

Selected U.S. Cases on the Availability of the Attorney-Client Privilege for Foreign Patent/Trademark Attorneys and Agents

NAME	COMMENT
<p><u>Advertising to Women, Inc. v. Gianni Versace S.p.A.</u>, 1999 U.S. Dist. LEXIS 12263 (N.D. Ill. 1999).</p>	<p>At issue: Application of the attorney-client privilege to communications between trademark holder and Italian patent (trademark) agent “related to Italian trademark activities.”</p> <p>Court looked to “Italian law to determine if the [communications] are privileged, because the drafter of these letters are Italian patent agents and/or attorneys and the communications ... are ... related to Italian trademark law.” The court found that the party asserting the privilege did not meet its burden of showing that the privilege attached. The party asserting the privilege failed to provide translations of the communications and other evidence, thus making it impossible for the court to determine if the communications contained privileged information, i.e., whether the agents were engaged in the “substantive lawyering process.”</p>

Alpex Computer Corp. v. Nintendo Co.,
1992 U.S. Dist. LEXIS 31219 (S.D.N.Y.
1992).

At issue were communications between Nintendo and a Japanese patent attorney (benrishi): (1) a letter from the benrishi and the President of Nintendo; (2) the benrishi's notes that form the basis of the letter; (3) notes taken by a Nintendo executive reflecting discussions with the benrishi.

Court held that Article 281 of the Japanese Code of Civil Procedure did not extend the privilege to the benrishi's client or to documents prepared in connection with the benrishi's advice.

Baxter Travenol Lab., Inc. v. Abbott Lab.,
1987 U.S. Dist. LEXIS 10300 (N.D. Ill.,
1987).

For various communications involving French, Israeli, German, and Canadian patent agents, the court concluded that the communications were not privileged.

Analysis: "In Mendenhall, the court concluded that if the communication is actually between the client and the foreign patent agent, and the attorney merely serves as a conduit for the information, the communication is not privileged unless under the foreign law communications between patent agents and client are privileged. Similarly, if the communication is actually between the attorney and the foreign patent office, and the foreign patent agent merely serves as a conduit, the communication is not privileged unless direct communication between the attorney and the foreign patent office is confidential. Where the communication consists not merely of information to be passed on to the foreign patent office, but is substantive, the result is different. If the foreign patent agent was primarily a functionary of the attorney, the communication is privileged to the same extent as any communication between an attorney and a non-lawyer working under his supervision. If the foreign patent agent is engaged in the lawyering process, the communication is privileged to the same extent as any

	communication between co-counsel.”
<u>Bayer AG v. Barr Lab., Inc.</u> , 33 U.S.P.Q.2d 1655 (S.D.N.Y. 1994).	<p>At issue: communications between party asserting privilege and its patent agents outside the U.S. In addition, communications between plaintiff's employee's and its German in-house patent attorneys.</p> <p>The court remanded the privilege issues to the Special Master, with general instructions on how to determine the applicable foreign privilege law.</p>
<u>Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.</u> , 1998 WL 159858 (S.D.N.Y. April 2, 1998).	The court found that the party asserting the privilege did not carry its burden of showing that a privilege equivalent to the attorney/client privilege exists in France for French patent agents as enjoyed by patent attorneys in the U.S.
<u>Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.</u> , 1998 WL 474206 (S.D.N.Y. August 12, 1998).	On motion to reconsider its earlier April 2, 1998 decision, the court stated its intention to hold an evidentiary hearing on whether the attorney-client privilege should apply to French patent agents' communications with inventors and others.

<p><u>Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.</u>, 188 F.R.D. 189 (S.D.N.Y. 1999).</p>	<p>The court denied a motion to reconsider its earlier decision denying the attorney-client privilege to communications between client and French patent agents because the client failed to provide evidence which established a client-patent agent privilege under French law, or an entitlement of patent agents to special secrecy protection under French law.</p>
<p><u>Burroughs Wellcome Co. v. Barr Lab., Inc.</u>, 143 F.R.D. 611, 25 U.S.P.Q.2d 1274 (E.D.N.C. 1992).</p>	<p>At issue: communications between plaintiff's U.K. patent agents and foreign patent agents.</p> <p>The burden to prove extension of the privilege to foreign patent agents rests with the party asserting privilege. The party asserting privilege must come forward with sufficient evidence to establish the privilege in foreign jurisdictions.</p>
<p><u>Chubb Integrated Sys. Ltd. v. Nat'l Bank of Washington</u>, 103 F.R.D. 52, 224 U.S.P.Q. 1002 (D.D.C. 1984).</p>	<p>At issue: communications "of [plaintiff's] United Kingdom patent agent" and plaintiff's U.S. counsel.</p> <p>"Federal courts give comity to foreign statutes governing the privileges of patent agents, when the communications relate solely to activities outside the United States. The court held the communications between foreign patent agent and U.S. attorney not privileged under both U.S. and U.K. law.</p>

