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Federal Circuit Confirms Patent Agent Privilege

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Yesterday, the Federal Circuit decided what it called “an issue of first impression . . . that has split the district courts.” The Court held that communications between a client and a non-attorney patent agent are subject to a “patent-agent privilege,” as long as the agent is “acting within the agent’s authorized practice of law before the Patent Office.

According to the Court, “the 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.” “[P]atent agents are not simply engaging in law-like activity, they are engaging in the practice of law itself. To the extent, therefore, 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.”

Based on this decision, clients can rest assured that communications with their patent agents relating to the preparation and prosecution of their patent applications can be privileged. “Communications that are not reasonably necessary and incident to the prosecution of patents before the Patent Office,” however, “fall outside the scope of the patent-agent privilege,” according to the Court.

The decision is *In re Queen’s Univ. at Kingston, Parteq Research and Development Innovations*, No. 2015-145 (Fed. Cir. Mar. 7, 2016) (available here). If you have any questions or wish to discuss how this decision may impact your business, please contact one of the authors.