably necessary and incidental to the preparation and prosecution of patent applications.<sup>428</sup> These activities include: (1) advising clients regarding the patentability of their inventions under U.S. patent law; (2) advising clients regarding alternate forms of protecting inventions; (3) participating in the drafting of the specification and claims of the patent application; and (4) preparation of amendments, which may require written arguments to establish the patentability of claimed inventions in light of the patent law and the prior art.<sup>429</sup> In the eyes of the USPTO, there is no significant difference between patent attorneys and patent agents either regarding their ability to handle the work or with respect to their ethical conduct.<sup>430</sup> Also, under 37 C.F.R. Section 10.57, both U.S. patent attorneys and patent agents are required to protect their client's confidences and secrets.<sup>431</sup>

Similarly, foreign patent attorneys and patent agents are licensed to practice patent law in their respective jurisdiction's patent office. In many foreign countries, patent agents are the only practical source for legal services and advice regarding patent rights in foreign patent offices.<sup>432</sup> While the legal systems in some countries recognize an attorney-client privilege for patent attorneys and agents, the concept of an evidentiary privilege is totally non-existent in many others.<sup>433</sup> In many countries, there is no need to recognize an evidentiary privilege to protect certain communications because the country does not allow discovery for those communications regardless of a privilege.<sup>434</sup> Regardless of whether a country's laws recognize the legal concept of attorney-client privilege, patent practitioners everywhere are required to maintain the confidences of their clients.<sup>435</sup>

A client of a U.S. patent agent, foreign patent attorney, or foreign patent agent will benefit by application of the federal common law of attorney-client privilege to its confidential communications made for the purpose of obtaining or providing patent law advice. The knowledge that such communications are protected by the attorney-client privilege from involuntary disclosure in U.S. patent litigation will allow clients to communicate freely with their patent agents so that the patent agents are able to provide effective legal advice.<sup>436</sup> By protecting confidential communications between a client and its U.S. patent agent, foreign patent attorney, or foreign patent agent, an expanded attorney-client privilege thus serves important private interests.

Public ends must also be served before an expanded attorney-client privilege can be recognized.<sup>437</sup> Again, *Jaffee* used the attorney-client privilege as a prime example of the public ends served by exclusionary privileges.<sup>438</sup> As discussed above, an expanded attorney-client privilege serves the public interest by encouraging "full and frank communications" between a client and its U.S. patent agent, foreign patent attorney, or foreign patent agent.<sup>439</sup> Such communication promotes \*339 "broader public interests in the observance of law and administration of justice."<sup>440</sup> Thus, public ends are also served by expansion of the attorney-client privilege.

The likely evidentiary benefit that would result from the denial of the privilege would be modest. Without a privilege, much

of the desirable evidence to which litigants seek access, for example, admissions against interest found in confidential written communications from clients to their patent practitioners simply would not exist, either because the evidence never came into being or because clients were subsequently advised to implement an aggressive document retention policy. In fact, a clear determination that the privilege does not apply to U.S. patent agents and foreign patent practitioners is likely to have more effect on the patent practitioner's conduct, as they are in a better position to understand the concept of the attorney-client privilege.<sup>441</sup> As more patent practitioners become aware of the non-privileged nature of communications between themselves and their clients, they may advise their clients to take proactive steps to ensure that confidential communications would not be created. This unwritten "evidence" would therefore serve no greater truth-seeking function than if it had been written and privileged. If the privilege were rejected, confidential communications and disclosures between clients and their U.S. patent agents and foreign patent practitioners would be chilled, particularly in cases where clients are concerned with patentability due to close prior art or were anticipating future patent litigation in the U.S. courts. If the privilege is expanded in a uniform way to include confidential communications with U.S. patent agents and foreign patent practitioners, the privilege will benefit all clients, whether plaintiff or defendant, in U.S. patent litigation. A uniform expansion of the attorney-client privilege as proposed in this thesis will provide predictability regarding which communications are privileged, will avoid substantial legal fees incurred in discovery disputes, and will promote judicial economy.

## **B. The Proposed Uniform Federal Common Law of Attorney-Client Privilege Expands the Definition of Lawyer**

To provide for a uniform federal common law of privilege in U.S. patent litigation, the federal common law of attorney-client privilege must continue to evolve. Since the analysis of Jaffee supports expansion of the attorney-client privilege to include communications with U.S. patent agents and foreign patent practitioners, the next question is how best to define a new uniform federal common law of privilege. The analysis begins with adoption of the general rule of privilege recommended by the Supreme Court in Proposed Rule 503(b)<sup>442</sup> or the more up-to- \*340 date rule provided by Uniform Rule of Evidence 502(b),<sup>443</sup> instead of the outdated and incomplete Wigmore or United Shoe definitions. Jaffee indicated that the fact that a privilege was included among the nine specific privileges recommended by the Advisory Committee in its Proposed Rules further supports its adoption.<sup>444</sup> Second, the terms "legal advisor," "lawyer," or "attorney" in the attorney-client context would be defined broadly to include persons authorized, or whom the client reasonably believes to be authorized, to practice law in any state or nation. This approach finds support in the Rules of Evidence for United States Courts and Magistrates that the U.S. Supreme Court recommended to Congress in 1972,<sup>445</sup> the Uniform Rules of Evidence since 1974,<sup>446</sup> the American Law Institute's Restatement (Third) of The Law Governing Lawyers promulgated in 2000,<sup>447</sup> the Rules of Evidence of many states,<sup>448</sup> and Dean Wigmore's Evidence treatise.<sup>449</sup> Even though Congress rejected Proposed Rule 503 in favor of Rule 501's general mandate, the Senate Report accompanying the 1975 adoption of the Rules does not indicate that the Proposed Rule 503's definition of "lawyer" was controversial in any manner whatsoever.<sup>450</sup> Third, the term "representative of the lawyer" would be defined as \*341 "a person employed, or reasonably believed by the client to be employed, by the lawyer to assist the lawyer in rendering professional legal services."<sup>451</sup> Fourth, since Proposed Rule 503 did not define "representative of the client," the proposed uniform federal common law of attorney-client privilege would adopt the definition found in Uniform Rule of Evidence 502(b)(4), which provides that a "representative of the client" is "a person having authority to obtain professional legal services, or to act on legal advice rendered, on behalf of the client or a person who, for the purpose of effectuating legal representation for the client, makes or receives a confidential communication while acting in the scope of employment for the client."<sup>452</sup>

These definitions would have many implications in U.S. patent litigation, as discussed below.

### **1. "Lawyer" Includes a Foreign Attorney; "Representative of the Lawyer" and "Representative of the Client" are Clarified**

Adoption of Proposed Rule 503's definition of "lawyer" would immediately provide that confidential communications between clients and foreign attorneys made for the purpose of obtaining or providing legal advice are protected by the federal common law of attorney-client privilege. As a result, the courts could avoid "excursion into conflict of laws questions" altogether when domestic or foreign attorneys were involved in the provision of legal services.<sup>453</sup> Clear definitions of "representative of the lawyer" and "representative of the client" would provide certainty to clients, attorneys, agents, and courts, when other individuals were involved in providing professional legal services to the client.

For example, confidential communications between a German patent attorney and a U.S. client made for the purpose of obtaining or providing legal services would be protected by the attorney-client privilege. Similarly, communications between a U.S. client and a German patent agent, who worked for a German attorney, would be covered by the privilege, because the

patent agent is a “representative of the lawyer.” Further, if a U.S. corporation hired a U.S. patent agent to coordinate patent protection in the European Union with a German patent attorney, communications between the U.S. patent agent and the German patent attorney would be \*342 privileged, since the U.S. patent agent was acting as the representative of the client and the German attorney was acting as the client’s lawyer. Additionally, if a U.S. corporation hired a U.S. patent attorney to coordinate patent protection in the European Union with a British patent agent, communications between the U.S. patent attorney and the British patent agent would be privileged, since the U.S. patent agent was acting as the client’s attorney and the British patent agent was acting as the representative of the lawyer.<sup>454</sup> Finally, if a U.S. corporation was involved in patent infringement litigation in the United States and the European Union, confidential communications among the corporation and its outside U.S. and E.U. litigation attorneys would be protected by the federal common law of privilege.

In an international patent prosecution and litigation environment, Proposed Rule 503, in combination with Uniform Rule of Evidence 502, protects confidential communications among the clients, the lawyers, the representatives of the lawyers, and the representatives of the clients. Arguably, use of Proposed Rule 503’s definition of “lawyer,” which explicitly extends the attorney-client privilege to foreign patent attorneys, extends the privilege to U.S. and foreign patent agents. However, the following two sections provide additional support for extending the privilege to U.S. and foreign patent agents.

## 2. Patent Agents Practicing Patent Law within the Scope of their Authorization are “Lawyers” for Purposes of the Attorney-Client Privilege

Patent agents practicing patent law within the scope of their authorization should be considered “lawyers” for purposes of the attorney-client privilege. In *Sperry v. Florida*,<sup>455</sup> the Supreme Court explained that registered U.S. patent attorneys and patent agents are members of the U.S. Patent Bar:

The rights conferred by the issuance of letters patent are federal rights. It is upon Congress that the Constitution has bestowed the power ‘To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries,’ [U.S. Const.] Art. I, § 8, cl. 8, and to take all steps necessary and proper to accomplish that end, [U.S. Const.] Art. I, § 8, cl. 18, pursuant to which the Patent Office and its specialized bar have been established.<sup>456</sup>

Patent law is a limited field of law where the USPTO’s powers under 35 U.S.C. Sections 2(b)(2)(D) and 32 preempt state law.<sup>457</sup> Under these statutes, the \*343 USPTO “has the exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.”<sup>458</sup> A state may not impose additional licensing requirements beyond those required by federal law to permit a patent agent to practice before the USPTO.<sup>459</sup>

In *Sperry*, the Supreme Court ruled that the preparation and prosecution of patent applications by patent agents for others constitutes the practice of law.<sup>460</sup> The Court also defined the limited scope of a patent agent’s authority to practice law. While being registered in the USPTO does not authorize the general practice of patent law, patent agents are authorized to provide all manner of legal services “reasonably necessary and incident to the preparation and prosecution of patent applications” before the USPTO.<sup>461</sup> In foreign legal systems, patent attorneys and patent agents are similarly authorized by their jurisdiction’s patent office.<sup>462</sup>

According to Dean Wigmore, where an administrative tribunal had the power to create its own bar, courts should extend the attorney-client privilege to members of that bar.<sup>463</sup> The fact that the member was not entitled to practice general law was irrelevant.<sup>464</sup> Other commentators have stated “[i]f the practitioner has been ‘authorized’ to practice before some administrative agency, the privilege can be denied only on the supposition that such activity is not ‘the practice of law.’”<sup>465</sup> If that were true, however, then the attorney-client privilege would not apply even to patent \*344 attorneys if they practiced exclusively before the USPTO.<sup>466</sup> This is not true, of course, in light of Supreme Court and Federal Circuit precedent.<sup>467</sup>

Patent agents should be considered to be lawyers, albeit for a limited purpose. If a patent agent attempts to practice law outside the scope of his authority, the communications would not be privileged because the communications were not made for the purpose of obtaining legal advice.<sup>468</sup> But where patent agents are practicing within the limited field of patent law, there is no logical basis for distinguishing between patent attorneys and patent agents with regard to applying the attorney-client privilege.<sup>469</sup>

To provide for a uniform federal common law of attorney-client privilege, a necessary step is to reject the common law requirement in *United Shoe*’s definition of attorney-client privilege that the attorney-client privilege attaches only between

clients and legal advisors who are members of a bar of a court or his subordinate.<sup>470</sup> This may be accomplished by adopting the general rule of privilege recommended by the Supreme Court in Proposed Rule 503(b)<sup>471</sup> or the more up-to-date rule provided by Uniform Rule of Evidence 502(b).<sup>472</sup> Use of Proposed Rule 503's or Uniform Rule 502's general rule of privilege, as well as their accompanying definitions, includes U.S. and foreign patent agents within the federal common law of attorney-client privilege.

Adoption of Proposed Rule 503 extends the holding of Sperry, which provided that patent agents are authorized to practice patent law, to its logical conclusion - the federal common law of attorney-client privilege protects confidential communications with patent agents, domestic or foreign, made for the purpose of obtaining or providing legal advice in the field of patent law. Since many courts \*345 have been unwilling to extend the holding of Sperry,<sup>473</sup> an unequivocal statement by the Court of Appeals for the Federal Circuit or the U.S. Supreme Court may be necessary stating that, in light of Sperry v. Florida, patent agents, domestic or foreign, are authorized to practice patent law, and thus, patent agents, domestic or foreign, are "lawyers" for purposes of the federal common law of attorney-client privilege when practicing patent law.

