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Reassessing Attorney-Client Privileged Legal Advice in Patent Litigation

The Federal Circuit on the Federal Circuit:

"[The Court of Appeals for the Federal Circuit] is charged with the duty of increasing doctrinal stability in the field of patent law."¹

The United States Supreme Court on privilege:

"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."²

I. INTRODUCTION

The attorney-client privilege, the oldest of the so-called "communication" privileges, exists to protect the confidential communications shared between a client and his legal advisor. The prevailing application of the privilege, however, undermines this purpose by operating in a one-directional manner, protecting only the statements of the client to the attorney and those of the attorney which would directly reveal the already privileged statements of the client.³ The effects of such an application are particularly felt in patent litigation where a great deal of advisory documents are at stake.⁴ The most dramatic repercussion of this one-directional approach is its inconsistent application, which has led to a great

³ In such a one-directional application, the privilege would protect a letter from the client to his attorney requesting advice, and the attorney's reply. However, this application would not provide protection to unsolicited legal advice from an attorney to his client under the rationale that such a communication reveals no prior communication from the client.
deal of confusion surrounding the privilege and its proper scope in patent scenarios. By returning to a bi-directional application of the attorney-client privilege, one which would protect both statements of the client to the attorney and those of the attorney to the client, not only will the true spirit behind the privilege be realized, but greater efficiency and consistency in pre-trial patent litigation will result.

This Note, therefore, endorses such a bi-directional approach through a multi-step analysis of the privilege and its application to patent litigation. Part II surveys the history and purpose of the privilege, presenting the two prevailing standards currently used in federal courts. Part III reviews the privilege’s tumultuous historical application in the field of patent law and highlights three common areas of confusion: (1) patent law as the practice of law, (2) the patent attorney’s duty of candor to the Patent and Trademark Office, and (3) the misdirected focus on the information behind the communication. Part IV argues for a bi-directional approach to the attorney-client privilege through a detailed examination and comparison of the original intent behind the two privilege standards. Part V analyzes the relationship of the Federal Circuit to the field of patent law and its most recent decision relating to this issue. Part VI proffers a means by which the Federal Circuit could adopt the bi-directional application of the attorney-client privilege to legal advice in patent litigation. Lastly, Part VII discusses the merit of the application of such a bi-directional privilege in patent litigation and concludes that the attorney-client privilege’s protection should encompass legal advisory correspondence from the patent attorney to the client.

II. THE ATTORNEY-CLIENT PRIVILEGE: AN OVERVIEW

In order to effectively analyze the merit and proper scope of the attorney-client privilege, a review of the history and purpose behind the privilege is necessary. Once that background and rationale is examined, a explanation of the two standards the circuits use at present will provide a foundation with which to examine the application of the attorney-client privilege in specific patent-based scenarios.

5 Original subject matter jurisdiction over all patent claims is vested in the federal judiciary. 28 U.S.C. § 1338 (1988).
A. History and Purpose of the Attorney-Client Privilege

The concept of privilege is a cornerstone of our legal system. However, by restricting full disclosure, the privilege conflicts with one of the major purposes of modern discovery. The justification behind the existence of any privilege is based upon social policy considerations: a balance must be struck between encouraging confidence in certain relationships and allowing full access to specific information for litigation purposes. Certain relationships are deemed valuable enough to merit the exclusion of the communications of that relationship from discovery under the category of communication privileges. The oldest of these communication privileges is the attorney-client privilege, dating back to the reign of Elizabeth I.

Yet, while the attorney-client privilege is the oldest of the common law privileges for confidential communications, the rationale supporting it was entirely different during its first 300 years of existence. Originally, the privilege was more concerned with the oath and honor of the attorney himself, rather than with the special relationship between the attorney and client. However, toward the end of the eighteenth century, this objective rationale lost ground to a more subjective one. Courts recognized that "the judicial search for the truth could not endure to be obstructed by a voluntary pledge of secrecy, nor was there any moral delinquency or public odium in breaking one's pledge under the force of

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6 The three major purposes behind modern discovery are: (1) to preserve relevant information that might not be available at trial, (2) to ascertain the issues that actually are in controversy between the parties, and (3) to allow a party to obtain information that will lead to admissible evidence on the issues in dispute. Fed. R. Civ. P. 26(b), 27, 32-34; see also James H. Friedenthal et al., Civil Procedure § 7.1 (1985). The concept of privilege conflicts with the third of these purposes, since it precludes a party from obtaining certain information.

Under these Federal Rules, the scope of discovery is extremely broad, subject to "privilege" as mentioned in Rule 26(b)(1), which under Rule 501 of the Federal Rules of Evidence refers to the common law definition of such. Fed. R. Evid. 501.

7 Friedenthal et al., supra note 6, § 7.4.
8 Id. § 10.2.
9 8 John Henry Wigmore, Evidence in Trials at Common Law § 2290, at 542 (McNaughton rev. ed. 1961). Other notable communication privileged relationships involve doctors and patients, mental health practitioners and patients, religious leaders and parishioners, and husbands and wives. Friedenthal et al., supra note 6, § 10.2.
10 8 Wigmore, supra note 9, at 543-45.
11 8 id.
the law."\textsuperscript{12} The British Dutchess of Kingston's Case\textsuperscript{13} finally put the "honor pledge" rationale to rest and began the era of the current rationale behind the notion of the attorney-client privilege.

Today, a more utilitarian justification is put forth to support the maintenance of an attorney-client privilege.\textsuperscript{14} This well established purpose behind the privilege is simply stated as the promotion of full and open communication between the attorney and client.\textsuperscript{15} By protecting confidential attorney-client communications, courts foster the viewpoint that society values the attorney-client relationship and, thus, the relationship should be encouraged.\textsuperscript{16}

Hence, the attorney-client privilege advances the public interest in two ways. First, it encourages full and frank dialogue between attorneys and clients, which undoubtedly leads to better legal representation.\textsuperscript{17} Second, by allowing this open discussion, the privilege promotes the broader public interests of encouraging the observation of law and the administration of justice.\textsuperscript{18}

This subjective rationale, however, requires some form of analysis with which to ascertain the applicability of the privilege. As with many areas of the law, more than one standard developed. From these developments, the different circuits have settled on one of two standards for the attorney-client privilege, opting for

\begin{itemize}
\item \textsuperscript{12} 8 \textit{id.} at 543.
\item \textsuperscript{13} 20 \textit{How. St. Tr.} 586 (1776), \textit{reprinted in NOTABLE BRITISH TRIALS SERIES} 256 (Melville ed. 1927). In this House of Lords trial for bigamy, Lord Barrington attempted to invoke his honor to avoid testifying against his friend, the accused (who was not his client). After adjourning to discuss this precarious situation, the Lords reconvened and declared that "it is the judgement of this House that you are bound by law to answer all such questions as shall be put to you." 8 \textit{WIGMORE}, \textit{supra} note 9, at 531 n.16.
\item \textsuperscript{16} Harman, \textit{supra} note 14; \textit{see also Developments in the Law—Privileged Communications}, 98 \textit{HARV. L. REV.} 1450, 1501 (1985).
\item \textsuperscript{17} \textit{Upjohn}, 449 U.S. at 389; \textit{see also Weil Ceramics & Glass, Inc. v. Work}, 110 F.R.D. 500, 504 (E.D.N.Y. 1986); Hercules, Inc. v. Exxon Corp., 434 F. Supp. 136, 144 (D. Del. 1977).
\item \textsuperscript{18} \textit{Upjohn}, 449 U.S. at 389; \textit{Weil Ceramics}, 110 F.R.D. at 504; \textit{Hercules}, 434 F. Supp. at 144.
\end{itemize}
either the Wigmore standard or the standard set forth in *United States v. United Shoe Machinery Corp.*

**B. The Wigmore Standard**

Dean Wigmore, the eminent twentieth century evidence scholar, explained the concept of privilege in his 1904 treatise *Evidence in Trials at Common Law.* Dean Wigmore defined the attorney-client privilege as:

(1) Where legal advice of any kind is sought (2) from a professional legal adviser in his capacity as such, (3) the communications relating to that purpose, (4) made in confidence (5) by the client, (6) are at his instance permanently protected (7) from disclosure by himself or by the legal adviser, (8) except the protection be waived.

This standard, hereinafter referred to as the Wigmore standard, has received substantial deference in federal court opinions. At present, five of the twelve circuits apply the Wigmore standard.

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19 89 F. Supp 357, 358-59 (D. Mass. 1950). A detailed analysis and breakdown of each of these standards is undertaken infra Part IV.

20 John Henry Wigmore is often recognized as an expert legal mind in the field of evidence. Just a few of these recognitions include: "the roster of scholars and judges . . . reads like an honor roll of the legal profession[,] . . . Wigmore . . . Corwin . . . Pound . . . Friendly," Lakeside v. Oregon, 435 U.S. 333, 345 (1978) (Stevens, J., dissenting); "my admiration for Professor Wigmore's scholarship is great . . .", Schmerber v. California, 384 U.S. 757, 774 (1966) (Black, J., dissenting); "a learned author . . .", Clark v. United States, 289 U.S. 1, 13 (1933) (Cardozo, J., relying on Wigmore's evidence treatise). In addition, the Supreme Court has cited Wigmore on Evidence on over 340 occasions with almost one hundred of those cites relating to the doctrine of privilege.

21 4 JOHN HENRY WIGMORE, EVIDENCE IN TRIALS AT COMMON LAW, chs. 79-84 (1904).

22 4 id. § 2292.

23 The Second, Sixth, Seventh, Ninth and Tenth Circuits have adopted the Wigmore standard. See United States v. Landof, 591 F.2d 36 (9th Cir. 1978); Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968); United States v. Goldfarb, 328 F.2d 280 (6th Cir. 1964); Radiant Burners, Inc. v. American Gas Ass'n, 320 F.2d 314 (7th Cir. 1963); United States v. Kovel, 296 F.2d 918 (2d Cir. 1961). *cf. infra* note 30 (the remaining seven circuits follow the *United Shoe* standard).

While the Federal Circuit actually brings the total number of circuits in the federal judiciary to thirteen, that circuit is absent from this figure due to the fact that the Federal Circuit established a policy of applying the procedural "law of the particular regional circuit court where appeals from the district court would normally lie." Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1572-75 (Fed. Cir. 1984); *see also* Heat & Control, Inc. v. Hester Indus., 785 F.2d 1017, 1022 n.4 (Fed. Cir. 1986). This is due to the specialized jurisdiction of the Court of Appeals for the Federal Circuit, discussed *infra* Part V. See generally 28 U.S.C. § 1295 (1988).
C. The United Shoe Standard

On March 10, 1950, Judge Charles Edward Wyzanski, Jr., a district court judge from Massachusetts,24 issued a pre-trial ruling on what probably appeared at the time to be another routine document discovery dispute.25 At issue in this ruling was the United Shoe Machinery Corporation’s objection to the introduction of nearly 800 exhibits on the ground that they fell within the scope of the attorney-client privilege.26

In his opinion, Judge Wyzanski went out on two limbs, one of which was subsequently rejected by the United States Supreme Court.27 The other has added much weight to its original offshoot; yet, it has grown cumbersome and needs reexamination. This remaining limb of the United Shoe tree has come to be known as the United Shoe or Wyzanski standard:

The [attorney-client] privilege applies only if (1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication was made (a) is a member

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24 Judge Wyzanski, appointed to the District Court of Massachusetts on December 19, 1941, was one of the youngest men ever appointed to the federal bench. He served as a federal trial judge in Massachusetts for 45 years and handed down many controversial decisions, with his most noteworthy being in the field of civil rights. See generally Charles E. Wyzanski Jr. Noted for Controversial Rulings - Jurist Who Emphasized Civil Rights Dies, L.A. TIMES, Sept. 6, 1986, at 7; Eric Pace, Charles E. Wyzanski, 80, is Dead - Judge on U.S. Court for 45 Years, N.Y. TIMES, Sept. 5, 1986, at 20 (late city final ed.).

Prior to his retirement, Judge Wyzanski was elevated to the position of Chief Judge of the District Court of Massachusetts and sat by designation on the courts of appeal of several circuits. Judge Wyzanski is widely recognized as an extraordinary district court judge who remained at the district court level for 45 years not for lack of ability, but because of his love for the trial court. See Mark L. Wolf, Few are Chosen: The Judicial Appointments of Oliver Wendell Holmes, Jr., and Charles Edward Wyzanski, Jr., 74 MASS. L. REV. 221 (1989); Citation: Judge Charles E. Wyzanski, Jr., BOSTON BAR J., April 1982, at 5 (Award for Distinguished Judicial Service presented to Wyzanski by the Boston Bar Foundation and the Boston Bar Association).


