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Federal Circuit recognises patent agent privilege

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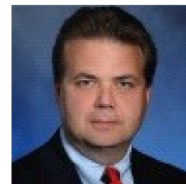

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On March 7 2016 the Federal Circuit, by a two-to-one decision in *In re: Queen's University,* recognised a "patent agent privilege". In the United States, a patent agent is not a licensed attorney, but has passed the US Patent and Trademark Office (USPTO) patent bar, and thus is authorised to prosecute patent applications before the USPTO. In a case of first impression, the court held that communications between a non-attorney patent agent and a patent applicant were protected by privilege, but this was limited to communications falling within the scope of practice.

Queen's University at Kingston had patents for attentive user interfaces, which allow devices to change their behaviour based on the user's eye contact with the device. The university sued Samsung in 2014, asserting that Samsung's SmartPause feature in its smartphones infringed its patents.

Queen's University refused to produce certain documents during discovery on the basis that they contained privileged information. In particular, the documents included communications between the university's employees and patent agents discussing the prosecution of the patents in suit. The district court held that a patent-agent privilege did not exist, but agreed to stay production of the documents at issue pending a petition for writ of mandamus.

The Federal Circuit granted the petition, holding that a separate patent agent privilege exists, independent of whether a patent attorney was involved in the prosecution of the application. The court found that congressional recognition of their authority to act, among other factors, counselled in favour of recognising an independent patent agent privilege.

This privilege is limited to communications "reasonably necessary and incident to the prosecution of patents before the Patent Office". In addition to preparing and prosecuting any patent application, it includes giving advice to a client considering filing a patent application and drafting a communication for an appeal to, or any other proceeding before, the Patent Trial and Appeal Board.

However, the privilege does not extend to activities outside this limited area. For example, a patent agent offering an opinion about the validity of a third-party patent would not be covered and may even constitute the unauthorised practice of law. Thus, any applicant wishing to maintain its privilege should limit communications with a patent agent strictly to prosecution matters, unless an associated attorney is involved.

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