Detection Sys., Inc. v. Pittway Corp., 96 F.R.D. 152, 220 U.S.P.Q. 716 (W.D.N.Y. 1982).

At issue: documents relating to foreign patents, e.g., "Document 46(O) is a letter from a Japanese patent agent concerning the Sontrix Japanese patent application sent to Sontrix's British patent agent. This correspondence was in turn forwarded with a cover letter to the Sontrix American attorney requesting instructions concerning the filing of the Japanese patent application. In this instance, it is evident that the British patent agent acted only as a conduit for transmitting the Japanese patent requirements to Sontrix. This type of activity cannot be used to shield documents from discovery, and any British rule concerning the attorney-client privilege is not applicable here. [The party claiming privilege] has submitted information concerning Japanese law, but whether a Japanese patent agent is considered an attorney for purposes of applying any Japanese rule concerning attorney-client privilege remains unclear. In any event, the Japanese legal system has no procedure corresponding to the discovery procedure used in the United States ... and absent this specific showing of privilege, the court will not restrict discovery." The court also found a communication with a Mexican patent agent not privileged.

Duplan Corp. v. Deering Milliken Inc., 397 F. Supp. 1146, 1168-69, 1171 (D.S.C. 1974)

Adopts the rule that no communications from patent agents, whether American or foreign, are subject to the attorney-client privilege in the United States. But “any communications touching base with the United States will be governed by the federal discovery rules while any communications related to matters solely involving [foreign countries] will be governed by the applicable foreign statute. The principle of comity applies.”

At issue: “communications between foreign patent agents and foreign corporate control members, their representatives, or foreign attorneys, relating to assistance in prosecuting patent applications in their own foreign country, the attachment of an attorney-client privilege depends on the law of the foreign country in which the patent application is filed. Comity requires such a result. There are two foreign countries for which a determination must be made in this order: France and Great Britain.”

France: “communications to or from a particular French patent agent ... would be protected by the attorney-client privilege when prosecuting French patent applications and when acting as patent house counsel in France.”

Great Britain: “communications to or from British patent agents must

	<p>be considered as within the scope of the attorney-client privilege for communications with foreign corporate control group members, their representatives, or foreign attorneys made after 1968 [date British statute was enacted] when prosecuting patent applications in Great Britain.</p>
<p><u>Foseco Int'l Ltd. v. Fireline, Inc.</u>, 546 F. Supp. 22, 218 U.S.P.Q. 157 (N.D. Ohio 1982).</p>	<p>As for communications between foreign patent agents and a foreign corporation concerning the prosecution of a foreign patent are privileged if such privilege is recognized under the law of the foreign country in which the patent application is filed. Also, communications between an attorney and a patent agent, foreign or domestic, are privileged where the patent agent is acting under the direction and control of an attorney as his agent.</p> <p>Communications from a British patent agent acting at the direction and control of a British corporation in asking a U.S. attorney for legal advice concerning a U.S. application were privileged just as if they had come directly from the corporation itself.</p>

Glaxo, Inc. v. Novopharm Ltd., 148 F.R.D. 535 (E.D.N.C. 1993).

“Of course, under the doctrine of comity, the privileged status of any communications between [plaintiff and its chart U.K. patent agents] which relate solely to the prosecution of a British patent application should be governed by United Kingdom law.” Court found privilege in the U.K.

Heidelberg Harris, Inc. v. Mitsubishi Heavy Indus., Ltd., 1996 U.S. Dist. LEXIS 19274 (N.D. Ill. 1996).

Court applied German law as to communications “connected with members of [plaintiff’s] patent department in Germany.” The court found that a Patentassessor (in-house patent attorney qualified to practice before the German Patent Office) is the functional equivalent of an attorney. The court also found the privilege to extend to the Patentassessor’s agents similar to that which exists between an American attorney and a paralegal or law clerk.