26 United Shoe, 89 F. Supp. at 358.

27 The first determination by Judge Wyzanski was that the relationship between an in-house patent attorney and his employer-corporation “is not that of attorney and client.” Id. at 361. This assertion has been harshly criticized and was eventually disapproved of by the Supreme Court. Sperry v. Florida, 373 U.S. 379 (1963). The details of Judge Wyzanski’s mischaracterization of the work of patent attorneys in United Shoe and its harmful effects on the issue of the attorney-client privilege in patent law is discussed infra Part III.A.
of the bar of a court, or his subordinate and (b) in connection
with this communication is acting as a lawyer; (3) the commu-
nication relates to a fact of which the attorney was informed
(a) by his client (b) without the presence of strangers (c) for
the purpose of securing primarily either (i) an opinion on law
or (ii) legal services or (iii) assistance in some legal proceed-
ning, and not (d) for the purpose of committing a crime or
tort; and (4) the privilege has been (a) claimed and (b) not
waived by the client.\textsuperscript{28}

This standard has garnered extraordinary precedential value since
its introduction in \textit{United Shoe}, with seven of the twelve circuits\textsuperscript{29}
adopting the Wyzanski standard.\textsuperscript{30}

\section*{III. HISTORICAL DIFFICULTIES OF APPLYING THE ATTORNEY-CLIENT PRIVILEGE TO PATENT LAW}

While the attorney-client privilege has been rooted firmly in
the common law for over 400 years, its application in certain areas
of the law, particularly patent law, has been less certain. This un-
certainty stems from a combination of factors unique to the field
of patent law: the historical view that patent attorneys did not
practice law, the patent attorney's duty of candor to the Patent
and Trademark Office, and the misdirected focus on the informa-
tion behind the communication.\textsuperscript{31} Sometimes more than one,
and occasionally, all of these factors lurk behind a court's attempt
to determine the scope of the attorney-client privilege in patent
law. An explanation of each factor is necessary to understand the
varying law concerning the attorney-client privilege's correct inter-
pretation in patent law.

\begin{footnotes}
\item[28] \textit{United Shoe}, 89 F. Supp. at 358-59.
\item[29] See infra note 23 (regarding the Federal Circuit's absence from this computation).
\item[30] The First, Third, Fourth, Fifth, Eighth, Eleventh, and District of Columbia Circuits
have adopted the \textit{United Shoe} standard. See \textit{In re Grand Jury Proceedings}, 899 F.2d 1039
(11th Cir. 1990); \textit{United States v. Wilson}, 798 F.2d 509 (1st Cir. 1986); \textit{In re Sealed
Case}, 737 F.2d 94 (D.C. Cir. 1984); \textit{In re Grand Jury Investigation}, 599 F.2d 1224 (3d
Cir. 1979); \textit{Diversified Indus., Inc. v. Meredith}, 572 F.2d 596 (8th Cir. 1977); \textit{United
States v. Knox}, 517 F.2d 666 (5th Cir. 1975); \textit{NLRB v. Harvey}, 349 F.2d 900 (4th Cir.
1965); cf. supra note 23 (the remaining five circuits follow the Wigmore standard).
\item[31] These three factors behind the confusion of the attorney-client privilege's applica-
tion to patent law all have the peculiar effect of serving only to support incorrect ap-
plications of the privilege.
\end{footnotes}
A. Patent Law as the Practice of Law

Only a half century ago, most of the work performed by patent lawyers was perceived by many judges and other learned citizens as not being part of the practice of law. Apart from other peculiarities of patent law, this misconception alone had a drastic effect on the development of the attorney-client privilege in patent litigation.

Ironically, a large source of this mischaracterization was Judge Wyzanski's opinion in *United States v. United Shoe Machinery Corp.* In discussing memoranda to and from United Shoe's patent department, the court found that "[a]ll the men in the [patent] department function[ed] less as detailed legal advisors than as a branch of an enterprise founded on patents." Judge Wyzanski stated that "the relationship of a person in the patent department to the corporation is not that of attorney and client. Hence the communication of a person in the patent department is... unprivileged." Soon after the *United Shoe* opinion, other courts expanded this interpretation and portrayed the patent attorney as a lower caste of lawyer. In *Zenith Radio Corp. v. Radio Corp. of America*, the Delaware District Court broadly defined the phrase "acting as a lawyer" as "encompass[ing] the whole orbit of legal functions." However, when it came to the work of patent attorneys, the court had the following about-face response:

They do not "act as lawyers" when not primarily engaged in legal activities; when largely concerned with technical aspects of a business or engineering character, or competitive considerations in their companies' constant race for patent proficiency, or the scope of public patents, or even the general application of patent law to developments of their companies and competitors; when making initial office preparatory determinations of patentability based on inventor's information, prior art, or legal tests for invention and novelty; when drafting or comparing patent specifications and claims; when preparing the application for letters patent or amendments thereto and prosecuting same in the Patent Office; when handling interference proceed-

33 Id. at 360.
34 Id. at 361.
36 Id. at 794.
ings in the Patent Office concerning patent applications. This view of them patent practitioners as mundane paper-pushers, unworthy of the same privileges as their astute non-patent colleagues, persisted with subsequent opinions.

Within a decade of the Zenith opinion the Supreme Court ruled that patent practice is the practice of law, putting this mischaracterization to rest. In Sperry v. Florida, the Florida Bar attempted to enjoin patent agents from advising clients within their state and argued that the various tasks performed by a patent attorney did in fact constitute the practice of law. In a long-awaited and subsequently praised opinion, the Court held:

We do not question the determination that...the preparation and prosecution of patent applications for others constitutes the practice of law. Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria, 35 U.S.C. §§ 101-103, 161, 171, as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves his participation in the drafting of the specification and claims of the patent application, 35 U.S.C. § 112, which this Court long ago noted "constitute[s] one of the most difficult legal instruments to draw with accuracy..."

With this leveling of the attorney-client privilege playing field for specialized attorneys after Sperry, the modern approach to the privilege in patent law began. However, this approach tended to

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37 Id. (footnote omitted) The court's rationale behind this statement was that some of these tasks were not solely within the performance domain of a patent attorney. Contra Chore-Time Equip. v. Big Dutchman, Inc., 255 F. Supp. 1020, 1023 (W.D. Mich. 1966) ("The mere fact that non-lawyers could also have performed the services in question does not in any way destroy the privilege.")


39 373 U.S. 379 (1963). While Sperry did not deal with the attorney-client privilege directly, the Supreme Court's decision that the work of patent attorneys is the practice of law directly disapproved the Zenith attorney-client privilege decision.

40 A patent agent is a person, not an attorney, registered to practice before the Patent and Trademark Office.

41 Sperry, 373 U.S. at 383 (citations omitted) (citing Topliff v. Topliff, 145 U.S. 156, 171 (1892)).

42 It should be noted that in light of the purposes and rationales behind the attorney-client privilege (see supra Part II.A.), even with this availing of the privilege to patent attorneys, an attorney in any field must be acting as a lawyer, not as a mere business
shift the focus of the privilege in patent situations to either the patent attorney's relationship with the Patent and Trademark Office, or to the information communicated between the attorney and client, neither of which was without nuances of its own.

B. Duty of Candor to the Patent and Trademark Office

To understand the patent attorney's responsibilities and relationship with the Patent and Trademark Office ("PTO"), it is necessary to understand the dual role of the patent attorney. In order to file a patent application, anyone representing the applicant (the inventor) must be registered to practice before the PTO. Upon receipt of the application, the PTO directs it to a patent examiner who has an expertise in the specific field of the invention. The examiner then conducts an independent prior art search and evaluates the invention's patentability. A patentable invention will satisfy three conditions: (1) novelty (see 35 U.S.C. § 102 (1988)), (2) utility (see U.S. CONST. art. I, § 8, cl. 8) and (3) non-obviousness (see 35 U.S.C. § 103 (1988)). In the extremely unlikely, yet ideal situation, the examiner reviews the application, finds it patentable, and grants the patent. Almost always, however, the application is rejected and returned. At this point, an interaction begins between the patent examiner and the patent attorney. The patent attorney may reword the claimed invention to distinguish it further from the prior art. Alternatively, the attorney may argue that the examiner's interpretation of the prior art or the invention's obviousness is incorrect. After the examiner is satisfied that the invention is sufficiently distinguished from the prior art and non-obvious to those knowledgeable in the field, a patent is granted. This interaction produces a file of the communications between the examiner and attorney. This file details the scope of the claimed invention. In a later infringement action, this file, under the doctrine of file wrapper estoppel or prosecution history estoppel, may be used to define the scope of the patent.

Should the examiner reject the application after this interactive process, the patentability of such invention can be appealed to the Board of Patent Appeals and Interferences. See ROBERT A. CHOATE ET AL., PATENT LAW 538-39 (3d ed. 1987). See generally 60 AM. JUR. 2D Patents §§ 293-523 (1987) (patent applications and examinations generally).

Such individuals consist of patent attorneys, patent agents, or individuals given limited recognition to practice by the Director of Enrollment and Discipline under 37 C.F.R. § 10.9. While both patent attorneys and patent agents have equal status before the PTO (see 37 C.F.R. § 10.6(a) & (b) (1993)), this Note deals only with the attorney-client privilege as it applies to the patent attorney. While the privilege's name and common law nature might raise the assumption of total inapplicability of the privilege to patent agents, this area is in dispute as well. See In Re Ampicillin Antitrust Litigation, 81 F.R.D.
This registration by the PTO is based upon the satisfaction of several admission requirements, most notably the successful completion of the patent bar exam. This examination is designed to test one’s “possess[ion] of the legal . . . qualifications necessary to . . . render applicants for patents valuable service[,]” as well as one’s competence “to advise and assist applicants for patent in the presentation and prosecution of their applications before the Office.” Upon admittance to the patent bar, one becomes a patent agent and may prosecute patents before the PTO. The patent attorney, in contrast, must also be a licensed attorney.

This dual certification of the patent attorney grants many privileges to members of the patent bar, yet it also imposes duties upon the patent attorney from an additional governing body.

PTO registration requires a duty of candor to the PTO. This duty, read into the specification provision of the federal code chapter on patent applications, is clearly set forth in the Code of Federal Regulations title on Patents, Trademarks, and Copyrights. It reads:

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability . . . . There is no duty to submit information which is not material to the patentability of any existing patent.

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45 See 37 C.F.R. § 10.7(a) (1993). The other substantial requirement for admission is the “possess[ion] of the . . . scientific . . . and technical qualifications necessary to enable him or her to render applicants for patents valuable service.” 37 C.F.R. § 10.7(a)(2)(ii) (1993). Satisfaction of this requirement stems either from a previous scientific and technical education or substantial scientific and technical work experience.


48 Prior to November 15, 1938, all individuals registered by the PTO (then called the Patent Office) were registered as attorneys, whether they were attorneys or not. See 37 C.F.R. § 10.6 (1993).

49 See Jack Winter, Inc. v. Koratron Co., 50 F.R.D. 225, 228 (N.D. Cal. 1970) ("[The patent attorney] must turn all such factual information over in full to the Patent Office pursuant to 35 U.S.C. § 112, . . . "). This view is construed from the statute’s text that, “the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112 (1988).
The existence of this duty has played a factor in the uncertain relationship between the attorney-client privilege and patent attorneys. This uncertainty stems from cases which held that the duty of candor to the PTO vitiated the attorney-client privilege with regard to patent attorneys.51

The leading case is *Jack Winter Inc. v. Koratron Co.*52 The district court in *Jack Winter* held that "the attorney exercises no discretion as to what portion of this information must be relayed to the Patent Office ... and hence[,] with respect to such material he acts as a conduit between his client and the Patent Office."53 This view, often called the "conduit" theory,54 vitiates the privilege because "a basic element required for the assertion of the attorney-client privilege is absent—that is, a communication not for relay but for the attorney's ears alone."55

While the conduit theory occasionally is raised in pre-trial patent decisions, two flaws inherent in the *Jack Winter* approach have led to its disfavor. First, courts with greater experience in patent application procedures re-examined the conclusion reached in *Jack Winter*. In *Knogo Corp. v. United States*,56 the Court of Claims carefully reviewed the conduit theory and determined that it "rest[ed] upon an oversimplification of the role of the patent attorney during the patent application process."57 By evaluating the actual role of the patent attorney in the application process, the court concluded that "[t]he attorney is not a mere conduit for either the client's communications containing the technical information or the technical information itself. He does not file his client's communications with the Patent Office[,] ... yet this is

50 Duty to disclose information material to patentability, 37 C.F.R. § 1.56 (1993).

51 This approach rests upon the incorrect assumption that all communications made to the attorney must be communicated to the PTO under the duty of candor. Under this assumption, the client has no confidence that his legal communications will remain inviolate and thus, no privilege should attach to the patent attorney-client relationship. See *Union Carbide Corp. v. Dow Chem. Co.*, 619 F. Supp. 1036, 1047 (D. Del. 1985); *Hercules, Inc. v. Exxon Corp.*, 434 F. Supp. 136, 144 (D. Del. 1977); *Jack Winter*, 50 F.R.D. at 225.


