

**LET'S ALL GET ON THE SAME PAGE:
EQUATING PATENT-AGENT PRIVILEGE TO ATTORNEY-CLIENT
PRIVILEGE**

Alexandra K. Kim*

Cite as: Alexandra K. Kim, *Let's All Get on the Same Page:
Equating Patent-Agent Privilege to Attorney-Client Privilege*, 27 RICH.
J.L. & TECH., no. 3, 2020.

* Patent Litigation Associate at Wolf, Greenfield & Sacks, P.C. in Boston, Massachusetts. J.D. from Northeastern University School of Law, M.S. from Tufts University School of Medicine, B.A. from Wellesley College. The author would like to acknowledge Professor Kara W. Swanson at the Northeastern University School of Law for her thoughtful suggestions and guidance. Additionally, the author would like to thank the editors and staff at the Richmond Journal of Law and Technology for their careful edits. The opinions expressed in this article are solely those of the author, and do not necessarily reflect the views or opinions of Wolf Greenfield or Northeastern.

ABSTRACT

In 2016, in *In re Queen's University*, the Federal Circuit recognized a new sort of privilege: patent-agent privilege. The court ruled that patent-agent privilege protects communications between a patent agent and client that are “reasonably necessary” for the patent prosecution process. District courts have since attempted to clarify the meaning of “reasonably necessary.” In 2017, the United States Patent and Trademark Office similarly recognized patent-agent privilege in Patent Trial and Appeal Board proceedings and all communications in front of the USPTO. However, the majority of state courts, following their own privilege rules for state law claims, have not yet addressed whether a privilege exists for patent agents and their clients.

Due to the inconsistent standard for communications that fall under patent-agent privilege, patent-agent privilege should be equal to attorney-client privilege in all venues. Doing so would allow the client to expect the same level of privacy in their work with a patent agent as with an attorney. Additionally, it would make patent prosecution more accessible since patent agents typically have lower billing rates than attorneys. Further, equating the two privileges would clarify what communications are in fact protected, all without expanding the patent agent’s ability to practice law in front of the USPTO.

This paper will delve into the different standards of patent-agent privilege and discuss why patent-agent privilege should be equivalent to attorney-client privilege in all venues. Holding otherwise would go against the very goal that patent-agent privilege was created to protect: the client.

I. ATTORNEY-CLIENT PRIVILEGE

[1] Attorney-client privilege is one of the oldest evidentiary privileges in the American legal system.¹ It exists to encourage clients to rely on their attorneys and for attorneys to properly represent their clients.² The U.S. Supreme Court has stated that attorney-client privilege's purpose is to "encourage full and frank communication" and "thereby promote broader public interests in the observance of law and administration of justice."³

[2] The Federal Rules of Evidence do not explicitly define attorney-client privilege.⁴ Instead, the rules provide that a federal common law of attorney-client privilege applies to federal law claims, and state common law governs privilege for state law civil claims or defenses.⁵ The common law definitions of attorney-client privilege guides courts.⁶ Dean Wigmore's Evidence treaty put forth one of the oldest articulations of attorney-client

¹ *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981).

² *See id.*

³ *Id.*

⁴ *See* FED. R. EVID. 501 (including Notes of Committee on the Judiciary, House Report No. 93-650, which states "[t]he Committee amended Article V to eliminate all of the Court's specific Rules on privilege.>").

⁵ *Id.*

⁶ *See* Matthew M. Welch, *Warning! Patent Agent Privilege Ends Abruptly*, 100 J. PAT. & TRADEMARK OFF. SOC'Y, 578, 583 (2019).

privilege that the First,⁷ Second,⁸ Sixth,⁹ Seventh,¹⁰ Eighth,¹¹ and Ninth Circuit Courts have since adopted.¹² Wigmore's definition is the following:

(1) Where legal advice of any kind is sought (2) from a professional legal adviser 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 adviser, (8) except the protection be waived.¹³

The Restatement (Third) of the Law Governing Lawyers also puts forth a definition of attorney-client privilege similar to Wigmore's formulation.¹⁴ It defines attorney-client privilege as protecting "(1) a communication (2) made between privileged persons (3) in confidence (4) for the purpose of obtaining or providing legal assistance for the client."¹⁵ Both federal

⁷ *See, e.g.*, *Cavallaro v. United States*, 284 F.3d 236, 245 (1st Cir. 2002) (outlining explicitly Wigmore's eight-part definition).

⁸ *See, e.g.*, *United States v. Richard Roe, Inc.*, 68 F.3d 38, 39–40 (2d Cir. 1995) (outlining explicitly Wigmore's eight-part definition).

⁹ *See, e.g.*, *Reed v. Baxter*, 134 F.3d 351, 355–56 (6th Cir. 1998) (outlining explicitly Wigmore's eight-part definition).

¹⁰ *See, e.g.*, *United States v. Evans*, 113 F.3d 1457, 1461 (7th Cir. 1997) (outlining explicitly Wigmore's eight-part definition).

¹¹ *See, e.g.*, *Hanes v. Dormire*, 240 F.3d 694, 717 (8th Cir. 2001) (outlining explicitly Wigmore's eight-part definition).

¹² *See, e.g.*, *United States v. Martin*, 278 F.3d 988, 999 (9th Cir. 2002) (outlining explicitly Wigmore's eight-part definition).

¹³ *Evans*, 113 F.3d at 1461.

¹⁴ RESTATEMENT (THIRD) OF THE LAW GOVERNING LAWYERS § 68 (2000).

¹⁵ *Id.*

common law formulations define attorney-client privilege as protecting communications for legal advice made in confidence between a client and an attorney. In state courts, the precise definition of attorney-client privilege varies, but the differences are small.¹⁶ There is “[g]enerally speaking . . . a high degree of uniformity amongst states.”¹⁷

[3] Attorney-client privilege is especially important during patent prosecution efforts. Patent prosecution is unique because patent applications often heavily depend on the data given to patent attorneys by the clients.¹⁸ Thus, clients are often concerned with whether or not the data they give their legal advisor is privileged.¹⁹ Appeals courts have held that if client-provided data is created for the specific purpose of receiving legal advice, the data is protected by attorney-client privilege.²⁰ However, courts have found that purely technical data given to complete a patent prosecution is not privileged.²¹ Further complicating matters, these privilege rules may

¹⁶ See *Phillips v. C.R. Bard, Inc.*, 290 F.R.D. 615, 625 (D. Nev. 2013) (“Nonetheless, Bard recognizes that under New Jersey, Arizona, and Nevada law, the basic substantive elements of the attorney-client privilege are the same . . . ‘[U]nder each state’s law, confidential communications between an attorney and client made for the purpose of giving or receiving legal advice are privileged.’”).

¹⁷ ARIAS, BASICS OF ATTORNEY-CLIENT PRIVILEGE 1 (2017), <https://www.arias-us.org/wp-content/uploads/2017/09/Privilege-and-its-Perils-Detailed-Outline-Materials.pdf> [<https://perma.cc/7PUK-FLX3>].

¹⁸ David Stephenson, *Biotechnology and the Independent Inventor: Experiments*, Law Office of Vincent Lotempio, PLLC (Mar. 6, 2021), <https://www.lotempiolaw.com/2015/02/blog-2/biotechnology-experiments/> [<https://perma.cc/LLF2-KB42>].