A number of communications involved Japanese entities and persons: e.g., “Doc. No. 19 – This is a fax from the Japanese division of [plaintiff] to another [plaintiff] employee of a copy of a Japanese patent application. This document must be produced...”; “Doc. Nos. 41 and 70 – ... Both are letters from the Japanese branch of [plaintiff] to [the head of the plaintiff’s German patent department] regarding the opening of a patent for public inspection and information about the patent itself. The documents contain only

	<p>business information and must therefore be produced.” No privilege attached to these documents.</p>
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Honeywell, Inc. v. Minolta Camera Co.,
1990 U.S. Dist. LEXIS 5954 (D.N.J. 1990).

At issue: During the taking of a deposition of a Minolta employee, who was neither an attorney nor a patent agent of any country, he was directed not to answer certain questions because of the attorney-client privilege and work product doctrine. The Magistrate Judge found that the Minolta employee was the “functional equivalent” of an attorney. On appeal, the Court noted that the Minolta employee “has never been licensed to practice law in any country and has never been registered as a patent agent in Japan or in the United States. [The Minolta employee] has a B.S. and, over the years, has attended various seminars, lectures and classes concerning legal and patent issues. The Court finds this is insufficient factual support for the finding that [the Minolta employee] is a de facto attorney.”

Application of Japanese law: “In their exhibits and at oral argument, Minolta raised the issue that this Court, under the principles of comity, ought to apply Japanese law to provide [the Minolta employee] with a privilege which would prevent the discovery at issue. This Court has considered Minolta’s arguments, as well as the exhibits of the parties, and finds that no sovereign interest of Japan is implicated in this action where depositions have been conducted in Japan merely as a courtesy to

	<p>Minolta. Also, the Court notes that the affidavits of the parties explaining Japanese law on the subject of privileges conflict with each other and do not provide a proper basis from which this Court could determine any applicable law.”</p>
<p><u>J.T. Eaton & Co. v. Atlantic Paste & Glue Co.</u>, 1987 WL 17084 (E.D.N.Y. 1987)</p>	<p>At issue: “correspondence between [plaintiff’s] United States patent counsel and its European patent agents.” Court recognized the <u>Status Time</u> holding as it applies to foreign patent agents, but “where the foreign law is not in conflict with the public policy interests of the forum, comity is given to foreign statutes.” The court gave comity to British law and held that the communications in question were privileged.</p>
<p><u>Kahn v. General Motors Corp.</u>, 1992 U.S. Dist. LEXIS 1489 (S.D.N.Y. 1992).</p>	<p>“As to the patent practitioners in Japan, Canada, Mexico and Australia, I agree with the [party requesting disclosure] that the vague reference to the ‘firms’ in the [attorney’s affidavit concerning the claim of privilege with respect to communications with foreign patent agents], without further identification of the individuals to whom the communications were addressed, is insufficient to demonstrate the existence of the attorney-client relationship.”</p>

McCook Metals L.L.C. v. Alcoa Inc., 192
F.R.D. 242 (N.D. Ill. 2000).

Party claimed attorney-client privilege on communications between in-house counsel and foreign attorneys and patent agents in connection with the prosecution of patents before foreign patent offices, including United Kingdom, France, Canada, Germany, and Japan.

The court made a number of rulings based on specific document categories, e.g., documents between in-house and outside American attorneys regarding foreign patents (giving advice or receiving updates on the status of foreign filings) found privileged. But communications between party's in-house counsel and other foreign outside counsel, and between outside American counsel and foreign counsel not privileged.

Mendenhall v. Barber-Greene Co., 531 F. Supp. 951, 217 U.S.P.Q. 786 (N.D. Ill. 1982).

At issue: communications with foreign patent agents and plaintiff's U.S. lawyer as to applications for foreign patents.

