Miscellaneous Docket No. 830

United States Court of Appeals

for the

Federal Circuit

IN RE SEAGATE TECHNOLOGY, LLC,

Petitioner.

On Writ of Mandamus from the United States District Court for the Southern District of New York in Case No. 00-CV-5141, Judge George B. Daniels

AMICUS CURIAE BRIEF ON BEHALF OF THE HOUSTON INTELLECTUAL PROPERTY LAW ASSOCIATION

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CERTIFICATE OF INTEREST

COUNSEL FOR Amicus Curiae, the Houston Intellectual Property Law Association, certifies the following:

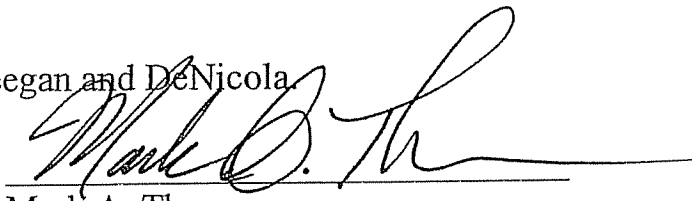
1. The full name of every party or amicus represented by me is the Houston Intellectual Property Law Association.

2. The name of the real party in interest represented by me is the Houston Intellectual Property Law Association.

3. The parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are: NONE

4. The names of all law firms and the partners or associates that appeared for the amicus now represented by me in the trial court or agency or are expected to appear in this Court are:

Mark A. Thurmon, of Roy, Kiesel, Keegan and DeNicola.



Mark A. Thurmon

March 19, 2007

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I. INTERESTS OF THE AMICUS CURIAE

The Houston Intellectual Property Law Association (HIPLA) is an association of over 400 lawyers and other professionals who work in the Houston, Texas area. The practice of most of the HIPLA membership relates in substantial part to the field of intellectual property law. Founded in 1961, HIPLA is one of the largest regional associations of intellectual property practitioners. No HIPLA member represents (or has represented) either party in the subject of this appeal.

On January 26, 2007, this Court entered an Order inviting *amicus curiae* briefs in accordance with Federal Rule of Appellate Procedure 29 and Federal Circuit Rule 29 to address certified questions involving issues associated with the waiver of attorney-client privilege when relying on the advice of counsel defense. HIPLA addresses these certified questions below, and takes no position with respect to the merits of this case. HIPLA submits a Motion for Leave to file this brief, because the parties did not all consent to its filing.

II. QUESTIONS PRESENTED AND BRIEF ANSWERS

The Court identified the following three questions in its January 26, 2007 Order setting this matter for en banc consideration:

1. Should a party's assertion of the advice of counsel defense to willful infringement extend waiver of the attorney-client privilege to communications with that party's trial counsel?

2. What is the effect of any such waiver on work-product immunity?

3. Given the impact of the statutory duty of care standard announced in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983), on the issue of waiver of attorney-client privilege, should this court reconsider the decision in *Underwater Devices* and the duty of care standard itself?

HIPLA believes these questions should be answered as follows:

1. The waiver of attorney-client privilege in this case should not extend to the accused infringers' communications with their trial counsel.

2. A waiver of attorney-client privilege should not result in a waiver of uncommunicated attorney work product material.

3. HIPLA does not believe the third question identified by the Court is ripe for decision.

III. SUMMARY OF ARGUMENT

This case presents a unique opportunity for the Court to resolve an issue that has long troubled and divided the federal district courts. In case-after-case, district courts have struggled to deal with the attorney-client waiver and attorney work product waiver issues that arise when a party accused of willful patent infringement raises a reliance on advice of counsel defense. As a recent article notes, "Current law makes it impossible to predict the scope of waiver that will

result from a decision to use an opinion letter." Lynne Maher, Lynn Pasahow, *Privileged Communications with Alleged Willful Infringers Post Knorr-Bremse*, 6 SEDONA CONF. J. 149 (Fall, 2005).

This Court has held that fairness prohibits selective waivers of the attorney-client privilege in order to prevent a party "from disclosing communications that support its position while simultaneously concealing communications that do not." *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005). Though fairness is an appropriate consideration in fixing the proper scope of waiver, it is not the only policy implicated by such decisions. When a court is faced with the question of whether to extend the waiver to trial counsel, a consideration of fairness, standing alone, leads to inequitable results. Calling such outcomes "fair" is grossly inaccurate.

