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Recent Developments in Patent Privilege Law

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I.	Introduction.....	1
II.	Work Product Protection for Communications Related to Litigation Financing in Patent Litigation	1
A.	The Work Product Doctrine.....	1
B.	Ordinary Work Product and Opinion Work Product	4
C.	The Increased Use of Litigation Funding	5
D.	Protecting Litigation Funding Documents and Communications Under the Work Product Doctrine	7
E.	Discovering Communications with Litigation Funders Based on Waiver	9
F.	Discovering Communications with Litigation Funders Based on Substantial Need	10
III.	Attorney-Client Privilege for Communications Between Patent Agents and their Clients.....	12
A.	Factual and Procedural Background of In re Andrew Silver.....	12
B.	Legal Background of Patent Agent Privilege	15
C.	Current Status of the Silver’s Petition for Writ of Mandamus	17
1.	The Parties’ Briefs on the Merits.....	17
2.	The Amicus Curiae Briefs	19
IV.	Conclusion	21

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TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Ashghari-Kamrani v. United Services Automobile Ass’n</i> , No. 2:15-CV-478, Dkt. 119 (E.D. Va. May 31, 2016)	10
<i>Bofi Fed. Bank v. Erhart</i> , 2016 WL 4150983 (S.D. Cal. Aug. 5, 2016)	9
<i>Cal. Sportfishing Prot. Alliance v. Chico Scrap Metal, Inc.</i> , 299 F.R.D. 638 (E.D. Cal. 2014)	9
<i>Canel v. Lincoln Nat. Bank</i> , 179 F.R.D. 224 (N.D. Ill. 1998)	3, 5
<i>Caremark, Inc. v. Affiliated Computer Services, Inc.</i> , 195 F.R.D. 610 (N.D. Ill. 2000)	4
<i>Carlyle Inv. Mgmt. LLC v. Moonmouth Co. S.A.</i> , 2015 WL 778846 (Del. Ch. Feb. 24, 2015)	7, 8, 11
<i>Devon IT, Inc. v. IBM Corp.</i> , 2012 WL 4748160 (E.D. Pa. 2012)	7, 9
<i>Dir., Office of Thrift Supervision v. Vinson & Elkins, LLP</i> , 124 F.3d 1304 (D.C. Cir. 1997)	5, 11
<i>Doe v. Soc’y of Missionaries of Sacred Heart</i> , 2014 WL 1715376 (N.D. Ill. May 1, 2014)	7
<i>Fletcher v. Union Pac. R.R. Co.</i> , 194 F.R.D. 666 (S.D. Cal. 2000)	4, 5
<i>Georgia-Pacific Corp. v. United States</i> , 318 F. Supp. 1116 (S.D.NY. 1970)	11
<i>Grochocinski v. Mayer Brown Rowe & Maw LLP</i> , 251 F.R.D. 316 (N.D. Ill. 2008)	9
<i>Hickman v. Taylor</i> , 329 U.S. 495 (1947)	2
<i>In re Andrew Silver</i> , 500 S.W.3d 644 (Tex. App.—Dallas Aug. 17, 2016, orig. proceeding [mand. pending])	12, 13, 14