Proposes an alternative analysis when it comes to foreign patent agent communications: "the privilege should not extend to the situation in which the foreign patent agent occupies the conduit role – where he is employed only because the foreign country somehow makes his services necessary to the United States lawyer. In that case the lawyer's use of an intermediary to transmit information to the foreign patent office should likewise not alter the outcome. So if direct communications between a United States lawyer and a foreign patent office are publicly available and thus not privileged on any bases, the same result should obtain if the transmittal goes via the patent agent.... [I]t makes no difference that the foreign country may grant a privilege to communications between a client and the non-lawyer patent agent. This is so because the communication is not really between client and agent but rather between United States lawyer and foreign patent office, so the agent's status is irrelevant. All the analysis shifts dramatically if the communication between lawyer and foreign agent is 'substantive' – if it is not simply meant to be passed along to the foreign patent

office as part of the client's application. In that event there are two possibilities: (1) If the foreign patent agent is primarily a functionary, with the real lawyering being done by the United States lawyer, the communication is like that between a lawyer and any non-lawyer who serves under the lawyer's supervision. ... It generally makes no difference whether the patent agent himself is generally covered by a privilege, any more than is required of an investigator under parallel circumstances. (2) If the patent agent is also engaged in the substantive lawyering process however (because of knowledge of the foreign law), the communications between United States lawyer and foreign patent agent are between two professionals. ... each is treated by his own county as a subject of the privilege...."

No privilege for mere conduit-type communications. Substantive communication (not mere conduit) privilege available.

Novamount North America Inc. v. Warner-Lambert Co., 1992 U.S. Dist. LEXIS 6622 (S.D.N.Y. 1992).

At issue: the status of communications between patent agents in about fifteen different countries and defendants' US and Swiss attorneys. All of the communications related to parallel foreign patent application proceedings involving the same subject matter as the patent in suit. The court stated that there "was no dispute that the documents and communications are highly relevant to this action since they were made on behalf of the defendants, who claim infringement of their patent, and relate to the patent subject in this action. They have a direct bearing on the validity of defendants' United States patent and, thus, on the outcome of this case. The court found the communications not privileged under the "bright line" Status Time rule.

<p><u>Odone v. Croda Int'l PLC.</u>, 950 F. Supp. 10 (D.D.C. 1997).</p>	<p>The defendant, a foreign entity, asserted the attorney-client privilege over communications between it and its British patent agent regarding whether the plaintiff should be named as an inventor in the defendant's priority patent application.</p> <p>The court refused to extend the privilege to communications with foreign patent agents since they are not attorneys-at-law. ("Expanding the privilege to treat foreign patents as if they are lawyers improperly expands the privilege beyond its proper bounds.").</p>
<p><u>Renfield Corp. v. E. Remy Martin & Co., S.A.</u>, 98 F.R.D. 442 (D. Del. 1982).</p>	<p>At issue: communications with French in-house counsel and defendants. Court concluded that "if a privilege is recognized by either French or United States law, the defendants may invoke it."</p>

Santrade Ltd. v. General Elec. Co., 150 F.R.D. 539, 27 U.S.P.Q.2d 1446 (E.D.N.C. 1993).

“[Defendant] contends that plaintiff has failed to meet its burden with respect to documents that reflect communications with Japanese patent attorneys and agents. [Plaintiff] relies on two letters provided by two of its Japanese patent attorneys. Neither letter is sufficient to establish attorney-client privilege. Article 281 of the Japanese Code of Civil Procedure refers to the applicability of privilege under Japanese law, citing Alpex v. Nintendo. However, the Code refers only to the testimony of the attorney or patent agent and does not allow the client of a Japanese patent agent to withhold document on the ground of privilege. Article 312 merely refers to production of documents...”

Saxholm AS v. Dynal, Inc., 164 F.R.D. 331 (E.D.N.Y. 1996).

At issue: communications with foreign patent agents, e.g., involving Denmark, Canada, Sweden, Great Britain.

Choice of law analysis employed where there are communications with foreign patent agents in connection with assistance they rendered in the prosecution of patent applications in their own foreign countries. This choice of law analysis does not apply if the communications with foreign patent agents do not concern foreign patent applications.

The court found privilege to attach to some documents (Canada, Sweden, and Great Britain) and not to attach to others (Denmark).

Smithkline Beecham Corp. v. Apotex Corp., 2000 U.S. Dist. LEXIS 13607 (N.D. Ill. 2000); See also 193 F.R.D. 530.

At issue: Application of attorney-client privilege to communications between U.S. patent holder and its U.K. patent agent.

