



## Choice of Law

The Split Can be Outcome Determinative

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## Unique to Patent Law?

Yes: Federal Circuit Law Applies	No: Regional Circuit Law Applies
"Invention record" from inventor to counsel to determine patentability and whether to file. <i>Spalding</i> (2000).	Communications from licensee's attorneys to licensor about prosecution of foreign counterparts. <i>Regents</i> (1996)
Does inequitable conduct constitute a "crime or fraud" for exception to privilege. <i>Spalding</i> (2000).	
Patent agent-client privilege. <i>Queen's University</i> (2016).	

## *In re Silver* (Tex. Ct. App.) (Pet. Pending)

- Facts unclear, but plaintiff sued for breach of contract, contending he owned patent.
- Defendant moved to compel production of emails between defendant and patent agent who had prosecuted application.
- Holds *Queen's U* inapplicable because state law claim.
- Because no state privilege, no privilege over 300 emails.

## Isn't Relevancy Irrelevant?

- Why does privilege turn on (a) whether communication is relevant to later litigation, or (b) whether state law creates that claim?
- My *amicus*: Parties didn't address choice of law, but Texas law says don't admit evidence privileged somewhere else, if there's good reason not to.

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## Title search: Privilege in Patent Cases: What's New?

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12<sup>th</sup> Annual Advanced Patent Law Institute session

"Privilege in Patent Cases: What's New?"