Intellectual Asset Management
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You and your patent agent

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It is well known among members of the patent bar that a person need not have a law licence in the United States to provide patent services. Section 31 of the Patent Act expressly permits the commissioner of patents to authorise practice before the US Patent and Trademark Office (USPTO) by non-lawyers. In considering this provision, the Supreme Court has held that the states may not prohibit patent agents from providing patent drafting and filing services, even if the state otherwise considers such activities to be "the practice of law", and most patent groups, whether working as an IP boutique or as part of a full-service law firm, employ the services of patent agents. However, as recent cases show, the issue of whether a patent agent enjoys the full benefits of a patent attorney with regard to patent prosecution remains unresolved.

For example, from time to time the question arises as to whether communications between a client and a non-attorney patent agent enjoy attorney-client privilege, or more accurately, 'patent-agent privilege'. This question was addressed in 2016 in two very different contexts and with opposite outcomes.

In March 2016 in *In re Queen's University at Kingston* the Federal Circuit upheld the notion of patent-agent privilege covering client communications with non-attorney patent agents. The court held that privilege extends to communications made in the course of an agent's authorised practice before the USPTO. The Federal Circuit stated:

> "*[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.*"

However, in August 2016 an intermediate civil appellate court in Texas in *In re Silver* refused to recognise patent-agent privilege, at least in the context of a contract dispute. This was true even though the contract related to a patent purchase agreement and the commercialisation of an invention. The court stated that: "Texas does not recognize patent-agent privilege and we decline to create a new common law privilege."

Interestingly, following the decision in *In re Silver* a petition for writ of mandamus was filed with the Fifth Court of Appeals to block discovery of emails between Andrew Silver and his patent agent. In response, a panel of the federal appellate court stated that it did not have the power to create a new common law discovery privilege and denied the petition.

In view of this divergence of law and these statements from federal appellate courts, in-house counsel and clients might ask whether it is safe for them to communicate with a patent agent without fear of losing confidentiality. Taking certain precautions will greatly increase the chances of the answer being "yes, it is safe".

As a rule, communications with a person who is an agent of an attorney for the purpose of obtaining legal advice or services are themselves privileged. This includes communications with legal assistants and other support staff. The same rationale supports patent-agent privilege – when the patent agent is otherwise working for or at the direction of a law firm. Indeed, this same rationale has been held to apply when domestic counsel is communicating with foreign patent associates in furtherance of obtaining patent protection.

Second, there must be at least an implied request for legal services from the person invoking privilege. Obviously, requesting the preparation of a patent application or other activities normally conducted by a patent agent before the USPTO would serve as such a request. Note, however, that requesting a stand-alone opinion on patent invalidity or unenforceability apart from the oversight of a patent attorney would likely not enjoy privilege.

Third, documents drafted or gathered at the direction of an attorney will generally enjoy protection under the attorney work product doctrine. This includes documents generated by third parties such as patent agents in anticipation of litigation.

Fourth, counsel should keep in mind that privilege extends only to communications reasonably necessary and incident to prosecuting patents before the USPTO. On this point, the Federal Circuit in *In re Queens* quoted 37 CFR § 11.5(b)(1):

> "*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.*"

This includes communications related to *inter partes* review and post-grant review proceedings. Communications sent by patent agents should be sent to the attorney as well. However, communications on other issues should be made in the presence of counsel or by copying counsel. Direct communications with a patent agent who is not serving as the agent of an attorney on any matters not listed in Section 11.5 of Title 37 CFR § 11.5 likely are not privileged. As an example, Silver's case in Texas was a breach of contract dispute that did not involve a determination of the validity of the underlying patent or whether the patent was infringed.

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