UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SILYNX COMMUNICATIONS, INC.,	:	
	:	
Petitioner,	:	
	:	
v.	:	Misc. Action No. 08-0694 (JR)
	:	
YOUNG & THOMPSON,	:	
	:	
Respondent.	:	
	:	

MEMORANDUM ORDER

In Civil Action No. 07-02676, now pending in the United States District Court for the District of Maryland, Nacre A/S, a Norwegian company, alleges the infringement of its patents by Silynx Communications, Inc. Silynx, counterclaiming, asserts that Nacre's patents are unenforceable. In the discovery phase of that Maryland litigation, Silynx served a subpoena *duces tecum* on Young & Thompson, the law firm that prosecuted the patents in the United States Patent and Trademark Office (PTO).[1] Young & Thompson has produced some documents, but, asserting the attorney-client privilege, has withheld 35 items of correspondence between its attorneys and employees of ABC-Patent, Siviling. Rolf Chr. B. Larsen A/S ("ABC-Patent"), the Norwegian patent agent that prosecuted the patents-in-suit in Europe. See

[1] Silynx's selection of this court for its discovery of Young & Thompson, a law firm with offices only in Alexandria, Virginia, is not explained on the record before me. A subpoena issued from this court reaches as far as Alexandria, see Fed. R. Civ. P. 45(b)(2)(B), but so would a subpoena issued from the District of Maryland.

Pet. Mot., Exs. H, I. Now before the court is Silynx's motion to compel Young & Thompson to produce the letters it has withheld.

Silynx's motion will be decided under American privilege law because the withheld letters "touch base" with the United States. See, e.g., Odone v. Croda Int'l PLC, 950 F. Supp. 10, 13 (D.D.C. 1997). American privilege law on the particular question presented, however, is not settled:

> [S]ome cases hold that no attorney-client privilege applies to patent agents, whether domestic of foreign[,] since the patent agent was not an attorney admitted to a United States bar, a second category upholds the privilege if the patent agent, domestic or foreign, was registered with the PTO, a third category of cases finds that the attorney-client privilege may apply to communications between an attorney, client, and an independent patent agent, "if that patent agent is working on behalf of and under the direction of the attorney," and a fourth category of cases upholds the privilege on the basis of a "constructive employee" theory.

Stryker Corp. v. Intermedics Orthopedics, Inc., 145 F.R.D. 298, 305 n.3 (E.D.N.Y. 1992) (internal citations omitted).

Citing decisions rendered by other judges of this court, Silynx urges application of the standards found in the second or third category of cases. See In re Ampicillin Antitrust Litig., 81 F.R.D. 377, 394 (D.D.C. 1978); Chubb Integrated Sys. Ltd. v. Nat'l Bank of Wash., 103 F.R.D. 52, 65 (D.D.C. 1984). Under either of these approaches, Silynx argues, the letters are not protected by the privilege, because none of

ABC-Patent's employees were registered with the PTO, see Larsen Decl., at ¶ 11, and ABC-Patent was not working under the direction of Young & Thompson, see Pet. Mot., Ex. A, at 2 (letter from ABC-Patent instructing Young & Thompson on patent prosecution).

The approach found in the fourth category of cases seems preferable to me, however. Those cases hold that communications between a foreign patent agent and American patent counsel are privileged if the patent agent acted at "the direction and control" of a foreign client, and if, "through the agency of its patent agent, the [foreign client] sought from the U.S. patent counsel legal advice and assistance concerning a United States patent application proceeding." Foseco Int'l Ltd. v. Fireline, Inc., 546 F. Supp. 22, 26 (N.D. Ohio 1982); see also Farmaceutisk Laboratorium Ferring A/S v. Reid Rowell, Inc., 864 F. Supp. 1273, 1274 (N.D. Ga. 1994). That standard reflects the prevailing trend in privilege law towards a more inclusive definition of "client" in the attorney-client relationship. See, e.g., In re Bieter Co., 16 F.3d 929 (8th Cir. 1994) (communications between a consultant to a partnership and the partnership's counsel are privileged); McCaugherty v. Siffermann, 132 F.R.D. 234 (N.D. Cal. 1990) (same); In re Copper Mkt. Antitrust Litig., 200 F.R.D. 213, 219 (S.D.N.Y. 2001) (communications between company's public relations firm and

company's counsel are privileged). And it effectuates the primary purpose of the privilege -- "too narrow a definition of 'representative of the client' will lead to attorneys not being able to confer confidentially with non-employees who, due to their relationship to the client, possess the very sort of information that the privilege envisions flowing most freely." Beiter, 16 F. 3d at 937-38.

If that approach is followed, Young & Thompson's assertion of the privilege appears to be valid. As ABC-Patent's lead patent agent attests, "ABC-Patent's initial requests to Young & Thompson relating to the patents-in-suit, and all the subsequent communications, were made as a result of ABC-Patent being directed by SINTEF [Nacre's predecessor] to secure U.S. Patent protection," Larsen Decl., at ¶ 16, and the "[c]ommunications between ABC-Patent and Young & Thompson relating to the patents-in-suit were made for the purposes of securing legal assistance and/or advice from Young & Thompson regarding the filing and prosecution of the underlying applications before the USPTO." Id., at ¶ 10.

The motion to compel is accordingly **denied**. It is important to remember, however, that, if the attorney-client privilege exists on the fact of this case (as I have found that it does), it belongs to Nacre, and not to Young & Thompson, and that Nacre has not appeared before me. My ruling is thus without

prejudice to further attempts by Silynx to defeat Nacre's assertion of the privilege, and it is offered with deference to the judge who presides over the underlying case.

JAMES ROBERTSON
United States District Judge