¹⁹ See *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 802 (Fed. Cir. 2000); *Shopify Inc. v. Express Mobile, Inc.*, No. 20-MC-80091-JSC, 2020 WL 4732334, at *4 (N.D. Cal. Aug. 14, 2020).

²⁰ *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805–06 (Fed. Cir. 2000).

²¹ *Willemijn Houdstermaatschaap BV v. Apollo Comput., Inc.*, 707 F. Supp. 1429, 1448 (D. Del. 1989).

not be evaded by attaching an unprivileged communication to a privileged communication, such as an email.²² As the New Jersey District Court stated, “[d]ocuments are not privileged simply because they end up with a lawyer or eventually prove useful to the lawyer’s provision of legal services.”²³

[4] The work-product doctrine is another avenue by which a patent attorney may try to protect information shared between the attorney and client.²⁴ Unlike attorney-client privilege that focuses on confidential communications, the work-product doctrine focuses on tangible documents containing the attorney’s thoughts and mental impressions.²⁵ To invoke this type of immunity, documents must have been prepared in anticipation of litigation, although there are a few exceptions.²⁶ These exceptions include when the materials are within the scope of discovery or when the party demonstrates a substantial need for the materials and cannot obtain them by other means without undue hardship.²⁷ The U.S. Supreme Court has

²² *AM Gen. Holdings, LLC v. Renco Grp., Inc.*, Nos. 7639-VCN, 7668-VCN, 2013 WL 1668627, at *3 (Del. Ch. Apr. 18, 2013) (“[i]f emails are privileged, but the attachments to the emails do not independently earn that protection, then the attachments may not be withheld on [grounds that the email is privileged].”) (alterations in original); *Roberts Tech. Grp., Inc. v. Curwood, Inc.*, No. 14-5677, 2015 WL 4503547, at *2 (E.D. Pa. Jul. 20, 2015) (holding that email attachments, otherwise not privileged, did not become privileged simply because it was attached to a privileged email from attorneys to in-house counsel).

²³ *Hoffmann-La Roche, Inc. v. Roxane Lab’ys, Inc.*, No. 09-6335, 2011 WL 1792791, at *8 (D.N.J. May 11, 2011) (citing EDNA SELAN EPSTEIN, *THE ATTORNEY-CLIENT PRIVILEGE AND THE WORK PRODUCT DOCTRINE* 126 (5th ed. 2007)).

²⁴ *See e.g.*, *Softview Comput. Prods. Corp. v. Haworth, Inc.*, No. 97 Civ. 8815 KMWHBP, 2000 WL 351411, at *12 (S.D.N.Y. Mar. 31, 2000) (documents created before the patent issued were found to be work product when counsel drafting the claims was informed of possible litigation before the patent issued).

²⁵ *Hickman v. Taylor*, 329 U.S. 495, 511 (1947); *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981).

²⁶ FED. R. CIV. P. 26(b)(3).

²⁷ *Id.*

reasoned that without this protection, an attorney's thoughts would not be his own."²⁸ Since the work-product doctrine rests heavily on whether the documents were prepared in anticipation of litigation, district courts have held that work performed by an attorney to prepare and prosecute a patent does not enjoy work product protection.²⁹ However, attorneys may enjoy this immunity to materials prepared in anticipation of reexamination proceedings, interferences, and appeals before the Patent Trial and Appeals Board (PTAB) since they are quasi-adversarial in nature.³⁰

[5] When it comes to protecting communications or documents, there are multiple options and a consistent standard that attorneys may consult. The same cannot be said for patent agents.

A. Privilege for Patent Agents

[6] Patent agents are critical to patent prosecution processes. As patent attorney Damon Kali said, “[patent agents are] the workhorses of this industry They really know their stuff and they’re great at what they do!”³¹ Patent agents have passed the patent bar and are registered to practice before the United States Patent and Trademark Office (USPTO).³² This means that they can provide opinions on patentability, search prior art, assist

²⁸ *Hickman*, 329 U.S. at 511.

²⁹ *See, e.g.*, *Games2U, Inc. v. Game Truck Licensing, L.L.C.*, No. MC–13–00053–PHX, 2013 WL 4046655, at *5 (D. Ariz. Aug. 9, 2013) (explaining that patent prosecution work alone is not sufficient to create privilege in work product).

³⁰ *McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 260–62 (N.D. Ill. 2000).

³¹ *See* Megan M. La Belle, *Privilege for Patent Agents*, 23 B.U. J. SCI. & TECH. L. 360 (2017) ((citing Stephen Key, *Should You Hire a Patent Agent Instead of a Patent Attorney?*, INC. (Oct. 26, 2016), <https://www.inc.com/stephen-key/should-you-hire-a-patent-agent-instead-of-a-patent-attorney.html> [<https://perma.cc/H7L8-95QU>]).

³² *See* Stewart Walsh, *What Is a USPTO Registered Practitioner?*, SIMPLE PATENTS (Aug. 2, 2011), <http://www.simplepatents.com/general-information/what-is-a-uspto-registered-practitioner/> [<https://perma.cc/KJ8Y-MQ6Y>].

inventors in preparing and filing a patent application, and advise on when to abandon the patent application.³³ Patent agents may also represent a client in proceedings before PTAB, upon a showing of good cause.³⁴ However, since they are not licensed attorneys, patent agents cannot litigate in federal or state court and thus do not enjoy work-product immunity.³⁵ For years, district courts were split on whether attorney-client privilege applied to communications between clients and their patent agents.³⁶

[7] Oftentimes, law firms will include an attorney on a case that a patent agent is assigned to for the purpose of preserving attorney-client privilege or to have work-product immunity available to them.³⁷ This drives up the

³³ Will Kenton, *Patent Agent*, INVESTOPEDIA (June 26, 2020), <https://www.investopedia.com/terms/p/patent-agent.asp> [<https://perma.cc/YVZ3-ADLN>].

³⁴ See 37 C.F.R. § 42.10© (2021).

³⁵ *Dow Chem. Co. v. Atlantic Richfield Co.*, 227 U.S.P.Q. (BNA) 129, 1985 WL 71991, at *7 (E.D. Mich. Apr. 23, 1985) (holding that independent patent agents prosecuting patent applications before the Patent Office may not represent a patent owner in the court of law and thus their work product cannot be characterized as being prepared in anticipation of litigation or for trial).

³⁶ Compare, e.g., *Bu'er's Direct Inc. v. Belk, Inc.*, No. SACV 12-00370-DOC, 2012 WL 1416639, at *3 (C.D. Cal. Apr. 24, 2012) (recognizing patent-agent privilege when the communications are for the presentation and prosecution of applications), and *Polyvision Corp. v. Smart Techs. Inc.*, No. 1:03-CV-476, 2006 WL 581037, at *2 (W.D. Mich. Mar. 7, 2006) (stating the privilege applies when a client “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 . . .”), with *Prowess, Inc. v. Raysearch Lab'ys. AB*, No. WDQ-11-1357, 2013 WL 247531, at *3 (D. Md. Jan. 18, 2013) (declining to recognize patent-agent privilege), and *Park v. Cas Enters., Inc.*, No. 08-cv-0385 DMS, 2009 WL 3565293, at *3 (S.D. Cal. Oct. 27, 2009) (stating that non-attorney communications between a patent agent and the defendant’s CEO were not privileged), abrogated by *In re Queen’s Univ.*, 820 F.3d 1287 (Fed. Cir. 2016).

