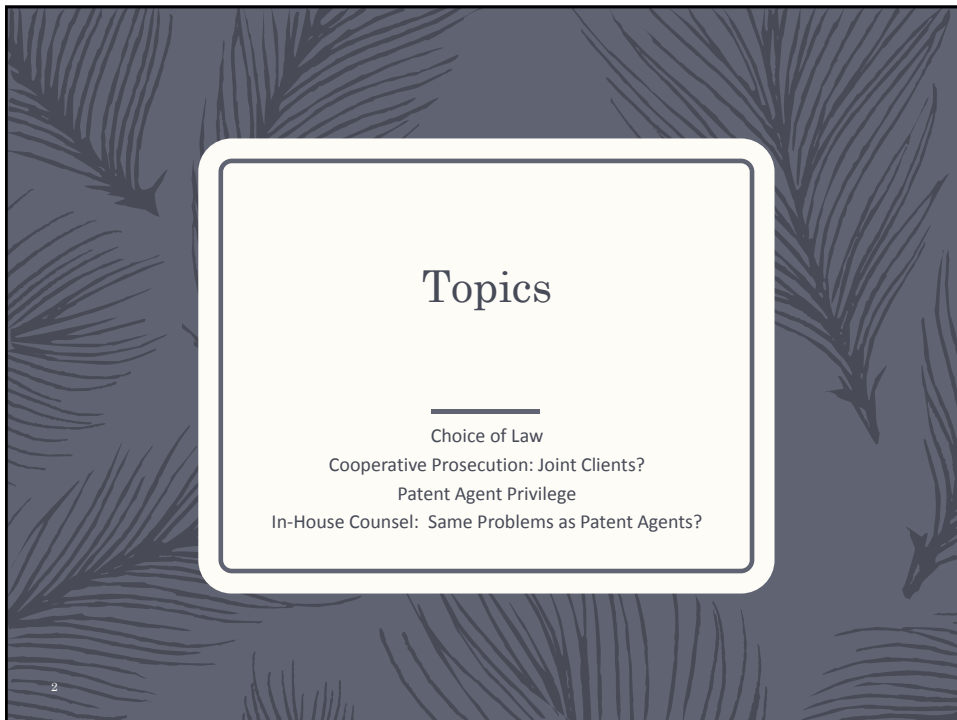




Privilege in Patent Cases: What's New?

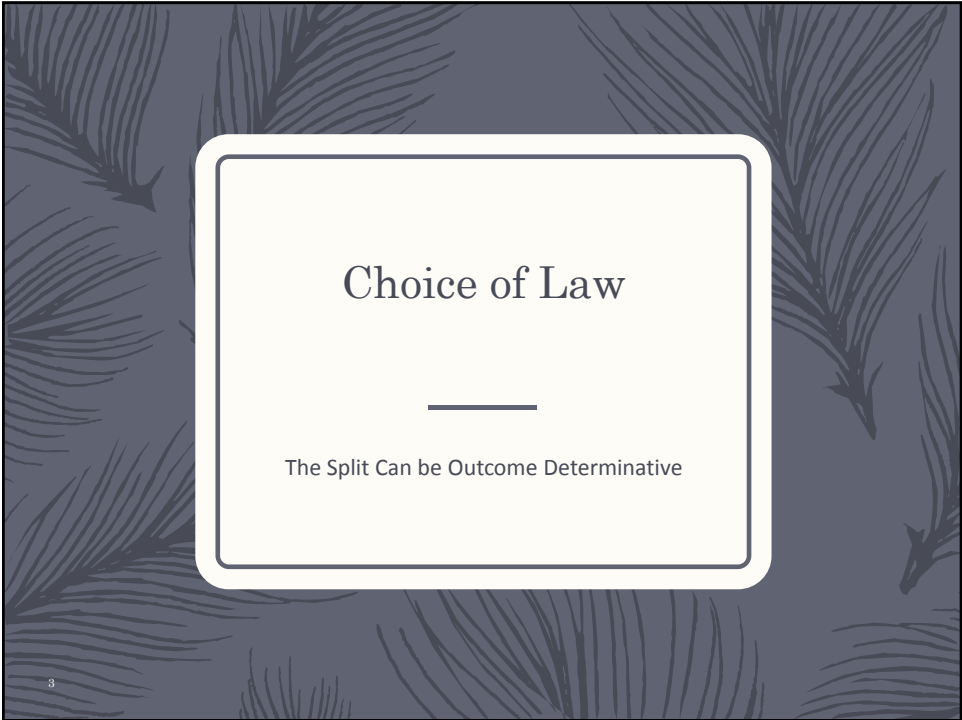
David Hricik
Professor, Mercer Law School
Of Counsel, Taylor English Duma, LLP



Topics

Choice of Law
Cooperative Prosecution: Joint Clients?
Patent Agent Privilege
In-House Counsel: Same Problems as Patent Agents?

2



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.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](http://utcle.org/elibrary)

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

Also available as part of the eCourse

[2017 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
12th Annual Advanced Patent Law Institute session

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