### 3. "Lawyer" Includes Those Reasonably Believed by the Client to Be Authorized to Practice Law

Even if courts do not agree that Proposed Rule 503 includes U.S. and foreign patent agents who are practicing patent law within the definition as "lawyer" for purposes of the federal common law of attorney-client privilege, courts should still treat them as "lawyers" for purposes of the attorney-client privilege. The purpose of the privilege is to encourage "full and frank communication" between clients and attorneys that would not occur in the absence of the privilege, so that clients may receive competent and informed legal advice.<sup>474</sup> When a client has a reasonable belief that the U.S. or foreign patent agent is authorized to practice patent law in that jurisdiction, the communication should be protected by the attorney-client privilege.<sup>475</sup> Given the Supreme Court's unequivocal statement that "preparation and prosecution of patent applications [by patent agents] for others constitutes the practice of law[,]"<sup>476</sup> a client's belief that the person is authorized to practice law is *prima facie* reasonable when clients consult with persons who hold themselves out as patent attorneys or patent agents, foreign or domestic. In practice, this means that the initial evidence in U.S. patent litigation required to prove a client's reasonable belief that the person consulted was authorized to practice law should consist of no more than simple production of a letterhead or business card indicating that the person held themselves out as being a patent attorney, a patent agent, or employed by a patent law firm, in any state or nation.<sup>477</sup> While the issue of whether the belief was reasonable may present a fact question as to the client's actual \*346 knowledge, proof of "reasonableness" would not warrant delving into the laws of foreign countries. A client should never be deprived of the attorney-client privilege simply because its reasonable belief turned out to be wrong.<sup>478</sup>

## C. Many States have already Adopted a Broad Definition of "Lawyer" in the Attorney-Client Context

Many states have adopted a broad definition of "lawyer" similar to Proposed Rule 503.<sup>479</sup> In Jaffee, although concerned with the privilege for psychotherapists, the Supreme Court observed that a consensus among state rules recognizing a privilege indicates that "reason and experience" support recognition of the privilege by federal courts.<sup>480</sup> For a client living in a state that has adopted a definition of "lawyer" that is similar to the one in Proposed Rule 503, the client's understanding of the attorney-client privilege, if any, as well as the client's expectations of confidentiality, would have little value if the privilege would not be honored in federal court.<sup>481</sup> Denial of an expanded attorney-client privilege in U.S. patent litigation may tend to negate the purposes of state legislation that was enacted to encourage full disclosure to persons authorized to practice law in any state or nation for the purpose of securing informed legal advice.<sup>482</sup>

Even though all states have not reached a consensus on the definition of "lawyer," this should not prevent federal courts from determining that in light of reason and experience, the attorney-client privilege should be expanded to include confidential communications with U.S. patent agents and foreign patent practitioners in U.S. patent litigation. Because confidential communications made for the \*347 purpose of obtaining or providing legal assistance between clients and persons authorized to practice patent law by the United States Patent and Trademark Office (U.S. patent attorneys and agents) or by the patent office of any nation (foreign patent attorneys and agents) serves a "public good transcending the normally predominant principle of utilizing all rational means for ascertaining truth,"<sup>483</sup> courts must allow the federal common law of attorney-client privilege to evolve by rejecting the common law requirement that the attorney-client privilege attaches only between clients and legal advisors who are members of a bar of a court or subordinates of those persons.<sup>484</sup>

#### D. No Inquiry into the Law of Attorney-Client Privilege of Foreign Countries

Proposed Rule 503's definition of "lawyer" provides that the attorney-client privilege extends to lawyers authorized to practice law anywhere.<sup>485</sup> There is no requirement that a foreign state or nation recognize the attorney-client privilege.<sup>486</sup> Proposed Rule 503's definition recognizes the fact that transactions frequently cross state and national boundaries and require consultation with legal advisors in many different jurisdictions, as is the case with international patent prosecution and litigation practice.<sup>487</sup> A client should not be expected to understand the intricacies of the scope of the attorney-client privilege as applied to domestic and foreign patent practitioners, nor should the client be forced to inquire into the details of foreign law to determine whether the attorney-client privilege exists, before the client can safely communicate with the patent practitioner.<sup>488</sup> For example, when an in-house counsel for a Delaware corporation with its principal offices in California seeks patent prosecution advice from patent attorneys located in New York, Paris, and Tokyo, the client should be entitled to assume that its confidential communications will be given as much protection as they would if the client had consulted California lawyers in California.

This position is consistent with the Restatement (Third) of The Law Governing Lawyers (2000):

**\*348** More recent codes and this Section do not require that the lawyer's home jurisdiction recognize the privilege. Because the privilege focuses on a lay client's reasonable belief, it would be incongruous to protect the client's intended confidences only if the law of another state or nation recognizes the privilege - a matter on which most clients would have no information or reason to inquire.<sup>489</sup>

Because Proposed Rule 503's broad definition of "lawyer" makes it unnecessary to inquire whether the licensing state or nation recognizes the attorney-client privilege, the Advisory Committee noted that this definition avoids "excursions into conflict of law questions."<sup>490</sup>

#### Conclusion

A uniform federal common law of attorney-client privilege in U.S. patent litigation can be developed slowly through the U.S. district courts, appealed to various regional circuit courts of appeal, and eventually established by the U.S. Supreme Court. On the other hand, the issue may be addressed more quickly and have a more immediate effect upon the legal practice of patent practitioners worldwide if it were decided by the Court of Appeals for the Federal Circuit. Since the Federal Circuit is the appellate court charged with "a duty of increasing doctrinal stability in the field of patent law,"<sup>491</sup> the Federal Circuit should cut the Gordian knot associated with whether the federal common law of attorney-client privilege protects confidential communications between clients and their U.S. patent agents and/or foreign patent practitioners. The Federal Circuit should adopt Proposed Rule 503's broad definition of "legal advisor," "lawyer," or "attorney" in the attorney-client privilege context to include a person authorized, or reasonably believed by the client to be authorized, to practice law in any state or nation. Also, the Federal Circuit should adopt Proposed Rule 503's or Uniform Rule 502's general rule of privilege, which eliminates the common law requirement that "legal advisors" must be members of a bar or his subordinate. Finally, the Federal Circuit should clarify that, in light of *Sperry v. Florida*, patent agents, domestic or foreign, are authorized to practice patent law, and thus, patent agents, domestic or foreign, are "lawyers" for purposes of the federal common law of attorney-client privilege when practicing patent law. As a result, confidential communications made for the purpose of obtaining or providing legal assistance between clients and persons authorized to practice patent law by the United States Patent and Trademark Office (U.S. patent attorneys and agents) or by the patent office of any nation (foreign patent attorneys and agents) would be protected by the federal common law of attorney-client privilege.<sup>492</sup> Courts would not look to the privilege law of a foreign nation as a matter of comity in determining the contours of the federal common law of attorney-client privilege in U.S. patent litigation. The adoption of a uniform federal common law of attorney-client privilege in U.S. patent litigation would result in greater predictability regarding the application of the privilege, fewer disputes between the parties regarding the scope of discovery, reduced attorney's fees and expenses to the clients, and conservation of judicial resources.

#### Footnotes

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<sup>1</sup> This hypothetical is based on *Status Time Corp. v. Sharp Elecs. Corp.*, 95 F.R.D. 27, 31-32 (S.D.N.Y. 1982), discussed in more detail in Part IV.A.1.

<sup>2</sup> This hypothetical is based on *Foseco Int'l Ltd. v. Fireline, Inc.*, 546 F. Supp. 22, 25-26 (N.D. Ohio 1982), discussed in more detail in Part IV.B.1, *Glaxo, Inc. v. Novopharm Ltd.*, 148 F.R.D. 535, 538-39 (E.D.N.C. 1993), and *Chubb Integrated Sys. Ltd. v. Nat'l Bank of Wash.*, 103 F.R.D. 52, 64-66 (D.D.C. 1984).

<sup>3</sup> This hypothetical is based on *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 95-98 (S.D.N.Y. 2002), discussed in more detail in Part IV.B.3.

<sup>4</sup> 37 C.F.R. §§ 10.56-57 (2005) (regulating U.S. patent attorneys and patent agents); Model Rules of Prof'l Conduct R. 1.6 (2001); Model Code of Prof'l Responsibility Canon 4 (1986); Model Code of Prof'l Responsibility DR 4-101(B) (1986).

<sup>5</sup> “[I]nstructions to foreign patent agents and representations to foreign patent offices may be relevant to the construction or validity of the United States patent....” *Baxter Travenol Labs., Inc. v. Abbott Labs.*, No. 84 C 5103, 1987 WL 12919, at \*7 (N.D. Ill. June 19, 1987).

<sup>6</sup> See, e.g., *Aktiebolag*, 208 F.R.D. at 99-105 (seeking production of communications between Korean attorney and U.S. client related to Korean patent infringement case); *Johnson Matthey, Inc. v. Research Corp.*, No. 01Civ.8115MBMFM, 2002 WL 1728566, at \*8-9 (S.D.N.Y. July 24, 2002) (while not a patent infringement case, defendant sought communications between plaintiff and British patent agents related to a license of right proceeding in British courts).

<sup>7</sup> See, e.g., *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805-806 (Fed. Cir. 2000) (an invention record prepared and submitted primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application is privileged in its entirety).

<sup>8</sup> A patent agent is a person who is registered to practice before the United States Patent & Trademark Office (“USPTO”), but who is not an attorney. 37 C.F.R. § 11.6(b) (2005). The requirements for registration for patent attorneys and agents are identical. See 37 C.F.R. § 11.7 (2005). Only practitioners registered before the USPTO may prosecute patent applications. 37 C.F.R. § 11.10(a) (2005). Patent agents are not authorized to practice in trademark or other non-patent cases. 37 C.F.R. § 10.14 (2005).

<sup>9</sup> *Upjohn Co. v. United States*, 449 U.S. 383, 393 (1981).

<sup>10</sup> See discussion *infra* Part IV.A.

<sup>11</sup> See *infra* note 445 and accompanying text.

<sup>12</sup> See *infra* note 446 and accompanying text.

<sup>13</sup> See *infra* note 447 and accompanying text.

<sup>14</sup> See *infra* note 479 and accompanying text.

<sup>15</sup> See *infra* note 449.

<sup>16</sup> 379 U.S. 379 (1963).

<sup>17</sup> *Id.* at 385.

<sup>18</sup> *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981) (citing 8 John H. Wigmore, *Evidence in Trials at Common Law* § 2290, at 542 (John T. McNaughton ed., rev. 1961) [hereinafter Wigmore]).

<sup>19</sup> *Trammel v. United States*, 445 U.S. 40, 51 (1980); Wigmore, *supra* note 18, § 2290, at 542 & § 2291, at 545.

<sup>20</sup> *Upjohn*, 449 U.S. at 390 (“[T]he privilege exists to protect not only the giving of professional advice to those who can act on it but also the giving of information to the lawyer to enable him to give sound and informed advice.”); *Fisher v. United States*, 425 U.S. 391, 403 (1976) (“Confidential disclosures by a client to an attorney made in order to obtain legal assistance are privileged.”) (citing Wigmore, *supra* note 18, § 2292, at 554).

<sup>21</sup> *Fisher*, 425 U.S. at 403; *United States v. Nixon*, 418 U.S. 683, 709-10 (1974) (asserting that the attorney-client privilege excludes relevant evidence and stands “in derogation of the search for the truth”).

<sup>22</sup> Wigmore, *supra* note 18, § 2292, at 554; see also *United States v. Evans*, 113 F.3d 1457, 1461 (7th Cir. 1997) (quoting Wigmore definition); *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 103 (S.D.N.Y. 2002) (citations omitted).

<sup>23</sup> Wigmore, *supra* note 18, § 2320, at 628-29.

<sup>24</sup> *Upjohn*, 449 U.S. at 390.

<sup>25</sup> See, e.g., *Cavallaro v. United States*, 284 F.3d 236, 245 (1st Cir. 2002) (citing *United States v. Massachusetts Inst. of Tech.*, 129 F.3d 681, 684 (1st Cir. 1997) (quoting Wigmore definition)).

<sup>26</sup> See, e.g., *In re Richard Roe, Inc.*, 68 F.3d 38, 39-40 (2d Cir. 1995) (quoting *United States v. Kovel*, 296 F.2d 918, 921 (2d Cir. 1961) (quoting Wigmore definition)).

<sup>27</sup> See, e.g., *Reed v. Baxter*, 134 F.3d 351, 355-56 (6th Cir. 1998) (citing *Fausek v. White*, 965 F.2d 126, 129 (6th Cir. 1992)). The *Fausek* case cites to *United States v. Goldfarb*, 328 F.2d 280, 281 (6th Cir. 1964) (quoting Wigmore definition).

<sup>28</sup> See, e.g., *United States v. Evans*, 113 F.3d 1457, 1461 (7th Cir. 1997) (quoting Wigmore definition). “This Circuit has long embraced the articulation of the attorney-client privilege first set forth by Dean Wigmore in his 1904 treatise *Evidence in Trials at Common Law*.” *Id.* (citing *United States v. White*, 950 F.2d 426, 430 (7th Cir. 1991); *United States v. Keplinger*, 776 F.2d 678, 700 (7th Cir. 1985); *Radiant Burners, Inc. v. American Gas Ass’n*, 320 F.2d 314, 318-319 (7th Cir. 1963) (en banc)).

<sup>29</sup> See, e.g., *Hanes v. Dormire*, 240 F.3d 694, 717 (8th Cir. 2001) (quoting *Fischel v. Margolis*, 557 F.2d 209, 211 (9th Cir. 1977) (quoting Wigmore definition)). But see *In re Bieter Co.*, 16 F.3d 929, 935 (1994) (quoting Proposed Rule 503(b) discussed *infra* Part I.A.3).