³⁷ See Megan M. La Belle, *Privilege for Patent Agents*, 23 B.U. J. SCI. & TECH. L. 360 (2017) (citing Ryan Davis, *Fed. Cir. Patent Agent Privilege Rule to Lower Legal Courts*, LAW360 (Mar. 9, 2016, 12:10 PM), <https://www.law360.com/articles/768772/fed-circ-patent-agent-privilege-rule-to-lower-legal-costs> [<https://perma.cc/UAP9-ZGGQ>]).

already steep costs for patent prosecution services.³⁸ It also increases the risk that the firm double-bills the client. Additionally, the practice escalates any potential tension between the patent agent and the attorney, as it emphasizes that agents are not of equal standing. Although they both perform similar work, including an attorney just to preserve privilege highlights the hierarchy existent in law firms and accentuates that attorneys enjoy protections that the patent agent cannot.

[8] The Federal Circuit’s holding in *In re Queen’s University at Kingston* created a better foundation for addressing these tensions. In *In re Queen’s University at Kingston*, the Federal Circuit formally recognized patent-agent privilege.³⁹ The court held that communications between patent agents and their clients were privileged if the communications were in furtherance of the patent agent’s tasks listed in 37 C.F.R. §11.5(b)(1).⁴⁰ Communications were also privileged if they were “reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate.”⁴¹ In 2017, the USPTO also recognized patent-agent privilege for communications “reasonably necessary and incident to the scope of the practitioner’s authority” in proceedings before the USPTO.⁴²

³⁸ *Id.*

³⁹ *In re Queen’s Univ. at Kingston*, 820 F.3d 1287, 1302 (Fed. Cir. 2016). For a discussion, see Megan M. La Belle, Privilege for Patent Agents, 23 B.U. J. SCI. & TECH. L. 360 (2017).

⁴⁰ *Id.* at 1301.

⁴¹ *Id.*

⁴² 37 C.F.R. § 42.57(a).

[9] Since *In re Queen's University*, district courts have continued to define patent-agent privilege.⁴³ Courts in both the Central District of California and the District of Colorado have characterized patent-agent privilege as “necessarily narrower than the scope of the attorney-client privilege.”⁴⁴ Generally, patent-agent privilege does not protect all communications in furtherance of legal advice as attorney-client privilege does; rather, it covers communications “reasonably necessary and incident to” the patent prosecution process.⁴⁵ Yet it is unclear which communications are “reasonably necessary” and whether data given to a patent agent is a type of communication that falls under this category. Although data given to an attorney may be privileged, whether data would be privileged when given to a patent agent remains unclear.

[10] Equating patent-agent privilege to attorney-client privilege would solve many issues, including the lack of clarity as to which communications are protected and which are not. By equating the two forms of privilege, clients would need to worry less about which communications to share, and instead the client could expect the same level of privacy in their work with a patent agent as with an attorney. Additionally, equating the two privileges increases opportunities for prosecuting patents, especially for individual inventors who may not be able to afford the high billing rates associated with patent attorneys. As the judges reasoned in *In re Queen's University*, “[w]hether those communications are directed to an attorney or his or her legally equivalent patent agent should be of no moment . . . [patent-agent

⁴³ *E.g.*, *Knauf Insulation, L.L.C. v. Johns Manville Corp.*, No. 1:15-cv-00111-TWP-MJD, 2019 WL 4832205, at *1 (S.D. Ind. Oct. 1, 2019); *see also* *Luv N' Care, Ltd. v. Williams Intellectual Prop.*, No. 18-mc-00212-WJM-KLM, 2019 WL 2471318, at *5 (D. Colo. June 12, 2019); *Onyx Therapeutics, Inc. v. Cipla Ltd.*, C.A. No. 16-988-LPS, 2019 WL 668846, at *2 (D. Del. Feb. 15, 2019); *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktenbologet LM Ericsson*, 2016 WL 6921124, at *2 (C.D. Cal. 2016).

⁴⁴ *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktenbologet LM Ericsson*, 2016 U.S. Dist. WL 6921124, at *3 (C.D. Cal. May 3, 2016); *see also* *Luv N' Care, Ltd. v. Williams Intell, Prop.*, 2019 U.S. Dist. WL 2471318, at *3 (D. Col. June 12, 2019).

⁴⁵ *In re Queen's Univ.*, 820 F.3d at 1301.

privilege provides] clients the freedom to choose between an attorney and a patent agent for representation before the Patent Office.”⁴⁶ Patent-agent privilege is not the same as attorney-client privilege, but for reasons set forth in this article—it should it be.

B. Patent-Agent Privilege in Federal Court

[11] *In re Queen’s University* was the first Federal Circuit case to formally recognize patent-agent privilege.⁴⁷ During discovery, Queen’s University asserted privilege over communications the patent agents had with clients when discussing prosecution of the patents-in-suit.⁴⁸ Samsung challenged the privilege and moved the case to the U.S. District Court of the Eastern District of Texas to compel disclosure of the communications.⁴⁹ The district court granted the motion, reasoning that patent agents were not attorneys and thus did not enjoy attorney-client privilege.⁵⁰ Queen’s University petitioned the Federal Circuit for a writ of mandamus and the Federal Circuit granted the petition.⁵¹ The Federal Circuit recognized privilege for communications in furtherance of tasks listed in 37 C.F.R. §11.5(b)(1) or for communications “reasonabl[y] necessary and incident to the preparation and prosecution of patent applications.”⁵² 37 C.F.R. §11.5(b)(1) provides the scope of the patent agent’s responsibilities:

⁴⁶ *Id.* at 1298.

⁴⁷ *See id.* at 1301.

⁴⁸ *See id.* at 1290.

⁴⁹ *Id.*

⁵⁰ *In re Queen’s Univ.*, 820 F.3d at 1302.

⁵¹ *See id.* at 1289.

⁵² *See id.* at 1301.

Practice before the Office in patent matters includes, but is 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 from the Office regarding a patent application; and drafting 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.⁵³

In making the decision, the majority expanded on the holding in *Sperry v. State of Florida* in which the U.S. Supreme Court recognized that “the preparation and prosecution of patent application . . . constitutes the practice of law.”⁵⁴ The Federal Circuit also considered that Congress had historically granted patent agents the ability to practice before the USPTO.⁵⁵ Referencing the “unique roles of patent agents, the congressional recognition of their authority to act, the Supreme Court’s characterization of their activities as the practice of law, and the current realities of patent litigation counsel in favor of recognizing an independent patent-agent privilege”, the majority established patent-agent privilege.⁵⁶ The Federal Circuit reasoned that “[a] client has a reasonable expectation that all

⁵³ 37 C.F.R. §11.5(b)(1).

⁵⁴ See *Sperry v. State of Florida ex rel. Florida Bar*, 373 U.S. 379, 383 (1963).

⁵⁵ See *In re Queen’s Univ.*, 820 F.3d at 1295–1296.

⁵⁶ *Id.* at 1295.

communications relating to ‘obtaining legal advice on patentability and legal services in preparing a patent application’ will be kept privileged.”⁵⁷

[12] The Federal Circuit in *In re Queen’s University* did limit some communications that would not be protected by patent-agent privilege.⁵⁸ For example, “communications 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 an infringement” would not be protected.⁵⁹ However, it is still ambiguous as to what is protected and what is not. Is it reasonable that communications regarding the business decision about whether to purchase a patent be within the scope of a patent agent’s duties—and thus be privileged? Is it within the realm of the patent agent’s duties to help a client decide whether to patent an invention or not, even if the invention is ultimately not patented? The district court decisions discussed below began to address these questions.

