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CHAPTER 16
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THE LAW OF ATTORNEY-CLIENT PRIVILEGE IN PATENT LAW

I. INTRODUCTION: ATTORNEY-CLIENT PRIVILEGE IN GENERAL

The attorney-client privilege is one of the oldest evidentiary privileges for confidential communications. The main purpose of the attorney-client privilege is “to encourage full and frank communications between attorneys and their clients.” The attorney-client privilege is necessary to guarantee “the fullest freedom and honesty of communication” from a client to his or her attorney. Furthermore, the 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 them to give sound and informed advice.” Thus, the ultimate goal of having the privilege is to promote sound legal advice that takes all information into account.

In general, the attorney-client privilege applies when (1) the person to whom the communication was made is acting as a professional legal advisor in his or her capacity as such, (2) the communication was made in confidence, and (3) the communication was made primarily for the purpose of securing an opinion on law or legal service. Courts have been struggling to find bright line rules for these factors as evident in the case law on the attorney-client privilege, which suggests that the application of the privilege can be complicated.

1 In re Seagate Tech., LLC., 497 F.3d 1360, 1372 (Fed. Cir. 2007) (quoting Upjohn Co., v. United States, 449 U.S. 383, 389 (1981)).
2 Id.
4 Upjohn, 449 U.S. at 389.
5 Id.
6 Cavallaro v. United States, 284 F.3d 236, 245 (1st Cir. 2002) (citing 8 John Henry Wigmore, EVIDENCE § 2292, at 554 (McNaughton rev. 1961); see also In re Spalding Sports Worldwide, Inc., 203 F.3d 800, 805 (Fed. Cir. 2000) (“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.”); United Shoe Mach. Corp., 89 F. Supp. at 358-359 (explaining the protection of the attorney-client privilege) (“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 some legal proceeding.”).

The factor requiring the communication be made for the purpose of obtaining legal opinion or legal service indicates that not all communications to a legal advisor are protected under the attorney-client privilege. Generally, the attorney-client privilege does not apply to facts and business advice. Facts underlying a legal opinion, separate from the communication itself, are not protected by the attorney-client privilege. Pure business advice will also generally be exempted from the attorney-client privilege. In Upjohn v. United States, the Supreme Court declined to establish a bright-line rule regarding the privilege as applied to business communications with counsel; instead the Supreme Court held that the law of privilege should evolve on a case-by-case basis. In the absence of a bright-line rule, courts have been examining the attorney-client privilege based on facts and circumstances specific to a case. When a court employs a case-by-case approach, however, it can be difficult to determine in this context whether a lawyer’s advice is strictly business advice or a mix of business advice and legal opinion.

The attorney-client privilege is further complicated in case of corporations. Since corporations are artificially created legal entities that make decisions through agents, both state and federal courts have been dealing with confusion and uncertainty in applying the attorney-client privilege to corporate clients. In particular, application of the
attorney-client privilege to communications between in-house counsel and their employers may be even more complicated because tasks of in-house counsel may include transactional work, which is different from traditional tasks for attorneys, such as litigation.

This article reviews the law of attorney-client privilege in patent-related matters. Part II of this article provides a review of the attorney-client privilege in the U.S. patent law context, with a focus on the application of the privilege to patent prosecution work and patent agent privilege. Part III analyzes the case law on the application of the privilege to communications with foreign patent agents. Part IV introduces the recent proposal by the United States Patent and Trademark Office (“USPTO”).

II. ATTORNEY-CLIENT PRIVILEGE IN U.S. PATENT LAW

Applicability of the attorney-client privilege to patent law in the United States can be complicated in two ways: (1) the factual nature of the communications in patent law; and (2) the lack of recognition in state law for this primarily Congressionally proscribed role in practicing before the USPTO. First, patent prosecution generally involves facts and technical information about an invention, and facts and technical information are not protected by the attorney-client privilege. Some courts had held that communications between a client and patent attorney regarding the patent application were accordingly not privileged. This view was ultimately rejected by In re Spalding Sports Worldwide, Inc. The Spalding court applied the attorney-client privilege to communications made in the preparation of patent applications. Section A provides a review of the case law on the attorney-client privilege in patent prosecution. Second, patent agents are authorized by Congress to practice law before the USPTO. Federal courts, following In re Queen’s University at Kingston, may protect communications between patent agents and their clients. State courts, however, may not recognize the patent agent-client privilege. Section B discusses federal and state courts’ decisions on the patent agent-client privilege. This article considers the attorney-client privilege from two perspectives: (1) the attorney-client privilege in patent prosecution work and (2) the patent agent-client privilege.