<sup>30</sup> See, e.g., *United States v. Martin*, 278 F.3d 988, 999 (9th Cir. 2002) (quoting Wigmore definition).

<sup>31</sup> Fisher v. United States, 425 U.S. 391, 403 (1976) (“Confidential disclosures by a client to an attorney made in order to obtain legal assistance are privileged.”) (citing Wigmore, *supra* note 18, § 2292, at 554; Charles T. McCormick, *Evidence* § 87, at 175 (Edward W. Cleary ed., 2d ed. 1972) [hereinafter McCormick 2d]).

<sup>32</sup> 89 F. Supp. 357 (D. Mass. 1950).

<sup>33</sup> *Id.* at 358-59.

<sup>34</sup> See *id.*

<sup>35</sup> See Gregg F. LoCascio, Note, *Reassessing Attorney-Client Privileged Legal Advice in Patent Litigation*, 69 *Notre Dame L. Rev.* 1203, 1228-30 (1994).

<sup>36</sup> *Upjohn Co. v. United States*, 449 U.S. 383, 390 (1981).

<sup>37</sup> See 24 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice and Procedure* § 5480, at 242 (1986) (“This was the common law rule.”); 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3:2 & n.13 (2d ed. 1999), WL ACPRI-FED § 3:2.

<sup>38</sup> See, e.g., *Rhone-Poulenc Rorer Inc. v. Home Indem. Co.*, 32 F.3d 851, 862 (3d Cir. 1994) (citing *In re Grand Jury Investigation*, 599 F.2d 1224, 1233 (3d Cir. 1979) (citing *United Shoe*)). But see *United States v. Rockwell Int’l*, 897 F.2d 1255, 1264 (3d Cir. 1990) (applying Wigmore definition) (citing *United States v. El Paso Co.*, 682 F.2d 530, 538 n.9 (5th Cir. 1982)).

<sup>39</sup> See, e.g., *In re Grand Jury Subpoena*, 341 F.3d 331, 335 (4th Cir. 2003) (quoting *United States v. Jones*, 696 F.2d 1069, 1072 (4th Cir. 1982) (per curiam) (quoting the “classic” *United Shoe* definition)); But see *United States v. Tedder*, 801 F.2d 1437, 1441-42 (4th Cir. 1986) (citing *NLRB v. Harvey*, 349 F.2d 900, 904 (4th Cir. 1965)) (Tedder and Harvey quote both the Wigmore definition and the *United Shoe* definition, referring to both as “straightforward definitions.”); *United States v. (Under Seal)*, 748 F.2d 871, 874 n.5 (4th Cir. 1984) (quoting Proposed Rule 503(b) discussed *infra* Part I.A.3).

<sup>40</sup> See, e.g., *United States v. Robinson*, 121 F.3d 971, 974 (5th Cir. 1997) (“The assertor of the lawyer-client privilege must prove: (1) that he made a confidential communication; (2) to a lawyer or his subordinate; (3) for the purpose of securing either a legal opinion or legal services, or assistance in some legal proceeding.”) (citing *United States v. Neal*, 27 F.3d 1035, 1048 n.24 (5th Cir. 1994); *In re Grand Jury Proceedings*, 517 F.2d 666, 670 (5th Cir. 1975) (quoting *United Shoe*)). Despite the *United Shoe* definition’s shortcomings, the court in *In re Grand Jury Proceedings* quoted to the *United Shoe* definition with the caveat “[W]e utilize this description solely because of Judge Wyzanski’s comprehensiveness, and not because it is any more accurate than a number of other widely-accepted general formulations.” 517 F.2d at 670 (citing Wigmore, *supra* note 18, § 2292, at 554; McCormick 2d, *supra* note 31, §§ 87-88, at 175-182). But see *United States v. El Paso Co.*, 682 F.2d 530, 538 n.9 (5th Cir. 1982) (quoting Wigmore definition).

<sup>41</sup> See, e.g., *In re Grand Jury (G.J. No. 87-03-A)*, 845 F.2d 896, 897 (11th Cir. 1988) (citing *United States v. Kelly*, 569 F.2d 928, 938 (5th Cir. 1978) (quoting *In re Grand Jury Proceedings*, 517 F.2d at 670 (quoting *United Shoe* definition)); *In re Federal Grand Jury Proceeding*, 89-10 (MIA), 938 F.2d 1578, 1581 (11th Cir. 1991) (citing *In re Grand Jury Proceedings*, 517 F.2d at 670 (quoting *United Shoe* definition)).

<sup>42</sup> See, e.g., *In re Lindsey*, 158 F.3d 1263, 1270 (D.C. Cir. 1998) (citing *In re Sealed Case*, 737 F.2d 94, 98-99 (D.C. Cir. 1984) (per curium) (quoting *United Shoe* definition).

<sup>43</sup> Rules of Evidence for United States Courts and Magistrates, 56 F.R.D. 183 (1972); *Jaffee v. Redmond*, 518 U.S. 1, 9 n.7 (1996).

<sup>44</sup> Jaffee, 518 U.S. at 9 n.7 (citing Trammel, 445 U.S. at 47).

<sup>45</sup> Id. (citing Proposed Rules 501-513, 56 F.R.D. at 230-261).

<sup>46</sup> Proposed Rule 503(b), 56 F.R.D. at 236.

<sup>47</sup> The rule contains no definition of “representative of the client,” because the Advisory Committee believed that the matter was better left to resolution by the courts with the law being unsettled at the time. See Proposed Rule 503 Advisory Comm. Notes, 56 F.R.D. at 237; In re Bieter Co., 16 F.3d 929, 935-36 (1994) (discussing “representative of the client”). Since the Supreme Court rejected the “control group” test in *Upjohn v. United States*, 449 U.S. 383, 397 (1981), the law has become stable enough that a definition of “representative of the client” is provided in Uniform Rule of Evidence 502(a)(4) (1999).

<sup>48</sup> Proposed Rule 503(a)(2), 56 F.R.D. at 236 (“A ‘lawyer’ is a person authorized, or reasonably believed by the client to be authorized, to practice law in any state or nation.”).

<sup>49</sup> See, e.g., Model Code of Evidence, Rule 209(b) (1942) (requiring a lawyer to be authorized “to practice law in any state or nation the law of which recognizes a privilege against disclosure of confidential communications between client and lawyer.”). See also Uniform Rule of Evidence 26(3)(c) (1953).

<sup>50</sup> Trammel, 445 U.S. at 47 (quoting 120 Cong. Rec. 40891 (1974) (statement of Rep. Hungate). See also Jaffee, 518 U.S. at 8 (citing S. Rep. No. 93-1277, at 13 (1974), reprinted in 1974 U.S.C.C.A.N. 7051, 7059).

<sup>51</sup> See, e.g., *United States v. Spector*, 793 F.2d 932, 938 (8th Cir. 1986), cert. denied, 479 U.S. 1031 (1987); *United States v. (Under Seal)*, 748 F.2d 871, 874 n.5 (4th Cir. 1984); *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 518 & n.2 (S.D.N.Y. 1992) (“The Federal Standards of Evidence embody pre-existing case law and are looked to as reliable guides notwithstanding the decision of Congress not to include them in the Federal Rules of Evidence.”) (citations omitted). See also 3 Jack B. Weinstein & Margaret A. Berger, Weinstein’s Federal Evidence, § 503.02, at 503-10 (Joseph M. McLaughlin ed., Matthew Bender 2d ed. 1997) (“Supreme Court Standard 503 restates, rather than modifies, the common-law lawyer-client privilege. Thus, it has considerable utility as a guide to the federal common law referred to in Rule 501....”).

<sup>52</sup> Unif. R. Evid. 502 (1999). Rule 502(b) of the Uniform Rules of Evidence defines the general rule of privilege as follows: “A client has a privilege to refuse to disclose and to prevent any other person from disclosing a confidential communication made for the purpose of facilitating the rendition of professional legal services to the client: (1) between the client or a representative of the client and the client’s lawyer or a representative of the lawyer; (2) between the lawyer and a representative of the lawyer; (3) by the client or a representative of the client or the client’s lawyer or a representative of the lawyer to a lawyer or a representative of the lawyer representing another party in a pending action and concerning a matter of common interest therein; (4) between representatives of the client or between the client and a representative of the client; or (5) among lawyers and their representatives representing the same client.” Id.

<sup>53</sup> See, e.g., *Fisher*, 425 U.S. at 403 (“Confidential disclosures by a client to an attorney made in order to obtain legal assistance are privileged.”) (citing Wigmore, *supra* note 18, § 2292, at 554); McCormick 2d, *supra* note 31, § 87, at 175).

<sup>54</sup> See, e.g., *United States v. (Under Seal)*, 748 F.2d 871, 874 n.5 (4th Cir. 1984) (quoting Proposed Rule 503).

<sup>55</sup> See, e.g., *In re Grand Jury Subpoena Duces Tecum*, 112 F.3d 910, 915 (8th Cir. 1997) (describing Proposed Rule 503 as “a useful starting place” for an examination of the federal common law of attorney-client privilege) (quoting *In re Bieter Co.*, 16 F.3d 929, 935 (1994)).

<sup>56</sup> Restatement (Third) of The Law Governing Lawyers (2000).

<sup>57</sup> Restatement (Third) of The Law Governing Lawyers § 68 (2000); *In re Spalding Worldwide, Inc.*, 203 F.3d 800, 805 (Fed. Cir. 2000) (“the central inquiry is whether the communication is one that was made by a client to an attorney for the purpose of obtaining legal advice or services.”); *Genentech, Inc. v. United States Int’l Trade Comm’n*, 122 F.3d 1409, 1415 (Fed. Cir. 1997) (“The attorney-client privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice.”); *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1546 (Fed. Cir. 1992) (citing *Fisher*, 425 U.S. at 403) (“the privilege protects a client’s confidential communications to an attorney necessary to obtain legal counselling [sic].”).

<sup>58</sup> Restatement (Third) of The Law Governing Lawyers § 68 cmt. a (2000).

<sup>59</sup> Restatement (Third) of The Law Governing Lawyers § 70 (2000);

<sup>60</sup> *United States v. Constr. Prods. Research, Inc.*, 73 F.3d 464, 473 (2d Cir.), cert. denied, 519 U.S. 927 (1996) (“To invoke the attorney-client privilege, a party must demonstrate that there was: (1) a communication between client and counsel, which (2) was intended to be and was in fact kept confidential, and (3) made for the purpose of obtaining or providing legal advice.”) (citations omitted).

<sup>61</sup> *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 188 F.R.D. 189, 199 (S.D.N.Y. 1999) (quoting Wigmore definition and citing Restatement (Third) of The Law Governing Lawyers § 118 (Proposed Final Draft No. 1 1996)).

<sup>62</sup> 28 U.S.C. § 1338(a) (District courts have original and exclusive jurisdiction of civil actions arising under the patent laws of the United States).

<sup>63</sup> Fed. R. Evid. 501; Fed. R. Evid. 501 Advisory Comm. Notes; *Upjohn*, 449 U.S. at 389. In diversity cases where the litigation in question turns on a substantive question of state law, privilege is determined by state law. Fed. R. Evid. 501 (“However, in civil actions and proceedings, with respect to an element of a claim or defense as to which State law supplies the rule of decision, the privilege of a witness, person, government, State, or political subdivision thereof shall be determined in accordance with State law.”). See also *Manual for Complex Litigation*, Third § 21.431 n.134 (2003).

<sup>64</sup> *Equal Employment Opportunity Comm’n v. Illinois Dep’t of Employment Sec.*, 995 F.2d 106, 107 (7th Cir. 1993); *Hancock v. Hobbs*, 967 F.2d 462, 466-67 (11th Cir. 1992); *Virmani v. Novant Health Inc.*, 259 F.3d 284, 286 n.3 (4th Cir. 2001); *Pearson v. Miller*, 211 F.3d 57, 66 (3d Cir. 2000); *von Bulow v. von Bulow*, 811 F.2d 136, 141 (2d Cir. 1987); *Hancock v. Dodson*, 958 F.2d 1367, 1373 (6th Cir. 1992).

<sup>65</sup> *Golan v. Pingel Enter., Inc.*, 310 F.3d 1360, 1368 (Fed. Cir. 2002) (citing *United States v. Hohri*, 482 U.S. 64, 75 (1987) (holding Congress’ desire to create national uniformity requires that the Federal Circuit decide questions arising under the federal Constitution and statutes whenever such questions arise in cases within the Federal Circuit’s jurisdiction); *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1358-59 (Fed. Cir. 1999) (en banc); *Interpart Corp. v. Italia*, 777 F.2d 678 (Fed. Cir. 1985)).

<sup>66</sup> 28 U.S.C. § 1295(a)(1); *Holmes Group v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 829 (2002) (citing 28 U.S.C. § 1295 (a)(1)). In *Holmes*, the Supreme Court held that the Federal Circuit may no longer rely solely on counterclaims arising under the patent laws to establish its appellate jurisdiction. *Id.* at 830-834. See also *Golan*, 310 F.3d at 1366 (holding that Federal Circuit had jurisdiction over an appeal involving patent issues, since the complaint arose under 28 U.S.C. § 1338 where the plaintiff’s well-pleaded complaint sought declarations of patent noninfringement). Not all cases involving a patent law claim fall within the Federal Circuit’s appellate jurisdiction. *Holmes*, 535 U.S. at 834. Since the Federal Circuit’s “mandate is to eliminate conflicts and uncertainties in the area of patent law,” *Biomedex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 856 (Fed. Cir. 1991) (quoting *Panduit Corp. v. All States Plastic Mfg., Co.*, 744 F.2d 1564, 1575 (Fed. Cir. 1984) (per curium)), at least one commentator has expressed concern that “the door is clearly open for the possible development of substantive patent law outside of the hands of the Federal Circuit and, even more significant, outside of the federal courts.” Christopher A. Cotropia, “*Arising Under*” Jurisdiction and Uniformity in Patent Law, 9 Mich. Telecomm. Tech. L. Rev. 253, 256 (2003).