C. The Meaning of “Reasonably Necessary” Communications

[13] After *In re Queen’s University*, district courts have attempted to clarify what communications are protected under patent-agent privilege. In 2016, the U.S. District Court of the Central District of California affirmed the magistrate judge’s ruling that the generalized argument of communications “used by the patent development organizations to file patent applications and to prosecute them” did not adequately establish privilege-protected communications.⁶⁰ The court also differentiated between privileged communications for legal advice and unprivileged communications for business advice, stating that “[g]eneral assertions” of

⁵⁷ *Id.* at 1298 (quoting *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 806 (Fed. Cir. 2000)).

⁵⁸ *See id.* at 1295–1296.

⁵⁹ *In re Queen’s Univ.*, 820 F.3d at 1301–1302.

⁶⁰ *TCL Commc’n Tech. Holdings Ltd. v. Telefonaktenbologet LM Ericsson*, 2016 WL 6921124, at *2 (C.D. Cal. 2016).

the communications’ “usefulness in the general process of patent prosecution are unavailing because such assertions do not properly account for the differences between the *legal* aspects of patent prosecution (e.g., determinations of patentability), and the *business* aspects of patent prosecution (e.g., usefulness to the business of obtaining a patent in a particular field, determinations of willingness to spend a certain amount of resources to obtain a particular anticipated patent, time management of patent prosecutors).”⁶¹

[14] In 2019, the District of Delaware in *Oynx Therapeutics, Inc. v. Cipla, Ltd.* referenced *In re Queen’s University* in determining whether e-mail chains mentioning prior art and documents assessing a patent would be produced to the defendants.⁶² The documents focused on developing a new chemical formulation, rather than seeking patent protection on an already-developed formulation.⁶³ While the court recognized that communications reasonably necessary to patent prosecution are protected by patent-agent privilege, the court held that these particular communications were not privileged and should be produced.⁶⁴ Even though protected by attorney-client privilege, communications focusing on understanding the patent landscape—prior to drafting any claims for a patent application, before finalizing any research plan, and before reducing the invention to practice—were not protected by patent-agent privilege.⁶⁵

[15] In June of 2019, the U.S. District Court for the District of Colorado narrowed *In re Queen’s University* to hold that communication between the patent agent and client were not privileged, despite the communications

⁶¹ *Id.* at *2.

⁶² *See* *Onyx Therapeutics, Inc. v. Cipla Ltd.*, C.A. No. 16-988-LPS, 2019 WL 668846, at *2 (D. Del. Feb. 15, 2019).

⁶³ *See id.* at *3.

⁶⁴ *See id.* at *2.

⁶⁵ *See id.*

having a subject matter of “advice of patent agent and/or advice of patent agent + advice of counsel.”⁶⁶ The court reasoned that “merely soliciting advice of a patent agent does not satisfy the burden of showing that the privilege applies.”⁶⁷ The court held that since the communications made no mention of the preparation or prosecution of a patent, the party asserting the privilege did not meet the burden in showing that the communication was “reasonably necessary and incident” to the patent agents’ duties before the USPTO.⁶⁸

[16] In October of 2019, the U.S. District Court in the Southern District of Indiana addressed the scope of patent-agent privilege for foreign patent agents.⁶⁹ In *Knauf Insulation, LLC v. Johns Manville Corp.*, Knauf, the holder of the patents-in-suit, claimed privilege over communications exchanged with Mr. Farmer, a patent agent in the U.K.⁷⁰ Although the Federal Circuit in *In re Queen’s University* did not address whether foreign patent agents enjoy patent-agent privilege, the district court was persuaded by the argument that clients should have a reasonable expectation of privilege and deemed the communications protected.⁷¹ The district court reasoned that “[t]he patent-agent privilege should be treated as analogous to the attorney-client privilege” and that “it also should be of no moment whether the foreign legal advisor relied upon by Knauf was an attorney or patent agent.”⁷² After all, if Mr. Farmer had been a patent

⁶⁶ *Luv N’ Care, Ltd. v. Williams Intellectual Prop.*, No. 18-mc-00212-WJM-KLM, 2019 WL 2471318, at *5 (D. Colo. June 12, 2019).

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *See Knauf Insulation, L.L.C. v. Johns Manville Corp.*, No. 1:15-cv-00111-TWP-MJD, 2019 WL 4832205, at *1 (S.D. Ind. Oct. 1, 2019).

⁷⁰ *Id.* at *1.

⁷¹ *Id.* at *5.

⁷² *Id.*

attorney, the defendant conceded the communications would have been privileged.⁷³ Additionally, the court noted that just as a foreign patent attorney is not registered by the USPTO, neither is a foreign patent agent, and thus the communications were deemed privileged.⁷⁴ The court reasoned that “[t]o hold otherwise would be contrary to the goal of protecting the client’s reasonable expectation of privilege in its communications with its legal advisor.”⁷⁵

[17] The court was further unpersuaded by the defendant’s argument that the documents discussed were not privileged because under U.S. law, they fell outside the scope of patent agents’ role in front of the USPTO.⁷⁶ The district court ruled that patent-agent privilege for foreign patent agents apply to services related to the patent agent’s services in the foreign country, not in the United States.⁷⁷

D. Patent-Agent Privilege at the USPTO

[18] The district court in *Knauf Insulation, LLC* partially based their decision to extend patent-agent privilege to foreign patent agents on the USPTO’s privilege rules for proceedings before the USPTO.⁷⁸ Effective December 7th, 2017, 37 C.F.R. § 42.57 codified that communications between a foreign patent agent and a client are privileged if the

⁷³ *Id.*

⁷⁴ *Knauf Insulation, LLC v. Johns Manville Corp.*, No. 1:15-cv-00111-TWP-MJD, 2019 U.S. Dist. WL 4832205, at *5 (S.D. Ind. Oct. 1, 2019).

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *See id.* at *6.

communications are “reasonably necessary and incident to the scope of the practitioner’s authority.”⁷⁹ 37 C.F.R. § 42.57 reads as follows:

(a) Privileged communications. A communication between a client and a USPTO patent practitioner or a foreign jurisdiction patent practitioner that is reasonably necessary and incident to the scope of the practitioner’s authority shall receive the same protections of privilege under Federal law 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 “USPTO patent practitioner” means a person who has fulfilled the requirements to practice patent matters before the United States Patent and Trademark Office under § 11.7 of this chapter. “Foreign jurisdiction 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. For foreign jurisdiction practitioners, this rule applies regardless of whether that jurisdiction provides privilege or an equivalent under its laws.

(c) Scope of coverage. USPTO patent practitioners and foreign jurisdiction patent practitioners shall receive the same treatment as attorneys on all issues affecting privilege or waiver, such as communications with employees or assistants of the practitioner and communications between multiple practitioners.⁸⁰

⁷⁹ 37 C.F.R. § 42.57 (effective December 7, 2017) (emphasis added).