A. Patent Prosecution

The Supreme Court and several federal courts have held that the attorney-client privilege applies to patent prosecution work. Previously, some courts had refused to apply the attorney-client privilege to patent prosecution work. In Zenith Radio Corporation v. Radio Corporation of America, the Delaware District Court held that attorneys do not act as lawyers for purposes of the attorney-client privilege when they perform patent prosecution work. However, the Supreme Court rejected this view in Sperry v. State of Florida by expressly holding that “the preparation and prosecution of patent applications for others constitutes the practice of law.”

Even after the Sperry court confirmed that patent prosecution work constitutes the practice of law, however, uncertainty remained with regard to the applicability of the privilege to patent application

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14 Id.

15 In re Queen’s Univ. at Kingston, 820 F.3d 1287, 1231 (Fed. Cir. 2016).

16 Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc., 265 F.3d 1294, 1307 (Fed. Cir. 2001).

17 Zenith Radio Corp., 121 F. Supp. at 794 (“Patent attorneys, who work for companies, do not act as lawyers for purposes of the attorney-client privilege when the attorneys are not primarily engaged in legal activities, when largely concerned with technical aspects of a business or engineering character, or competitive consideration 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 inventions and novelty; when drafting or comparing patent specifications and claims; when preparing the application for letter patent or amendments thereto and prosecuting same in the Patent Office; when handling interference proceedings in the Patent Office concerning patent applications.”).

18 Sperry v. Fla., 373 U.S. 379, 383 (1963) (“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 state law.”). The court also notes that drafting of the specification and claims of the patent application under 35 U.S.C. § 112, which has been considered as “one of the most difficult legal instruments to draw with accuracy.” Id.
documents. This uncertainty left a split between two distinct lines of cases, one from *Jack Winter, Inc. v. Koratron Co.* and the other from *Knogo v. United States.* This split was resolved by the Federal Circuit case, *In re Spalding Sports Worldwide, Inc.*

The *Jack Winter* court based its decision on the disclosure requirement under 35 U.S.C. § 112 and 37 C.F.R. §1.56. Since an application for a patent must include a bona fide full disclosure of sufficient factual information to enable one skilled in the art to make and practice the invention, the court considered an attorney filing a patent application as a conduit between his or her client and the USPTO. The *Jack Winter* court held that the attorney-client privilege did not apply to the communication because the client did not expect the information included in the patent application to remain confidential.

On the contrary, in *Knogo*, the court distinguished “the duty to disclose how to make and use the invention” from the “mere funneling of technical information from the client through the attorney to the Patent Office.” The *Knogo* court recognized the attorney-client privilege for the communication between the attorney and client, not for the technical information contained in the communication. In a case following *Knogo*, *Advanced Cardiovascular System v. C.R. Bard, Inc.*, the court held that communications between inventors and their patent attorneys included substantial private dialogue as part of the process of drafting a patent application. The attorney-client privilege may be presumed even for entirely technical communications from inventors to their patent attorney, unless such communications rested on a “very compelling showing” that the inventor expected the patent attorney to merely pass on the communication to the USPTO without changes.

The Federal Circuit in *Spalding* resolved this split by following *Knogo* and applied the attorney-client privilege to patent application documents. Since the Federal Circuit law controls the discovery rules in patent cases, the *Spalding* decision effectively ended the *Jack Winter* line of cases and rationales.

B. Patent Agent-Client Privilege

The rule of privilege in patent prosecution work is further complicated by the unique role of patent agents.

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23 *Id.* at 228.


26 *Id.*


28 *Id.*


30 *Id.* at 805.