Involuntary waiver of the attorney-client privilege as to trial counsel is an extreme result that should occur only in rare cases. Where a party has sought the advice of an independent, outside patent attorney, and later relies on that advice to defend against a charge of willful infringement, there are strong reasons for limiting the scope of waiver to outside counsel. Extending the waiver to trial counsel will lead most parties to forego the advice of counsel defense, because such a waiver makes the litigation process almost unworkable. This effectively

eliminates an important defense, and may lead accused infringers to think twice about seeking advice from an outside patent attorney in the first place.

Extending the waiver of attorney-client privilege to trial counsel also undermines the policy behind the attorney work product doctrine. The work product doctrine typically is considered only *after* a court has reached a conclusion as to the proper scope of the waiver of the attorney-client privilege. There are, to be sure, some issues distinct to each of these forms of protection, but it is misguided to attempt to resolve one without any consideration of the other. The interconnection between these two forms of protection is particularly important when the issue is whether to extend a waiver of attorney-client privilege to trial counsel. An appropriate scope of attorney-client privilege waiver rule, therefore, should balance fairness against the need to protect the core attorney work product of trial counsel.

A properly balanced scope of waiver rule will encourage parties to seek advice from an independent patent attorney, will protect core trial counsel work product, and will ensure that parties asserting willful infringement claims are treated fairly. Where an accused infringer has obtained an opinion from a competent, independent, outside attorney, the party's decision to rely upon that opinion to defend against a charge of willful infringement should rarely result in a

waiver of the attorney-client privilege or the attorney work product doctrine as to trial counsel. Such a waiver is unjustified absent a showing of actual prejudice or other extraordinary circumstances that justify a broader waiver.

The district court properly held that uncommunicated work product of trial counsel is not waived by the assertion of an advice of counsel defense. This Court reached the same result in *In re EchoStar Commc'ns Corp.*, 448 F.3d 1294 (Fed. Cir. 2006).

IV. ARGUMENT

A. The Fairness Policy, When Applied in Isolation, Results in Broad Waiver

> The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter. The waiver extends beyond the document initially produced out of concern for fairness, so that a party is prevented from disclosing communications that support its position while simultaneously concealing communications that do not.

Fort James Corp. v. Solo Cup Co., 412 F.3d 1340, 1349 (Fed. Cir. 2005) (internal citations omitted). As a leading commentator explains, "He cannot be allowed, after disclosing as much as he pleases, to withhold the remainder." VIII J. Wigmore, EVIDENCE IN TRIALS AT COMMON LAW § 2327 (McNaughton, rev. 1961).

These descriptions of the fairness doctrine are unassailable. When a party attempts to use the attorney-client privilege as both a sword—by waiving its privilege as to favorable evidence—and a shield—by maintaining its privilege as to unfavorable evidence—the result is unfair and must not be sanctioned by recognizing the claim of privilege as to the unfavorable communications. *EchoStar*, 448 F.3d at 1301. But what result is required when a party has communicated with two attorneys on the same subject matter, seeks to waive privilege only as to the communications with the first, and discloses nothing about the communications with the second?

Most courts hold that fairness requires a waiver as to both attorneys in this scenario. *EchoStar*, 448 F.3d at 1299; *see generally* William F. Lee, Lawrence P. Cogswell, III, *Understanding and Addressing the Unfair Dilemma Created by the Doctrine of Willful Patent Infringement*, 41 Hou. L.R. 393, 436 n.242 (Summer 2004) (collecting cases). This result is reasonable, because to hold otherwise would seem to allow one to "get away with" the more disturbing type of selective waiver simply by refusing to disclose anything about unfavorable communications.

The fairness doctrine does not make any distinction as to the roles of the attorneys who provide the opinions. It makes no difference whether one attorney is an outside opinion attorney and the other is trial counsel. If both attorneys

provide advice and counsel on the same issue, and if the advice and counsel of both attorneys is relevant, the fairness doctrine will lead to a waiver of privilege as to both attorneys if the client expressly waives its privilege as to either.

The fairness doctrine, when considered in the abstract, is unexceptional. It becomes a problem in patent cases because of the nature of the underlying issue. To appreciate this point, consider first a dispute in which a party is accused of breaching a confidentiality agreement in bad faith by publicly disclosing certain information about a joint project. Assume that prior to making the disclosure, the accused party retained a competent, independent attorney to provide an opinion on whether the disclosure would violate the agreement. The attorney concluded the disclosure did not violate the agreement, and provided a written opinion to the effect. When it is later sued, the party expressly relies upon the outside attorney's opinion to refute the accusation of bad faith. The party discussed all of these issues with its trial counsel, who provided its views on the strengths and weaknesses of the party's case.