<sup>67</sup> *In re Spalding Worldwide, Inc.*, 203 F.3d 800, 803 (Fed. Cir. 2000) (citing *Institut Pasteur v. Cambridge Biotech Corp.*, 186 F.3d 1356, 1358 (Fed. Cir. 1999)); *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in

relevant part) (“with respect to nonpatent issues we generally apply the law of the circuit in which the district court sits”).

<sup>68</sup> *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 97 (S.D.N.Y. 2002) (citing cases).

<sup>69</sup> *Spalding*, 203 F.3d at 803 (citing *Midwest Indus., Inc. v. Karavan*, 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part)).

<sup>70</sup> *Id.* (citing *Midwest Indus.*, 175 F.3d at 1359 (en banc in relevant part)).

<sup>71</sup> 203 F.3d 800 (Fed. Cir. 2000).

<sup>72</sup> *Id.* at 803-04.

<sup>73</sup> *Id.* at 804-06.

<sup>74</sup> *Id.* at 804-05.

<sup>75</sup> Fed. R. Civ. P. 26(b)(1).

<sup>76</sup> *Jaffee v. Redmond*, 518 U.S. 1, 9 (1996).

<sup>77</sup> *Trammel v. United States*, 445 U.S. 40, 50 (1980) (quoting *United States v. Bryan*, 339 U.S. 323, 331 (1950)).

<sup>78</sup> *In re Grand Jury Investigation No. 83-2-35*, 723 F.2d 447, 451 (6th Cir. 1983).

<sup>79</sup> 418 U.S. 683 (1974).

<sup>80</sup> *Id.* at 710.

<sup>81</sup> 445 U.S. 40 (1980).

<sup>82</sup> *Id.* at 50 (quoting *Elkins v. United States*, 364 U.S. 206, 234 (1960) (Frankfurter, J., dissenting)).

<sup>83</sup> 425 U.S. 391 (1976).

<sup>84</sup> *Id.* at 403.

<sup>85</sup> See, e.g., *Agfa Corp. v. Creo Prods., Inc.*, No. Civ.A. 00-10836-GAO, 2002 WL 1787534, at \*2 (D. Mass. Aug. 1. 2002) (citations omitted) (denying attorney-client privilege to communications between client and U.S. patent agent); *Novamont N. Am. Inc. v. Warner-Lambert Co.*, No. 91 Civ. 6482 (DNE), 1992 WL 114507, at \*2-3 (S.D.N.Y. May 6, 1992) (denying attorney-client privilege to communications between U.S. and Swiss patent attorneys and foreign patent agents) (citing *von Bulow v. von Bulow*, 811 F.2d 136, 141 (2d Cir. 1987); *In re Horowitz*, 482 F.2d 72, 81 (2d Cir. 1973)); Restatement (Third) of The Law Governing

Lawyers § 68 Reporter's Note (2000).

<sup>86</sup> Bausch & Lomb Inc. v. Alcon Labs., Inc., 173 F.R.D. 367, 372 (W.D.N.Y. 1995) (citing Upjohn, 449 U.S. at 389; Allen v. West Point-Pepperell Inc., 848 F. Supp. 423, 426 (S.D.N.Y. 1994)).

<sup>87</sup> Jaffee v. Redmond, 518 U.S. 1, 10 (1996) (quoting Trammel v. United States, 445 U.S. 40, 51 (1980)).

<sup>88</sup> Trammel, 445 U.S. at 51.

<sup>89</sup> 425 U.S. 391 (1976).

<sup>90</sup> Id. at 403.

<sup>91</sup> 449 U.S. 383 (1981).

<sup>92</sup> Id. at 389.

<sup>93</sup> Jaffee, 518 U.S. at 11 (citing Upjohn, 449 U.S. at 389).

<sup>94</sup> Upjohn, 449 U.S. at 389.

<sup>95</sup> Jaffee, 518 U.S. at 9-11.

<sup>96</sup> See United States v. United Shoe Mach. Corp., 89 F. Supp. 357, 360-61 (D. Mass. 1950); Zenith Radio Corp. v. Radio Corp. of Am., 121 F. Supp. 792, 794 (D. Del. 1954).

<sup>97</sup> 89 F. Supp. 357 (D. Mass. 1950).

<sup>98</sup> United Shoe, 89 F. Supp. at 361 (“[T]he relationship of a person in the patent department to the corporation is not that of attorney and client.”).

<sup>99</sup> See id. (“[T]he communication of a person in the patent department is as unprivileged as that of a lawyer who shares offices with his so-called client and gives him principally business but incidentally legal advice.”) (citing United States v. Vehicular Parking, 52 F. Supp. 751, 753-54 (D. Del. 1943)).

<sup>100</sup> Id. at 360.

<sup>101</sup> Id.

<sup>102</sup> 121 F. Supp. 792 (D. Del. 1954).

<sup>103</sup> Id. at 794.

<sup>104</sup> Id. at 794 & n.1.

<sup>105</sup> 18 F.R.D. 463 (S.D.N.Y. 1956).

<sup>106</sup> Id. at 464 (citing *Zenith Radio Corp. v. Radio Corp. of Am.*, 121 F. Supp. 792, 794 (D. Del. 1954); *United States v. United Shoe Mach. Corp.*, 89 F. Supp. 357, 360 (D. Mass. 1950).

<sup>107</sup> Id. at 465.

<sup>108</sup> Id. at 464; *Am. Cyanamid Co. v. Hercules Powder Co.*, 211 F. Supp. 85, 89-90 (D. Del. 1962) (patent infringement study and analyses of patents and claims thereunder were not privileged); *Paper Converting Mach. Co. v. FMC Corp.*, 215 F. Supp. 249, 252 (E.D. Wis. 1963) (communications between in-house patent attorney and others regarding patentability and infringement search were not privileged).

<sup>109</sup> See *Ellis-Foster Co. v. Union Carbide & Carbon Corp.*, 159 F. Supp. 917, 920 (D.N.J. 1958) (Referring to the Zenith case, the court stated, “I am not completely in accord with Judge Leahy’s conclusions with reference to the work of those technicians who are both lawyers and scientific specialists.... The mere fact that a non-attorney practitioner might have carried on for [the patent attorney’s] client does not in my opinion destroy the attorney-client relationship.... [T]he admission of other than lawyers in the field of patent practice should not be considered reason for breaking down well recognized and soundly based rules affecting the claim of privilege.”). See also *Int’l Minerals & Chems. Corp. v. Golding Keene Co.*, 162 F. Supp. 137, 141 (W.D.N.Y. 1958) (upholding attorney-client privilege).

<sup>110</sup> 159 F. Supp. 917 (D.N.J. 1958).

<sup>111</sup> Id. at 918, 920.

<sup>112</sup> Id. at 920.

<sup>113</sup> 373 U.S. 379 (1963).

<sup>114</sup> Id. at 381-82.

<sup>115</sup> Id. at 382.

<sup>116</sup> Id. at 384-86, 388.

<sup>117</sup> Id. at 383 (citations omitted).

<sup>118</sup> See, e.g., *Underwater Storage, Inc. v. United States Rubber Co.*, 314 F. Supp. 546, 548 (D.D.C. 1970) (Activities of patent attorney in determining patentability, drafting patent specifications, and preparing and processing patent applications did not constitute giving legal advice, because the attorney was merely performing tasks which could easily have been done by non-attorneys. Thus, the attorney-client privilege did not apply to such services.).

<sup>119</sup> 213 F. Supp. 515 (S.D. Cal. 1963).

<sup>120</sup> Id. at 519 (citations omitted).

<sup>121</sup> Ledex, Inc. v. United States, 172 U.S.P.Q. (BNA) 538, 540 (Ct. Cl. 1972) (quoting Panduit Corp. v. Burndy Corp., 172 U.S.P.Q. (BNA) 46, 47 (N.D. Ill. 1971)).

<sup>122</sup> Hercules Inc. v. Exxon Corp., 434 F. Supp. 136, 147 (D. Del. 1977) (citations omitted).

<sup>123</sup> See, e.g., *In re Spalding Sports Worldwide*, 203 F.3d 800, 806 (Fed. Cir. 2000) (holding that an invention record that was prepared and submitted to the corporate legal department primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application was privileged in its entirety).

<sup>124</sup> See *McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 248-51 (N.D. Ill. 2000) (discussing historical treatment of scope of privilege for patent attorneys); Jonathan G. Musch, Note, *Attorney-Client Privilege and the Patent Prosecution Process in the Post-Spalding World*, 81 Wash. U. L.Q. 175, 182-91 (2003); Gregg F. LoCascio, Note, *Reassessing Attorney-Client Privileged Legal Advice in Patent Litigation*, 69 Notre Dame L. Rev. 1203, 1212-20 (1994). Many courts treat patent attorneys as mere conduits of technical information between clients and the USPTO. See, e.g., *Jack Winter, Inc. v. Koratron Co.*, 50 F.R.D. 225, 228 (N.D. Cal. 1970). This so-called “conduit theory” of patent prosecution denies clients the protections of the attorney-client privilege under the rationale that the communications are: (1) not made for the purpose of obtaining legal advice, see, e.g., *Saxholm AS v. Dynal, Inc.*, 164 F.R.D. 331, 335 (E.D.N.Y. 1996) (citing cases); (2) not made with the expectation of confidentiality, see, e.g., *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 537-39 (N.D. Ill. 2000) (citing *Jack Winter*, 50 F.R.D. at 228); or (3) both, see, e.g., *Saxholm*, 164 F.R.D. at 335-36. Other courts have rejected the “conduit theory” and held that many communications between clients and patent attorneys are requests for legal advice where they relate to assessments of patentability and preparation of patent applications. See *Knogo Corp. v. United States*, 213 U.S.P.Q. (BNA) 936, 939-41 (Ct. Cl. 1980); *Spalding*, 203 F.3d at 806 & n.3 (rejecting “conduit theory”). The Federal Circuit focuses on whether the confidential communications were made between clients and U.S. patent attorneys for the primary purpose of obtaining or providing legal assistance. See, e.g., *Spalding*, 203 F.3d at 806.

<sup>125</sup> *Sperry v. Florida*, 373 U.S. 379, 383 (1963).

<sup>126</sup> 253 F. Supp. 999 (D.N.J. 1966).

<sup>127</sup> Id. at 1000.

<sup>128</sup> Id. at 1001 (quoting *United States v. United Shoe Mach. Corp.*, 89 F. Supp. 357, 358 (D. Mass. 1950)).

<sup>129</sup> Id. at 1002.

<sup>130</sup> Id. at 1001.

<sup>131</sup> Id. at 1002.

<sup>132</sup> Id. at 1002 n.4.

<sup>133</sup> 232 F.2d 855 (8th Cir. 1956).

<sup>134</sup> Id. at 863 (“The attorney-client privilege is one that exists to enable a client to have subjective freedom of mind in committing his affairs to the knowledge of an attorney, whether the matter is one of consultation or of litigation; and, in order that the client’s feeling of security may be complete, the protection against disclosure is one that extends both to the communications made by him to the attorney and to the communications made by the attorney to him related to the confidence.” (citing 7 John H. Wigmore, *Evidence in Trials at Common Law* §§ 2294, 2306, 2310, 2317, 2320 (3d ed. 1940)).

<sup>135</sup> United States v. Chen, 99 F.3d 1495, 1501 (9th Cir. 1996) (citing Wigmore, *supra* note 18, § 2291, at 559) (emphasis in original)). “The attorney-client privilege applies to communications between lawyers and their clients when the lawyers act in a counseling and planning role, as well as when lawyers represent their clients in litigation. Indeed, the axiom that ‘every man knows the law’ presupposes that everyone can find it out by consulting a lawyer, before being hauled into court for violating the law.” *Id.* (citing Wigmore, *supra* note 18, § 2291, at 547-48).

<sup>136</sup> See 37 C.F.R. § 10.56 (2005) (“A practitioner should preserve the confidences and secrets of a client.”); 37 C.F.R. § 10.57 (2005) (“‘Confidence’ refers to information protected by the attorney-client or agent-client privilege under applicable law.”).

<sup>137</sup> *Joh. A. Benckiser G.m.b.H., Chemische Fabrik v. Hygrade Food Prods. Corp.*, 253 F.Supp. 999, 1002 (D.N.J. 1966).

<sup>138</sup> *Schwimmer*, 232 F.2d at 863 (citing *Chirac v. Reinicker*, 24 U.S. (11 Wheat.) 280, 294 (1826)).

<sup>139</sup> U.S. Const. art. III.