31 *Id.*

32 *Id.* at 802 n.2.

33 *Id.* at 806.

34 *Id.*

35 *Id.*

36 *Id.*
Patent agents are not members of the bar of any state although they are authorized to practice law before the USPTO. To be a patent agent, one must pass the patent registration examination, which is administered by the USPTO. Although the USPTO only requires a science undergraduate degree or equivalent experience in the industry to sit for the patent bar, in-depth knowledge of patent law is expected of a patent agent. Thus, a patent agent working as an outside consultant or an in-house consultant should have a thorough understanding of patent law including the procedures and rules of the USPTO. In turn, a patent agent is able to provide legal advice to clients on patent law, in particular, on patent protection strategies.

Historically, no privilege is applied unless the patent agent is working under the direction and supervision of an attorney. However, some courts recognized that the attorney-client privilege can extend to patent agents acting on their own and not under authority or control of a lawyer. Federal and state courts may diverge on the applicability of the attorney-client privilege to communications between patent agents and their clients.

1. Federal Court

In Sperry, the Supreme Court found that the rights conferred to patent agents are federal rights and Congress expressly permitted patent agents to practice law before the USPTO through the 1952 Patent Act. Uncertainties, however, remained as to which activities performed by patent agents are entitled to the privilege.

In In re Queen’s University at Kingston, the Federal Circuit resolved some of the uncertainties surrounding the application of privilege to communications with patent agents and defined the scope of the patent agent-client privilege (hereafter “patent agent privilege”). The Federal Circuit recognized that the scope of the patent agent privilege should extend to the activities that Congress has authorized for non-attorney patent agents to engage in the practice of law. More specifically, the Federal Circuit limits the scope of the activities of non-attorney patent agents to activities authorized by Congress in 37 C.F.R § 11.5 (b)(1). The scope of activities under 37 C.F.R. § 11.5 (b)(1) include, but are not limited to:

“Preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding.”

The Federal Circuit held that the patent agent privilege applies to tasks “reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office (USPTO) involving a patent application.” On the other hand, communications that fall outside the scope of the patent agent privilege include communications that are not reasonably necessary and incident to the prosecution of patents before the USPTO. For example, a communication “with a patent agent who is offering an opinion on the validity of another party’s patent in contemplation of litigation, or for the sale or purchase of a patent, or on infringement” may fall outside of the scope of the patent agent privilege.

Traditional legal activities such as licensing agreements and litigating lawsuits may also likely fall outside the patent agent privilege unless it is done under the direction or control of a lawyer.

Although In re Queen’s University at Kingston defined the scope of the patent agent privilege, some uncertainties remain. For example, it is still unclear how much of patent agent communications would fall under the patent agent privilege in case of inter partes review or post-grant review proceedings before the USPTO. It is also not clear whether a freedom-to-

41 Sperry, 373 U.S. at 379.
42 In re Queen’s Univ. at Kingston, 820 F.3d 1287, 1231 (Fed. Cir. 2016).
operate study would be considered as an activity authorized for patent agents. As will be discussed in Part IV, the USPTO has recently proposed a new rule to clarify the scope of the patent agent privilege in USPTO proceedings.

2. State Court

Federal law is used to determine when a potential privileged communication involves a legal issue that is substantively related to patent law. However, if the communication relates to a legal issue primarily outside patent law, the law of the local jurisdiction may apply. For example, under the Texas state law, the patent agent privilege may not exist for communications between patent agents and their clients. A Texas state court, in a recent case, In re Andrew Silver, refused to recognize the patent agent privilege for communications between patent agents and their clients in a breach of contract case. While federal rules of evidence permit federal courts to determine new discovery privileges, Texas state courts can only recognize privileges grounded in the Texas Constitution, statutes, the Texas Rules of Evidence, or other regulations. Texas state courts are prohibited from determining new discovery privileges and may rely only on privileges already grounded in rules established by state law. In Silver, the Fifth Court of Appeals held that the In re Queen’s University at Kingston decision is not binding on a breach of contract dispute that does not involve a determination of the validity of a patent or a patent infringement. Thus, because Texas state courts base their decisions on the Texas evidentiary rules, the patent agent privilege may not protect communications between patent agents and their clients in Texas state courts when a case deals primarily with non-patent issues.