<i>In re Andrew Silver</i> , No. 16-0682 (Tex. Jan. 17, 2017)	17, 18, 20, 21
<i>In re Cendant Corp. Sec. Litig.</i> , 343 F.3d 658 (3d Cir. 2003).....	4
<i>In re Grand Jury Subpoena Dated Nov. 8, 1979</i> , 622 F.2d 933 (6th Cir. 1980)	4
<i>In re Grand Jury Subpoena, Mark Torf/Torf Env'tl. Mgmt. (Torf)</i> , 357 F.3d 900 (9th Cir. 2004)	3
<i>In re Int'l Oil Trading Co., LLC</i> , 548 B.R. 825 (Bankr. S.D. Fla. 2016)	7, 8, 9
<i>In re Murphy</i> , 560 F.2d 326 (8th Cir. 1977)	4, 5
<i>In re Prof'l's Direct Ins. Co.</i> , 578 F.3d 432 (6th Cir. 2009)	3
<i>In re Queen's Univ.</i> , 820 F.3d 1287 (Fed. Cir. 2016).....	15, 16
<i>Ioengine LLC v. Imation Corp.</i> , Civil Action No. 14-1572-GMS, Dkt. 147 (D. Del. Aug. 2, 2016)	7
<i>Ioengine LLC v. Interactive Media Corp.</i> , Civil Action No. 14-1571-GMS, Dkt. 109 (D. Del. Aug. 2, 2016)	7
<i>JumpSport, Inc. v. Jumpking</i> , 213 F.R.D. 329 (N.D. Cal. 2003).....	4
<i>Kaplan v. S.A.C. Capital Advisors, L.P.</i> , 2015 WL 5730101 (S.D.N.Y. Sept. 10, 2015).....	10
<i>Mahoning Cty. Bar Assn. v. Harpman</i> , 608 N.E.2d 872 (Ohio Bd.Unauth.Prac. 1993).....	14
<i>Maine v. U.S. Dep't of the Interior</i> , 298 F.3d 60 (1st Cir. 2002).....	3
<i>Miller UK Ltd. v. Caterpillar, Inc.</i> , 17 F. Supp. 3d 711 (N.D. Ill. 2014)	passim
<i>Mitchell Eng'g v. City & Cty. of San Francisco</i> , No. C 08-04022 SI, 2010 WL 455290 (N.D. Cal. Feb. 2, 2010).....	2

<i>Mondis Tech., Ltd. v. LG Elecs., Inc.</i> , 2011 WL 1714304 (E.D. Tex. May 4, 2011).....	7, 10
<i>NLRB v. Sears, Roebuck & Co.</i> , 421 U.S. 132 (1975).....	2
<i>Odyssey Wireless, Inc. v. Samsung Elecs. Co.</i> , 2016 U.S. Dist. LEXIS 188611 (S.D. Cal. Sept.19, 2016).....	7, 11
<i>Oppenheimer Fund, Inc. v. Sanders</i> , 437 U.S. 340 (1978).....	1
<i>PepsiCo, Inc. v. Baird, Kurtz & Dobson LLP</i> , 305 F.3d 813 (8th Cir. 2002)	3
<i>Piazza v. First American Title Ins. Co.</i> , 2007 WL 4287469 (D. Conn. Dec. 5, 2007).....	10
<i>S.E.C. v. Schroeder</i> , 2009 WL 1125579 (N.D. Cal. Apr. 27, 2009).....	9
<i>Samuels v. Mitchell</i> , 155 F.R.D. 195 (N.D. Cal. 1994).....	9
<i>Sandra T.E. v. S. Berwyn Sch. Dist. 100</i> , 600 F.3d 612 (7th Cir. 2010)	3
<i>Sperry v. State of Florida ex rel. Florida Bar</i> , 373 U.S. 379 (1963).....	15
<i>United States v. Adlman</i> , 134 F.3d 1194 (2d Cir. 1998).....	3, 8
<i>United States v. AT&T</i> , 642 F.2d 1285 (D.C. Cir. 1980).....	10
<i>United States v. Deloitte LLP</i> , 610 F.3d 129 (D.C. Cir. 2010).....	3, 8, 9
<i>United States v. El Paso Co.</i> , 682 F.2d 530 (5th Cir. 1982), cert. denied, 466 U.S. 944 (1984).....	3
<i>United States v. Homeward Residential, Inc.</i> , 2016 WL 1031154 (E.D. Tex. Mar. 15, 2016)	7
<i>United States v. Nobles</i> , 422 U.S. 225 (1975).....	2, 3, 4

<i>United States v. Ocwen Loan Servicing, LLC</i> , 2016 WL 1031157 (E.D. Tex. Mar. 15, 2016)	7, 10, 11
<i>Upjohn Co. v. United States</i> , 449 U.S. 383 (1981).....	2
<i>Walker Digital, LLC v. Google, Inc.</i> , No. 11-cv-309-SLR, Dkt. 280 (D. Del. Feb. 12, 2013)	10
<i>Westinghouse Elec. Corp. v. Republic of Phil.</i> , 951 F.2d 1414 (3d Cir. 1991).....	9
STATUTES	
37 C.F.R. §§ 11.5, 11.6	12
37 C.F.R. § 11.5(b)(1).....	16
37 C.F.R. § 11.7	12
37 C.F.R. § 42	18
35 U.S.C. §§ 101-103, 161, 171	15
35 U.S.C. § 112.....	15
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FED. R. EVID. 501	1