<sup>140</sup> See, e.g., *Rayette-Faberge, Inc. v. John Oster Mfg. Co.*, 47 F.R.D. 524, 526 (E.D. Wis. 1969) (“In my opinion, the attorney-client privilege does not apply to the correspondence in question for the reason that the communications are with a group of agents who, apparently, are not attorneys at law.”); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1169 (D.S.C. 1975) (“The federal courts have refused to extend the attorney-client privilege to encompass American patent agents.”) (citing *Benckiser*, 253 F. Supp. at 1001-1002; *United States v. United Shoe Mach. Corp.*, 89 F. Supp. 357, 360 (D. Mass. 1950); *Brungger v. Smith*, 49 F. 124, 125 (C.C.D. Mass. 1892); *Sneider v. Kimberly-Clark Corp.*, 91 F.R.D. 1, 5 (N.D. Ill. 1980) (characterizing work of patent agents as “quasi-legal service”); *Agfa Corp. v. Creo Prods., Inc.*, No. Civ.A. 00-10836-GAO, 2002 WL 1787534, at \*2 (D. Mass. Aug. 1, 2002) (“I see no reason to extend ... the common law attorney-client privilege to non-lawyer patent agents authorized to practice before [the] Patent and Trademark Office.”)).

<sup>141</sup> No. Civ.A. 00-10836-GAO, 2002 WL 1787534 (D. Mass. Aug. 1, 2002).

<sup>142</sup> *Id.* at \*2 (citing *Couch v. United States*, 409 U.S. 322, 335 (1973); *Cavallaro v. United States*, 284 F.3d 236, 246 (1st Cir. 2002)).

<sup>143</sup> 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3:19 (2d ed. 1999), WL ACPRI-FED § 3:19.

<sup>144</sup> *United Shoe*, 89 F. Supp. at 358-59.

<sup>145</sup> *Zenith Radio Corp. v. Radio Corp. of Am.*, 121 F. Supp. 792, 794 (D. Del. 1954).

<sup>146</sup> *Id.*

<sup>147</sup> 49 F.R.D. 82 (E.D. Pa. 1969), aff’d, 478 F.2d 1398 (3d Cir. 1973).

<sup>148</sup> *Id.* at 83-84.

<sup>149</sup> Id. at 84 (citing *Zenith*, 121 F. Supp. at 794; 8 John H. Wigmore, *Evidence* § 2301 (3d ed. 1940)).

<sup>150</sup> Id. at 84.

<sup>151</sup> *Sperry v. Florida*, 373 U.S. 379, 383 (1963).

<sup>152</sup> No. CIVA5:03CV0530(DEP), 2003 WL 22225580 (N.D.N.Y. Sept. 17, 2003).

<sup>153</sup> Id. at \*4-5.

<sup>154</sup> 434 F. Supp. 136 (D. Del. 1977).

<sup>155</sup> Id. at 146 (D. Del. 1977) (citing *Congoleum*, 49 F.R.D. at 83-84).

<sup>156</sup> See e.g., *Gorman v. Polar Electro, Inc.*, 137 F. Supp. 2d 223, 227 (E.D.N.Y. 2001) (attorney-client privilege only protects patent agents working under authority and control of an attorney) (quoting *Saxholm v. Dynal, Inc.*, 164 F.R.D. 331, 337 (E.D.N.Y. 1996); citing *Golden Trade S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 518-19 (S.D.N.Y. 1992) (citations omitted)); *Cuno, Inc. v. Pall Corp.*, 121 F.R.D. 198, 204 (E.D.N.Y. 1988) (citing *W.R. Grace & Co. v. Pullman, Inc.*, 446 F. Supp. 771, 776 (W.D. Okla. 1976); *Hercules, Inc. v. Exxon Corp.*, 434 F. Supp. 136, 146 (D. Del. 1977)); *Foseco Int'l Ltd. v. Fireline, Inc.*, 546 F. Supp. 22, 25 (N.D. Ohio 1982); *Status Time Corp. v. Sharp Elecs. Corp.*, 95 F.R.D. 27, 33 (S.D.N.Y. 1982) (“only communications between an attorney or an agent of the attorney and his client are covered by the privilege.”); *Contra Sneider v. Kimberly-Clark Corp.*, 91 F.R.D. 1, 5 (N.D. Ill. 1980) (“Although the representatives of an attorney will fall within the scope of the privilege, patent agents are not regarded as an attorney’s representative.... Patent agents, however, are regarded as separate entities who maintain an independent status and whose functioning is not contingent upon their affiliation with an attorney.”).

<sup>157</sup> 186 U.S.P.Q. (BNA) 324 (D.N.J. 1975).

<sup>158</sup> Id. at 325.

<sup>159</sup> Id. at 325; 37 C.F.R. § 1.31 (2005). See also 37 C.F.R. § 11.6 (2005) (establishing a system of registration and limiting the authorization to practice before the USPTO).

<sup>160</sup> Vernitron, 186 U.S.P.Q. at 325. See 37 C.F.R. § 11.1(c) (defining “attorney” or “lawyer” and “practitioner”) (2005).

<sup>161</sup> Vernitron, 186 U.S.P.Q. at 325. See 37 C.F.R. § 11.7 (2005) (requirements for registration).

<sup>162</sup> Vernitron, 186 U.S.P.Q. at 325. See 37 C.F.R. § 11.7(a), (b) (2005).

<sup>163</sup> Vernitron, 186 U.S.P.Q. at 325. See 37 C.F.R. § 10.20-.129 (2005).

<sup>164</sup> Vernitron, 186 U.S.P.Q. at 325. See 37 C.F.R. § 10.56 (2005). “Confidence” refers to information protected by the attorney-client or agent-client privilege under applicable law.” 37 C.F.R. § 10.57 (2005).

<sup>165</sup> Vernitron, 186 U.S.P.Q. at 325.

<sup>166</sup> 81 F.R.D. 377 (D.D.C. 1978).

<sup>167</sup> *Id.* at 392-394.

<sup>168</sup> 24 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice and Procedure* § 5480, at 254 (1986).

<sup>169</sup> Ampicillin, 81 F.R.D. at 393.

<sup>170</sup> *Id.*

<sup>171</sup> *Id.* (footnotes omitted). See also *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 304 (E.D.N.Y. 1992) (adopting conclusion in Ampicillin).

<sup>172</sup> Ampicillin, 81 F.R.D. at 393 n.32.

<sup>173</sup> *Id.* at 393. See also *Upjohn*, 449 U.S. at 393 (“[I]f the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.”).

<sup>174</sup> Ampicillin, 81 F.R.D. at 394.

<sup>175</sup> *Id.*

<sup>176</sup> This hypothetical is based on *John Labatt Ltd. v. Molson Breweries*, 898 F. Supp. 471, 475 (E.D. Mich. 1995).

<sup>177</sup> *Id.*

<sup>178</sup> *Id.*

<sup>179</sup> 227 U.S.P.Q. (BNA) 129 (E.D. Mich. 1985).

<sup>180</sup> *Id.* at 133.

<sup>181</sup> *Id.*

<sup>182</sup> No. 01 C 1576, 2001 WL 1268587 (N.D. Ill. Nov. 15, 2001).

<sup>183</sup> *Id.* at \*4-5.

184        *Id.* at \*3.

185        *Sperry v. Florida*, 373 U.S. 379 (1963).

186        *Mold Masters*, 2001 WL 1268587, at \*4.

187        *Id.* at \*4.

188        *Id.* at \*5 (citing *Wigmore*, *supra* note 18, § 2292, at 554).

189        *Id.* at \*4-5; *Dow Chem. Co. v. Atl. Richfield Co.*, 227 U.S.P.Q. (BNA) 129, 133-134 (E.D. Mich. 1985); *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 393-94 (D.D.C. 1978). See also *Vernitron Med. Prods., Inc. v. Baxter Labs., Inc.*, 186 U.S.P.Q. (BNA) 324, 325-26 (D.N.J. 1975).

190        47 F.R.D. 524, 163 U.S.P.Q. (BNA) 373 (E.D. Wis. 1969).

191        *Id.*, 47 F.R.D. at 526-27, 163 U.S.P.Q. at 374-75 & n.1. Only the opinion reported in the *United States Patent Quarterly* (U.S.P.Q.) indicates that the foreign patent agents were employed by a British patent firm.

192        *Id.*, 47 F.R.D. at 526, 163 U.S.P.Q. at 374.

193        *Id.*

194        65 F.R.D. 26 (D. Md. 1974).

195        *Id.* at 40 (citing *Wigmore*, *supra* note 18, § 2301, at 583).

196        *Id.*

197        *Id.* (citing *Rayette-Faberge*, 47 F.R.D. at 526).

198        See *id.*

199        95 F.R.D. 27 (S.D.N.Y. 1982).

200        *Id.* at 28.

201        *Id.* at 30-31.

202        *Id.* at 32. See *id.* at 29 (quoting *United Shoe*, 89 F. Supp. at 358-59).

203 Id. at 32 (citing *Burlington Indus. v. Exxon Corp.*, 65 F.R.D. 26, 40 (D. Md. 1974); *Ledex, Inc. v. United States*, 172 U.S.P.Q. (BNA) 538, 540 (Ct. Cl. 1972); *Rayette-Faberge*, 47 F.R.D. at 526; *Benckiser*, 253 F. Supp. at 1001-02).

204 Id. (citing *Ampicillin*, 81 F.R.D. at 392-93; *Vernitron*, 186 U.S.P.Q. at 325-26; *In re Yarn Processing Patent Litigation*, 177 U.S.P.Q. (BNA) 514 (S.D. Fla. 1973); *Jack Winter*, 54 F.R.D. at 48).

205 Id. at 33.

206 Id. (emphasis added). It is unclear whether the Status Time court would have recognized a privilege for foreign patent attorneys authorized to practice law in their own countries and foreign patent agents working under their direction and control.

207 373 U.S. at 383.

208 See also *Daiske Yoshida, Note, The Applicability of the Attorney-Client Privilege to Communications with Foreign Legal Professionals*, 66 Fordham L. Rev. 209, 233 (1997) (quoting *Virginia J. Harnisch, Confidential Communications Between Clients and Patent Agents: Are They Protected Under the Attorney-Client Privilege?*, 16 Hastings Comm. & Ent. L.J., 443, 443-44 (1994)).

209 See, e.g., *Kahn v. General Motors Corp.*, No. 88 Civ. 2982 (PNL), 1992 WL 28119, at \*2 (S.D.N.Y. Feb. 11, 1992) (“As to the non-attorney patent agents in Great Britain, Germany, France and the Netherlands ... I agree with Judge Gershon’s reasoning in *Status Time Corp. v. Sharp Electronics Corp.*, 95 F.R.D. 27, 32-33 (S.D.N.Y. 1982), rejecting the rationale of certain reported decisions extending the protection of the attorney client privilege to these persons.”); *Duttle v. Bandler & Kass*, 127 F.R.D. 46, 52 (S.D.N.Y. 1989) (“I am persuaded by the court’s reasoning in *Status Time* that, in any event, the federal common law ought not recognize a privilege for communications with patent agents.”) (citing *Status Time*, 95 F.R.D. at 33); *Novamont N. Am. Inc. v. Warner-Lambert Co.*, No. 91 Civ. 6482 (DNE), 1992 WL 114507, at \*3 (S.D.N.Y. May 6, 1992) (“Consistent with prior decisions of this Court, I decline to extend the attorney-client privilege, on the basis of comity, to communications with foreign patent agents who are not admitted attorneys.”).

210 No. 91 Civ. 6482 (DNE), 1992 WL 114507 (S.D.N.Y. May 6, 1992).

211 Id. at \*1. “I decline to extend the attorney-client privilege, on the basis of comity, to communications with foreign patent agents who are not admitted attorneys.” Id. at \*3.

212 143 F.R.D. 514 (S.D.N.Y. 1992).

213 Id. at 518.

214 See e.g., *Congoleum Indus., Inc. v. GAF Corp.*, 49 F.R.D. 82, 84 (E.D. Pa. 1969), aff’d, 478 F.2d 1398 (3d Cir. 1973) (citing *Zenith Radio Corp. v. Radio Corp. of Am.*, 121 F. Supp. 792, 794 (D. Del. 1954); *Wigmore*, supra note 18, § 2301); *Hercules, Inc. v. Exxon Corp.*, 434 F. Supp. 136, 146-47 (D. Del. 1977); *Glaxo, Inc. v. Novopharm Ltd.*, 148 F.R.D. 535, 538-39 (E.D.N.C. 1993) (citations omitted); *Novamont*, 1992 WL 114507, at \*1.

215 *Status Time*, 95 F.R.D. at 33.

216 See *Novamont*, 1992 WL 114507, at \*1 (“[C]ommunications with foreign patent agents, who are neither members of the bar in this or their own countries, nor agents of attorneys admitted to practice, are not protected by the attorney-client privilege.”). This would be consistent with the definition of “lawyer” provided by Proposed Rule 503(a)(2). See Proposed Rule 503(a)(2), 56 F.R.D. 183, 236. (“A ‘lawyer’ is a person authorized, or reasonably believed by the client to be authorized, to practice law in any state or nation.”).

<sup>217</sup> Glaxo, 148 F.R.D. at 539; *Saxholm AS v. Dynal, Inc.*, 164 F.R.D. 331, (E.D.N.Y. 1996) (citing *Cuno, Inc. v. Pall Corp.*, 121 F.R.D. 198, 204-05 (E.D.N.Y. 1988)); *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, No. 95 Civ. 8833 (RPP), 1998 WL 158958, at \*1 (S.D.N.Y. Apr. 2, 1998) (citing *Status Time*, 95 F.R.D. at 31-32; *Golden Trade*, 143 F.R.D. at 519).