The court held that the communications were privileged in accordance with U.K. law, which court concluded treats communications between client and patent agent as privileged. The court applied the “comity-functionalism” test, leading to the application of U.K. law -- the British patent agents were “more or less functioning as attorneys,” thus

	presenting no inherent conflicts with U.S. law.
<u>Softview Computer Products Corp. v. Haworth, Inc.</u> , 58 U.S.P.Q.2D 1422 (S.D.N.Y. 2000).	<p>At issue: application of attorney-client privilege to communications between a U.S. patent holder and his German patent agent regarding a related EPO application.</p> <p>The court applied German privilege law as a matter of comity, and extended privilege to those documents containing client confidences because German law extends privilege to communications between clients and patent agents. But the Court conducted an <u>in camera</u> review of documents and found some documents not reflecting client confidences and thus not privileged.</p>

Status Time Corp. v. Sharp Elecs. Corp.,
95 F.R.D. 27, 217 U.S.P.Q. 438 (S.D.N.Y.
1982).

At issue: Documents Y through EE are correspondence between the U.S. law firm that assumed responsibility for the prosecution of the [application of the patent-in-suit] after the death of Mr. Graham, and various foreign patent agents, relating to foreign counterparts of the ... application.

The court refused to extend the privilege to communications with foreign patent agents since they are not attorneys-at-law. Id. at 33 (“Expanding the privilege to treat foreign patents as if they are lawyers improperly expands the privilege beyond its proper bounds.”) The Status Time approach provides a “bright line” test for determining whether communications with a foreign patent agent may be protected by the attorney-client privilege.

Stryker Corp. v. Intermedics Orthopedics, Inc. F.R.D. 298, 24 U.S.P.Q. 1676 (E.D.N.Y. 1992).

At issue: U.K. patent agent communications regarding European patent application.

The court concluded that under U.K. law, U.S. attorney’s correspondence with patent agent located in England pertaining to European patent application was privileged.

Vernitron Med. Prods., Inc. v. Baxter Labs., Inc., 186 U.S.P.Q. 324 (D.N.J. 1975).

Stands for the proposition that patent agents are equivalent to attorneys. Discusses foreign patent agents: "And where a specially authorized representative of one country conveys information to his counterpart in another country in connection with the processing of a patent application, such communications would also be privileged."

VL T Corp. v. Unitrode Corp., 194 F.R.D. 8
(D. Mass. 2000).

At issue: Application of the attorney-client privilege to (1) a letter from the U.S. patent holder's U.S. patent attorney to a Japanese patent attorney (benrishi), seeking advice regarding the effect of prior art on the U.S. patent's Japanese counterpart patent; and (2) a letter from the U.S. patent holder to his U.S. patent attorney, his U.K. patent agent, and his German patent attorney, seeking advice regarding the effect of prior art, under U.K. law, on the U.S. patent's British counterpart patent.

For communication (1): Under Japanese law, the letter is privileged because Japanese Civil Procedure Code Article 197 treats as privileged, information shared between clients and both Japanese attorneys (bengoshi) and Japanese patent attorneys (benrishi), and client-benrishi communications are exempt from production under Japanese discovery rules.

For communication (2): Court applied U.K. attorney-client privilege law, finding that the letter is privileged because English law treats as privileged, information shared between clients and both solicitors and patent agents.

Willemijn Houdstermaatschaap BV v. Apollo Computer Inc., 707 F. Supp. 1429 (D. Del. 1989).

At issue were a number of communications involving foreign patent agents, including communications involving foreign patent agents prosecuting patents in their native countries. Plaintiff provided the court with authority in the form of US case law and legal opinions of foreign attorneys and patent agents to support privilege in, for example, Japan. The court asked to inspect the documents and to accept further information on the privilege applicable in the countries of question.

The court considered communications between a U.S. patent attorney and foreign patent agents relating to patent prosecution in foreign countries. The foreign patent agents were found performing substantive lawyering roles and the documents dealt entirely with matters of foreign law. As for these communications, the existence of the attorney-client privilege depended upon the law of the foreign countries.

The court stated that “documents prepared by foreign patent agents that deal with matters of foreign patent law do not touch base with the United States and comity requires that they be given the same attorney-client privilege protection that they would be given abroad .. [with regard to] documents produced by or no

	<p>behalf of foreign patent agents [which] relate solely to matters outside of the United States, whether and to what extent they are privileged depends entirely on the laws of the countries concerned.”</p>
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