III. COMMUNICATIONS WITH FOREIGN PATENT AGENTS

Use of patent agents may be more prevalent in some foreign countries. Determining the patent agent privilege issue with foreign patent agents usually involves choice-of-law issues and analysis of foreign privilege law. In cases where communications with a foreign patent agent relate to a United States patent, the law of the United States, not the foreign jurisdiction, applies. Determining applicability of the patent agent privilege to communications between a foreign patent agent and his or her client concerning foreign patents, most federal courts employ a two-part analysis: courts first determine whether U.S. privilege law or foreign privilege law should apply, and second, if the court determines that foreign privilege law applies, the court must then determine whether the foreign privilege law protects communications with patent agents from discovery. In a case where a court establishes that foreign privilege law should apply, the party claiming the privilege has the burden to establish that the attorney-client privilege extends to the patent agent and that the communications were intended to be confidential. Section A reviews the approaches that courts have been taking to determine whether U.S. privilege law or foreign privilege law should apply. Section B discusses cases involving foreign patent agents specific to France, Japan, Korea, and Sweden.

A. Choice of Law

Courts have applied several different approaches to address the choice-of-law issues. Mainly, courts have followed the “touching base” approach or “the most direct and compelling interest” approach when determining whether U.S. privilege law or foreign privilege law should apply.

Under the “touching base” approach, the main inquiry is whether communications with a foreign agent “touch base” with the United States. Communications are considered to “touch base” with the United States when they are related to prosecuting U.S. patent applications, issues of the U.S. patent law, or U.S. litigation. Furthermore, under the “touching base” approach, the main inquiry is whether communications with a foreign agent “touch base” with the United States.

53 In re Ampicillin Antitrust Litig., 81 F.R.D. 377, 391 (D.D.C. 1978) (emphasizing the United States’ strong interest in “regulating activities that involve its own patent laws”). The court held that “all communications relating to patent activities in the United States will be governed by the American rule.” Id.


57 Id.


50 In re Andrew Silver, No. 05-16-00774-CV (Tex. App.—Dallas 2016).

51 Id.

52 Id.
B. Foreign Privilege Law

Statutes on the privilege have the highest authority in determining applicability of privilege; however, courts may also consider other rules of law and regulations before the applicable patent office. In some countries where patent prosecution work is mostly done by patent agents, not attorneys, no patent agent privilege exists. As discussed in more detail below, however, some courts have found communications involving a foreign patent agent privileged even though the substantive law of the foreign country did not provide the privilege comparable to the U.S. attorney-client privilege to communications with patent agents.

1. France

Some courts in the United States have denied protection of the patent agent privilege to communications between French patent agents and their clients. In France, French patent agents (conseil d'invention) are required to maintain client communications confidential. Furthermore, French patent agents are subject to professional secrecy, which extends broadly to communications with clients, professional correspondence exchanged, and all documents prepared for the purpose of communicating with clients. However, courts in the United States have held that these provisions alone do not provide protection comparable to the protection of the attorney-client privilege in the United States. Initially, the court in Duplan Corp. v. Deering Milliken, Inc., found the protection under the privilege law applied to French patent agents. In Duplan, the court held that a communication between a French patent agent and his clients should be protected because the clients of the French patent agent reasonably expected under French law that the communications would remain confidential. In a subsequent case, Bristol-Myers Squibb v. Rhone-Poulenc Rorer, however, the court further considered that both the French Penal Code and the regulations pertaining to patent agents may permit French patent agents to make disclosures in court.

