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Via email: ACPrivilege@uspto.gov

Ms. Soma Saha
Mr. Edward Elliott
Office of Policy and International Affairs
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent and Trademark Office

Docket No. PTO-C-2014-0066

Dear Ms. Saha and Mr. Elliott:

On behalf of Illumina, Inc., I am responding to the Patent and Trademark Office's Request for Comments on *Domestic and International Issues Relating to Privileged Communications Between Patent Practitioners and Their Clients*.

Illumina is a global leader in genomics – an industry at the intersection of biology and technology. At a fundamental level, we enable our customers to read and understand genetic information. Our products are the result of numerous technological innovations, many of which we protect using patents. We employ patent agents both in-house and externally in law firms in the U.S. and internationally.

As we frequently utilize the services of patent agents, it is important for our business to eliminate the uncertainty surrounding the privilege afforded to our communications with our patent agents. Illumina respectfully requests that the Office of Policy consider the need that businesses have for certainty and uniformity in the protection of communications between patent agents and their clients. We suggest that such communications should be protected in a manner that is similar to the protection afforded by the attorney-client privilege.

In *Upjohn Co. v. United States*, 449 US 383 (1981), the United States Supreme Court dealt with privilege protection in the corporate context and emphasized the importance of certainty:

> [I]f the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.

Yet, in both the domestic and the international contexts, it is difficult to predict the privilege's applicability to patent-related communications made by a patent agent. However, in *Sperry v. Florida*, 373 U.S. 379 (1963), the Supreme Court sheds light on the role and conduct of a patent agent and their "attorney-like" function:

> Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves participation in his drafting of the specification and claims of the patent application which this Court long ago noted constitute[s] one of the most difficult legal instruments to draw with accuracy.

The Court concluded that a patent agent's work constitutes the practice of law, and that a patent agent is entitled to practice patent law in the state of Florida without the need for a state law license.

Another reason to apply a "patent agent-client privilege" to U.S. patent agents is to continue the outstanding efforts of the USPTO at global harmonization of patent laws. As in multiple other countries, privilege laws apply equally to both patent agents and patent attorneys.

U.S. District Courts have found that French, German, Japanese and UK law recognizes a privilege for patent agents. In *Duplan Corp. v. Deering Milliken*, Inc., 397 F. Supp. 1146, 1170 (D.S.C. 1975), the court held that the privilege protects communications with French patent agents who "are rendering legal advice to foreign corporate control group members, their representatives, or foreign attorneys on the patent law of their own country." In *Astra Aktiebolag v. Andrx Pharms*., 208 F.R.D. 92, 99-100 (S.D.N.Y. 2002), it was concluded that German law protects as privileged confidential communications between German patent agents and their clients. In *VLT Corp. v. Vicor Corp*., 194 F.R.D. 8 (D. Mass. 2000), it was concluded that Japanese law recognizes an evidentiary privilege for confidential communications between a client and either a patent attorney or a patent agent. And, in *In re Rivastigmine Patent Litigation*, 237 F.R.D. 69 (S.D.N.Y. 2006), it was found that the law in the United Kingdom recognizes a privilege for communications regarding patent matters between a client and a patent agent.

It is time to establish a clear U.S. patent agent-client privilege that is applied equally throughout the U.S., further harmonizing U.S. patent laws with the laws of other nations and solidifying the view of the U.S. courts.

Best regards,

Charles Dadswell
Senior Vice President & General Counsel