53 Id. at 228.


55 *Jack Winter*, 50 F.R.D. at 228 (citing 8 *WIGMORE*, *supra* note 9, § 2311).

56 213 U.S.P.Q. (BNA) 936 (Cl. Cl. 1980).

57 Id. at 941.
the impression one derives from a reading of the \textit{Jack Winter} view.\textsuperscript{58} This recent approach to the privilege, allowing it to co-exist with the duty of disclosure in patent application scenarios,\textsuperscript{59} was best summarized by the \textit{Knogo} court:

A distinction can be made between the duty to disclose how to make and use the invention and the mere funneling of technical information from the client through the attorney to the Patent Office. The former is the job of the patent attorney, while the latter is an inaccurate, and uninformed characterization of the patent attorneys [sic] role in the preparation and prosecution of a patent application.\textsuperscript{60}

Aside from the erroneous characterization underlying the conduit theory, the \textit{Jack Winter} court overlooked an additional argument. While a duty of candor does exist in all dealings with the PTO, a similar duty is imposed upon all attorneys in \textit{ex parte} proceedings, whether patent or otherwise.\textsuperscript{61} Under Rule 3.3 of the American Bar Association Model Rules of Professional Conduct, "[i]n an \textit{ex parte} proceeding, a lawyer shall inform the tribunal of all material facts known to the lawyer which will enable the tribunal to make an informed decision, whether or not the facts are adverse."\textsuperscript{62} Even in situations where "[t]he object of [the] proceeding is nevertheless to yield a substantially just result[,]"\textsuperscript{63} such a duty upon the attorney has no effect upon the existence of an attorney-client privilege. Therefore, in the patent lawyer's world, as well as in the legal community at large, the attorney-client privilege can in fact peacefully co-exist with duties of candor toward decision-making bodies.\textsuperscript{64}

\textsuperscript{58} Id.

\textsuperscript{59} See also FMC Corp. v. Old Dominion Brush Co., 229 U.S.P.Q. (BNA) 150 (W.D. Mo. 1985).

\textsuperscript{60} \textit{Knogo}, 213 U.S.P.Q. (BNA) at 940-41.

\textsuperscript{61} See \textsc{\textit{Model Rules of Professional Conduct}} Rule 3.3 (1984) (entitled Candor Toward the Tribunal). The dealings in an \textit{ex parte} proceeding can be analogized to the patent attorney's dealings with the PTO during a patent application. In applying for a patent, only that applicant's patent attorney details the status of the prior art and distinguishes the proposed invention's scope from this prior art, with no opportunity at that time for potentially interested parties to respond.

\textsuperscript{62} Id.

\textsuperscript{63} \textsc{\textit{Model Rules of Professional Conduct}} Rule 3.3 cmt. (1984).

\textsuperscript{64} One-policy reason behind this coexistence is undoubtedly the privilege's protection of communications and not information, a topic dealt with \textit{infra} Part III.C.
C. The Misdirected Focus on Information

Another factor behind the confusing spectrum of attorney-client privilege patent decisions involves the focus of the privilege—communications. Unfortunately, this focus has often been blurred to include the information communicated in addition to the communications; in some circumstances, the focus has been distorted to include only the information communicated. It is not difficult to envision how this developed. To a layperson uninterested in the rationale behind the doctrine of privilege, the distinction between the information communicated and the communications probably goes unnoticed or seems like an obtuse academic exercise. This blurring is further exacerbated by the fact that the words "communication" and "communications" can have different meanings due to their singular and plural distinction. For instance, the singular "communication" can invoke the definition "the facts or information communicated," whereas the plural "communications" can be read to mean "an interchange of thoughts or opinions." These definitions correspond directly to the attorney-client privilege distinction discussed above; "communication" refers to the unprotected information communicated, and "communications" refers to the relationship protected by the privilege.

The most comprehensive opinion to attempt to clarify the focus of the privilege is In re Ampicillin Antitrust Litigation. In Ampicillin, the court found that "the distinction between the information and the communication [has] not [been] articulated clearly." Due to the policy rationale behind the privilege, the court went on to hold that the attorney-client privilege provides protection only to the communications "and not [to] facts or oth-

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65 See supra text accompanying notes 14-15.
66 WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 460 (1986) [hereinafter WEBSTER'S].
67 Id.
68 This distinction is discussed at length infra Part IV.B.3(b), due to the wording of the United Shoe standard, which altered Wigmore's plural usage of the term to its singular form.
70 Id. at 389.
71 See supra Part II.A.
NOTE—PRIVILEGED ADVICE IN PATENT LITIGATION

er information contained [therein]."72 More recent case law outside of the patent realm has accepted this protection of the communications, and not the information, as the appropriate scope of the attorney-client privilege.73

This misdirected focus on the information behind the communications, whether intentional or unintentional, has yielded varying results regarding the applicability of the attorney-client privilege. In patent cases, the focus on information tends to have more dramatic results than in other areas of the law due to the peculiar nature of the information behind patent related legal communications. Two of these peculiarities have caused difficulty in ascertaining the scope of the attorney-client privilege: communications containing technical information and communications containing public information.

1. Technical Information

While it is clear that the attorney-client privilege applies only to communications of legal advice between an attorney and client,74 definitions of what constitutes legal advice have on occasion omitted the work performed by patent attorneys.75 This exclusive definition of legal advice, and the accompanying exclusion from the attorney-client privilege’s protection, was partially due to the

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72 *Ampicillin*, 81 F.R.D. at 389. Under the doctrine of privilege, the facts communicated in a privileged relationship continue to be accessible to examination. "Although neither [party to the communication] may be questioned directly regarding the privileged communication per se, the [party revealing the information in the communication] may always be questioned on the facts behind the communication." *Id.* at 391 n.23 (citing 2 *JACK B. WEINSTEIN & MARGARET A. BERGER, WEINSTEIN’S EVIDENCE*, §§ 503(a)(4)-(b)(3) (1975)).

A good example of this *Ampicillin* scenario was given by the *Knogo* court: "[i]n other words, the client cannot assert the privilege if asked how the invention works; but he can assert the privilege if he is asked to recount what he told his attorney concerning how the invention works." *Knogo Corp. v. United States*, 213 U.S.P.Q. (BNA) 936, 941 (Ct. Cl. 1980).

73 See *In re 6 Grand Jury Witnesses*, 979 F.2d 939 (2d Cir. 1992); *United States v. Sayan*, 968 F.2d 55, 64 (D.C. Cir. 1992) ("Thus information other than "communications" . . . are unprotected." (citing In re Sealed Case, 676 F.2d 795, 808-09 (D.C. Cir. 1982))); see also Elizabeth G. Thornburg, *Sanctifying Secrecy: The Mythology of the Corporate Attorney-Client Privilege*, 69 *NOTRE DAME L. REV.* 157, 171-72 (1993) ("Remember that the attorney-client privilege does not (at least in theory) protect the litigant from supplying relevant facts to its opponent; the privilege protects only the communication and not the underlying information.").

74 See *supra* text accompanying notes 22 & 28 (federal standards for the attorney-client privilege).

75 See *supra* Part III.A.
technical nature of the patent attorney’s work product.

Due to the technical material included in most, if not all, patent prosecution related communications, courts have previously misapplied the attorney-client privilege by focusing on the presence of this technical information rather than concentrating on the relationship between the attorney and client. Under the guise of treating patent related legal advice as purely business or technical advice, courts have held that “[c]ommunications dealing . . . with the technical engineering aspects of patent prosecution or with other matters which may as easily be handled by laymen are not privileged.”

Conversely, some courts have held that the presence of technical information does not destroy the privilege’s protection. In Chore-Time Equipment Inc. v. Big Dutchman Inc., the court, while not disavowing its inappropriate concern with the information communicated, granted the privilege to such technical communications. Demonstrating an understanding of the dual role of the patent attorney, Chore-Time held that “[w]here a lawyer possesses multifarious talents, his clients should not be deprived of the attorney-client privilege, where applicable, simply because their correspondence is also concerned with highly technical matters.”

The debate over whether the presence of technical information destroys the privilege’s protection continues today. If a trend exists in patent law, however, it points toward applying the privilege to such technically oriented communications.

2. Public Information

Some courts, erroneously focusing on the information behind attorney-client communications, some courts have also used a public information rationale to refuse to apply the privilege to patent related legal communications. This approach hinges the privilege’s protection upon the confidentiality or public availability

78 See infra Part III.B.
of the information communicated. The public information rationale seems to have tenuously developed from the wording of the privilege, which requires that the client believe that his discussions with the attorney will be kept confidential for the privilege's protection to apply. However, due to subsequent paraphrasing and misinterpretation, this requirement has been recruited by advocates of this rationale to eliminate communications involving publicly available information from the scope of the attorney-client privilege.

The court in *Congoleum Industries Inc. v. G A F Corp.*, building upon the foundation provided by *United Shoe* and *Zenith*, held that documents containing legal advice which made reference to public information "as opposed to legal advice based upon confidential information [were] for this reason . . . without the asserted privilege." Following the *Congoleum* approach, the court in *Community Savings & Loan Ass'n v. Federal Home Loan Bank Board* went a step further and ruled that the privilege did not extend to correspondence containing advice based upon public information rather than confidential information. Since the communication in *Community Savings & Loan* "consisted almost entirely of material which was in the public record[,]" the court held that no protection from the attorney-client privilege applied to the attorney's opinions based upon this information. This "publicly available information" exclusion operates to deny the privilege's protection to legal opinions from the patent attorney to his client based upon the prior art.

Similar to the duty of candor approach, the public information rationale has been used to deny the attorney-client privilege to communications related to patent prosecution. This stems from the fact that, under the conduit theory, any information disclosed to the patent attorney during the patent application process is assumed to become part of the public record when the patent issues. Assuming *arguendo* that this theory was true, recent pat-

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82 *Congoleum*, 49 F.R.D. at 86.
84 Id. at 382.
85 Id.
86 In patent law, the term "prior art" refers to any relevant knowledge, acts, descriptions and patents which pertain to, but predate, the invention in question. See BLACK'S LAW DICTIONARY 1193 (6th ed. 1990).
87 But see supra Part II.B.
ent opinions have rebuked the concept that the eventual public disclosure at the patent's issuance should vitiate the privilege. In Knogo, which dealt with a combination of patent factors, the court held that "[t]he fact that much of the technical information in one form or another finds its way into the patent application, to be made public when the patent issues, should not preclude the assertion of the privilege over the communication in which that information was disclosed to the attorney." While this facet of the public information rationale appears more settled than the facet dealing with patent attorney's opinions based upon information within the public domain, both situations must be considered in light of the policy interests underlying the entire doctrine of privilege. While these two types of information tend to cause confusion in the application of the privilege, they are in fact irrelevant under a proper analysis of the attorney-client privilege; the scope of the attorney-client privilege protects the communications between the attorney and client—not the information within those communications.

IV. RELOCATING THE BI-DIRECTIONAL APPROACH WITHIN THE CURRENT ATTORNEY-CLIENT PRIVILEGE STANDARDS

Striving to bring the present application of the attorney-client privilege in line with the policy rationales underlying its existence, this Note advocates a bi-directional application of the privilege. First, this Note demonstrates that current standards of the attorney-client privilege support such an interpretation. This support can be found through a detailed historical and linguistic analysis of each standard.