⁸⁰ *Id.*

The USPTO appeared to equate patent-agent privilege to attorney-client privilege, codifying that patent agents' and foreign practitioners' communications in front of the USPTO receive the same protections as attorney-client privilege under federal law.⁸¹ Under the new rule, the patent agent's validity opinion in PTAB proceedings are privileged, as well as validity opinions for a client seeking reexamination of a patent before the USPTO.⁸² However, the USPTO clarified that while communications between clients and patent agents for purposes of PTAB proceedings are privileged, this rule is "primarily intended to protect communications made when seeking patents at the USPTO or foreign IP offices, such as when prosecuting applications or contemplating whether to file."⁸³ The communications may not be involved in PTAB proceedings at all. However, the rule's purpose is to "protect any communications with authorized counsel from discovery in PTAB, not just communications about the instant proceeding."⁸⁴

[19] While this rule only applies to USPTO proceedings, the rule was developed by "the agency authorized by Congress to regulate patent agents."⁸⁵ Like the U.S. District Court of the Southern District of Indiana in *Knauf Insulation*,⁸⁶ other courts may similarly be persuaded to apply the USPTO rule to district court rulings.

⁸¹ See 37 C.F.R. § 42.57©.

⁸² See 37 C.F.R. § 42.57.

⁸³ Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51571 (Nov. 7, 2017).

⁸⁴ *Id.* (emphasis added).

⁸⁵ *In re Queen's Univ. at Kingston*, 820 F.3d 1287, 1310 (Fed. Cir. 2016) (Reyna, dissenting).

⁸⁶ *Knauf Insulation, L.L.C. v. Johns Manville Corp.*, No. 1:15-cv-00111-TWP-MJD, 2019 WL 4832205, at *6 (S.D. Ind. Oct. 1, 2019).

E. Patent-Agent Privilege in State Court

[20] Further complicating matters, state courts have their own separate sources of privilege.⁸⁷ While the Federal Circuit has jurisdiction on patent claims, state law claims are not governed by the federal common law of patent-agent privilege.⁸⁸ In 2018, Texas became the first state to recognize patent-agent privilege.⁸⁹

[21] In *In re Silver*, the Supreme Court of Texas reversed the Texas Court of Appeals' decision declining to extend attorney-client privilege to patent agents.⁹⁰ The case involved a breach of contract between Mr. Silver and Tabletop Media, LLC, in which Mr. Silver alleged that Tabletop had failed to pay for the patent he sold to them.⁹¹ Tabletop sought communications, such as emails Mr. Silver had had with his patent agent, but Mr. Silver refused, claiming patent-agent privilege over them.⁹² The lower court declined to follow *In re Queen's University* and did not compel production of these communications.⁹³ Citing *In re Queen's University* and *Sperry* (where the court recognized that patent agents practice law in front of the USPTO), the Supreme Court of Texas reversed the decision.⁹⁴ The court also referred to Texas's Rule of Evidence Rule 503's definition of "lawyer",

⁸⁷ See Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51571.

⁸⁸ *In re Qu'en's Univ.*, 820 F.3d at 1294 ("state law governs privilege regarding a claim or defense for which state law supplies the rule of decision").

⁸⁹ *In re Silver*, 540 S.W.3d 530, 539 (Tex. Sup. Ct. 2018).

⁹⁰ *Id.*

⁹¹ *Id.* at 533.

⁹² *Id.*

⁹³ *Id.* at 538–39; see *In re Queen's Univ.*, 820 F.3d at 1302.

⁹⁴ *In re Silver*, 540 S.W.3d at 534, 539.

finding that patent agents are “authorized [to] practice law” in front of the USPTO.⁹⁵ The court held that patent-agent privilege applied.⁹⁶

[22] As more state law claims, like contract disputes, involving patents arise, state courts will be able to decide whether there is a patent-agent privilege. However, it is unclear how the other 49 states will rule. Depending on whether states recognize patent-agent privilege, it may incentivize forum shopping between state courts. For example, a plaintiff bringing a state law claim, such as unfair competition, may bring the suit in a state that does not recognize patent-agent privilege. Additionally, a state declining to recognize patent-agent privilege may lead to a situation where communications related to federal claims in a case are protected, but the state claims in the same suit are not. This incongruent nature between each state and the federal standard may unnecessarily overwhelm court proceedings, as well as confuse patent owners as to why communications are privileged within one claim—but for another claim, is not. Such an inconsistent application of patent-agent privilege between PTAB proceedings, to state and federal courts is bound to confuse patent owners—the very party patent-agent privilege is purported to protect.

II. EQUATING PATENT-AGENT PRIVILEGE TO ATTORNEY-CLIENT PRIVILEGE IN ALL VENUES

[23] The USPTO rule recognized that before the USPTO, clients have privilege for all communications with patent agents that are “reasonably necessary and incident to the scope of the practitioner’s authority.”⁹⁷ In *In re Queen’s University*, the Federal Circuit recognized a privilege for patent agents’ communications in furtherance of tasks listed in 37 C.F.R. §11.5(b)(1) or for communication “reasonably necessary and incident to the preparation and prosecution of patent applications” before the Office

⁹⁵ *Id.* at 534–36.

⁹⁶ *Id.* at 539.

⁹⁷ 37 C.F.R. § 42.57(a) (2021).

involving a patent application or patent in which the practitioner is authorized to participate.”⁹⁸

[24] On the surface, these two privileges seem very similar. However, there are striking differences between patent-agent privilege in front of the USPTO and patent-agent privilege in Federal Court. In *In re Queen's University*, the Federal Circuit ruled that “communications with a patent agent who is offering an opinion on the validity of another party’s patent in contemplation of litigation” were not protected.⁹⁹ However, the patent agent’s validity opinion are protected in front of the PTAB.¹⁰⁰ After all, “[a]gents are already authorized to practice before PTAB in any USPTO proceedings.”¹⁰¹ Yet it leads to the question of which communications will be privileged in PTAB proceedings, but will not be privileged in federal courts. Since *In re Queens*, district court decisions such as *Oynx Therapeutics, Inc.* have continued to limit what communications are protected. Meanwhile, the majority of state courts have yet to address the issue of patent-agent privilege for state law claims, which are not governed by federal common law of patent-agent privilege.¹⁰² State courts are also not regulated by the USPTO as “[t]he USPTO and states have separate jurisdiction”, although “[s]tates may of course consider the policy issues the USPTO has documented when deciding privileged matters within their own courts for domestic and foreign patent agents and attorneys.”¹⁰³

⁹⁸ *In re Queen's Univ.*, 820 F.3d at 1301.

⁹⁹ *Id.* at 1301–1302.

¹⁰⁰ 37 C.F.R. § 42.57(c).

¹⁰¹ Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51573.

¹⁰² *In re Qu'en's Univ.*, 820 F.3d at 1294 (“state law governs privilege regarding a claim or defense for which state law supplies the rule of decision”).

¹⁰³ Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51573.

[25] This difference in treatment between different jurisdictions and venues leads to confusion about what a client may reasonably expect to remain between the client and the patent agent. If the patent is litigated in federal court, patent-agent privilege may be regarded differently than during reexamination in front of the PTAB.¹⁰⁴ For example, in front of the USPTO, strategies about whether to patent would likely be privileged; in federal court, if a patent is not produced, those communications might not be.¹⁰⁵ In state court, patent-agent privilege for state law claims may not even apply, whereas it may apply for federal law claims for the same patent.¹⁰⁶ “Attorney-client privilege exists to protect clients,” but how effectively could patent-agent privilege protect the clients if the client is forced to navigate different standards within different jurisdictions?¹⁰⁷ As opined by the U.S. Supreme Court when establishing attorney-client privilege, “[a]n uncertain privilege, or which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.”¹⁰⁸ Equating patent-agent privilege to attorney-client privilege — in all forums — would begin to clarify which communications are privileged and which are not. All communications in furtherance of legal advice with the patent agent would be protected whether in front of the PTAB, state, or federal court. Thus, the client could be rest assured that all communications were privileged with their patent agent, regardless of which court their patent was later brought to. Further, clients could receive privilege over the same communications with a patent agent that they would have received if they had communicated with a patent attorney. As the judges reasoned in *In re Queen’s University*, “[w]hether those communications are directed to an attorney or his or her legally equivalent patent agent should be of no

¹⁰⁴ 37 C.F.R. § 42.57(c); *See supra* text accompanying notes 94–95.

