The New Rule For Privilege in PTAB Trials

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On November 7, 2017, the Federal Register published "Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board," 82 FR 51575 (2017), promulgating privilege rule 37 CFR 42.57 "Privilege for patent practitioners."

The rule becomes effective December 12, 2017. The new rule reads as follows:

> 42.57 Privilege for patent practitioners
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> (a) Privileged communications. A communication between a client and a USPTO patent practitioner or a foreign jurisdiction patent practitioner that is reasonably necessary and incident to the scope of the practitioner's authority shall receive the same protections of privilege under Federal law as if that communication were between a client and an attorney authorized to practice in the United States, including all limitations and exceptions.
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> (b) Definitions. The term ''USPTO patent practitioner'' means a person who has fulfilled the requirements to practice patent matters before the United States Patent and Trademark Office under § 11.7 of this chapter. ''Foreign jurisdiction patent practitioner'' means a person who is authorized to provide legal advice on patent matters in a foreign jurisdiction, provided that the jurisdiction establishes professional qualifications and the practitioner satisfies them. For foreign jurisdiction practitioners, this rule applies regardless of whether that jurisdiction provides privilege or an equivalent under its laws.
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> (c) Scope of coverage. USPTO patent practitioners and foreign jurisdiction patent practitioners shall receive the same treatment as attorneys on all issues affecting privilege or waiver, such as communications with employees or assistants of the practitioner and communications between multiple practitioners.

I list below my synthesis of the PTO's comments on the rule, and changes relative to the proposed rule. These comments clarify the scope of privilege defined by the rule.

Q. What are the scope of covered activities?
A. Those are "subject to determination by an appropriate authority."

Q. Does the rule refer to federal privilege?
A. The PTO "adjusted the [proposed] rule [in paragraph (a)] to specify "privilege under Federal law" in paragraph (a).

Q. Are U.S. attorney communications with the foreign practitioner privileged?
A. "U.S. Federal law, attorney-client privilege generally encompasses communications with an attorney made by the client's representatives as well as the client... with an attorney's employee or assistant, as well as communications between multiple attorneys working for a client...[so long as communications] meet the other requirements for privilege, such as appropriate subject matter... We have added paragraph (c) to the rule to clarify."

Q. What are the "limitations and exceptions" to the rule?
A. These are defined by "longstanding common law, which continues to evolve."

Q. Does the privilege apply to practitioners with limited recognition?
A. The proposed rule section "b" is amended to cover resident alien practitioners and limited recognition practitioners.

Q. Is the rule moot in view of or redundant of the Federal Circuit *In re Queen's University* decision?
A. No. *Queen* does not address foreign patent agents; the rule does.