60 Golden Trade, 143 F.R.D. at 522.
61 RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 139(2) cmt. d (1988).
63 Duplan Corp. v. Deering Milliken Inc., 397 F. Supp. 1146, 1170 (D.S.C. 1974) (citing to Article 378 of the French Penal Code) (“[P]ersons who are depositories, by their condition or profession or by temporary or permanent duties, of secrets which are entrusted to them, who, except in cases where the law obliges or authorizes them to be informers, shall have revealed such secrets, shall be punished by imprisonment of one month to six months and by a fine of 500 to 3,000 francs.”).
65 Duplan Corp. 370 F. Supp. at 766.
66 Id. at 768.
The court held that “the fact that a statute requires a party to keep clients’ affairs secret does not mean that a privilege exists.” The professional secrecy is not equivalent to the attorney-client privilege in the United States. The court concluded that communications between French patent agents and their clients are not entitled to the protection of the attorney-client privilege.

In 1990, France introduced the title of “Industrial Property Attorney (conseil en propriete industrielle),” and in turn, added a new factor to the patent agent privilege analysis. The pre-existing patent agents who could not become or were not qualified as Industrial Property Attorneys under the French Intellectual Property Code were put on a Special List and allowed to continue to practice as they previously had. In response to the Bristol-Myers decision, the French Intellectual Property Code was amended by deleting language which denied the privilege to client’s communications and adding Article L. 422-11, which requires professional secrecy to be afforded to Industrial Property Attorneys. The privilege applies only to an Industrial Property Attorney who is independent from “other professions and commercial influences” as provided in Article L. 422-12 and 13.

In Commissariat a l’Energie Atomique v. Samsung Electronics Co., the court held that “employees of a corporation do not have independence to assert evidentiary privilege because they are subordinate to management that does not enjoy that right.” Thus, the decision in Commissariat a l’Energie Atomique adds another factor in the privilege analysis of communications with French patent agents.

2. Japan

Prior to 1998, Japanese law did not have a privilege law for Japanese patent agents (benrishi) comparable to the attorney-client privilege in the United States. Accordingly, the U.S. courts, prior to 1998, held that Japanese law did not provide for the patent agent privilege. In 1998, Japan amended its Code of Civil Procedure to include a privilege provision very similar to the attorney-client privilege in the United States. In particular, Article 197(2) states that an attorney, which includes a patent agent, may refuse to testify when he is questioned with regard to a communication made to him in “the exercise of his professional duties.”

The U.S. courts have recognized this privilege. In VLT Corp. v. Unitrode Corp., the court held that a communication with a Japanese patent agent was privileged because Japanese patent agents “may appear before the Japanese patent office, offer legal advice concerning infringement and validity issues under Japanese patent law, send warning letters to potential infringer, and appear on behalf of clients in certain court proceedings relating to patents.” The court in Eisai Ltd. v. Dr. Reddy’s Labs., Inc., also recognized that “Japanese law extends a privilege to documents created by benrishi, and has done so at least since an amendment to the Code of Civil Procedure of Japan in 1998.” The court in Eisai distinguished Japanese law from French law in the Bristol-Myers decision and concluded that Japanese law provides a privilege, whereas French law did not extend such protection to patent agents’ communications. Since the patent agent privilege law in Japan clearly provides for the patent agent privilege, communications with Japanese

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67 Bristol-Myers, 1998 U.S. Dist. LEXIS 4213, at *5 (further considering the Article 12, Section 12.3 of the French regulations concerning the professional secrecy obligations of patent agents, which states that “the professional secrecy rules are not enforceable either against persons legally empowered to conduct judicial, administrative or customs investigations, or against courts of legal jurisdiction.”).

68 Id. at *6.

69 Id.

70 Id. at *7.


72 Id.

73 Id. at 182. (“In all matters and for all services referred to in Article L. 422-1, the industrial property attorney shall observe professional secrecy. Such secrecy extends to all communications addressed to or destined to his client, to professional correspondences exchanged with his client, a colleague or attorney, to discussion notes, and more generally, to all the documents of the file.”).

74 Id. at 186. See also id. at 182 (stating Article L. 422-12) (“An Industrial Property Attorney cannot be involved with any commercial activity, nor associate with any association, partnership, limited liability company, or report to any chairman of the board of directors, member of the managing board, general or assistant general director or president of a company or corporation unless the association, partnership, company corporation or superior engages in the profession of Industrial Property Attorney.”).