A. A New Look at the Wigmore Standard

Understanding the context surrounding the Wigmore standard is crucial to its re-evaluation. Before enunciating his relationship-specific privilege standards, Dean Wigmore discussed

88 The Knogo court dealt with the duty of candor, technical information, and the publicly available information factors in trying to clarify this area of the law.
90 See supra Part II.A.
91 This context exists in 4 WIGMORE, supra note 21, pt. III, tit. II, subit. III (subtitle on Testimonial Privilege).
92 Examples of these relationship-specific privileges are the spousal privilege and the attorney-client privilege. See supra note 9.
the broader topic of “Confidential Communications in General”\textsuperscript{93} in his 1904 treatise \textit{Evidence in Trials at Common Law}.\textsuperscript{94} Looking at the principle of privilege “as an exception to the general liability of every person to give testimony to all facts inquired of in a court of justice,”\textsuperscript{95} Wigmore ascertained “four fundamental conditions . . . as necessary to the establishment of a privilege against the disclosure of communications between persons standing in a given relation.”\textsuperscript{96} These four fundamental conditions, valuable context to any examination of a Wigmore relationship-based privilege,\textsuperscript{97} are:

(1) The communications must originate in \textit{confidence} that they will not be disclosed;

(2) This element of \textit{confidentiality must be essential} to the full and satisfactory maintenance of the relation between the parties;

(3) The \textit{relation} must be one which in the opinion of the community ought to be sedulously \textit{fostered};

(4) The \textit{injury} that would inure to the relation by the disclosure of the communications must be \textit{greater than the benefit} thereby gained for the correct disposal of litigation.\textsuperscript{98}

Only the first requirement relates directly to the communications between the parties. The emphasis of this condition, evident from Wigmore’s typeface selection, is the “\textit{confidence} that [these communications] will not be disclosed.”\textsuperscript{99} Hence, with regard to the actual communications, the parties must only have the intent to keep such communications in confidence for the general doctrine of privileged communications to apply.\textsuperscript{100} This context,
placing import upon the confidence behind the communications, as well as the policy behind the attorney-client privilege, \(^{101}\) must be considered in re-evaluating the Wigmore standard.

When re-examining his relationship-specific attorney-client privilege, Wigmore's chosen phrasing and punctuation requires careful analysis to ascertain its original intent. To facilitate this careful examination, consider the identical text of the Wigmore standard\(^ {102}\) in the following format:

1. Where legal advice of any kind is sought from a professional legal adviser in his capacity as such,
2. the communications relating to that purpose,
3. made in confidence by the client,
4. are at his instance permanently protected from disclosure by himself or by the legal adviser,
5. except the protection be waived.\(^ {103}\)

The above format, emphasizing Wigmore's chosen phrasing, demonstrates that the Wigmore standard hinges on five, not eight, distinct factors.

Note that only the third factor intrudes into the sphere of the communications themselves.\(^ {104}\) The third phrase—"made in confi-
dence by the client,”—can be read in two ways: One seriously altering the privilege as it stood at the time of Wigmore’s writing, the other accurately interpreting the phrase in a manner consistent with the remainder of Wigmore’s privilege chapter as well as the legal precedent prior to the standard’s publication.105

The first reading, which is inconsistent with Wigmore’s phrasing, proffers that this third phrase actually consists of two phrases, or two prongs. These prongs—“made in confidence” and “by the client”—would therefore both relate back and attach to the word “communications” in the second phrase of the standard. Under this interpretation, the privilege applies only to communications made in confidence, and narrowing the scope of the privilege further, to only the portion of those “communications made in confidence” which were made by the client to the attorney. This is an incorrect reading of the Wigmore standard’s language. From a linguistic viewpoint, this interpretation lacks clear support, as evidenced by Wigmore’s chosen punctuation. Specifically, a comma between the phrases “made in confidence” and “by the client” would be necessary for this interpretation to be valid. The pres-

mandates that the communications be tied into the legal advisory relationship of the previous phrase.

The fourth factor lays bare what effect the privilege has upon the requisite relationship. The words “at his instance” refer to the client having the sole right to exercise the privilege, a hornbook constant which is not refuted in any way by this interpretive study. See Hunt v. Blackburn, 128 U.S. 464, 470 (1888) (“[T]he [right to assert the] privilege is that of the client alone, and no rule prohibits the [client] from divulging his own secrets . . . .”). The remainder of this phrase reinforces that once the client opts for the privilege to apply, neither the client nor the attorney can be compelled to disclose their communications as evidence.

Lastly, the fifth factor places a slight exception on the general definition, specifically that the privilege will apply “except [where] the privilege [has been] waived.” This term has come to mean that either explicit or implicit waiver will vitiate the privilege, and in most reported cases, such a waiver is actually inadvertent. See James M. Grippando, Attorney-Client Privilege: Implied Waiver Through Inadvertent Disclosure of Documents, 39 U. MIAMI L. REV. 511 (1985); see generally, 8 WIGMORE, supra note 9, §§ 2327-29; Harman, supra note 14.

105 See Root v. Wright, 84 N.Y. 72, 76 (1881) (The privilege “extends to communications in reference to all matters which are the proper subject of professional employment.”); Jenkinson v. Andrews, 5 Blackf. 465 (1840) (information given by attorney to client held privileged); Hughes v. Biddulph, 4 Russ. 190 (1827); Annesley v. Earl of Anglesea, 77 How. St. Tr. 1225 (1749); 4 WIGMORE, supra note 21, § 2320; Anon. (“C.”), reprinted in THE LAW MAGAZINE, xvii, 68 (1837) (“Through skilled attorneys] every man’s case is brought with nearly equal ability and chance of success . . . [and] [s]uch equality never can exist, unless client and attorney are completely identified, and their communications held to be impervious to judicial investigation, as if they never had been uttered.”).
ence of a comma in that location would make the phrase "made in confidence" an appositive. 106 Both the appositive, "made in confidence," and the subsequent phrase "by the client" would refer to the "communications." However, without a comma between "made in confidence" and "by the client," 107 no appositive is created and, therefore, the two pronged reading is invalid. 108

Wigmore's punctuation and other external evidence 109 seems to have intended the alternative reading. It requires only that the client regard the "communications" of the second phrase as confidential—in both directions—from the client to the attorney and from the attorney to the client. This reading applies the phrase "made in confidence" to the "communications" and the phrase "by the client" to the aforementioned confidence requirement. Such an interpretation, consistent with Wigmore's phrasing 110 and the policy of encouraging full and frank communications between attorney and client, 111 would protect communications between attorney and client in both directions, so long as their communications were believed to be confidential by the client.

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106 An appositive is a grammatical apposition. An apposition is "a grammatical construction that consists of two nouns or noun equivalents referring to the same person or thing standing in the same syntactical relation to the rest of the sentence without being joined to each other by a coordinating conjunction, and typically adjacent to each other." WEBSTER'S, supra note 66, at 105.

107 Had Wigmore placed a conjunction at this location, for example — "and," the same effect of making this third phrase two-pronged would have resulted.

108 See Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968). In Natta, the Tenth Circuit explicitly dealt with the question of what portion of the standard the "by the client" phrase applied to, determining that [Appellant's] reliance on [the numbering present in the Wigmore standard in Evidence in Trials at Common Law] is misplaced. Reference is there made to communications "by the client." In the discussion which follows, Wigmore makes it clear that the reference is to differentiate between communications made by the client and those made by a third person.

109 See 4 WIGMORE, supra note 21, § 2320; see also supra note 105.

110 See supra text accompanying notes 103 & 108.

111 See supra Part II.A.
In addition to this interpretation's linguistic support, it is undeniable from a historical perspective that the privilege was bi-directional when first published in 1904. During his discussion of the words "by the client," Wigmore devotes an entire section of his commentary to privileged communications from attorney to client, concluding that the fact "that the attorney's communications to the client are also within the privilege was always assumed in the earlier cases and has seldom been brought into question."

While this strict emphasis on original phrasing may seem overly academic, Wigmore himself realized and was concerned about the difficulty in drafting a standard which would be read uniformly. In the sentence immediately preceding his general definition of the attorney-client privilege, Wigmore arguably sets forth a caveat against misapplication of the privilege. Specifically, Wigmore wrote, "the phrasing of the general principle so as to represent all its essentials, but only essentials, and to group them in a natural sequence is a matter of some difficulty." Hence, from his terminology to his punctuation, Wigmore didn't arrange these essentials of the attorney-client privilege whimsically or in haste, but in a careful and considered manner.

Therefore, Wigmore's chosen wording of the attorney-client privilege standard, currently relied upon in five circuits, reveals that Wigmore's standard applied in a bi-directional manner to protect both sides of the attorney-client communicative relationship. Arguably, courts should apply Wigmore's standard in such a manner consistent with its original intent and the policy behind the privilege it was put forth to represent.

B. Reconsidering the Foundation and True Meaning Behind the United Shoe Standard

For reasons not immediately apparent, Judge Wyzanski set forth a new standard of the attorney-client privilege in his United

112 See 4 WIGMORE, supra note 21, § 2320.
113 8 WIGMORE, supra note 9, § 2320, at 628. This section in the 1961 McNaughton revision cites only three cases questioning the bi-directionality of the privilege, each only partially contradicting Wigmore's statement. Id. at 628 n.2; 8 JOHN HENRY WIGMORE, EVIDENCE IN TRIALS AT COMMON LAW § 2920, at 185 (McNaughton rev. ed. 1991 Supp.). Unfortunately, Wigmore himself was never required to expand upon his statements in § 2320, as no case directly conflicted with his bi-directional approach until seven years after his death, when Judge Wyzanski put forth his United Shoe opinion.
114 4 WIGMORE, supra note 21, § 2292, at 3204 (emphasis added).
115 See supra note 23.
Shoe opinion. One might assume that these "main qualifications which are necessary," when presented with such a formal and analytical approach to the age-old privilege, were gleaned directly and accurately from either legal precedent or accepted learned treatises. However, a closer examination of Judge Wyzanski's opinion reveals that he paraphrased a previous standard with his own wording. His paraphrasing moreover permitted ambiguous interpretation by later courts contrary to the intended scope of the privilege at the time of United Shoe.

1. The United Shoe Standard's Dearth of Precedential Case Law Sources

Prior to introducing his standard for the attorney-client privilege, Judge Wyzanski explained the policy considerations behind the privilege. This explanation cited two cases which dealt with aspects of the attorney-client privilege tangentially related to the issues in United Shoe. These cases represent the only case law relied upon in creating the United Shoe standard.

The first case was Hunt v. Blackburn, an 1888 United States Supreme Court case. Its only relationship to the attorney-client privilege was the defendant's last chance attempt to salvage her case. The defendant, argued that her counsel deceived and

116 This newer standard of the attorney-client privilege, put forth by Judge Wyzanski in United Shoe reads as follows:

The [attorney-client] privilege applies only if (1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication was made (a) is a member of the bar of a court, or his subordinate and (b) in connection with this communication is acting as a lawyer; (3) the communication relates to a fact of which the attorney was informed (a) by his client (b) without the presence of strangers (c) for the purpose of securing primarily either (i) an opinion on law or (ii) legal services or (iii) assistance in some legal proceeding, and not (d) for the purpose of committing a crime or tort; and (4) the privilege has been (a) claimed and (b) not waived by the client.


117 United Shoe, 89 F. Supp. at 358 (Judge Wyzanski used the sentence, "[I]t will be enough now to note in general, and later to apply in detail, the main qualifications which are necessary[,]" as a segue to setting forth his standard of the privilege.).

118 See supra Part II.A.

119 This analysis of the United Shoe attorney-client privilege standard makes the assumption that if Judge Wyzanski had relied directly or even substantially upon prior case law or any other published source in arranging his standard, he would have cited to the appropriate sources.

120 128 U.S. 464 (1888).

121 Id. at 470.
misadvised her, she was ignorant of her rights, and therefore she should not have been held to the outcomes of previous adjudications. The attorney-client privilege was implicated by her additional claim “that her attorney, on the ground of privileged communications, should not be permitted to defend himself by testifying to the facts and circumstances under which he advised her and the advice which he actually gave.” The Court, denying this attempt by the defendant to avoid an implied waiver of the privilege, issued the following policy rationale behind the attorney-client privilege:

The rule which places the seal of secrecy upon communications necessary between client and attorney is founded upon the necessity, in the interest and administration of justice, of the aid of persons having knowledge of the law and skilled in its practice, which assistance can only be safely and readily availed of when free from the consequences or the apprehension of disclosure.

