

## Hernandez, Jesus

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**From:** Charlie Bustamante <cbustama@lenovo.com>  
**Sent:** Wednesday, January 28, 2015 7:01 PM  
**To:** ACPrivilege  
**Subject:** Comments for Rountable on Agent-Client Privilege

Dear Table members,

At the outset, let me disclose that I work as a patent agent for a corporation. Hopefully that discloses any potential bias. However, I believe that my comment below is unbiased due to its scope. By this I mean to convey that my commentary does not affect me personally, neither now; since I am not in private practice, nor in the future; since I plan specifically not to ever enter private practice.

In a corporate environment there is an easy workaround and that is to always address or cc an attorney in any communications, and there are always attorneys available for this. So in a corporate environment, there is only an issue of convenience (i.e., not an issue).

My comments relate more to the private practitioner, where I believe a real issue exists.

Often, ill-advised inventors attempt to patent their inventions themselves. This is mostly an exercise in futility. But many inventors who cannot afford patent-attorney rates can sometimes manage to pay patent-agent rates which are typically 25% less.

So let's consider those US inventors who seek the professional help of US-registered patent agents in private practice. The question I pose is: should these US inventors be disadvantaged (penalized really) in US courts?

Firstly, in *Sperry v. Florida*, the Supreme Court clarified that the day to day workings of a patent agent constitutes the practice of law. It found that 35 U.S.C. § 31 is constitutional and that by establishing the Patent Office and authorizing competent persons to assist in the preparation of patent applications, Congress has not exceeded the bounds of what is "necessary and proper" to the operation of the patent system established under Art. I, § 8, Ch 8, of the Constitution.

Keeping in mind that a patent agent's law practice is not a practice at the state level, but actually a law practice at the federal level and that patent cases are ultimately adjudicated within the federal court system, please consider this situation:

An innocent US inventor calls the patent office or visits the USPTO's website and selects a USPTO registered agent for prosecuting his or her application; and

The application eventually issues as a patent that eventually ends up in federal court over a large infringement settlement.

Ah, but let's say that there was an email communication between the inventor and the agent which would somehow be damaging and if not held to be privileged would keep this US inventor from winning his or her settlement.

Should this US inventor lose his or her settlement?

Who would it serve? *Sperry v. Florida* was a 1963 case. Has patent agency damaged the patent attorney profession?

Shouldn't we, as agents, attorneys, and judges, zealously advocate for citizens?

Understanding that life is not fair in general, here we are talking about a **justice system**. If our justice system is to be just to all citizens, a US inventor should not lose this settlement because at the time of filing he or she could only afford the fees of an agent and could not afford the fees of a patent attorney.

## Conclusion

The courts should afford privilege between a US inventor and his or her US registered agent in the narrow field of federal patent law, only.

The Constitution establishes the right for the legislature to create a patent system. The patent system has established patent agency. Patent agency was challenged by the Florida Bar in *Sperry v. Florida* at the Supreme Court. The Supreme Court in turn has ruled, amongst other things, that patent agency amounts to law practice at a federal level. Meanwhile, patent cases are ultimately adjudicated at the federal level. Thus, when a US inventor confers with a federal agency (the PTO) and that agency lists a register of agents and attorneys to pick from whom are qualified to practice before that federal agency --at the exclusion of most non-technical "general attorneys"-- then federal courts should afford privilege to such agents to consistently protect the rights of citizens.

Best regards,

**Charlie Bustamante**

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