McKool Smith

Recent Developments in Patent Privilege Law

Litigation Funding and Patent Agents

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Confidential Communications with Patent Agents

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Attorney-Client Privilege for Patent Agents

- Whether communications between patent agents and their clients in furtherance of the preparation and prosecution of patent applications are protected as confidential under the attorney-client privilege of Texas Rule of Evidence 503

Texas Rule of Evidence 503

- (a) **Definitions**. In this rule:
  - (3) A "lawyer" is a person authorized, or who the client reasonably believes is authorized, to practice law in any state or nation.
- (b) **Rules of Privilege**.
  - (1) ***General Rule***: A client has a privilege to refuse to disclose and to prevent any other person from disclosing confidential communications made to facilitate the rendition of professional legal services to the client:
    - (A) between the client or the client's representative and the client's lawyer or the lawyer's representative . . . .

Sperry v. State of Florida ex rel. Florida Bar

373 U.S. 379 (1963)

- The Supreme Court stated that it "d[id] not question the determination that under Florida law **the preparation and prosecution of patent applications for others constitutes the practice of law**."
- "Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria, as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves his participation in the drafting of the specification and claims of the patent application, which this Court long ago noted 'constitute[s] one of the most difficult legal instruments to draw with accuracy.'"

In re Queen's University

820 F.3d 1287 (Fed. Cir. 2016)

- The Federal Circuit "recognize[d] **a patent-agent privilege** extending to communications with non-attorney patent agents when those agents are acting within the agent's authorized practice of law before the Patent Office."
- "[T]he 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."
- "To the extent . . . that the traditional attorney-client privilege is justified based on **the need for candor between a client and his or her legal professional** in relation to the prosecution of a patent, that justification would seem to apply with equal force to patent agents."
- "To the extent **Congress has authorized non-attorney patent agents to engage in the practice of law before the Patent Office**, reason and experience compel us to recognize a patent-agent privilege that is coextensive with the rights granted to patent agents by Congress.

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