<sup>218</sup> *Hercules*, 434 F. Supp. at 146.

<sup>219</sup> 143 F.R.D. 514 (S.D.N.Y. 1992).

<sup>220</sup> *Id.* at 518.

<sup>221</sup> *Id.* at 518-19 (quoting 2 Jack B. Weinstein & Margaret A. Berger, *Weinstein's Evidence* P 503(a)(3)[01], at 503-27 (1990)).

<sup>222</sup> *Id.* at 517.

<sup>223</sup> *Id.* at 523.

<sup>224</sup> *Id.*

<sup>225</sup> *Id.*

<sup>226</sup> *Id.*

<sup>227</sup> *Id.*

<sup>228</sup> *Id.*

<sup>229</sup> *Id.* at 519 n.3.

<sup>230</sup> *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 305 n.3 (E.D.N.Y. 1992) (quoting *Willemijn Houdstermaatschaapij BV v. Apollo Computer Inc.*, 707 F. Supp. 1429, 1446 (D. Del. 1989)).

<sup>231</sup> *Apollo Computer*, 707 F. Supp. at 1446-47; *Mendenhall v. Barber-Greene Co.*, 531 F. Supp. 951, 954 (N.D. Ill. 1982). See *Golden Trade*, 143 F.R.D. at 519 n.3; *Mitts & Merrill, Inc. v. Shred Pax Corp.*, 112 F.R.D. 349, 352 (N.D. Ill. 1986).

<sup>232</sup> 707 F. Supp. 1429 (D. Del. 1989).

<sup>233</sup> *Id.* at 1432, 1444-45.

<sup>234</sup> *Id.* at 1445.

235 Id. at 1446.

236 Id. at 1442.

237 Id. at 1447 (citing *Mendenhall v. Barber-Greene Co.*, 531 F. Supp. 951, 954 (N.D. Ill. 1982)). See also *Stryker*, 145 F.R.D. at 305 (citing *Baxter Travenol Labs., Inc. v. Abbott Labs.*, No. 12919, 1987 WL 12919, at \*8 (N.D. Ill. June 19, 1987)).

238 No. 91 Civ. 6482 (DNE), 1992 WL 114507 (S.D.N.Y. May 6, 1992).

239 Id. at \*3.

240 See *id.* But see *Mitts & Merrill*, 112 F.R.D. at 352 (suggesting that communications might be privileged on the grounds that the foreign patent agent was acting as the agent of the U.S. patent attorney).

241 112 F.R.D. 349 (N.D. Ill. 1986).

242 Id. at 352.

243 Id. (citing *Mendenhall*, 531 F. Supp. at 954).

244 Id.

245 148 F.R.D. 535 (E.D.N.C. 1993).

246 Id. at 538-39.

247 Id. at 539.

248 Id.

249 *Golden Trade*, 143 F.R.D. at 518.

250 *Glaxo*, 148 F.R.D. at 539.

251 Id. at 539. See also *Chubb Integrated Sys. v. Nat'l Bank of Wash.*, 103 F.R.D. 52, 64-66 (D.D.C. 1984). But see *Foseco Int'l Ltd. v. Fireline, Inc.*, 546 F. Supp. 22, 25-26 (D. Ohio 1982) (foreign patent agent deemed to be agent of the client, rather than of the attorney).

252 186 U.S.P.Q. (BNA) 324 (D.N.J. 1975).

253 Id. at 325.

254 Id. at 325-26.

255 See *id.* at 326; Harnisch, *supra* note 208, at 447. One commentator advocated a slightly different approach: “[T]he goals of the attorney-client privilege are best served by a tempered functional analysis, which focuses on whether the foreign advisor was engaged in the ‘substantive lawyering process’ and whether the foreign advisor possessed professional qualifications that would justify the client’s expectations of privilege.” Yoshida, *supra* note 208, at 247.

256 Harnisch, *supra* note 208, at 447.

257 98 F.R.D. 442 (D. Del. 1982).

258 *Id.* at 444.

259 *Id.*

260 *Id.*

261 See *Honeywell, Inc. v. Minolta Camera Co., Ltd.*, No. Civ. A. 87-4847, 1990 WL 66182 (D.N.J. May 15, 1990) (rejecting “de facto attorney” theory of legal advisor who had never been licensed to practice law in any country and had never been registered as a patent agent in any country).

262 No. 95 C 0673, 1996 WL 732522 (N.D. Ill. Dec. 18, 1996).

263 *Id.* at \*9.

264 *Id.* at \*8.

265 *Id.*

266 *Id.* at \*9 (citing *Sneider v. Kimberly-Clark Corp.*, 91 F.R.D. 1, 2 (N.D. Ill. 1980)).

267 *Id.*

268 *Id.* at \*3 n.2.

269 *Id.* at \*10 (citing *Mendenhall v. Barber-Greene Co.*, 531 F. Supp. 951, 953 (N.D. Ill. 1982)); *Baxter Travenol Labs., Inc. v. Abbott Labs.*, No. 84 C 5103, 1987 WL 12919, at \*8 (N.D. Ill. June 19, 1987)).

270 Yoshida, *supra* note 208, at 228 (citing Harnisch, *supra* note 208, at 445-46).

271 397 F. Supp. 1146 (D.S.C. 1975).

<sup>272</sup> Yoshida, *supra* note 208, at 228.

<sup>273</sup> Duplan, 397 F. Supp. at 1164-67.

<sup>274</sup> *Id.* at 1169.

<sup>275</sup> *Id.* at 1167.

<sup>276</sup> *Id.*

<sup>277</sup> *Id.*

<sup>278</sup> See *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 806 n.3 (Fed. Cir. 2000) (rejecting “conduit theory”).

<sup>279</sup> Duplan, 397 F. Supp. at 1167-68.

<sup>280</sup> *Id.* at 1169.

<sup>281</sup> *Id.*

<sup>282</sup> *Sperry v. Florida*, 373 U.S. 379, 383, 402 (1963).

<sup>283</sup> Duplan, 397 F. Supp. at 1169 (citing Benckiser, 253 F. Supp. at 1001-02; United Shoe, 89 F. Supp. at 360; Brungger v. Smith, 49 F. 124, 125 (C.C.D. Mass. 1892)).

<sup>284</sup> *Id.* (citing Celanese Corp. v. E. I. duPont de Nemours & Co., 58 F.R.D. 606 (S.D. Fla. 1973); Jack Winter, Inc. v. Koratron Co., 54 F.R.D. 44 (N.D. Cal. 1971)).

<sup>285</sup> *Id.* See e.g., Santrade, Ltd. v. General 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.”) (citing Burroughs Wellcome Co. v. Barr Labs., Inc., 143 F.R.D. 611, 616 (E.D.N.C. 1992)).

<sup>286</sup> Duplan, 397 F. Supp. at 1169.

<sup>287</sup> *Id.* at 1169-70.

<sup>288</sup> *Id.* at 1170-71.

<sup>289</sup> *Id.* at 1170-71.

<sup>290</sup> The court rejected Proposed Rule 503, and instead, changed the federal common law of attorney-client privilege by incorporating foreign law. See *id.* at 1160-61.

<sup>291</sup> See, e.g., *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 391 (D.D.C. 1978) (“Comity, however, will not be extended to foreign law if it is contrary to the public policy of the forum.”) (citing *Duplan*, 397 F. Supp. at 1169); *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 155 (W.D.N.Y. 1982); *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 143 F.R.D. 611, 616-17 (E.D.N.C. 1992) (citing *Duplan*, 397 F. Supp. at 1169); *Odome v. Croda Int’l PLC*, 950 F. Supp. 10, 12 (D.D.C. 1997) (citing *Duplan*, 397 F. Supp. at 1169). But see *McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 256 (N.D. Ill. 2000) (“Therefore, if an attorney-client privilege exists in a country, then comity requires us to apply that country’s law to the documents at issue.”) (citing *Alplex Computer Corp. v. Nintendo Co.*, No. 86 CIV. 1749 (KMW), 1992 WL 51534, at \*2 (S.D.N.Y. Mar. 10, 1992)).

<sup>292</sup> 143 F.R.D. 514 (S.D.N.Y. 1992).

<sup>293</sup> *Id.* at 523. See also *J. T. Eaton & Co., Inc. v. Atl. Paste & Glue Co.*, No. CV-84-4438 (EHN), 1987 WL 17084, at \*1 (E.D.N.Y. Aug. 31, 1987) (Since British patent agent was retained solely to assist in the prosecution of U.S. corporation’s European patent application, there was no conflict with the policy interests of the United States, and comity was given to British law) (citing *Detection Systems*, 96 F.R.D. at 155; *Ampicillin*, 81 F.R.D. at 391-92).

<sup>294</sup> 531 F. Supp. 951 (N.D. Ill. 1982).

<sup>295</sup> *Id.* at 953.

<sup>296</sup> *Id.* See also *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 520 (S.D.N.Y. 1992) (citing *Duplan*, 397 F. Supp. at 1170-71); *McCook Metals*, 192 F.R.D. at 256 (quoting *Burroughs Wellcome*, 143 F.R.D. at 616).

<sup>297</sup> *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 305 (E.D.N.Y. 1992) (citing *Duplan*, 397 F. Supp. at 1169-70).

<sup>298</sup> 950 F. Supp. 10 (D.D.C. 1997).

<sup>299</sup> *Id.* at 11, 13.

<sup>300</sup> *Id.* at 13.

<sup>301</sup> *Id.* at 13-14.

<sup>302</sup> *Id.* at 13 (emphasis in original) (citing *Chubb Integrated Sys. Ltd v. Nat’l Bank of Wash.*, 103 F.R.D. 52, 65 (D.D.C. 1984)).

<sup>303</sup> *Id.* (citing *Chubb*, 103 F.R.D. at 65; *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 305 (E.D.N.Y. 1992)).

<sup>304</sup> *Odome*, 950 F. Supp. at 13.

<sup>305</sup> *Id.* at 14 (citing *Duplan*, 397 F. Supp. at 1169).

<sup>306</sup> *Id.*

307 See *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 99 (S.D.N.Y. 2002) (citing *Odome*, 950 F. Supp. at 13) (*Odome* found that “communications involving not only United States patents but also the foreign priority applications of U.S. patents ‘touch base’ with the United States.”).

308 One commentator has criticized *Odome* as a “particularly cynical and result-oriented use of the ‘touch base’ test.” *Yoshida*, supra note 208, at 240. Another commentator characterized the *Odome* definition of “touching base” as “intolerably broad.” 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3:20 (2d ed. 1999), WL ACPRI-FED § 3:20.

309 See *Golden Trade, S.r.l. v. Lee Apparel Co.*, 143 F.R.D. 514, 523 (S.D.N.Y. 1992) (“[R]ecognizing foreign-law protection for foreign patent agent’s communications with their foreign clients concerning the prosecution of foreign patents will not undermine any compelling policy interest reflected in domestic law governing privilege claims.”).

310 194 F.R.D. 8 (D. Mass. 2000).

311 *Id.* at 15.

312 *Golden Trade*, 143 F.R.D. at 520 (citing *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1169-70 (D.S.C. 1975)).

313 *Duplan*, 397 F. Supp. at 1171.

314 *Id.* at 1169-71; *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 391 (D.D.C. 1978); *Golden Trade*, 143 F.R.D. at 520.

315 546 F. Supp. 22 (N.D. Ohio 1982).

316 *Id.* at 25-26.

317 *Id.* at 23-24.

318 *Id.* at 26.

319 *Id.*

320 *Id.*

321 103 F.R.D. 52 (D.D.C. 1984).

322 *Id.* at 64-65.

323 *Id.* at 65.

324 *Id.* at 64-65.

325       Id. at 66.

326       Id.

327       148 F.R.D. 535 (E.D.N.C. 1993).

328       Id. at 539.

329       Id.

330       See *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 535 n.6 (N.D. Ill. 2000) (recognizing that “comity plus function” approach is different from the “touch base” and the “most direct and compelling interest” approaches).

331       531 F. Supp. 951 (N.D. Ill. 1982).

332       Id. at 952.

333       Id. at 952-53.

334       Id. at 953.

335       Id.

336       Id. (citations omitted).

337       *Baxter Travenol Labs., Inc. v. Abbott Labs.*, No. 84 C 5103, 1987 WL 12919, at \*8 (N.D. Ill. June 19, 1987) (citing *Mendenhall v. Barber-Greene Co.*, 531 F. Supp. 951, 953-54 (N.D. Ill. 1982)); *McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 256 (N.D. Ill. 2000) (quoting *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 143 F.R.D. 611, 616 (E.D.N.C. 1992)).

338       *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 535 (N.D. Ill. 2000); *Advertising to Women v. Gianni Versace, S.p.A.*, No. 98 C 1553, 1999 WL 608711, at \*3 (N.D. Ill. Aug. 4, 1999) (citing *Baxter Travenol*, 1987 WL 12919, at \*8).

339       *Smithkline Beecham*, 193 F.R.D. at 535 (citing *McCook Metals*, 192 F.R.D. at 256; *Advertising to Women*, 1999 WL 608711, at \*2; *Baxter*, 1987 WL 12919, at \*8).