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Jeff A. Anderson et al., <i>The Work Product Doctrine</i> , 68 CORNELL L. REV. 760 (1983).....	8
MOORE’S FED. PRACTICE 3d. § 26.70[2][b]	3
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www.law360.com/ip/articles/959672/3rd-party-funding-finding-a-home-in- patent-litigation	5, 6

I. INTRODUCTION

The protection of communications between a party and its attorneys based on attorney client privilege and work product protection is well-established in the law.¹ Recently, courts have considered the discoverability of communications between a party and other entities on issues relevant to (and sometimes unique to) patent law. First, courts have considered whether work product protection applies to communications with third-party litigation funders. Third-party funders are involved during the preparation of litigation, but attorneys may or may not be involved in working with a third-party funder. Second, federal and state courts have considered whether privilege applies to communications with a party and a patent agent when prosecuting and preparing patent applications. This paper analyzes recent developments related to both issues.

II. WORK PRODUCT PROTECTION FOR COMMUNICATIONS RELATED TO LITIGATION FINANCING IN PATENT LITIGATION

A. The Work Product Doctrine

It is well established that a party “may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case.”² Relevant information need not be admissible at trial to be discoverable.³ Relevance is construed broadly to include any matter that bears on, or reasonably could lead to other matters that could bear on, any issue that may be in the case.⁴ Federal Rule of Civil Procedure 26(b)(3) states, however, that “a party may not discover documents and tangible things that are prepared in anticipation of litigation or for trial by or for another party or its representative (including the

¹ FED. R. EVID. 501; FED. R. CIV. P. 26.

² FED. R. CIV. P. 26(b)(1).

³ *Id.*

⁴ *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 350-51 (1978) (footnote omitted) (citing *Hickman v. Taylor*, 329 U.S. 495, 501 (1947)).

other party’s attorney, consultant, surety, indemnitor, insurer, or agent).”⁵ Those work-product materials may be discovered only if “(i) they are otherwise discoverable under Rule 26(b)(1); and (ii) the party shows that it has substantial need for the materials to prepare its case and cannot, without undue hardship, obtain their substantial equivalent by other means.”⁶ And even when substantial need for those work-product materials is shown, courts must still “protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of a party’s attorney or other representative concerning the litigation.”⁷

The work product doctrine’s purpose is to protect the integrity of adversarial proceedings by shielding documents prepared in anticipation of litigation, and by shielding the surrounding expression of thoughts and opinions.⁸ The doctrine generally protects from discovery by an adverse party any materials prepared by or for a party in “anticipation of litigation.”⁹ The work product doctrine promotes the adversary system by allowing an attorney to assemble relevant information, develop legal theories, and plan legal strategies without undue concern as to whether his or her adversary will be privy to such preparation.¹⁰

The party asserting work product protection bears the burden of proving that the withheld material are: 1) documents and tangible things; 2) prepared in anticipation of litigation or for trial; and 3) the documents and tangible things were prepared by or for the party asserting the privilege.¹¹ Importantly, the work product doctrine does not bar discovery of facts.¹²

⁵ FED. R. CIV. P. 26(b)(3)(A) (emphasis added).

⁶ *Id.*

⁷ FED. R. CIV. P. 26(b)(3)(B).

⁸ *Hickman*, 329 U.S. at 512–13.

⁹ *Id.* at 508; *see also* FED. R. CIV. P. 26(b)(3).

¹⁰ *Hickman*, 329 U.S. at 508; *see also Upjohn Co. v. United States*, 449 U.S. 383, 397-98 (1981); *United States v. Nobles*, 422 U.S. 225, 237 (1975).

¹¹ *See* Charles Alan Wright & Arthur R. Miller, FEDERAL PRACTICE AND PROCEDURE § 2024 (2d ed. 1995); *see also* FED. R. CIV. P. 26(b)(3); *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132 (1975).

¹² *Mitchell Eng'g v. City & Cty. of San Francisco*, No. C 08-04022 SI, 2010 WL 455290, at *2 (N.D. Cal. Feb. 2, 2010) (quoting *Fin. Tech. Int'l, Inc. v. Smith*, No. 99-9351, 2000 WL 1855131, at *8 (S.D.N.Y. Dec.19, 2000))

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