Does the fairness doctrine require a waiver as to the party's communications with trial counsel in this hypothetical case? No. The issue raised by the accusation was whether the party acted in bad faith when it made the disclosure. The opinion of counsel obtained *prior to the disclosure* may be relevant to that issue, but the

subsequent discussions with trial counsel are not. Nothing trial counsel tells the client can change what the client's state of mind was when the disclosure was made. There is a temporal limitation on the scope of waiver in this scenario because the state of mind issue arises at a discrete point in time.

The state of mind issue in patent infringement cases is different because patent infringement is an ongoing tort. *See, e.g., Crystal Semiconductor Corp. v. Tritech Microelects. Int'l, Inc.*, 246 F.3d 1336, 1352 (Fed. Cir. 2001). As long as the accused infringer continues to engage in the actions that allegedly infringe the patent, the accused infringer's state of mind remains relevant to the willfulness inquiry. To complete the comparison with the hypothetical case described above, if a party obtains an opinion from an independent, outside patent attorney before it begins the allegedly infringing activity, that opinion would be relevant to the party's state of mind. If the party is later sued and retains trial counsel, the opinions of trial counsel are also relevant to the accused infringer's state of mind, assuming the allegedly infringing activities are still occurring.

It is difficult to support a temporal limitation on the scope of waiver in many patent cases because the accused infringer's state of mind typically remains at issue throughout the litigation. *Akeva LLC v. Mizuno Corp.*, 243 F. Supp. 2d 418, 423 (M.D.N.C. 2003) ("because infringement is a continuing activity, the

requirement to exercise due care and seek and received advice is a continuing duty"). When the fairness doctrine is applied to the scope of waiver issue in a patent case, the logical result is often a complete waiver of all communications on the subject matter with all attorneys, including trial counsel. The problem lies not in application of the fairness doctrine, but in courts' failure to recognize that the broad waivers supported by the fairness analysis conflict with other, equally important policy considerations. It is to those considerations that we now turn.

B. Waivers of the Attorney-Client Privilege as to Trial Counsel Will Reduce Reliance on Advice of Counsel

This Court has held that when a person "has actual notice of another's patent rights, he has an affirmative duty to exercise due care to determine whether or not he is infringing." *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389 (Fed.Cir.1983). Though some have questioned this affirmative duty, *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1348-52 (Fed. Cir. 2004) (*en banc*) (Dyk, J., concurring in part and dissenting in part), it is widely understood that public policy strongly favors the exercise of care by one who is aware that its actions may infringe upon the rights of another.

From this general principle, it follows that a party who seeks the advice of a competent, independent attorney in good faith has acted in a reasonable manner. Again, this statement is quite general, and applies well beyond the world of patent

law. It applies, however, with particular force in patent law because the legal rights at issue are based upon a unique type of legal document, a patent. Few laypersons can be expected to fully understand the typical patent, and even fewer have sufficient knowledge of the law and the resources necessary (e.g., the patent file history) to properly evaluate the patent. Given the complexities of patent law, this Court should strongly favor rules that encourage persons to seek advice from a competent patent attorney when faced with a potential patent law issue.

The broad scope of waiver results that follow from application of the fairness doctrine, however, produce the opposite result. The more district courts extend the waiver of attorney-client privilege to communications with trial counsel, the less often accused infringers will raise the advice of counsel defense. As parties begin to realize they cannot use opinions of counsel to defend against charges of willful infringement, the incentive to obtain such opinions will decline substantially.

Balancing the fairness doctrine against the policy favoring the exercise of due care is not a simple matter. Any application of the fairness doctrine that results in a waiver broader than that desired by the waiving party may create some disincentive to seek legal advice in the first place. Just as the fairness doctrine can

be taken too far, so can the desire to encourage parties to seek legal advice. What is needed here is a reasoned balance of these two important policies.