340       Id.

341       Id.

342       143 F.R.D. 514 (S.D.N.Y. 1992).

343       Id. at 520.

<sup>344</sup> *Id.* at 520-21.

<sup>345</sup> *Id.* at 521.

<sup>346</sup> *Id.* (emphasis added).

<sup>347</sup> *Id.*; VLT Corp. v. Unitrode Corp., 194 F.R.D. 8, 16 (D. Mass. 2000) (discussing *Golden Trade*).

<sup>348</sup> *Golden Trade*, 143 F.R.D. at 520-21.

<sup>349</sup> *Id.* at 522-24.

<sup>350</sup> Restatement (Second) of Conflict of Laws (1988); VLT Corp., 194 F.R.D. at 16; Yoshida, *supra* note 208, at 234-38.

<sup>351</sup> Restatement (Second) of Conflict of Laws § 139(2) (1988); VLT Corp., 194 F.R.D. at 16; Yoshida, *supra* note 208, at 235.

<sup>352</sup> Restatement (Second) of Conflict of Laws § 139(2) cmt. d (1988).

<sup>353</sup> *Id.*; Yoshida, *supra* note 208, at 235-36.

<sup>354</sup> Restatement (Second) of Conflict of Laws § 139(2) cmt. d (1988).

<sup>355</sup> *Id.*

<sup>356</sup> *Id.*

<sup>357</sup> *Id.*

<sup>358</sup> *Id.*

<sup>359</sup> Yoshida, *supra* note 208, at 235 (commenting that the Second Restatement's notion of "most significant relationship" is ill-defined).

<sup>360</sup> Restatement (Second) of Conflict of Laws § 139(2) cmt. e (1988).

<sup>361</sup> 33 U.S.P.Q.2d (BNA) 1655 (S.D.N.Y. 1994).

<sup>362</sup> *Id.* at 1659.

363 194 F.R.D. 8 (D. Mass. 2000).

364 Id. at 10.

365 Id. at 13.

366 A “benrishi” is not an attorney-at-law, although the English translation is “patent attorney.” A “bengoshi,” in contrast, is similar to an English barrister and engages in litigation. *Id.* at 17 (citing Constance O’Keefe, *Symposium: Winds of Change--A Global Look at Legal Education: Legal Education in Japan*, 72 *Or. L. Rev.* 1009 (1993)).

367 *Id.* at 13, 18. At the time of the letter: (1) the British patent agent represented the corporation in an amendment proceeding before the British patent office related to the British counterpart patent; (2) the German attorney represented the corporation in patent infringement litigation in Germany related to the German counterpart patent; and (3) the U.S. patent attorney represented the corporation before the USPTO regarding a reissue proceeding involving the U.S. patent. *Id.* at 13.

368 *Id.* Further, the plaintiff admitted that neither letters sought to have foreign patent agents act under the authority of the U.S. patent attorney. *Id.* at 14.

369 *Id.* at 16 (quoting *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 521 (S.D.N.Y. 1992)).

370 *Id.* at 17.

371 *Id.*

372 *Id.* at 17-18.

373 *Id.* at 18.

374 *Id.*

375 *Id.* at 19.

376 *Id.*

377 *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 188 F.R.D. 189, 191 (S.D.N.Y. 1999) (citing *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, No. 95 Civ. 8833 (RPP), 1998 WL 158958 (S.D.N.Y. Apr. 2, 1998)); *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 520 (S.D.N.Y. 1992) (citing *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1170-71 (D.S.C. 1975)); *Saxholm AS v. Dynal, Inc.*, 164 F.R.D. 331, 337 (E.D.N.Y. 1996) (citing *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 305-06 (E.D.N.Y. 1992); *Golden Trade*, 143 F.R.D. at 520; *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 155-56 (W.D.N.Y. 1982)).

378 See, e.g., *Softview Computer Prods. Corp. v. Haworth, Inc.*, 58 U.S.P.Q.2d (BNA) 1422, 1433 (S.D.N.Y. 2000) (applying German privilege law when patent agent was located in Germany); *Bristol-Myers*, 188 F.R.D. at 198 (applying French privilege law when patent agent was located in France) (citing *Yoshida*, *supra* note 208, at 226); *Stryker*, 145 F.R.D. at 306 (applying British privilege law when patent agent was located in England); *J.T. Eaton & Co., Inc. v. Atl. Paste & Glue Co.*, No. CV-84-4438 (EHN), 1987 WL 17084, at \*1 (E.D.N.Y. Aug. 31, 1987) (applying British privilege law when patent agent was located in England).

<sup>379</sup> Duplan, 397 F. Supp. at 1171; VLT Corp. v. Unitrode Corp., 194 F.R.D. 8, 17-19 (D. Mass. 2000); Aktiebolag v. Andrx Pharm., Inc., 208 F.R.D. 92, 98-99 (S.D.N.Y. 2002) (determining whether German privilege law protected copies of confidential communications in Swedish between Swedish in-house counsel and other Swedish employees in Sweden discussing opinions and advice rendered by Swedish corporation's German attorney).

<sup>380</sup> 208 F.R.D. 92 (S.D.N.Y. 2002).

<sup>381</sup> *Id.* at 104-05.

<sup>382</sup> *Id.* at 95-96, 104-105.

<sup>383</sup> *Id.* at 104-05.

<sup>384</sup> *Id.* at 95.

<sup>385</sup> *Id.* at 100.

<sup>386</sup> *Id.* (citing Alpex Computer Corp. v. Nintendo Co., Ltd., No. 86 Civ. 1749 (KMW), 1992 WL 51534, at \*2 (S.D.N.Y. Mar. 10, 1992); Bayer AG v. Barr Labs., Inc., No. 92 Civ. 0381 (WK), 1994 WL 705331, at \*5 (S.D.N.Y. Dec. 16, 1994); Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc., No. 95 Civ. 8833 (RPP), 1998 WL 158958, at \*3 (S.D.N.Y. Apr. 2, 1998)).

<sup>387</sup> *Id.* at 101 (citing Bristol-Myers, 1998 WL 158958, at \*3; Bayer, 1994 WL 705331, at \*5; Alpex, 1992 WL 51534, at \*2; Santrade, Ltd. v. Gen. Elec. Co., 150 F.R.D. 539, 547 (E.D.N.C. 1993)).

<sup>388</sup> *Id.*

<sup>389</sup> *Id.*

<sup>390</sup> *Id.*

<sup>391</sup> *Id.* at 102.

<sup>392</sup> *Id.*

<sup>393</sup> *Id.*

<sup>394</sup> *Id.* (citing *United States v. First Nat'l City Bank*, 396 F.2d 897, 901 (2d Cir. 1968)).

<sup>395</sup> *Id.*

<sup>396</sup> *Id.* (citing *Golden Trade*, 143 F.R.D. at 520-23 (finding that claimant's "showing adequately establishes that the communications

were covered by the attorney-client privilege in American terms” so that the court need not even resort to foreign law).

397 Id.

398 Id. at 104-05.

399 Restatement (Second) of Conflict of Laws (1988).

400 Id. at § 139(1).

401 Id. at § 139 cmt. c.

402 Id.

403 Andrx, 208 F.R.D at 102.

404 Id. at 99-100 (stating communications between clients and German patent attorneys and patent agents “would also be protected from disclosure by the attorney-client privilege under the law of this Circuit.”).

405 The Andrx court appears to be using the definition of “lawyer” approved by the Supreme Court in Proposed Rule 503(a)(2), 56 F.R.D. 183, 236 (1972), which defines a “lawyer” as “a person authorized, or reasonably believed by the client to be authorized, to practice law in any state or nation.”

406 Smithkline Beecham Corp. v. Apotex Corp., 193 F.R.D. 530, 534 (N.D. Ill. 2000) (citing United States v. Evans, 113 F.3d 1457, 1461 (7th Cir. 1997)); Saxholm AS v. Dynal, Inc., 164 F.R.D. 331, 333 (E.D.N.Y. 1996) (citing von Bulow v. von Bulow, 811 F.2d 136, 144 (2d Cir. 1987); Stryker Corp. v. Intermedics Orthopedics, Inc., 145 F.R.D. 298, 301 (E.D.N.Y. 1992)); Santrade, Ltd. v. Gen. Elec. Co., 150 F.R.D. 539, 542 (E.D.N.C. 1993) (citing Republican Party of N.C. v. Martin, 136 F.R.D. 421, 426 (E.D.N.C. 1991)).

407 Saxholm, 164 F.R.D. at 333 (citing United States v. Davis, 131 F.R.D. 391, 402 (S.D.N.Y. 1990)).

408 Id. (citing In re Grand Jury Subpoena Dated Jan. 4, 1984, 750 F.2d 223, 225 (2d Cir. 1984)).

409 Smithkline Beecham, 193 F.R.D. at 535 (citing McCook Metals L.L.C. v. Alcoa, Inc., 192 F.R.D. 242, 256 (N.D. Ill. 2000); Advertising to Women, Inc. v. Gianni Versace S.p.A., No. 98 C 1553, 1999 WL 608711, at \*3 (N.D. Ill. Aug. 4, 1999)).

410 See, e.g., Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc., 188 F.R.D. 189, 200 (S.D.N.Y. 1999) (French regulations concerning professional secrecy obligations of French patent agents is not comparable to the attorney-client privilege in the U.S.); Santrade, 150 F.R.D. at 547 (letters from two Japanese patent attorneys were insufficient to establish that an attorney-client privilege existed in Japan).

411 McCook Metals, 192 F.R.D. at 257-58.

412 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3.20 (2d ed. 1999), WL ACPRI-FED § 3:20 (“The proponent of this privilege, of course, has the often insurmountable burden of establishing the foreign law.”).

<sup>413</sup> See, e.g., McCook Metals, 192 F.R.D. at 257-258.

<sup>414</sup> Fed. R. Evid. 501.

<sup>415</sup> See, e.g., Agfa Corp. v. Creo Prods., Inc., No. Civ. A. 00-10836-GAO, 2002 WL 1787534, at \*2 (D. Mass. Aug. 1, 2002); Novamont N. Am. Inc. v. Warner-Lambert Co., No. 91 Civ. 6482 (DNE), 1992 WL 114507, at \*2-3 (S.D.N.Y. May 6, 1992).

<sup>416</sup> See, e.g., Duplan Corp. v. Deering Milliken, Inc., 397 F. Supp. 1146, 1169-70 (D.S.C. 1975); In re Ampicillin Antitrust Litig., 81 F.R.D. 377, 391 (D.D.C. 1978); Smithkline Beecham Corp. v. Apotex Corp., 193 F.R.D. 530, 535-36 (N.D. Ill. 2000).

<sup>417</sup> Jaffee v. Redmond, 518 U.S. 1, 8 (1996) (citing *Trammel* v. United States, 445 U.S. 40, 47 (1980)); *Upjohn* Co. v. United States, 449 U.S. 383, 393 (1981) (“[I]f the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.”).

<sup>418</sup> 518 U.S. 1 (1996).

<sup>419</sup> *Id.* at 2.

<sup>420</sup> *Id.* at 8 (quoting Fed. R. Evid. 501).

<sup>421</sup> *Id.* at 8-9 (citing *Trammel*, 445 U.S. at 47).

<sup>422</sup> *Id.* at 9-10 (citing *Trammel*, 445 U.S. at 51).

<sup>423</sup> *Id.* at 11.

<sup>424</sup> *Id.* (quoting *Upjohn*, 449 U.S. at 389).

<sup>425</sup> *Id.* at 11.

<sup>426</sup> *Id.* at 10 (The attorney-client privilege is “rooted in the imperative need for confidence and trust.”) (quoting *Trammel*, 445 U.S. at 51).

<sup>427</sup> See, e.g., *Sperry v. Florida*, 373 U.S. 379, 383 (1963) (“[T]he preparation and prosecution of patent applications [by a patent agent before the USPTO] constitutes the practice of law.”); 37 C.F.R. § 1.34 (2005) (non-attorneys may be registered as patent agents to practice before the USPTO).

<sup>428</sup> *Sperry*, 373 U.S. at 386.

<sup>429</sup> *Id.* at 383.

430        Id. at 402.

431        37 C.F.R. § 10.57(a) (2005). “‘Confidence’ refers to information protected by the attorney-client privilege or agent-client privilege under applicable law.” Id.

432        Harnisch, *supra* note 208, at 445.

433        See, e.g., *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 100-01 (S.D.N.Y. 2002).

434        Id. at 101-02.

435        See, e.g., 37 C.F.R. § 10.56 (2005) (United States); *VLT Corp. v. Unitrode Corp.*, 194 F.R.D. 8, 17-19 (D. Mass. 2000) (discussing Japanese and United Kingdom privilege law); *Yoshida*, *supra* note 208, at 223-26 (discussing Japanese, United Kingdom, and European Patent Attorney confidentiality requirements); *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 524 (S.D.N.Y. 1992) (discussing German and Israeli confidentiality law); *Aktiebolag v. Andrx Pharm., Inc.*, 208 F.R.D. 92, 99-101 (S.D.N.Y. 2002) (discussing German and Korean confidentiality law).

