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THOMPSON & KNIGHT LLP

ATTORNEYS AND COUNSELORS

HERBERT HAMMOND
DIRECT DIAL: 214.969.1607
EMAIL: Herbert.Hammond@tklaw.com

ONE ARTS PLAZA
1722 ROUTH STREET • SUITE 1500
DALLAS, TEXAS 75201
214.969.1700
FAX 214.969.1751
www.tklaw.com

AUSTIN
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January 20, 2017

Via E-mail

Don Jones
Office of Legal Counsel
PO Box 12487
Austin, Texas 78711

Re: State Bar of Texas Intellectual Property Section Request for Permission to File
Amicus Brief

Dear Don:

I write on behalf of the State Bar of Texas Intellectual Property Section, as Chair-Elect, to request permission to file an amicus brief in the case *In re Silver*, 05-16-00774-CV pending in the Texas Supreme Court.

Silver is a mandamus proceeding in which the relator (*Silver*) seeks an order directing the trial court to withdraw an order compelling production of communications between relator and his patent agent.¹ In this breach-of-contract case, the trial court rejected *Silver*'s claim of privilege in connection with a discovery request for communications with his patent agent and ordered those communications be produced. *Silver* filed a mandamus petition, which the Fifth District Court of Appeals denied in a 2-1 decision, holding that the patent-agent privilege was not recognized in Texas and that intermediate appellate courts could not create new discovery privileges.

Silver filed a petition with the Texas Supreme Court, which has now ordered briefing on the merits. Relator's brief was due on January 17, 2017; respondent's brief is due February 6, and relator's reply is due February 21, 2017. Although there is no deadline for filing an amicus brief, I have been advised by one of my partners—a former Texas Supreme Court clerk—that to have a fair chance of consideration an amicus brief should be filed within a week of the reply, *i.e.* by March 1, 2017. Accordingly, there is some urgency to this request.

The question presented in *Silver* is whether the attorney-client privilege afforded to patent agents under federal law in connection with the prosecution of patent applications extends to non-federal, *i.e.* state-law matters. In *In re Queens Univ. at Kingston*, 820 F.3d 1287 (Fed. Cir.

¹ A patent agent is a person who is not a lawyer but who has fulfilled the requirements of the Patent and Trademark Office (PTO) to represent clients before the Office and is therefore licensed to prepare and prosecute patent applications before the PTO. The requirements for licensure before the PTO are the same for agents and attorneys; the ethical and other practice obligations imposed on agents and attorneys are identical with respect to activities in front of the PTO. In the PTO, the only difference between a patent attorney and patent agent is that a registered patent attorney is also licensed to practice law in one of the United States.

2916), the U.S. Court of Appeals for the Federal Circuit held that a patent-agent privilege extends to communications with non-attorney patent agents when those agents are acting within the agent's authorized practice of law before the PTO. The Dallas Court of Appeals declined to extend the privilege to a breach of contract case where no federal questions were at issue.

The Section's position is that the attorney-client privilege, which is available under federal law to patent agents licensed by the PTO engaged in the preparation and prosecution of patent applications, should also extend to non-federal, *i.e.* state-law questions, where the advice rendered to the client by the patent agent relates to the preparation and prosecution of patent applications.

The filing of amicus briefs in appropriate circumstances falls within the purposes of the State Bar. The filing of an amicus brief in this case involves matters of patent law and falls within the particular expertise of a large percentage of the Section's membership who are PTO-licensed attorneys.

The position taken by the Section does not violate state or federal law. No Texas court before *Silver* has ruled on this question; indeed, no other state has considered the question to our knowledge. The Section's position is consistent with the Federal Circuit's decision in *Queen's University* where the Federal Circuit upheld the existence of the attorney-client privilege with respect to communications by a licensed patent agent and his client relating to the preparation and prosecution of patent applications.

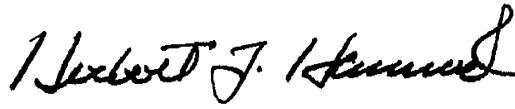
On January 17, after twice soliciting comments from its members, the Council voted unanimously to seek permission to file an amicus brief urging extension or application of the patent-agent privilege to non-federal questions where the communications relate to the preparation and prosecution of patent applications. With the exception of objections from two Section members who represent the respondent in this matter, the comments received from the solicitations were all generally supportive of filing the brief.

One Council member, Bhaveeni Parmar, represents respondent Tabletop. She recused herself and did not participate in the Council's discussion or vote. No other member of the Council has any personal or professional conflict of interest in the matter. Both relator and respondent were made aware that the Section was considering a proposed amicus brief and both parties were given an opportunity to provide comments to the Council prior to the vote. Each party agreed to disclose the other party's written responses to the January 17 solicitation for member comments, and the Section disclosed such correspondence with each party on January 11, 2017.

The amicus brief has not been prepared. We are awaiting approval by the State Bar before proceeding. If permission is granted, a draft of the brief will be provided to your office as soon as possible.

January 20, 2017
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Sincerely,

A handwritten signature in black ink that reads "Herbert J. Hammond". The signature is written in a cursive style with a large, prominent initial 'H'.

Herbert Hammond

HH/df

cc: Hope Shimabuku
Steve Koch