While this is an accurate policy statement—both in 1888 and today—Wyzanski’s limited reliance on Hunt in his introductory statement that “[the attorney-client privilege] is founded upon the belief that it is necessary ‘in the interest and administration of justice’” lends no authority to his formalistic standard which followed.

Judge Wyzanski’s only other citation in support of his privilege standard was People’s Bank v. Brown, a Third Circuit case which was nearly half a century old at the time of United Shoe. Wyzanski paraphrased a very small portion of the opin-

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122 Id.
123 Id.
124 Id. at 470-71 (“[T]he [right to assert the attorney-client] privilege is that of the client alone, and no rule prohibits the latter from divulging [her] own secrets; and if the client has voluntarily waived the privilege, it cannot be insisted on to close the mouth of the attorney. When Mrs. Blackburn entered upon a line of defence which involved what transpired between herself and [her attorney], and respecting what she testified, she waived her right to object to his giving his own account of the matter.”); see also Grippando, supra note 104.
125 Hunt, 128 U.S. at 470.
127 112 F. 652 (3d Cir. 1902).
ion—which it only related to how, not where or when, to apply the privilege—stating that "the privilege should be strictly construed in accordance with its object." While Wyzanski once again cites to an accurate policy statement regarding the privilege, it does not support the formal standard he created.

2. The Influence of Dean Wigmore on the United Shoe Standard

Since Wyzanski did not cite to any authority to derive his standard, the next step in analyzing the merit of the United Shoe standard is to ascertain other possible uncited influences behind Judge Wyzanski's terminology.

Chronologically, it is likely that Wigmore's standard played some part in the formulation of Judge Wyzanski's United Shoe standard. For instance, other district courts had already begun citing to the Wigmore standard as the well-settled rule in this area.

128 While certainly not the linchpin of this Note's support of the bi-directional attorney-client privilege, it is an interesting aside to consider the portion of the People's Bank's discussion of the privilege left unmentioned by Judge Wyzanski. It is difficult to believe that Judge Wyzanski could have intended his standard to be truly one-directional where the first sentence of the privilege discussion in People's Bank — the most recent decision cited by Wyzanski in relation to the foundation of his standard — put forth that:

This court has neither the authority nor inclination to repudiate the rule which protects from exposure, unless with the client's consent, all communications between him and his counsel, made during the subsistence of that relation, in reference to any matter respecting what the latter has been, and properly could be, professionally consulted.

Id. at 654 (emphasis added). This terminology, like almost all such relied upon pre-United Shoe, echoes Wigmore's study that the privilege applies to the interaction between both parties to the relationship, not merely the traffic of words leaving the client's lips destined for the attorney's ears.

129 United Shoe, 89 F. Supp. at 358 (citing People's Bank, 112 F. at 652 (discussing the necessity of balancing the value of the privileged relationship with the consequences of the resulting suppression of evidence)).

130 Wigmore also realized the necessity of applying the attorney-client privilege in a careful manner. His commentary immediately preceding his general definition of the standard reads, "[the privilege] ought to be strictly confined within the narrowest possible limits consistent with the logic of its principle." 8 WIGMORE, supra note 9, § 2291, at 554.

131 As a safety mechanism underlying the assumption of accurate citation by Judge Wyzanski (see supra note 119), an on-line search (LEXIS, MEGA library) of all United States case law prior to March 10, 1950 (the date of the United Shoe opinion) was undertaken to search for any occurrences of the particular terminology used in the United Shoe standard, either in whole or in part. No substantially similar wording (nor meaning similar to the one-directional reading, for that sake) was ever found.

132 Forty-six years, as well as twelve editions of Evidence in Trials at Common Law, separate Wigmore's standard from the United Shoe holding chronologically.
prior to the time of the United Shoe holding.\textsuperscript{133} In fact, Judge Wyzanski's very own district court had relied on Wigmore's treatise in deciding a question of attorney-client privilege within three years of the decision in United Shoe.\textsuperscript{134} Despite Dean Wigmore's influence in the field of evidence throughout the legal community in 1950, the most convincing evidence that Judge Wyzanski was influenced by Wigmore's approach lies within the United Shoe opinions of March 10, 1950 themselves.\textsuperscript{135}

The first of these opinions,\textsuperscript{136} also resolving a document dispute,\textsuperscript{137} pertained to statements of individual employees as extra-judicial admissions attributable to the corporation under the regular business entry statute.\textsuperscript{138} Judge Wyzanski, resolving this evidentiary dispute, looked for advice to Dean Wigmore's treatise on three occasions where no case law supporting his position existed within the First Circuit.\textsuperscript{139}

The second of the United Shoe opinions handed down that day by Judge Wyzanski, and certainly the more notorious decision of the two, set forth the aforementioned United Shoe standard for the first time.\textsuperscript{140} Aside from enunciating his newly devised standard, Judge Wyzanski also resolved several issues in this pre-trial discovery dispute, one of which was whether information disclosed by a person outside of the defendant's organization could be privileged.\textsuperscript{141} In ascertaining that, "for example, there is no privilege for so much of a lawyer's letter, report or opinion as [it] relates to a fact gleaned from a witness,"\textsuperscript{142} Judge Wyzanski cited directly to Wigmore's commentary to the Wigmore standard. To further bolster this example, Wyzanski recommended a perusal of Wigmore's Evidence in Trials at Common Law, revealing his defer-
ence on evidentiary issues to the scholarship of Dean Wigmore.\textsuperscript{143}

3. The True Meaning of the United Shoe Standard

Combining the lack of explicit citations in United Shoe to any previous standard,\textsuperscript{144} the unsuccessful search for any substantially similar, yet uncited, case law,\textsuperscript{145} and Judge Wyzanski's certain knowledge of the Wigmore standard,\textsuperscript{146} it becomes evident that in enunciating his United Shoe standard, Judge Wyzanski intended to expand upon the Wigmore language by adding further precision to the then-prevailing attorney-client privilege standard.\textsuperscript{147} A direct comparison of the United Shoe language and the Wigmore standard will illustrate their differences.\textsuperscript{148} This will first address direct carryovers of the Wigmore language into the United Shoe standard. Once that has eliminated a large portion of the United Shoe language from our scrutiny, the remaining language will disclose Judge Wyzanski's divergences in terminology from the Wigmore standard. It is through an examination of these divergences in terminology that the exact scope of the United Shoe standard will become clear.

(a) Terminology common to both the United Shoe and Wigmore standards.—Much of Judge Wyzanski's language in the United Shoe standard is substantially similar to that of Dean Wigmore. Comparing these "equal" phrases of the two standards does little

\textsuperscript{143} United Shoe, 89 F. Supp. at 359 (citing 4 Wigmore, supra note 139, § 2317).

This citation to section 2317 is convincing evidence of Judge Wyzanski's awareness and knowledge of the Wigmore standard of attorney-client privilege at the time of his penning the United Shoe standard, as that section is part of Wigmore's Chapter 82, entitled "Communications Between Attorney and Client." More explicitly, section 2317 deals with certain situations pertaining to the "by the client" phrase of the actual Wigmore standard previously enunciated. See supra notes 104-13 and accompanying text.

\textsuperscript{144} See supra Part IV.B.1.

\textsuperscript{145} See supra note 131.

\textsuperscript{146} See supra Part IV.B.2.

\textsuperscript{147} The only other possibility is that Judge Wyzanski actually intended to dramatically alter the scope of the attorney-client privilege by defining it in a one-directional manner. Such a definition would have been contrary to the policy supporting the mere existence of an attorney-client privilege (see supra Part II.A.) and therefore would have been not only inappropriate, but incorrect as well.

\textsuperscript{148} In attempting this comparison, it may be helpful to view the terminology of either standard in its entirety at some point. See supra text accompanying notes 22 & 28 (Wigmore standard and United Shoe standard respectively).
to clarify the scope of the *United Shoe* standard with regard to the Wigmore standard. Therefore, while these "equal" phrases will not be omitted from the comparison of the standards, they will merely be presented side-by-side in the following piecemeal comparison.\(^{149}\)

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<thead>
<tr>
<th>Wigmore(^{150})</th>
<th>United Shoe(^{151})</th>
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\(^{149}\) This piecemeal comparison of the two standards is presented in the order of the five-factor Wigmore standard (developed *supra* Part IV.A.). Most of these paired phrases are substantially similar in meaning so as to require no additional commentary. However, slight divergences are dealt with through additional footnoting and large divergences from the Wigmore terminology are evidenced by the notation ‘[see discussion below]’ and dealt with *infra* Part IV.B.3(b). Additionally, Part IV.B.3(b) will discuss any terminological additions to the Wigmore standard by Judge Wyzanski; such additions are omitted from the following comparison in order to maintain its continuity, as they have no “partner” in the Wigmore terminology.

\(^{150}\) The parenthetical numbers preceding Wigmore’s phrases are taken from the five-factor standard developed and explained in detail previously. *See supra* text accompanying note 103.

\(^{151}\) The parenthetical numbers preceding Judge Wyzanski’s phrasing are taken directly from his *United Shoe* opinion. *See supra* text accompanying note 28.

\(^{152}\) The addition of the phrase “or his subordinate” by Judge Wyzanski does not effect a difference between the standards. While not explicitly mentioned in Wigmore’s standard, his extensive commentary following the standard deals with this situation in a section entitled, “Communication to an Agent of the Attorney.” Wigmore wrote: “It has never been questioned that the privilege protects communications to the attorney’s clerks and his other agents (including stenographers) for rendering his services.” 4 *WIGMORE, supra* note 21, § 2301, at 583.
(2) the communications relating to that purpose ... (3) the communication relates to a fact of which the attorney was informed ...
[see discussion below]

(3) made in confidence by the client, ... (3) ... (a) by his client (b) without the presence of strangers ...
[see discussion below]

(4) are at his instance permanently protected from disclosure by himself or by the legal adviser, ...

(4) the privilege has been (a) claimed ...

(5) except the protection be waived. (4) ... and (b) not waived by the client.

This comparison of the two attorney-client privilege standards demonstrates that any distinctions drawn between the United Shoe and Wigmore standards' scope are based upon slight terminological differences. With these "equal" phrases removed from further analysis, comparison of the two standards can focus upon these possible terminological "contradictions" between the United Shoe standard and its predecessor, the Wigmore standard.

(b) Terminological "contradictions" between the United Shoe and Wigmore standards.—In comparing the language behind the United Shoe and Wigmore attorney-client privilege standards, four phrases from the United Shoe language seem to contradict the language chosen by Wigmore to represent the essentials153 of the privilege. Two of these phrases are additions to the terminology chosen by Wigmore, direct attempts by Judge Wyzanski to increase the specificity of the existing privilege standard. The other two are "contradictory" phrases154—slight differences between the chosen language of Judge Wyzanski and Dean Wigmore—and are ambiguous enough to have caused the uncertainty relating to the directionality of the United Shoe standard. Both these additional

153 See supra note 114 and accompanying text.
154 See text accompanying note 151. These two "contradictory" phrases are identified by the "[see discussion below]" notation in the previous piecemeal comparison of the United Shoe and Wigmore standards. See supra Part IV.B.3(a).
and "contradictory" phrases, when discussed in the context of the Wigmore standard, reveal Judge Wyzanski's intent to restate the attorney-client privilege in a manner consistent with both the underlying policy behind the privilege and the prevailing Wigmore standard of the time.