When an accused infringer has obtained opinions from more than one outside opinion attorney (i.e., where there are at least two opinions from outside attorneys other than trial counsel), an express waiver of the privilege as to one of the outside opinion attorneys should result in a waiver of the privilege as to the other opinion attorneys in most cases. This result will have a chilling effect, but the primary practice it will chill is the process of going from one patent attorney to another until an attorney is found who will provide a favorable opinion. That practice is not favored, and the broad waiver resulting from an application of the fairness doctrine in this scenario is, therefore, appropriate in most cases.

Similar reasoning applies when an accused infringer has received opinions from an outside opinion attorney and from an in house attorney, a situation the Court addressed in *In re EchoStar Commc'ns Corp.*, 448 F.3d 1294 (Fed. Cir. 2006). As the Court held in *EchoStar*, fairness generally requires a waiver as to both attorneys if the party expressly relies upon the advice of either. *EchoStar*, 448 F.3d at 1299. The waiver upheld in *EchoStar* may have a chilling effect on the practice of seeking a favorable outside opinion when in house counsel has

provided an unfavorable opinion.[1] That situation, however, is much like the one described in the preceding paragraph. In both situations, the fairness doctrine exposes and tends to discourage parties who have received both favorable and unfavorable advice, but wish to waive the privilege only as to the favorable advice. That practice is not to be encouraged, and the policy favoring the exercise of due care, therefore, provides no reason to limit the application of the fairness doctrine in such situations.

The result is different when the waiver extends to trial counsel for at least three reasons. First, extending the waiver to communications with trial counsel will have a much more powerful chilling effect than extending waiver to multiple outside opinion attorneys or to both outside and in house attorneys. In scenarios that do not involve trial counsel, the client remains able to communicate freely with trial counsel and to participate actively in its own defense. When the waiver is extended to trial counsel, however, the chilling effect extends to the very litigation process. The client and its trial counsel may no longer freely discuss matters. The client must distance itself from the preparation of its own case or risk

[1] The *EchoStar* case actually involved the opposite scenario. The accused infringer sought to rely on the advice of in house counsel, while claiming privilege for apparently unfavorable views expressed by an outside attorney. *EchoStar*, 448 F.3d at 1298-99.

divulging further details of its litigation strategy to its adversary. Extending the waiver to trial counsel creates an almost impossible situation for a litigant.

The second important distinction between extending waiver to trial counsel compared to non-trial counsel is closely related to the first. Because waiving privilege as to trial counsel makes litigation almost unworkable, a party has a strong reason to maintain its privilege as to trial counsel independent of the nature of the advice received.[2] The same conclusion may not follow in the other scenarios discussed above. When, for example, an accused infringer received opinions from more than one outside attorney, but wishes to waive its privilege as to only one of those attorneys, it is reasonable to assume the other opinion was less favorable. Indeed, if both opinions were favorable, one would expect the party to waive its privilege as to both. The same conclusion simply does not follow when trial counsel is involved. Few accused infringers would voluntarily waive their

[2] The district court in this case seems to have recognized that Seagate's motivation for arguing against an extension of the waiver to its trial counsel may have been independent of the content of Seagate's discussions with trial counsel. After refusing to limit the waiver to trial counsel communications that conflicted with or cast doubt upon the opinions of Seagate's outside opinion counsel, the district went on to make the following observation: "Moreover, a waiver that encompasses both negative and positive information would not cause unfairness to Seagate, since the additional disclosure of favorable evidence would only bolster its advice-of-counsel defense." (Dist. Op. at 16).

privilege as to trial counsel, even it all the advice received from trial counsel was favorable.

The third difference between extending waiver to trial counsel or to other non-trial attorneys results from the litigation process itself. Trial counsel will reveal much of its strategy through the litigation process. If a party is allowed to selectively waive the privilege as to one outside opinion while maintaining the privilege as to another outside opinion, its adversary will never learn anything more about the second outside opinion. But if the privilege is waived as to an outside opinion but maintained as to communications with trial counsel, the adversary will learn more about the positions taken by trial counsel. Trial counsel will make claim construction arguments at a Markman hearing, which may occur relatively early in the litigation process. Trial counsel will disclose parts of its strategy through the discovery it seeks and through the arguments it makes in motions, particular if summary judgment motions are submitted.

Such disclosures of trial counsel positions are not equivalent to a waiver of the attorney-client privilege. These disclosures, however, are relevant to a proper balancing of the fairness and due care policies. The paradigm example of unfairness exists when a party tries to waive privilege for favorable communications while maintaining its privilege for unfavorable communications.