436        *Fisher v. United States*, 425 U.S. 391, 403 (1976); *Mold-Masters Ltd. v. Husky Injection Molding Sys., Ltd.*, No. 01 C 1576, 2001 WL 1268587, at \*4 (N.D. Ill. Nov. 15, 2001).

437        *Jaffee v. Redmond*, 518 U.S. 1, 11 (1996) (quoting *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981)).

438        Id. (quoting *Upjohn*, 449 U.S. at 389).

439        Id. (quoting *Upjohn*, 449 U.S. at 389).

440        Id. (quoting *Upjohn*, 449 U.S. at 389).

441        See Edna S. Epstein, *The Attorney-Client Privilege and the Work Product Doctrine* 7 (4th ed. 2001).

442        Proposed Rule 503(b), 56 F.R.D. 183, 236 (1972).

443        Unif. R. Evid. 502(b) (1999).

444        *Jaffee*, 518 U.S. at 14.

445        Rules of Evidence for United States Courts and Magistrates, 56 F.R.D. 183, 236 (1972) (Proposed Rule 503(a)(2) states “A ‘lawyer’ is a person authorized, or reasonably believed to be by the client to be authorized, to practice law in any state or nation.”); *Jaffee*, 518 U.S. at 9 n.7.

446        Unif. R. Evid. 502(a)(3) (1999) (“‘Lawyer’ means a person authorized, or reasonably believed by the client to be authorized, to engage in the practice of law in any State or country.”); Revised Unif. R. Evid. 502(a)(3) (1974) (“A ‘lawyer’ is a person authorized, or reasonably believed by the client to be authorized, to engage in the practice of law in any state or nation.”) (quoted in Charles T. McCormick, *Evidence* § 87 n.10, at 207 (Edward W. Cleary ed., 3d ed. 1984)).

447 Restatement (Third) of The Law Governing Lawyers § 72 (2000) (a “lawyer” is a person who is a lawyer, or who the client or prospective client reasonably believes to be a lawyer); *Id.* at § 72 cmt. e (“a lawyer admitted to practice in a foreign nation is a lawyer for purposes of the privilege.”); § 72 Reporter’s Note cmt. e (“This Section follows the position of most evidence codes and decisions in defining ‘lawyer’ broadly to include a person admitted to practice law anywhere.”) (citing *Mitts & Merrill, Inc. v. Shred Pax Corp.*, 112 F.R.D. 349, 352 (N.D. Ill. 1986) (finding communications with a German patent agent to be privileged)).

448 See *infra* note 479.

449 Wigmore, *supra* note 18, § 2300a, at 582.

450 The Senate Report indicates that criticism associated with the Supreme Court’s definition of attorney-client privilege centered on Rule 503’s failure to define “representative of the client.” S. Rep. No. 93-1277 (1974), reprinted in 1974 U.S.C.C.A.N. 7051, 7053 (“[E]ven the attorney-client privilege as drafted came in for its share of criticism because of its failure to define representative of the client, as critical issue for corporations and organizations.”). See also *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1160-61 (D.S.C. 1975) (rejecting application of Proposed Rule 503(b) and criticizing the rule’s failure to define “representatives of the client”). The Advisory Committee had purposely left the term “representative of the client” undefined to be resolved on a case-by-case basis. Proposed Rule 503(a)(1) Advisory Committee Note, 56 F.R.D. 183, 237 (1972). The Uniform Rules of Evidence defines “representatives of the client.” Unif. R. Evid. 502(a)(4) (1999). Others criticized Rule 503(b)’s failure to define “in furtherance of the rendition of professional legal services.” See, e.g., *Duplan*, 397 F. Supp. at 1160-61 (rejecting application of Proposed Rule 503(b) and criticizing the rule’s failure to define “in furtherance of the rendition of professional legal services”). However, this concern was probably insignificant in light of the fact that Advisory Committee noted that “[a]ll these communications must be specifically for the purpose of obtaining legal services for the client; otherwise the privilege does not attach.” Proposed Rule 503(b) Advisory Committee Note, 56 F.R.D. at 239. See also *Duplan*, 397 F. Supp. at 1161 (“a communication between an attorney and a client is not privileged unless it is necessary for the rendition of a legal opinion or legal advice.”).

451 Unif. R. Evid. 502(a)(5) (1999). See also Rules of Evidence for United States Courts and Magistrates, 56 F.R.D. 183, 236 (1972) (Proposed Rule 503(a)(3) states “A ‘representative of the lawyer’ is one employed to assist the lawyer in the rendition of professional legal services.”).

452 Unif. R. Evid. 502(a)(4) (1999).

453 See Proposed Rule 503(a)(2) Advisory Comm. Notes, 56 F.R.D. at 238.

454 Similarly, if a German corporation hired a German attorney to coordinate patent protection in the United States with a U.S. patent agent, then communications between the U.S. patent agent and the German patent attorney would be privileged since the German attorney was acting as the client’s lawyer and the U.S. patent agent was acting as the representative of the lawyer.

455 373 U.S. 379 (1963).

456 *Id.* at 401.

457 *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001).

458 *Id.*

459 *Id.*

460 Sperry, 373 U.S. at 383.

461 Id. at 386, 402.

462 See, e.g., Heidelberg Harris, Inc. v. Mitsubishi Heavy Indus., Ltd., No. 95 C 0673, 1996 WL 732522, at \*8 (N.D. Ill. Dec. 18, 1996) (German patent agents, or “patentassessors” are “qualified to conduct any activities which take place before the German Patent Office, including the appealing of decisions of examiners on applications, and the filing and litigating of opposition proceedings. Patentassessors may also provide legal advice to clients on such issues as patentability, patent infringement and validity.”); Golden Trade, S.r.L. v. Lee Apparel Co., 143 F.R.D. 514, 519 (S.D.N.Y. 1992) (“[M]any foreign countries treat their patent agents as the functional equivalent of an attorney and recognize what amounts to an attorney-client privilege for his communications with his clients.”); Id. at 522 (“[F]oreign patent agents perform services akin to lawyers in their field of specialization.”); Novamont N. Am. Inc. v. Warner-Lambert Co., No. 91 Civ. 6482 (DNE), 1992 WL 114507, at \*2 (S.D.N.Y. May 6, 1992) (“[F]oreign patent agents, despite their title, do the same work that patent attorneys do in the United States, receive confidential legal communications from their clients and give legal advice, subscribe to a code of conduct and ethics, and are regulated by their government’s patent offices.”).

463 Wigmore, *supra* note 18, § 2300a, at 582.

464 Id.

465 24 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice and Procedure* § 5480, at 253 (1986).

466 Id. “The argument would be that if appearing before such tribunals is not the ‘practice of law,’ then the person who retains a lawyer for such an appearance is not a ‘client’ because the lawyer is not rendering ‘professional legal services.’” Id. at n.109.

467 Sperry v. Florida, 373 U.S. 379, 383 (1963) (“[T]he preparation and prosecution of patent applications for others constitutes the practice of law.”); *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805-06 (Fed. Cir. 2000) (invention record submitted to in-house patent counsel is protected by the attorney-client privilege).

468 Proposed Rule 503(b) Advisory Committee Note, 56 F.R.D. 183, 239 (1972).

469 *Mold-Masters Ltd. v. Husky Injection Molding Sys., Ltd.*, No. 01 C 1576, 2001 WL 1268587, at \*4 (N.D. Ill. Nov. 15, 2001) (citing Wigmore, *supra* note 18, § 2300a, at 582).

470 This requirement was articulated in 1950 in *United States v. United Shoe Machinery Corp.*, 89 F. Supp. 357, 358-59 (D. Mass. 1950). See also 24 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice and Procedure* § 5480, at 242 (1986) (“This was the common law rule.”); 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3:2 (2d ed. 1999), WL ACPRI-FED § 3:2.

471 Proposed Rule 503(b), 56 F.R.D. at 236.

472 *Unif. R. Evid.* 502(b) (1999).

473 See, e.g., *Joh. A. Benckiser G.m.b.H. v. Chemische Fabrik v. Hygrade Food Prods. Corp.*, 253 F. Supp. 999, 1001-02 (D.N.J. 1966) (no privilege for U.S. patent agents); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1160-61, 1169 (D.S.C. 1974) (no privilege for U.S. patent agents, ignoring definition provided by Proposed Rule 503(a)(2) instead, applying foreign law to find privilege for foreign patent agents); *Status Time Corp. v. Sharp Elecs. Corp.*, 95 F.R.D. 27, 33 (S.D.N.Y. 1982) (no privilege for U.S. or foreign patent agents).

474 Upjohn Co. v. United States, 449 U.S. 383, 389 (1981); Fisher v. United States, 425 U.S. 391, 403 (1976).

475 Cal. Evid. Code § 950 Law Revision Cmt. (West 2002); Wigmore, *supra* note 18, § 2302, at 584.

476 Sperry v. Florida, 373 U.S. 379, 383 (1963).

477 See e.g., Stryker Corp. v. Intermedics Orthopedics, Inc., 145 F.R.D. 298, 306 n.5 (E.D.N.Y. 1992) (letterhead indicated that the patent agents were located in London, England, and that they are “Chartered Patent Agents” and “European Patent Attorneys”).

478 See Restatement (Third) of The Law Governing Lawyers § 72 cmt. e (2000).

479 Ala. R. Evid. 502(a)(3) (2003); Alaska R. Evid. 503(a)(3) (Michie 2003); Ark. R. Evid. 502(a)(3) (Michie 2004); Cal. Evid. Code § 950 (West 1995); Del. Unif. R. Evid. 502(a)(3) (2004); Fla. Stat. Ann. § 90.502(1)(a) (West 1999); Haw. R. Evid. 503(a)(3) (Michie 1995); Idaho R. Evid. 502(a)(3) (Michie 2004); Ky. R. Evid. 503(a)(3) (Michie 2003); La. Code Evid. Ann. Art. 506(a)(3) (West 1995); Me. R. Evid. 502(a)(3) (West 2003); Miss. R. Evid. 502(a)(3) (West 2001); Neb. Rev. Stat. Ann. § 27-503(b) (Michie 1995); Nev. Rev. Stat. Ann. § 49.065 (Michie 2002); N.H. R. Evid. 502(a)(3) (2003) N.M. R. Evid. 11-503(A)(2) (2004); N.D. R. Evid. 502(a)(3) (2004); Okla Stat. Ann. tit. 12, § 2502(A)(1) (West 1993); Or. Rev. Stat. § 40.225(c) (2003) (Or. Evid. Code R. 503(c)); S.D. Codified Laws § 19-13-2(3) (Michie 2001) (Rule 502(a)(3)); Tex. R. Evid. 503(a)(3) (Vernon 2003); Utah R. Evid. 504(a)(2) (2004); Vt. R. Evid. 502(a)(3) (2003); Wis. Stat. Ann. § 905.03(1)(b) (West 2000). Contra N.J. Stat. Ann. § 2A:84A-20(3)(b) (N.J. R. Evid. 504(3)(b)) (West 1994) (“[L]awyer” means a “person authorized, or reasonably believed by the client to be authorized to practice law in any State or nation the law of which recognizes a privilege against disclosure of confidential communications between client and lawyer.”). New Jersey’s definition is based upon Rule 26 of the Uniform Rules of Evidence (1953), rather than the Rule 503 of the Revised Uniform Rules of Evidence (1974). See N.J. Stat. Ann. § 2A:84A (West 1994).

480 Jaffee v. Redmond, 518 U.S. 1, 12-13 (1996) (citing *Trammel v. United States*, 445 U.S. 40, 48-50 (1980); *United States v. Gillock*, 445 U.S. 360, 368 n.8 (1980)).

481 See *id.* at 13.

482 See *id.*; Fisher, 425 U.S. at 403.

483 Jaffee, 518 U.S. at 15 (citing *Trammel*, 445 U.S. at 50).

484 This requirement was articulated in 1950 in *United States v. United Shoe Machinery Corp.*, 89 F. Supp. 357, 358-59 (D. Mass. 1950). See also 24 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice and Procedure* § 5480, at 242 (1986) (“This was the common law rule.”); 1 Paul R. Rice, *Attorney-Client Privilege in the United States* § 3:2 (2d ed. 1999). WL ACPRI-FED § 3:2.

485 Restatement (Third) of The Law Governing Lawyers § 72 Reporter’s Note cmt. e (2000).

486 Proposed Rule 503(a)(2) Advisory Committee Note, 56 F.R.D. at 238; Restatement (Third) of The Law Governing Lawyers § 72 Reporter’s Note cmt. e (2000).

487 See, e.g., Cal. Evid. Code § 950 Law Revision Cmt. (West 2002).

488      *Id.*

489      Restatement (Third) of The Law Governing Lawyers § 72 Reporter's Note cmt. e (2000).

490      Proposed Rule 503(a)(2) Advisory Committee Note, 56 F.R.D. at 238; Restatement (Third) of The Law Governing Lawyers § 72 Reporter's Note cmt. e (2000).

491      *Chemical Eng'g Corp. v. Marlo, Inc.*, 754 F.2d 331, 333 (Fed. Cir. 1984). See also *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 856 (Fed. Cir. 1991) (the Federal Circuit's "mandate is to eliminate conflicts and uncertainties in the area of patent law") (quoting *Panduit Corp. v. All States Plastic Mfg., Co.*, 744 F.2d 1564, 1575 n.14 (Fed. Cir. 1984) (per curium)).