The first of Judge Wyzanski's additions to the specificity of the Wigmore standard is the introduction and first clause of the United Shoe standard, which states that "[t]he privilege applies only if (1) the asserted holder of the privilege is or sought to become a client; . . . ." While from the text of the Wigmore standard alone this principle is not apparent, its presence in the United Shoe standard causes no disparity among the application of the standards. With regard to situations where the "holder of the privilege is . . . a client," it is clear that Wigmore's standard applies: Not only are the client's confidence and the client's request for protection from disclosure required for the privilege to apply, but one would be hard pressed to define anyone seeking legal advice "from a professional legal adviser in his capacity as such" as anything but a client. The other half of this first United Shoe phrase, stating that "the privilege applies . . . if the asserted holder . . . sought to become a client," is also clearly within the domain of Wigmore's definition of the attorney-client privilege. While at first glance both Wigmore's and Wyzanski's use of the term "sought" could mislead one seeking to harmonize the standards, the harmony instead lies within Wigmore's extensive commentary to his standard. Judge Wyzanski's inclusion of potential clients within the privilege's protection was always implicit in the Wigmore standard, though not necessarily apparent on its face. Wigmore's commentary in the section entitled "Time of con-

155 See supra text accompanying note 28 (introduction and first phrase of the United Shoe standard).
156 This is the first possible scenario under the first United Shoe phrase. See supra text accompanying note 28.
157 See supra notes 99-100, 103-04 and accompanying text (third Wigmore phrase).
158 See supra note 103 and accompanying text (fourth Wigmore phrase).
159 See generally supra note 103 and accompanying text (first Wigmore phrase).
160 This is the second possible scenario under the first United Shoe phrase. See supra text accompanying note 28.
161 While both standards employ the term "sought" in their first phrase, the meanings are entirely different. Wigmore's use requires the client to have "sought" legal advice (Wyzanski opted for the term "securing" legal advice), while Judge Wyzanski's use exhibits the rule that those persons who "sought to become" clients, but in actuality did not receive representation, can still avail themselves of the privilege's protection.
sultation; Rejection of retainer by attorney,"\(^{162}\) posits that "[a]n interesting question, however, arises when the communication is made *pending negotiations for the retainer.*"\(^{163}\) Wigmore's assessment of this situation is exactly as Judge Wyzanski would later include in the *United Shoe* standard, that "[h]ere it would seem plain by the reason of the privilege, that, since the would-be client cannot certainly predict the attorney's acceptance of the employment, the former must be protected in his preliminary statements when making the overtures, even if the overture is refused."\(^{164}\) Therefore, Judge Wyzanski's addition of the phrase "the privilege applies only if (1) the asserted holder of the privilege is or sought to become a client,"\(^{165}\) taking into account Wigmore's phrasing within his standard and commentary, while a meritorious addition from a thoroughness standpoint, has no effect on any attempt to distinguish the scope of the two standards.

The second of these additions to the Wigmore standard exists in section (d) of the third *United Shoe* clause, which requires that the communication was "not (d) for the purpose of committing a crime or tort; . . . ."\(^{166}\) Once again, the Wigmore standard, while seemingly remiss on its face, encompasses this facet of the privilege as well. In Wigmore's commentary dealing with the first clause of his attorney-client privilege standard, Wigmore devoted two sections to this issue, the first entitled "Advice in a criminal or fraudulent transaction."\(^{167}\) In this discussion Wigmore wrote, "[i]t has been agreed from the beginning that the privilege cannot avail to protect the client in concerting with the attorney a *crime* or other evil enterprise."\(^{168}\) In setting forth this already well-founded condition of the privilege, Wigmore detailed the policy of such a crime/fraud exception, specifically that "logically . . . no such enterprise falls within the just scope of the relation between legal adviser and client."\(^{169}\) The remainder of Wigmore's commentary on this exception indicates a concern over how to define

\(^{162}\) 4 WIGMORE, *supra* note 21, § 2304.

\(^{163}\) 4 *id.* at 587.

\(^{164}\) *Id.*

\(^{165}\) See *supra* text accompanying note 28 (introduction and first phrase of the *United Shoe* standard).

\(^{166}\) See *supra* text accompanying note 28 (requirement of section (d) of the third phrase of the *United Shoe* standard).

\(^{167}\) 8 WIGMORE, *supra* note 9, § 2298.

\(^{168}\) 8 *id.* at 572.

\(^{169}\) 8 *id.*; cf. *supra* notes 14-18, 98 and accompanying text (relating to the policy behind the attorney-client privileged relationship).
the boundaries of this limitation.\textsuperscript{170} Perhaps Wigmore's difficulty in ascertaining the appropriate scope of such an exception to the privilege was in fact the impetus behind its omission from his standard. Nevertheless, its explicit addition through the \textit{United Shoe} standard did very little to alter the status of the privilege from the Wigmore standard.

As demonstrated in this comparison of the \textit{United Shoe} and Wigmore standards' terminology,\textsuperscript{171} two of Judge Wyzanski's phrases appear "contradictory" to the language chosen by Dean Wigmore. While these \textit{United Shoe} phrases relate to different requirements of the standard, they in effect bring about only one possible difference between the \textit{United Shoe} standard and the Wigmore standard. Unfortunately, however, this one divergence from the Wigmore standard has had a drastic and haphazard effect upon the jurisprudence of the attorney-client privilege post-\textit{United Shoe}. The \textit{United Shoe} terminology, specifically in these "contradictory" phrases, selected by Wyzanski left the scope of the privilege open to ambiguity and possible application in either a one-directional or bi-directional manner.

By separating the legal advice requirement from the professional legal adviser requirement in the \textit{United Shoe} standard,\textsuperscript{172} additional terminology was required to identify the party to whom the \textit{United Shoe} requirements in section (2)(a) and (2)(b)\textsuperscript{173} apply.\textsuperscript{174} In addressing this party to the privilege, Judge Wyzanski chose the wording "(2) the person to whom the communication was made," which on its surface can be seen to identify the party

\textsuperscript{170} Wigmore, considering the very fundamentals of the privilege and its presupposition of requiring the attorney to furnish legal advice to not only the worthy client, but the culpable client as well, posits the question "[h]ow, then, can the privilege continue to exist at all if any exception is to be made by which the confidences of the guilty are to be disclosed?" \textit{8} WIGMORE, \textit{supra} note 9, at 572. Apparently, the scope of this exception to the privilege posed a dilemma to Wigmore and, after further analysis deducing there must exist such an exception, he still found it "difficult to see how any moral line can properly be drawn at that crude boundary [of crime and civil fraud.]" \textit{8} id. at 577.

\textsuperscript{171} As highlighted by the notations [see discussion below] in Part II.C.3(a), the language of sections (2)(a) and (3)(a)-(b) of the \textit{United Shoe} standard conflict with the terminology of the Wigmore standard. \textit{See supra} text accompanying notes 150-51.

\textsuperscript{172} \textit{Contra supra} text accompanying note 103 (the Wigmore standard simultaneously handles these requirements in its first phrase).

\textsuperscript{173} \textit{United Shoe} sections (2)(a) and (2)(b) mandate that this party "(a) is a member of the bar of a court, or his subordinate and (b) in connection with this communication is acting as a lawyer, . . . ." \textit{See supra} text accompanying notes 28 & 151.

\textsuperscript{174} This party identification terminology is located at the beginning of section (2), but preceding the start of subsection (a) of that section. \textit{Id}. 

in communication with the client, or the attorney. However, Wyzanski's "to whom" terminology connotates a privileged flow only in the direction "to" the attorney, whereas Wigmore's reference to the "communications" of the attorney-client relationship indicates no such directional distinction. While this use of the words "to whom" in the United Shoe standard contributes to the standard's ambiguous directionality, Judge Wyzanski's third phrase in the standard has an even greater impact on that aspect of the standard's interpretation.

The greatest of these "contradictions" lies at the center of each standard and, as do many differences in interpretation do, owes itself to slight yet critical alterations of specific language.\textsuperscript{175} Dean Wigmore's second and third phrases read, "(2) the communications relating to that purpose, (3) made in confidence by the client, . . . ." In comparison, subsections (a) and (b) of the third United Shoe phrase read, "(3) the communication relates to a fact of which the attorney was informed (a) by his client (b) without the presence of strangers . . . ." Once again, some readers of these two excerpts might consider them identical in nature and purpose; unfortunately, distinctions in their wording create a disparity regarding the United Shoe standard's application.

Under United Shoe's terminology, the confidence of the client in the attorney-client relationship may no longer be important, an interpretation directly in conflict with both the Wigmore standard\textsuperscript{176} and the policy underlying the existence of the privilege.\textsuperscript{177} The United Shoe switch from the Wigmore language of "made in confidence by the client" to "by his client without the presence of strangers" causes such a redirection of the standard's focus. Where under the Wigmore standard the focus was on the "confidence,"\textsuperscript{178} the focus under this interpretation of United Shoe is on the "communication."

At first, this shift in focus would not seem detrimental to the bi-directionality of the privilege since under the doctrine of privilege, the communications are in fact what is privileged, and not

\textsuperscript{175} These differences exist in sections (3)(a)-(b) of the United Shoe standard, as compared to sections (2) and (3) of the Wigmore standard. Compare supra text accompanying notes 28 & 151 (United Shoe factors) with supra text accompanying notes 103 & 150 (Wigmore factors).
\textsuperscript{176} See supra text accompanying notes 98-100.
\textsuperscript{177} See supra text accompanying notes 14-18.
\textsuperscript{178} See supra text accompanying notes 99, 104 & 109-11.
he information communicated.\textsuperscript{179} However, as previously demonstrated,\textsuperscript{180} the plural and singular forms of this term—"communications" versus "communication"—can have entirely different meanings and in turn, they can define entirely different scopes of the privilege. The plural "communications"—as used by Wigmore—can be thought of as a discourse\textsuperscript{181} and defined by either an "interchange of thoughts or opinions,"\textsuperscript{182} "a close of intimate rapport,"\textsuperscript{183} or "opinions between two or more people."\textsuperscript{184} These definitions, like the plural form "communications," fit within the policy rationales behind the privileged communications doctrine,\textsuperscript{185} and are therefore privileged. On the other hand, the singular "communication"—as shortened from its plural form by Judge Wyzanski in the United Shoe standard—can be viewed as a mere statement\textsuperscript{186} and interpreted by such definitions as "the facts or information communicated,"\textsuperscript{187} or the "act of imparting information."\textsuperscript{188} It is clear that these interpretations, which, like their singular counterpart "communication," have a one-directional flow inherent in their nature, do not correspond with the rationales behind the privilege.\textsuperscript{189} Since these meanings do not imply a confidential relationship on their own, Wyzanski was forced to include additional party terminology in the United Shoe standard, specifically the phrase "of which the attorney was informed by his client . . . ." This addition, necessary to remedy Judge Wyzanski's use of the singular "communication," first raised the specter of the one-directional attorney-client privilege where none had existed previously at common law.\textsuperscript{190} Therefore, this alteration of the privilege's language by Judge Wyzanski, through his seemingly innocent switch in terminology from "communications" to "communication," caused the uncertainty over the privilege's directionality which exists today.

This re-evaluation of the United Shoe attorney-client privilege

\textsuperscript{179} See supra Part III.C.
\textsuperscript{180} Id.
\textsuperscript{181} WILLIAM C. BURTON, LEGAL THESAURUS 88 (2d ed. 1992).
\textsuperscript{182} WEBSTER'S, supra note 66, at 460.
\textsuperscript{183} Id.
\textsuperscript{184} BLACK'S LAW DICTIONARY 279 (6th ed. 1990).
\textsuperscript{185} See supra text accompanying notes 93-101.
\textsuperscript{186} BURTON, supra note 181.
\textsuperscript{187} WEBSTER'S, supra note 66, at 460.
\textsuperscript{188} Id.
\textsuperscript{189} See supra Parts II.A & III.C.
\textsuperscript{190} See supra notes 109-13 and accompanying text.
standard, no longer treating the paraphrasing of Judge Wyzanski as both a beginning and an end to understanding the attorney-client privilege,\textsuperscript{191} demonstrates that this uncertainty need not exist any longer. Careful examination of Judge Wyzanski's opinion has revealed that the \textit{United Shoe} standard was intended to apply with the same scope as the attorney-client privilege set forth almost fifty years earlier by Dean Wigmore. The \textit{United Shoe} standard can only be applied in accordance with its foundation, the Wigmore standard, through a bi-directional application, an approach inherent in the Wyzanski terminology itself.\textsuperscript{192} A bi-directional application, consistent with the policy supporting the attorney-client privilege\textsuperscript{193} and providing harmony among the circuits,\textsuperscript{194} would fully protect the attorney-client communicative relationship. It is only through this bi-directional protection that the privilege can successfully promote full and frank dialogue between attorneys and clients.\textsuperscript{195}

V. THE FEDERAL CIRCUIT AND THE \textsc{American Standard Decision}

In the United States, patents are regulated on the federal level through the PTO, a branch of the Department of Commerce. While originally granted under state patent laws, state regulation soon ceased with the adoption of the Federal Constitution and the Patent Act of 1790.\textsuperscript{196} The Patent and Copyright Clause of the Constitution provides Congress with the power "to promote the Progress of the Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ."\textsuperscript{197} Although the Constitution and the first Patent Act provided the authority for the federal government to regulate patents, the patent system in its cur-

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\textsuperscript{191} The neutralization of the effects of this costly paraphrasing by Judge Wyzanski, albeit principally the mere removal of the letter "s" from the word communications, will require extensive judicial analysis along the line of this Note. This is due to the amount of time courts have had to apply the \textit{United Shoe} standard in various ways. Nevertheless, this substantial undertaking follows from the belief of Jeremy Bentham that "error is never so difficult to be destroyed as when it has its root in language." \textsc{Jesse Dukeminier \& Stanley M. Johanson, Wills, Trusts and Estates 33} (quoting Bentham with regard to the problems of linguistic inaccuracy).