When the selective waiver issue involves trial counsel, the party seeking broader waiver will have some ability, through the litigation process, to determine whether conflicts exist between the positions taken by opinion counsel and trial counsel.

There is, of course, a risk that adopting a rule based on a balance of the fairness doctrine and the due care policy will merely shift the current confused state of the law to a new, but equally confused, state of the law. The adoption of a bright line rule would prevent such confusion, but is difficult to justify given the myriad ways in which the scope of waiver issue arises. There is yet another important policy to consider in the balancing process, and that policy adds additional weight on the side of maintaining the claim of attorney-client privilege as to trial counsel.

C. An Involuntary Waiver of the Attorney-Client Privilege Undermines the Important Attorney Work Product Doctrine

The attorney work product doctrine recognized by federal courts today is based in large part on the Supreme Court's analysis in *Hickman v. Taylor*, 329 U.S. 495 (1947). *Hickman* involved witness statements prepared by an attorney. The court held that the statements were protected from disclosure because they reflected the work of an attorney in anticipation of litigation, and because the adversary had the ability to obtain generally equivalent information through other

means. The witnesses were still available, so the Court saw little reason to force the attorney to provide the statements he had obtained.

Since *Hickman* was decided, the courts and the Federal Rules of Civil Procedure have refined the work product doctrine. It is now well-established that the work product doctrine provides varying levels of protection, depending upon how central the material is to an attorney's involvement in the litigation process. *See, e.g., United States v. Nobles*, 422 U.S. 225, 238 (1975); *EchoStar*, 448 F.3d at 1300-01. Under the Federal Rules of Civil Procedure, a "court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories" of counsel, a requirement that seems to create an absolute bar to involuntary waiver of such materials. Fed. R. Civ. P. 26(b)(3). This standard applies regardless of whether the "mental impressions, conclusions, opinions, or legal theories" are those of trial counsel or an attorney who was working in anticipation of litigation.

The protections of the work product doctrine are most important when the "mental impressions, conclusions, opinions, or legal theories" of trial counsel are involved. *Coastal States Gas Corp. v. Dep't of Energy*, 617 F.2d 854, 864 (D.C. Cir. 1980). Nothing is more central to the fair and effective administration of our adversarial justice system than the inner thoughts and strategies of trial counsel. *Hickman*, 329 U.S. at 511 (Jackson, J., concurring) ("The effect [of a failure to

protect attorney work product] on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served."). Protection of core work product should be nearly absolute. The district court decision in this case, however, may[3] require the involuntary production of precisely such information.

The Supreme Court held in *Hickman* that witness statements obtained by an attorney warrant some protection from discovery, and the Federal Rules now create a seemingly absolute bar to disclosure of core work product. Surely it follows that an appropriate scope of waiver rule must include a strong presumption against the disclosure of trial counsel's "mental impressions, conclusions, opinions, or legal theories."

D. Crafting a Proper Scope of Waiver Rule

When the fairness doctrine is balanced against the policy favoring the exercise of due care and the policy favoring nearly absolute protection for core attorney work product, it becomes clear that the district court went too far in this

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[3] We say "may" because the district required in camera inspection of documents that reveal "trial strategy." There are likely to be ongoing disputes as to what this category includes, but it does not appear to be as inclusive as the "mental impressions, conclusions, opinions, or legal theories" standard of Rule 26(b)(3). In addition, the district court's procedure applies only to documents, but the waiver extends to testimony, as well. It is not clear how the district court intends to deal with "trial strategy" issues arising at depositions of trial counsel.

case. But what result should have been reached in this case? And what scope of waiver rule should be used to determine whether to extend the waiver to trial counsel?

The attorney work product doctrine seems to require an almost absolute rule against involuntary waiver of certain trial counsel communications. The desire to encourage parties to seek opinions from competent, independent attorneys also favors a rule that only rarely extends waiver to trial counsel. The fairness doctrine is the only justification for extended a waiver of the attorney-client privilege to trial counsel. Yet even the fairness doctrine does not support a broad waiver if trial counsel's opinions and advice are consistent with those of the outside opinion counsel. The most that can be said in favor of the broad waiver found in this case is that it *might* be justified under the fairness doctrine.[4] The *possibility* that one of

[4] Ironically, the district court rejected this position in the context of the attorney-client privilege, but endorsed it in the context of the attorney work product doctrine. The court held the attorney-privilege was waived as to communications with trial counsel that were "consistent with and contrary to" the advice Seagate received from its outside opinion counsel. (Dist. Op. at 16). Yet when evaluating the scope of the waiver as to attorney work product, the district court held absent "evidence that trial and opinion counsel have conspired to create a 'sham opinion' to gain an unfair advantage in litigation, production of the un-communicated work product of trial counsel is unwarranted." (*Id.* at 20). Because there was no such evidence in this case, the district court held the work product protection was not waived as to uncommunicated work product of trial counsel.