¹⁰⁵ *See supra* text accompanying notes 56–59.

¹⁰⁶ *See supra* text accompanying notes 80–90, 100–101.

¹⁰⁷ Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51571.

¹⁰⁸ *Upjohn Co. v. United States*, 449 U.S. 383, 393 (1981).

moment . . . [patent-agent privilege provides] clients the freedom to choose between an attorney and a patent agent for representation before the Patent Office.”¹⁰⁹ Patent-agent privilege should also provide clients the freedom to choose between an attorney and a patent agent if the client’s patent is litigated in state or district court. Applying a different standard of protection for the client is arbitrary and unfair.

[26] Treating patent-agent privilege the same as attorney-client privilege would also encourage inventors, especially independent inventors, to rely on patent agents for their prosecution aims. There are typically very high costs associated with filing a patent. Depending on the type of invention, filing a patent with a patent attorney can range anywhere from \$5,000 to over \$16,000.¹¹⁰ However, patent agents generally charge lower fees than attorneys, as their “hourly billing rate is often substantially less than that of an attorney.”¹¹¹ Allowing the client to depend on a patent agent, who charges less, seems especially important given that independent inventors may already be disadvantaged due a first-to-file, rather than first-to-invent, system under the 2011 Leahy-Smith America Invents Act.¹¹²

[27] In recognizing patent-agent privilege initially, the dissent in *In re Queen’s University* argued that most patent agents are supervised by

¹⁰⁹ *In re Queen’s Univ.*, 820 F.3d at 1298.

¹¹⁰ See Megan M. La Belle, Privilege for Patent Agents, 23 B.U. J. SCI. & TECH. L. 360 (2017) (citing Gene Quinn, *The Costs of Obtaining a Patent in the US*, IPWATCHDOG (Apr. 4, 2015), <https://www.ipwatchdog.com/2015/04/04/the-cost-of-obtaining-a-patent-in-the-us/id=56485/> [<https://perma.cc/9MS3-H6MA>]).

¹¹¹ DONALD RIMAI, A GUIDE FOR IMPLEMENTING PATENT STRATEGY 38 (2019), <https://onlinelibrary.wiley.com/doi/pdf/10.1002/9781119407119> [<https://perma.cc/RL89-XFC7>].

¹¹² See Megan M. La Belle, Privilege for Patent Agents, 23 B.U. J. SCI. & TECH. L. 360 (2017) (citing David Abrams & R. Polk Wagner, *Poisoning the Next Apple? The America Invents Act and Individual Inventors*, STAN. L. REV. 517, 519–20 (2013) (small inventors “are likely to be slower in turning an invention into a patent application than larger corporations . . .”).

attorneys and thus there is no need for a patent-agent privilege.¹¹³ However, before *In re Queen's University*, it was not uncommon in law firms to include a patent attorney supervising the patent-agent's work "just to preserve attorney-client privilege."¹¹⁴ This "dr[ove] up the costs of preparing and prosecuting patent applications," a consideration already in mind for small inventors.¹¹⁵ Due to the inconsistency and ambiguity of what communications are protected after *In re Queen's University*, attorneys are likely still supervising patent agents just to preserve privilege. Equating patent-agent privilege to attorney-client privilege may begin to foster more independence for patent agents, particularly those in law firms, as well as free up time for attorneys to focus on litigation matters or prosecution on more extensive or complicated patents. Attorney and agents could begin to work more on separate projects, diminishing any threat of a "turf war" between the two. Additionally, equating the two privileges may lessen any tension between attorneys and agents, the latter of which may feel overly supervised by attorneys or feel less useful if only some of their communications with clients are protected.

[28] Critics may argue that equating patent-agent privilege to attorney-client privilege would place patent agents and patent attorneys on the same footing. For example, the dissent in *In re Queen's* argued that patent agents are not licensed attorneys and it is appropriate to treat them differently when it comes to privilege.¹¹⁶ However, patent agents are only authorized to practice law in front of the USPTO.¹¹⁷ They cannot represent a client in state or district court. Extending patent-agent privilege to cover all

¹¹³ *In re Queen's Univ.*, 820 F.3d at 1305.

¹¹⁴ Belle, *supra* note 37.

¹¹⁵ *Id.*

¹¹⁶ *In re Queen's Univ.*, 820 F.3d at 1303.

¹¹⁷ *Patent Agent v. Patent Attorney: Everything You Need to Know*, UPCOUNSEL, <https://www.upcounsel.com/patent-agent-vs-patent-attorney> [<https://perma.cc/WRW7-QMYG>].

communications in furtherance of legal advice would not change this fact. During the discussion about establishing patent-agent privilege, opponents argued that “practicing before PTAB is tantamount to practicing before Federal courts when there is concurrent litigation on the same patents.”¹¹⁸ The USPTO responded that considering that the PTAB and federal courts are different venues with separate practices, the fact that privilege is extended to communications in front of the USPTO does not grant practitioners authorization to practice in a different forum.¹¹⁹ In the same line of thinking, if patent-agent privilege is equated to attorney-client privilege, just because communications with patent agents would be privileged does not grant authority to patent agents to practice law outside of the USPTO.

[29] Furthermore, as iterated by the USPTO, “privilege does not confer additional power to patent agents because it vests in the client, not the agent or the attorney.”¹²⁰ After reasoning that patent-agent privilege should be analogous to attorney-client privilege, the U.S. District Court in the Southern District of Indiana honored the goal of “protect[ing] the client’s expectation of privilege in its communications with its legal advisor.”¹²¹ Privilege exists to ensure that the client feels that their communications with their legal advisor remains between the two of them. As clarified by the USPTO, “[a]pplying the privilege to agents simply recognizes that they perform legal services and that clients deserve the same protections

¹¹⁸ Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51573.

¹¹⁹ *Id.* (“Just because a practitioner is authorized to address the issue in one forum does not mean they are authorized to address it in other forums.”).

¹²⁰ *Id.* at 51571.

¹²¹ *Knauf Insulation, LLC v. Johns Manville Corp.*, 2019 WL 4832205 at *5 (S.D. Ind. 2019).

regardless of which type of authorized legal provider they choose.”¹²² Similarly, extending patent-agent privilege to be the same as attorney-client privilege in all forums would be in line with protecting the client’s expectation of privacy, regardless as to whether they work with an attorney or agent.

A. Is Lab Data Protected under Patent-Agent Privilege?

[30] Equating patent-agent privilege to attorney-client privilege would also elucidate the murky understanding of what communications are protected by patent-agent privilege. The USPTO indicated that “information exchanged for purposes of obtaining legal opinions or services, not underlying facts or business documents” are protected.¹²³ However, the Federal Circuit ruled that “reasonabl[y] necessary” communications are protected. What are “reasonabl[y] necessary” communications? If a client provides the agent data for the patent prosecution, will the data itself be privileged during trial in federal court?