\textsuperscript{192} See supra Part IV.B.

\textsuperscript{193} See supra Part II.A.

\textsuperscript{194} Compare note 23 with note 30.

\textsuperscript{195} See supra note 17.

\textsuperscript{196} See generally CHoATE ET AL., supra note 43, at 68-77.

\textsuperscript{197} U.S. CONST. art I, § 8, cl. 8.
rent form did not take shape until the passage of the Patent Act of 1836.198

A. The Relationship of the Federal Circuit to Patent Law

District courts have exclusive subject matter jurisdiction over all patent actions, excluding actions brought against the United States.199 Prior to 1982, appeals from such patent actions were heard much like any other appeal, by the appropriate circuit court of appeals depending upon the geographic region of the lower district court.200 In 1982, however, the United States Court of Appeals for the Federal Circuit, with a jurisdiction uniquely defined by subject matter rather than geography, was made the thirteenth judicial circuit court of appeal.201 This court was created under the Federal Courts Improvement Act of 1982202 in order to "provide[] a new forum for the definitive adjudication of selected categories of cases . . . ,"203 in which the existing "appellate courts [had] reach[ed] inconsistent decisions on the same issue, or in which—although the rule of law may [have] be[en] fairly clear—courts [had] appl[ied] the law unevenly . . . ."204 The diverse, yet specifically subject-oriented, jurisdiction of the Court of Appeals for the Federal Circuit ("CAFC") developed out of this need for doctrinal stability in certain fields of law: trademark deci-

198 Act of July 4, 1836, ch. 357, 5 Stat. 117 (codified as amended at 35 U.S.C. § 1 (1988)). This Act removed many early burdens from federal patent procedure, as well as curtailed the extent to which fraud permeated the system.


200 One special appellate court did exist prior to 1982 for the purpose of dealing with some patent issues. The Court of Customs and Patent Appeals (CCPA), aside from having jurisdiction over all final judgments of the United States Custom Court (28 U.S.C. § 1541 (repealed 1982)), had jurisdiction over appeals from decisions of the Patent Office. Opinions of the CCPA were reviewable by the Supreme Court under normal writ of certiorari principles. 28 U.S.C. § 1256 (repealed 1982). The CCPA is considered the predecessor to the United States Court of Appeals for the Federal Circuit, albeit with different jurisdiction. See ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT viii (1988).

201 The creation of the Federal Circuit was brought about through the consolidation of the CCPA and the former Court of Claims.


204 Id.
tions, \textsuperscript{205} tariff and customs law, \textsuperscript{205} technology transfer regulations, \textsuperscript{207} government contract, \textsuperscript{208} and labor disputes, \textsuperscript{209} and most substantially, patent law. \textsuperscript{210} In addition, the CAFC's patent decisions are particularly powerful as the Supreme Court, due to its own docket problems and lack of expertise in the field, rarely reviews patent law decisions. \textsuperscript{211} The CAFC is therefore usually a "court of last resort" for patent appeals.

While the court is charged with "a duty of increasing doctrinal stability in the field of patent law[,]" \textsuperscript{212} a conflict develops when the CAFC is confronted with a procedural issue. \textsuperscript{213} Due to its subject matter jurisdiction, the CAFC has decided it must follow the "law of the particular regional circuit court where appeals from the district court would normally lie" \textsuperscript{214} on all non-patent issues, over which it is not bestowed with the task of eliminating uncertainty and conflicts. In relation to the confusing application of the attorney-client privilege to patent law, this decision results in an interesting question: Does the current status of the attorney-client privilege in patent law situations affect the doctrinal stability of patent law greatly enough to merit action by the CAFC on this procedural doctrine? \textsuperscript{215} An examination of the CAFC's most re-

\textsuperscript{205} The CAFC hears appeals from the trademark decisions of the PTO. 28 U.S.C. § 1295(a)(4)(b) (1988). However, this jurisdiction does not include trademark infringement cases.

\textsuperscript{206} The CAFC hears appeals from the Court of International Trade and reviews certain final decisions of the International Trade Commission. \textit{Id.} § 1295(a)(5)-(6).

\textsuperscript{207} The CAFC reviews findings of law by the Secretary of Commerce relating to importation of instruments or apparatus. \textit{Id.} § 1295(a)(7).

\textsuperscript{208} See \textit{id.} § 1295(a)(2),(3) & (10).

\textsuperscript{209} See \textit{id.} § 1295(a)(9) (appeals from the Merit System Protection Board).

\textsuperscript{210} See \textit{id.} § 1295(a)(1) (granting CAFC exclusive jurisdiction "of an appeal from a final decision of [the] district court[s] . . . if the jurisdiction of that court was based, in whole or in part, on [28 U.S.C.] section 1338[,]" which encompasses civil actions arising under any Act of Congress relating to patents and other intellectual property). Due to the fact that patent law uniformity was at the heart of the creation of the Federal Circuit, a clear majority of cases heard by the CAFC fall within this area of its jurisdiction.

\textsuperscript{211} The Supreme Court also rarely reviewed patent law cases of the individual circuits prior to the creation of the Federal Circuit, which in part led to the CAFC's creation. \textit{See} Rochelle Cooper Dreyfuss, \textit{The Federal Circuit: A Case Study in Specialized Courts}, 64 N.Y.U. L. Rev. 1, 6 (1989).

\textsuperscript{212} Chemical Eng'g Corp. v. Marlo, Inc., 754 F.2d 331, 333 (Fed. Cir. 1984).

\textsuperscript{213} This conflict stems from the fact that under Congress' jurisdictional grant to the CAFC, practitioners and district courts would be accountable to two different courts of appeal if the CAFC was to develop its own non-patent substantive law. \textit{See} Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1572-75 (Fed. Cir. 1984).

\textsuperscript{214} \textit{Id.} at 1575.

\textsuperscript{215} For the answer to this question see infra note 257 & accompanying text.
B. The American Standard Decision

Five years after the court's creation, the CAFC had to determine the applicability of the attorney-client privilege to patent validity and invalidity opinions. In American Standard, Inc. v. Pfizer Inc., the Federal Circuit was presented with an order from the District Court for the Northern District of Indiana. The order held that since "the opinion letter relied on non-confidential information gleaned from public records . . . there [was] no privilege in the document." In reviewing this order, the CAFC steered clear of the pitfall which snared the district court; yet at the same time, the CAFC missed an opportunity to finally put to rest the directionality aspect of the attorney-client privilege.

The Federal Circuit recognized, unlike the district court, that the attorney-client privilege was designed to protect the communications between the attorney and client, and not the information underlying such communications. However, shifting the focus of its examination from the information to the communications, the CAFC was confronted with a procedural decision, specifically whether or not the privilege was bi-directional. Following its policy

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216 A patent validity opinion is a communication from a patent attorney to his client reflecting the patent attorney's opinion, based upon the prior art and all available literature in the field, as to whether a patent which has been obtained for an invention is valid. Conversely, an invalidity opinion expresses the patent attorney's opinion that based upon his research, a patent is invalid.

In a typical example, a manufacturer seeks an opinion prior to making a product or in order to specifically design a product so that it does not infringe a similar patented product. Without having received an opinion finding manufacture of the product not to be infringement, a manufacturer can be guilty of willful infringement.

The issue of privilege with regard to these opinions is important in nearly every patent litigation. Usually, the holder of the patent charges willful infringement and the defendant responds by claiming it possesses an invalidity opinion on that patent. In American Standard, this opinion was shared with the patentee and then, interestingly, the patentee claimed that this opinion was privileged under the defendant's attorney-client privilege. The patentee argued for the privilege to apply in the hope that other related documents would then become available under the waiver doctrine. American Standard, Inc. v. Pfizer Inc., 828 F.2d 734, 738 (Fed. Cir. 1987); see supra note 104 (fifth Wigmore phrase). See generally ARTHUR H. SEIDEL, WHAT THE GENERAL PRACTITIONER SHOULD KNOW ABOUT PATENT LAW AND PRACTICE § 3.05 (4th ed. 1984).

217 828 F.2d 734 (Fed. Cir. 1987).


219 Id. at 745 ("[The attorney-client privilege] protects communications made in confidence . . . "). See also supra Part III.C.
of ruling on procedural issues in accordance with the law of the regional circuit, the CAFC looked to the Seventh Circuit for guidance in making its decision.

Discovering that "[t]he courts have not been clear and of one mind in applying the privilege to communications from attorney to client," the court found that Seventh Circuit precedent was limited to "general principles" of applicability. With the Seventh Circuit Court of Appeals undecided on the issue, the Federal Circuit looked to a decision from the Northern District of Illinois, Ohio-Sealy Mattress Manufacturing Co. v. Kaplan, to ascertain the Seventh Circuit position on this issue. The Ohio-Sealy court, basing its interpretation on non-Seventh Circuit opinions, granted the privilege to "statements from an attorney to his client only if convinced that the statements in fact do reveal, directly or indirectly, the substance of a confidential communication by the client." With no additional discussion of the Ohio-Sealy approach, the CAFC adopted this as the view of the Seventh Circuit and thereby affirmed the district court's attorney-client privilege order, stating: "We agree with [the Ohio-Sealy] interpretation, and, because there is no such revelation in the opinion letter at hand, we cannot view as clearly erroneous the district court's finding that it was not privileged."

It was with this decision, or more aptly stated, with this lack of a decision, that the Federal Circuit failed to satisfy their fundamental mandate. In affirming the district court's finding of no privilege, albeit on different grounds, the Federal Circuit made two mistakes. First, if the court felt compelled to allow the District Court for the Northern District of Illinois to speak for the Seventh Circuit Court of Appeals with its opinion in Ohio-Sealy, the CAFC should have concerned itself with the accuracy and merit of that decision. Secondly, in passing up an extremely rare opportunity to

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220 See supra note 214 and accompanying text.
221 American Standard, 828 F.2d at 745.
222 Id.
223 Id. (quoting Ohio-Sealy Mattress Mfg. Co. v. Kaplan, 90 F.R.D. 21, 28 (N.D. Ill. 1980)).
224 90 F.R.D. 21 (N.D. Ill. 1980).
225 Id. at 28 (citing Matter of Fischel, 551 F.2d 209, 211 (9th Cir. 1977)).
226 American Standard, 828 F.2d at 745.
clarify this issue, the CAFC failed to fulfill its mandate of clarifying and stabilizing patent law.

1. *American Standard: The Adoption of the Ohio-Sealy Misinterpretation*

Upon ascertaining that the Seventh Circuit had not specifically discussed the application of the privilege to communications from attorney to client, the CAFC appropriately looked to the district courts of that circuit for insight into how the Court of Appeals would decide the issue. The CAFC, however, failed to realize that the Seventh Circuit Court of Appeals, had this issue been before them, would have scrutinized the Ohio-Sealy view prior to adopting it as the proper interpretation for that circuit.

In adopting Ohio-Sealy as the proper interpretation of attorney-client privilege directionality in the Seventh Circuit, the CAFC found that it could not “view as clearly erroneous the district court’s finding that [the opinion letter] was not privileged.” According to the CAFC’s interpretation of the Seventh Circuit’s standard of review, an abuse-of-discretion standard applied to its review of the district court’s order. “Under [this] standard, an abuse of discretion occurs when . . . the decision is based on an erroneous conclusion of law . . . .” Thus, had an erroneous conclusion of law been found by the CAFC in American Standard, the privilege ruling could have been reversed. Therefore, if Ohio-Sealy, the linchpin of American Standard’s directionality analysis, had been founded upon an incorrect conclusion of law, a different outcome should have resulted. Unfortunately for those seeking greater stability in patent law through the Federal Circuit’s opinions, the CAFC did not examine Ohio-Sealy for an error of law.

The merit of the Ohio-Sealy decision depends on its purported

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228 *American Standard*, 828 F.2d at 745.

229 *Id.*

230 *Id.* at 739 (citing Deitchman v. E.R. Squibb & Sons, Inc., 740 F.2d 556, 563 (7th Cir. 1984)).