75 Id.


78 Id.


80 Id.
patent agents would be considered privileged as long as Japanese privilege law applies.

3. Korea

Korean substantive law does not recognize an attorney-client privilege comparable to that of the United States.\textsuperscript{81} However, in \textit{Astra Aktiebolag v. Andrx Pharmaceuticals, Inc.}, the court protected communications between a foreign client and its Korean attorneys.\textsuperscript{82} In \textit{Astra}, a Swedish corporation’s in-house counsel and employees communicated with Korean attorneys regarding patent litigation pending in Korean courts and patent proceedings before the Korean Intellectual Property Office.\textsuperscript{83} The litigation documents contained communications from Korean attorneys regarding proceedings in Korea, confidential communications between Swedish employees and experts in the Korean proceedings, and other documents prepared for the purpose of providing legal advice.\textsuperscript{84} The defendant sought production of all of these documents for use against the plaintiff in a patent suit in the United States.\textsuperscript{85}

The \textit{Astra} court found some Korean evidentiary procedures related to the concept of attorney-client privilege in the United States, although none provided protection comparable to the attorney-client privilege in the United States.\textsuperscript{86} However, even though the court noted that “if no privilege is provided for by the statutes of the foreign forum, no privilege can be implied,” the court determined that the lack of a statutory attorney-client privilege and work product protection in Korea would not necessarily require that parties would have to testify or produce documents concerning confidential communications in a lawsuit in the Korean courts.\textsuperscript{87} According to Korean law, a court may only issue an order to compel document production under limited circumstances, and none of the challenged documents would be compelled for production.\textsuperscript{88}

Since the law governing document disclosure is procedural, the court in \textit{Astra} found that discovery of the Korean documents should be governed by the Federal Rules of Civil Procedure. Because Korean discovery practice only permits minimal discovery, ordering discovery without any protection would be against the public policy of Korea, which would prevent disclosure of privileged documents.\textsuperscript{89} In such case, application of Korean privilege law would require disclosure of many document that are 1) privileged under American law and 2) not discoverable under Korean law. This would contradict the public policies of the United States, which strive to uphold or expand privileges to protect documents that would be protected in other countries.\textsuperscript{90} Therefore, the court in \textit{Astra} followed “the most direct and compelling interest” approach and applied the U.S. privilege law to the Korean documents, even though the communications do not “touch base” with the United States.\textsuperscript{91}

4. Sweden

Although some courts in the United States have recognized the patent agent privilege for Swedish patent agents, it is unclear whether the patent agent privilege exists in Sweden. In \textit{Santrade Ltd. v. General Electric Co.}, the court recognized that the attorney-client privilege extended to documents created by a Swedish patent attorney under Swedish law because a declaration submitted by the Swedish patent attorney in question sufficed to provide privilege to the document.\textsuperscript{92} The court in \textit{Santrade} concluded that the Swedish attorney-client privilege extended to patent agents. In a subsequent case, \textit{Saxholm AS v. Dynal, Inc.}, the court followed the decision in \textit{Santrade}, holding that “in the absence of evidence to contrary,” \textit{Santrade} should govern.\textsuperscript{93} However, in \textit{In re Rivastigmine Patent Litigation}, the court held that citing to \textit{Santrade} alone, without any reference to Swedish law, would not grant the privilege to the communications in question. The Swedish privilege law was not examined by the \textit{Rivastigmine} court.

In 2010, Sweden passed a law that applies the evidentiary privilege to communications between authorized Swedish patent attorneys and their clients.\textsuperscript{94} In the absence of U.S. case law after the enactment of this Swedish law, it is uncertain whether U.S. courts would apply the evidentiary privilege to

\textsuperscript{81} Astra Aktiebolag v. Andrx Pharm., Inc., 208 F.R.D. 92, 100-01 (S.D.N.Y. 2002).
\textsuperscript{82} \textit{Id.} at 99.
\textsuperscript{83} \textit{Id.}
\textsuperscript{84} \textit{Id.}
\textsuperscript{85} \textit{Id.}
\textsuperscript{86} \textit{Id.} at 101.
\textsuperscript{87} \textit{Id.}
\textsuperscript{88} \textit{Id.}
\textsuperscript{89} \textit{Id.}
\textsuperscript{90} \textit{Id.}
\textsuperscript{91} \textit{Id.}
communications between authorized Swedish patent attorneys and their clients. But based on the case law involving foreign patent agents, U.S. courts would most likely recognize a privilege for authorized Swedish patent attorneys.