[31] Data is often included in patents, especially in biological and chemical patents.¹²⁴ Due to the unique nature of patent law, scientific results from a lab can lay the groundwork for writing the claims to a patent application.¹²⁵ Data can also be crucial in proving inventorship, showing communication of the invention to an earlier application during a derivation

¹²² Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570, 51571.

¹²³ *Id.*

¹²⁴ David Stephenson, Biotechnology and the Independent Inventor: Experiments, Law Office of Vincent Lotempio, PLLC (Mar. 6, 2021), <https://www.lotempiolaw.com/2015/02/blog-2/biotechnology-experiments/> [<https://perma.cc/LLF2-KB42>].

¹²⁵ *See, e.g.*, Gene Quinn, Drafting Patent Applications: Writing Method Claims, IPWatchDog (Mar. 6, 2021), <https://www.ipwatchdog.com/2013/10/11/drafting-patent-applications-writing-method-claims-2/id=45670/> [<https://perma.cc/MGC5-KNLL>].

proceeding, or supplementing the specification during patent prosecution.¹²⁶ Additionally, due to the laborious work or potentially secretive process of how the data was obtained, patent owners often worry during trial about handing their data or communications about the prosecution of their patent to an opposing party and competitor¹²⁷. Whether data itself is a privileged communication is a question of great interest to patent owners and the litigators representing them. However, under patent-agent privilege, whether data sent to a patent agent is privileged appears to be unclear. There seems to be few, if any, precedent that addresses the issue. However, if the patent-agent privilege is held under the same standards as attorney-client privilege, there is an abundance of precedent from district courts that establishes standards of when data is privileged under attorney-client privilege and when it is not.¹²⁸ Equating patent-agent privilege to attorney-client privilege would elucidate whether technical data are communications protected by patent-agent privilege.

[32] District courts have held that technical materials created for the specific purpose of receiving legal advice is protected by attorney-client privilege.¹²⁹ In *In re Spalding*, the Federal Circuit determined the invention record containing technical information—some of which would enter the public in a patent application—was privileged since the record was produced for the attorney to evaluate patentability or advising on a patent

¹²⁶ *Should You Throw Away Your Lab Notebook?*, NUTTER (Mar. 6, 2021), <https://www.nutter.com/ip-law-bulletin/should-you-throw-away-your-lab-notebook> [<https://perma.cc/5ALW-8XE6>].

¹²⁷ *See In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 802 (Fed. Cir. 2000); *Shopify Inc. v. Express Mobile, Inc.*, No. 20-MC-80091-JSC, 2020 WL 4732334, at *4 (N.D. Cal. Aug. 14, 2020).

¹²⁸ *See supra* text accompanying notes 129–133.

¹²⁹ *See Kimberly-Clark Corp. v. Tyco Healthcare Retail Grp.*, 2007 WL 1246411, at *1 (E.D. Wis. 2007) (testing results completed on the advice of counsel were privileged, the court stating that it was “undisputed that the purpose of the tests was to obtain legal advice...it is a case where the attorney’s existence, and his rendering of legal advice, were the *sina qua non* of the information in the first place”).

application.¹³⁰ In the District of Massachusetts, the district court denied a motion to compel entries in the scientist's notebook, ruling that the entries were privileged when they were prepared not for research purposes, but to convey information to the attorney for legal advice on preparing pending or future patent applications.¹³¹ However, data already in existence is not protected by attorney-client privilege when the data was purely factual and was not produced for the purpose of receiving legal advice.¹³² The U.S. District Court in the Eastern District of Wisconsin found that purely technical documents, such as tests and experiments, were not entitled to attorney-client privilege when the documents were provided simply to complete a patent application rather than for interpretation or legal advice.¹³³

[33] While there is precedent about whether data is protected under attorney-client privilege, there appears to be no case law about whether data sent from the client to the patent agent would be privileged under patent-agent privilege. After *Onyx Therapeutics Inc.*, it is unlikely that data given to the attorney for an invention not yet reduced to practice, prior to drafting of any claims, and before finalizing a research plan would not be privileged in federal court. However, would data sent to the patent agent for legal advice be privileged? Would data created at the request of the patent agent be privileged? How would this differ between federal court, state court, or in front of the USPTO? If patent-agent privilege is equated to attorney-client

¹³⁰ See *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805–806 (Fed. Cir. 2000).

¹³¹ See *Skyhook Wireless, Inc. v. Google Inc.*, 2012 WL 1478789, at *1 (D. Mass. 2012).

¹³² See *McCook Metals LLC v. Alcoa Inc.*, 192 F.R.D. 248, 252 (N.D. Ill. 2000) (the district court ordered the production of technical drawings, sketches, tables, and test results because the inventors sending documents to the patent department for patent prosecution did not request legal advice); *Shire Development Inc. v. Cadila Healthcare Ltd.*, 2012 WL 5247315, at *4 (D. Del. 2012) (court ordered the production of documents that were purely technical and factual in nature, the court stating that “tests, testing results, and formulation strategies are not privileged in and of themselves.”).

¹³³ *Willemijn Houdstermaatschaap BV v. Apollo Comput. Inc.*, 707 F.Supp. 1429, 1448 (D. Del. 1989).

privilege, whether data given to agents is privileged would be clear. As of now, there appears to be little, if any, case law addressing the matter, leading to an increased risk of confusion for clients about what is protected and what is not.

B. Work-Product Doctrine

[34] Work-product immunity is another doctrine to protect documents from disclosure that is available for attorneys, but not for patent agents. For attorneys, the work product doctrine protects documents and tangible things that the attorney prepared in anticipation of litigation from being disclosed to third parties.¹³⁴ District courts have held that work performed by an attorney to prepare and prosecute a patent does not enjoy work product protection.¹³⁵ However, attorneys can enjoy work-product immunity for work done on a patent application—even if the documents were created prior to the patent being issued—if the work was done with an eye towards litigation.¹³⁶ Due to the quasi-adversarial nature of PTAB proceedings, attorneys may also enjoy work-product immunity to materials prepared in anticipation of reexamination proceedings, interferences, and appeals before the PTAB.¹³⁷

¹³⁴ FED. R. CIV. P. 26(b)(3)(A).

¹³⁵ *Games2U, Inc. v. Game Truck Licensing, LLC*, No. MC-13-00053-PHX-GMS, 2013 WL 4046655, at *5 (D. Ariz. Aug. 9, 2013); *McCook Metals*, 192 F.R.D. at 261 (ex parte administrative acts are too far removed from specific anticipated litigation and thus the preparation and prosecution of patent applications do not enjoy work-product immunity).

¹³⁶ *Cave Consulting Grp., Inc. v. Optuminsight, Inc.*, No. 15-cv-03424-JCS, 2016 WL 7475820, at *10 (N.D. Cal. Dec. 29, 2016) (the communications and materials generated for the patent application were conducted with “an eye towards litigation” and thus were protected under work product doctrine); *Softview Comput. Prods. Corp. v. Haworth, Inc.*, No. 97 Civ. 8815 KMWHBP, 2000 WL 351411, at *12 (S.D.N.Y. Mar. 31, 2000) (documents created before the patent issued were found to be work product when the counsel drafting the claims was informed of possible litigation before the patent issued).

