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# IP Newsflash



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## FEDERAL CIRCUIT CASES

### Patent Agent-Client Communications Now Afforded Some Degree of Privilege Protection

The Federal Circuit, in a 2-1 opinion, and for the first time, recognized the protection of communications between United States Patent and Trademark Office-registered patent agents and their clients based on a “patent agent privilege.” First, relying on previous Supreme court decisions, the court acknowledged that a patent agent’s “preparation and prosecution of patent application for others constitutes the practice of law” and thus should be protected. Second, the court looked to similar limited privileges—such as spousal and psychotherapist privileges—and found that the same policy considerations support a patent agent privilege. The court indicated that there is an “imperative need for confidence and trust” between patent agents and their clients. The court held that “the lack of a patent agent privilege would hinder communications between patent agents and their clients, undermining the real choice Congress and the Commissioner have concluded clients should have between hiring patent attorneys and hiring non-attorney patent agents.”

However, in adopting the privilege, the court narrowly construed its scope. Notably, the court limited the privilege to communications between the patent agent and the client, “which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceedings before the Office.” The court also provided examples of patent agent communications not covered by the privilege, such as opinions on the validity of a patent in the context of actual or potential litigation, or opinions on infringement.

*In re: Queens University at Kingston*, C. A. No. 15-145 (Fed. Cir. Mar. 7, 2016)

- Author: [James Duncan](#)

## CONTACT INFORMATION

If you have any questions regarding this issue of *IP Newsflash*, please contact—

**[Todd Eric Landis](#)**  
[tlandis@akingump.com](mailto:tlandis@akingump.com)  
214.969.2787

**[Michael Simons](#)**  
[msimons@akingump.com](mailto:msimons@akingump.com)  
512.499.6253

[www.akingump.com](http://www.akingump.com)



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