231 *Id.*
foundation, *Radiant Burners, Inc. v. American Gas Ass’n.* In *Radiant Burners*, the Seventh Circuit adopted the Wigmore standard of the attorney-client privilege. *Radiant Burners* first discussed the policy behind having such a privilege, and then accepted the Wigmore standard as the governing standard in the Seventh Circuit. It quoted verbatim from Wigmore’s treatise *Evidence in Trials at Common Law.* *Radiant Burners* adopted the entire Wigmore standard as the proper application of the attorney-client privilege, including its inherent bi-directionality.

Nevertheless, the District Court for the Northern District of Illinois diverged from this standard in *Ohio-Sealy*. Announcing that the Seventh Circuit had adopted the Wigmore standard in *Radiant Burners*, the *Ohio-Sealy* court then proceeded to misquote both the original Wigmore phrasing as well as the *Radiant Burners* language.

The court defined a portion of the standard under the *Ohio-Sealy* test: “(3) the communications relating to that purpose, (4) made in confidence, (5) by the client, (6) are at his instance permanently protected . . .” But this portion of the *Radiant Burners* opinion actually reads, “(3) the communications relating to that purpose, (4) made in confidence (5) by the client, (6) are at his instance permanently protected . . .”

Under this Note’s five-factor Wigmore analysis, the *Ohio-Sealy* discrepancy results in an entirely different third factor. Under the Wigmore/Radiant Burners standard, this factor reads, “made in confidence by the client,” whereas under the erroneous *Ohio-Sealy* standard, this factor reads “made in confidence, by the client.”

The addition of the comma in *Ohio-Sealy* makes this third factor

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232 320 F.2d 314 (7th Cir.) (en banc), cert. denied, 375 U.S. 929 (1963).
233 See supra note 23.
234 Radiant Burners, 320 F.2d at 318-19.
235 Id. at 319 (citing 8 Wigmore, supra note 9, § 2292). The quote in *Radiant Burners* is identical to Wigmore’s standard as put forth in his treatise. See also supra text accompanying note 22.
236 See supra Part IV.A.
238 Ohio-Sealy, 90 F.R.D. at 28.
239 Radiant Burners, 320 F.2d at 319 (citing 8 Wigmore, supra note 9, § 2292).
240 See supra note 105 and accompanying text.
241 In actuality, if the *Ohio-Sealy* standard was the true text of the Wigmore standard, this Note would have broken the Wigmore standard down into six factors as opposed to five. Contra supra note 103 and accompanying text.
two-pronged, and therefore limits the attorney-client privilege's protection to only the statements from the client to the attorney. Accordingly, the sentence immediately following this erroneous depiction of the Wigmore standard states, "[t]his formulation presupposes that communications for which privilege is claimed will emanate directly from the client." Such a presupposition of one-directionality, while supported by the incorrect Ohio-Sealy version of the Wigmore standard, has no foundation in valid Seventh Circuit precedent. Conversely, from its adoption in Radiant Burners, the Seventh Circuit has accepted a bi-directional application of the attorney-client privilege as correct, in accordance with the policy and history of the privilege.

Therefore, when the Ohio-Sealy court held that "the [one-directional] approach best comport[ed] with the general principles governing attorney-client privilege as enunciated in this Circuit[,]" it disregarded the specific text, phrasing, and principles of the standard adopted by the Seventh Circuit. Had the CAFC noticed it, this misapplication of the law in Ohio-Sealy would have altered the court's analysis of Seventh Circuit precedent, leading to a reversal of the district court below and providing the Federal Circuit with the motivation to re-evaluate and clarify the status of the privilege as well.

2. **American Standard: A Procedurally Non-Activist Federal Circuit**

To many spectators of the Federal Circuit's jurisprudence, the decision in American Standard was a cruel flashback to the state of the law which brought about the creation of the CAFC. In her strong dissenting opinion, Judge Newman went so far as to say that, "[t]his ruling negates decades of hard won precedent, and is

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242 See supra note 106 and accompanying text (discussing the two-pronged result of this comma, due to its making the phrase "made in confidence" into a grammatical appositive).
243 This linguistic argument was put forth in detail supra Part IVA.
245 See supra Part IVA. (demonstrating the inherent bi-directionality of the Wigmore standard).
246 See supra Part IIA.
247 Ohio-Sealy, 90 F.R.D. at 28.
248 Radiant Burners, Inc. v. American Gas Ass'n, 320 F.2d 314, 319 (7th Cir. 1963).
a giant step backward into uncertainty, confusion, and prejudice."250 While Judge Newman's interpretation of the majority opinion may have been somewhat harsh, her concern was not unwarranted: the position taken by the majority in American Standard avails itself to an argument in favor of not applying the attorney-client privilege to any patent validity or invalidity opinion.251

The main reason for the divergent readings of the American Standard decision—ranging from a mere denial of the privilege in a unique fact situation252 to a general negation of the privilege's protection of patent validity opinions253—was the court's attempt to resolve this case independently, without actively considering its potential contributions to the development of patent law. The majority did this in American Standard by appending the following caveats to its holding:

We do not here hold that no patent-validity opinions are ever protected by the attorney-client privilege. Nor do we hold that patent-validity opinions based on publicly available information (as most such opinions are) are for that reason alone outside the attorney-client privilege. Nor do we hold that what the attorney told the client in an opinion letter is always irrelevant. We merely hold that, under the facts of this case, the district court did not err in determining that the opinion letter here at issue did not reveal confidential communications and therefore was not privileged . . . .

These caveats, while slightly confusing, were necessary to allay the fears brought about by the court's distinction that "[the district court] did not say the opinion letter was not privileged merely because it relied on publicly available information. It clearly said the letter relied on nonconfidential information gleaned from public records."255 It is difficult to imagine that a court which could proffer such a minuscule and confusing distinction was content with the current status of the privilege, in light of its mandate to increase doctrinal stability in patent law. Yet, amidst this confusion, the Federal Circuit declined the opportunity in American Standard to even attempt to clarify the attorney-client

252 Id.
254 Id. at 746 (footnote omitted).
255 Id.
Returning to our previous question of whether the CAFC felt that the status of the attorney-client privilege affected the stability of patent law greatly enough to merit action on this procedural doctrine, it appears from the holding in American Standard that the Federal Circuit has answered this question in the negative.257

VI. UNTYING THE HANDS OF THE FEDERAL CIRCUIT

From its decision in American Standard, it becomes clear that the hands of the CAFC are tied with regard to solving procedural problems which happen to be exaggerated in patent cases,258 so long as the CAFC remains a non-activist court merely analyzing the current interpretations of the federal attorney-client privilege standards. To a Federal Circuit intent on fulfilling its mandate of "increasing doctrinal stability in patent law,"259 however, these restraints are easily broken. Examination of the self-imposed procedural limitation upon the CAFC reveals that it can be circumvented should the situation merit such treatment.

In Panduit Corp. v. All States Plastic Manufacturing Co.,260 the CAFC decided that it should follow "the law of the particular regional circuit court where appeals from the District Court would normally lie"261 on all non-patent issues. The CAFC reached this decision by balancing the Federal Circuit's mandate262 with the court's concern over district courts being accountable to the procedural rules of two different courts of appeals.263 While it seems from the Panduit decision that the CAFC wishes to impose a precise distinction between "substance" and "procedure," it has never offered an explanation solidifying this distinction.264 In addition,

256 Another commentator has suggested that the Federal Circuit has disregarded the attorney-client privilege in other decisions as well. See Nelson, supra note 15, at 415 ("The Federal Circuit neglected to address or even acknowledge the privilege. The privilege has existed too long and is too widely accepted for this type of cursory treatment.").

257 See supra note 215 and accompanying text.

258 This is due to the CAFC's decision in Panduit to defer to regional law on procedural issues. See supra notes 213-14 and accompanying text.

259 Chemical Eng'g Corp. v. Marlo, Inc., 754 F.2d 331, 333 (Fed. Cir. 1984).

260 744 F.2d 1564 (Fed. Cir. 1984).

261 Id. at 1575.

262 See supra text accompanying note 259.

263 See supra note 213.

264 In the Panduit decision, the court cited to Sibbach v. Wilson & Co., 312 U.S. 1, 14 (1941), regarding the "substance"/"procedure" distinction. The Sibbach opinion, a companion to decisions such as Hanna v. Plummer, 380 U.S. 460 (1965), in the development
the Federal Circuit has not clarified which procedural matters are so "unique to patent issues" that they merit exemption from its Panduit limitation on procedural rulings.

The Supreme Court provides limited guidance on the issue. In fact, the seminal Supreme Court case on the distinction between "substance" and "procedure," in the context of the Erie doctrine, Byrd v. Blue Ridge Rural Electrical Cooperative, Inc., provides as much confusion as it does valuable guidance. Simply put, distinctions between "substance" and "procedure" are "inherently ephemeral and thus difficult to draw." This underlying fact explains the lack of clear guidance available, because no set criteria can precisely distinguish these two overlapping concepts.

In Guaranty Trust Co. v. York, Justice Frankfurter exposed the inadequacy of a distinction between "substance" and "procedure" when he said:

Matters of "substance" and matters of "procedure" are much-talked about in the books as though they defined a great divide cutting across the whole domain of law. But, of course, "substance" and "procedure" are the same keywords to very different problems. Neither "substance" nor "procedure" repre-
sents the same invariants. Each implies different variables depending upon the particular problem for which it is used.273

Frankfurter's last sentence, that the classification "depend[s] upon the particular problem for which it is used[,]"274 holds the key to resolving the CAFC's Panduit limitation with regard to attorney-client privileged legal advice in patent litigation. The Federal Circuit, in light of the particular problems surrounding the application of the attorney-client privilege to patent advice,275 should hold that in situations involving legal advice from a patent attorney to his client, the issue of the attorney-client privilege is a substantive issue. That would not conflict with the court's Panduit decision276 because in Panduit the CAFC retained its power to rule on procedural matters which are "unique to patent issues."277 Since the uncertain application of the attorney-client privilege to patent law278 also runs counter to the CAFC's mandate of increasing doctrinal stability in patent law,279 the attorney-client privilege should be a substantive issue for the CAFC to rule on in accordance with its mandate.

Faced with a substantive decision as to the scope of the attorney-client privilege in patent law, the CAFC should not only look at the current standards of the privilege in the regional circuits, but also to the policy supporting the existence of the attorney-client privilege. From this analysis, the Federal Circuit will discover that the policy behind the privilege,280 as well as the correct interpretations of both the Wigmore and United Shoe standards,281 support a bi-directional application of the privilege. Such an application in the field of patent law will eliminate the confusion surrounding this issue282 by protecting all legal advice from a patent attorney to his client.

273 Id. at 108.
274 Id.
275 See supra Part III.
276 See supra notes 260-63 and accompanying text.
277 Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984). Without further elaboration by the CAFC, the Panduit decision itself demonstrates the overlap between "substance" and "procedure". By deeming certain procedural issues "unique to patent issues" and therefore open to Federal Circuit rulings, the CAFC is basically deeming those issues substantive in the field of patent law.
278 See supra Parts III & V.B.
279 See supra Part V.A.
280 See supra Part II.A.
281 See supra Part IV.
282 See supra Parts III. & V.B.
VII. CONCLUSION

The attorney-client privilege exists to promote the full and open communications between an attorney and client, a goal which undoubtedly leads to better legal representation. However, current applications of this privilege in a one-directional manner are eroding the privilege's protection, and in turn, breeding uncertainty surrounding the attorney-client privilege. This uncertainty undermines the goal of full disclosure in attorney-client relationships. The expectation of receiving the privilege, not some later judicial ruling, is what encourages honesty and candor in the advisory relationship, and that expectation requires certainty in the law. This uncertainty is exacerbated by the many factors unique to patent law which confuse the role of the patent attorney.

In accordance with its mandate of clarifying patent law, the Court of Appeals for the Federal Circuit should take action and re-examine the status of the attorney-client privilege in patent litigation. Carefully considering the policy behind the privilege and the prevailing regional standards of the attorney-client privilege, the CAFC should adopt a bi-directional application of the privilege. This would not only increase doctrinal stability in patent law in accordance with its mandate, but would harmonize the modern attorney-client privilege with the policy behind its existence. Only through such stability and harmony will the attorney-client privilege in patent litigation be rescued from eroding to the point of being "little better than no privilege at all."

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283 See supra Part II.A.
284 See Thornburg, supra note 73, at 166.
285 See supra Part III.
286 See supra Part V.A.
287 See supra Part IV.