¹³⁷ *See McCook Metals*, 192 F.R.D. at 260–262; *Golden Trade, S.r.L v. Lee Apparel Co.*, 1992 WL 367070, at *4 (S.D.N.Y. 1992) (“[I]f a document is prepared in anticipation of or with an eye to future adversarial administrative proceedings or future litigation, it will

[35] Like attorneys, independent patent agents can represent clients in proceedings before the PTAB.¹³⁸ They perform the exact same tasks that an attorney performs during PTAB proceedings.¹³⁹ However, courts have held that the work-product immunity is not available to patent agents.¹⁴⁰ Instead, a patent agent's materials prepared in anticipation of litigation must still be under the authority of an attorney to ensure work-product immunity is an available option.¹⁴¹ If a client uses a patent agent instead of a patent attorney, the work product the patent agent performs will not be protected under the work-product doctrine.¹⁴² The clients must still employ an attorney—and pay the higher costs associated—to have their legal advisor's thoughts and impressions on their patent protected.¹⁴³ Additionally, if a patent agent cannot be assured that their work will be protected from discovery, the patent agent's thoughts may not be his own. "The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served."¹⁴⁴ The same interests of the client and the cause for justice call for an extension of the work-product

be protected. . . even if a document was prepared to address issues in an *ex parte* patent proceeding. . .").

¹³⁸ 37 C.F.R. §42.10(c).

¹³⁹ Seth I. Appel., et al, INTELLECTUAL PROPERTY LAW 219 (Mark Halligan, 2nd ed. 2017).

¹⁴⁰ See *Dow Chem. Co. v. Atlantic Richfield Co.*, 227 U.S.P.Q. 129, 1985 WL 71991 (E.D. Mich. 1985).

¹⁴¹ See *Willemijn Houdstermaatschaap BV v. Apollo Comput. Inc.*, 707 F. Supp. 1429, 1445–46 (D. Del. 1989).

¹⁴² *Dow Chem.*, 227 U.S.P.Q. at 129.

¹⁴³ *Id.*; See Megan M. La Belle, Privilege for Patent Agents, 23 B.U. J. SCI. & TECH. L. 360 (2017) (citing Stephen Key, Should You Hire a Patent Agent Instead of a Patent Attorney?, INC. (Oct. 26, 2016), <https://www.inc.com/stephen-key/should-you-hire-a-patent-agent-instead-of-a-patent-attorney.html> [<https://perma.cc/H7L8-95QU>]).

¹⁴⁴ *Hickman v. Taylor*, 329 U.S. 495, 511 (1947) (recognizing work-product doctrine).

immunity for work performed by patent agents. Patent agents perform the exact same tasks that an attorney performs during PTAB proceedings; it is only reasonable that they enjoy the same work-product protections that attorneys do.

C. Changing Federal and State Common Law

[36] In order for patent-agent privilege to be equivalent to attorney-client privilege and work-product immunity to apply for patent agents' materials prepared in anticipation of PTAB proceedings, federal and state common law would need to be modified. The current work-product doctrine and attorney-client privilege are common law principles.¹⁴⁵ No statute limits common law.¹⁴⁶ Instead, federal and state common law are judge-made.¹⁴⁷ The judiciary can change common law because it is "judge-made and judge-applied, [and] can and will be changed when changed conditions and circumstances establish that it is unjust or has become bad public policy."¹⁴⁸ Thus, common law can be amended with the needs of the society. As the Supreme Court of Oklahoma reasoned, "[common law is] a dynamic principle, which allows it to grow, and to tailor itself to meet changing needs within the doctrine of *stare decisis*, which if correctly understood, was not static and did not forever prevent the courts from reversing themselves or from applying principles of common law to new situations as the need arose."¹⁴⁹

¹⁴⁵ See *id.* at 511; see *Bradt v. Smith*, 634 F.2d 796, 800 (5th Cir. 1981) (privilege is a product of state and federal common law).

¹⁴⁶ Mary Ross, *The Development of the Common Law on Appeal*, FOR THE DEFENSE (Dec 1, 2010), <https://www.plunkettcooney.com/pp/publication-The-Development-of-the-Common-Law-on-Appeal.pdf?55081> [<https://perma.cc/8Z7A-ZVZ3>].

¹⁴⁷ *Id.*

¹⁴⁸ *Brigance v. Velvet Dove Restr., Inc.*, 725 F.2d 300 (Okla. 1986).

¹⁴⁹ *Id.* at 303.

[37] Considering the ways in which clients and patent agents would benefit from changes to patent-agent privilege and the work-product doctrine, judges should change the current rules. This could also involve law students clerking for a district, state, or PTAB judge and advocating to extend work-product for patent agents. This could also require attorneys litigating patent cases in federal or state court to put forth the argument that patent-agent privilege should equal attorney-client privilege when communications are compelled by the opposing party. Federal and state judges should additionally look to the USPTO for guidance, an agency that deals exclusively with patents and is an expert on the topic. This would not be an unprecedented practice. In *Knauf Insulation, LLC*, the district court in the Southern District of Indiana partially based their decision to extend patent-agent privilege to foreign patent agents on the USPTO's privilege rules for proceedings before the USPTO.¹⁵⁰ Although the court admitted that “this rule applies only to proceedings before the [US]PTO”, the court wrote that “it is noteworthy that it was developed by ‘the agency authorized by Congress to regulate patent agents. . . applying its expertise and experience.’”¹⁵¹

[38] Patent agents would similarly need to be familiar with the current privilege rules and cognizant of how privilege for patent agents differs from privilege for attorneys. The National Association of Patent Practitioners, a non-profit organization supporting patent practitioners, could publish articles about broadening patent-agent privilege or recognizing patent agents' work-product. Additionally, patent attorneys who support the idea could present the argument in their law firm blog posts. Clients could learn of the privilege rules through these posts or from reading opinion pieces at law-related news sites.

¹⁵⁰ *Knauf Insulation, LLC v. Johns Manville Corp.*, 2019 WL 4832205, at *6 (S.D. Ind. Oct. 1, 2019).

¹⁵¹ *In re Queen's Univ. at Kingston*, 820 F.3d 1287, 1310 (Fed. Cir. 2016) (Reyna, J., dissenting).

[39] The changes to privilege for patent agents could likewise begin to be implemented by various restatements of law writing on the argument. Restatements of law offer sources of support for common law changes.¹⁵² Judges, academics, and practicing lawyers prepare the restatements.¹⁵³ Although the restatements usually codify existing law, occasionally they offer suggestions for the law's improvement.¹⁵⁴ Additionally, even though restatements tend to focus on the attorney's practice, the Restatement (Third) of Law Governing Lawyers defines the role of non-lawyers.¹⁵⁵ Restatements can similarly address the role and privilege for patent agent's communications and work-product.

III. CONCLUSION

[40] Patent-agent privilege should be treated the same as attorney-client privilege in all venues. It would clarify what communications are protected, lower costs of patent prosecution, and would best serve the privacy interests of the client. Patent agents should also enjoy work-product protection for the documents prepared in anticipation of PTAB proceedings. Doing so would serve the interests of the client, lower costs of patent prosecution, and assure the patent agent that their work may be able to qualify for work-product immunity. Patent agents are crucial to patent prosecution processes. Expanding patent-agent privilege and recognizing work-product immunity would accord with their important role as legal advisors to their clients.

¹⁵² Ross, *supra* note 146.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ RESTATEMENT (THIRD) OF LAW GOVERNING LAWYERS § 4 cmt. e (AM. LAW INST. 2000) (providing the example of the role of a non-lawyer employee of a corporation).