

Hernandez, Jesus

From: Daniel Feigelson <djf@4d-ip.com>
Sent: Wednesday, February 25, 2015 11:12 PM
To: ACPrivilege
Subject: privilege in communications

Dear Sirs:

In response to the FR Notice of January 26, 2015, I provide these brief comments.

I am a US citizen who has spent many years living outside the US. I am admitted to practice before the USPTO and the Israel PTO, and I have also passed the bar exam in Israel and in New York. The bulk of my work involves representing Israeli clients before the Israel PTO and the USPTO; I also represent a fair number of US clients before the Israel PTO. I personally am not affected by questions about the scope of privilege, nor are my clients. Nevertheless, as will be explained below, I think the current state of affairs with respect to privilege with foreign patent practitioners leaves much to be desired.

One of the things I've noticed as a result of living abroad is the tendency in the US to assume that the rest of the world operates in the same way that the US does. That assumption is often false. In the present context, to the best of my knowledge it is only the US and Canada where people first obtain an undergraduate degree and then go to law school. The situation in Israel is more similar to what exists in most of the world, as far as I can tell: law is an undergraduate degree – for many people their only university degree – whereas patent practitioners studied science or engineering, and may have worked in industry, before undertaking on-the-job training and study to qualify as patent practitioners.

The point is that the US-oriented perception that, for purposes of privilege, there are lawyers and then there is everyone else simply doesn't make sense in much of the world. In Israel, while lawyers are permitted to practice in patent cases before the ILPTO even without a technical background (due to a historical quirk), the fact is that almost no lawyers will undertake such work, because they realize it would constitute malpractice. Israeli entities seeking patent protection (including those who eventually plan to avail themselves of the Paris Convention and/or the PCT, and file outside Israel) usually engage the services of a local patent practitioner who is not a lawyer. Such practitioners nevertheless have legal training in patent matters and a better understanding of patent law than most lawyers. (Indeed, unlike in the US, which did away with claim drafting in the USPTO licensing examination in 1997, the Israel PTO licensing exam includes claim drafting.) Given the lack of technical training among lawyers, it would be folly for patent-seeking entities to engage the services of a lawyer.

That being the case, Israelis engaging the services of a local patent practitioner expect the same kind of privilege in their communications that they expect in communications with their lawyers on other matters. And, contrary to what the WIPO report states, courts in Israel have recognized such a privilege.

I therefore find the fact that some US courts will only look at matters through the lens of the US system, and refuse to recognize a privilege between non-US patent practitioners and their clients, just because those practitioners are not “lawyers” in the US sense, to be repugnant. This is even more so in view of the fact that, to the best of my knowledge, the US is the only country with significant pre-trial discovery. Civil procedure in Israel provides for very limited discovery. Israelis, for the most part, don’t expect US-style discovery, and they certainly don’t expect their communications with the patent practitioners to be subject to scrutiny, any more than they expect their communications with their lawyers to be subject to scrutiny. To force Israelis involved in US litigation to divulge communications with their local Israel patent counsel, when such communications would be deemed privileged had they been made to someone who majored in law rather than engineering, is wrong.

(For what it’s worth, my observation among US practitioners has been that a patent agent with a PhD and industry experience is far more likely to be a good patent practitioner than someone who went straight from undergraduate to law school to law firm; I think the failure to extend privilege to communications with such practitioners is similarly absurd.)

In the same vein, I think it would be ridiculous to say that there is no privilege in communications between US-based applicants and foreign patent counsel, simply because that foreign patent counsel doesn’t fit into the US-based notion of a lawyer.

As I said at the outset, these comments are brief. I have no suggestions at this time for how to word uniform rules regarding privilege, nor do I have a clue about costs of implementation. But then it doesn’t appear to me that such uniform rules could be adopted in any event, or would be likely to be adopted – *inter alia*, the lawyers’ guilds have too much at stake in keeping privilege as their own province.

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