IV. USPTO PROPOSED RULE

On October 18, 2016, the USPTO proposed a new rule on patent agent privilege. The proposed rule states that communications between clients and patent agents, both domestic and foreign, during USPTO proceedings “shall receive the same protections of privilege as if that communication were between a client and an attorney authorized to practice in the United States.”95 The goal of this proposed rule is to clarify the protection afforded to communications between patent agents and their clients.96

This new proposed rule can “reduce uncertainty and mitigate discovery costs.”97 Following the In re Queen’s University at Kingston decision, this rule would expressly define the scope of a privilege to activities that a patent agent is authorized to carry out.98 The rule can also “ensure consistent outcomes with respect to privilege matters” in USPTO proceedings, improve public understanding on privilege questions in the practice before the Patent Trial and Appeal Board (PTAB), and “help further judicial economy by providing PTAB judges with a clear, concise statement of when privilege applies.”99

V. CONCLUSION

The law of attorney-client privilege in patent law can be complicated. Although the Spalding decision confirmed that documents related to patent applications are within the scope of the attorney-client privilege, patent applicants can take protective measures such as keeping confidentiality logs, putting a “confidential” seal on documents, and avoiding disseminating documents to general employees to ensure protection of documents from the risk of discovery.

With regard to the patent agent privilege in the United States, some uncertainties are resolved by the In re Queen’s University at Kingston decision where the Federal Circuit held that communications with a patent agent are protected when the patent agent performs tasks within the scope of activities authorized by Congress. The USPTO recently proposed a new rule extending the attorney-client privilege for domestic and foreign patent agents to resolve some of uncertainties surrounding privilege issues in USPTO proceedings. However, communications with patent agents that fall outside the scope authorized by Congress may not be protected. In order to keep communications with patent agents privileged, in many cases it would be advisable for patent agents to work under direction or control of an attorney.

Case law interpreting the patent agent privilege of foreign countries suggests that unless the foreign law on the patent agent privilege is clear, courts may reach different outcomes. After Japan amended its Code of Civil Procedure, courts have ruled that Japanese privilege law clearly extends to Japanese patent agents. In cases involving French patent agents, however, courts held that the existence of a professional secrecy obligation did not automatically mean that a privilege exists. On the other hand, despite the lack of privilege law in Korea, the court in Astra applied the U.S. attorney-client privilege because production of the documents in question would not be compelled under


§ 42.57 Privilege for patent practitioners.

(a) Privileged communications. A communication between a client and a domestic or foreign patent practitioner that is reasonably necessary or incident to the scope of the patent practitioner's authority shall receive the same protections of privilege as if that communication were between a client and an attorney authorized to practice in the United States, including all limitations and exceptions.

(b) Definitions. The term “domestic patent practitioner” means a person who is registered by the United States Patent and Trademark Office to practice before the agency under section 11.6. “Foreign patent practitioner” means a person who is authorized to provide legal advice on patent matters in a foreign jurisdiction, provided that the jurisdiction establishes professional qualifications and the practitioner satisfies them, and regardless of whether that jurisdiction provides privilege or an equivalent under its laws.


96 Id.

97 Id. at 71654 (quoting a comment received by the USPTO on whether it should apply privilege to communications between patent applicants and owners and their U.S. patent agents or foreign patent practitioners). The USPTO collected comments on the new rule and respondents unanimously supported a rule recognizing the attorney-client privilege for patent agents. Id.

98 Id. at 75655.

99 Id.
Korean law. Therefore, to ensure protection of communication with foreign patent agents regarding litigation in the United States, foreign evidentiary law on discovery must be thoroughly examined. And in cases of potential ambiguities, steps should be taken to increase the probability that privilege will be applied, such as by involving a licensed attorney of the respective jurisdiction.