It is indeed ironic that the district court seems to have concluded that withholding certain trial counsel materials would not be unfair to the Plaintiffs, but in the same decision, held that fairness required a waiver as attorney-client communications with trial counsel.

the three policies at issue *might* support the result is simply insufficient to justify such an extreme result.

It is possible to avoid these problems. A better rule is one that encourages desirable practices while providing reasonable protections against unfairness. Seeking advice from independent, outside counsel should be encouraged. Full and frank disclosure to and discussions with trial counsel should be encouraged. To further these goals, the Court should adopt the following rule:

> Where an accused infringer has obtained an opinion from a competent, independent outside attorney, a party's decision to rely upon that opinion to defend against a charge of willful infringement will not result in a waiver of the attorney-client privilege or the attorney work product doctrine as to trial counsel, absent a showing of actual prejudice or other extraordinary circumstances that justify a broader waiver.

This rule effectively creates a presumption that the waiver will not extend to trial counsel, but identifies grounds for overcoming the presumption when the facts justify that result. For example, if the opinion was obtained from trial counsel or an attorney who was not truly independent from the litigation process, this rule would not apply. Actual prejudice would result if there is evidence that limiting the waiver to opinion counsel would result in manifest unfairness.

It is expected that this rule will only rarely result in a waiver of the attorney-client privilege as to trial counsel. That would represent a change in the current state of the law, as a troubling number of district court decisions have allowed at

least a limited waiver of the privilege as to trial counsel. Such a change is needed to restore balance to the process.

The proposed rule does not rely on a temporal limitation to the scope of waiver. In some cases, temporal limitations will be appropriate, but in many cases the accused infringer's state of mind will remain at issue from the time of actual notice until trial. For that reason, we do not propose a bright-line temporal rule.

Nor do we propose that outside opinions obtained after litigation is instituted should be treated in a fundamentally different manner. As the facts of this case show, it is quite possible that post-filing opinions will result from analysis and work that predated the filing of the complaint. But even where the entire evaluation occurs post filing, we do not believe a special rule is needed. Court may well be justified in according less weight to such opinions, depending upon the facts, but adopted a rule that post-filing opinions are per se unreasonable seems unwise. Such a rule would encourage patentees to "sue first and talk later," because the sooner they sue, the greater the chances the accused infringer would be unable, as a matter of law, to raise an advice of counsel defense. The rule set forth above, and fact finders' inherent ability to weigh evidence, is sufficient to deal with outside opinions, regardless of when such opinions were rendered.

E. Uncommunicated Work Product Is Not Waived

The second question presented in this case is whether a waiver of the attorney-client privilege resulting from an accused infringer's reliance on an advice-of-counsel defense also requires a waiver of all work product protection. It is not entirely clear whether the Court intended to limit this question to situations in which a district court extends the attorney-client waiver to trial counsel, or whether the more general issue was raised. We will address both the general and specific issues.

When a party relies on an advice-of-counsel defense to a charge of willful patent infringement, the question arises as to whether such reliance also requires a waiver of all the attorney work product of the party's opinion counsel. Some courts have held that the work product waiver should be limited to communicated work product, which essentially limits the waiver to materials already within the scope of the waiver of attorney-client privilege. *See generally,* Lee & Cogswell, *supra* at 438-48 (discussing cases reaching different conclusions as to the scope of the work product waiver).

Other courts have extended the work product waiver to all the work product of the opinion attorney. *Id.* at 438-44. The rationale for such a broad work product waiver is that the party alleging willful infringement may need to go beyond the communicated advice to fully examine the work done by opinion counsel. Courts

taking this position, however, miss an important point. It is the accused infringer's state of mind that is at issue, not the state of mind of the opinion attorney. Forcing accused infringers to involuntarily produce the uncommunicated work product of their opinion attorneys is seldom justified because such uncommunicated materials will seldom shed any light on the accused infringer's state of mind.

The same logic applies in those rare cases where the attorney-client privilege waiver is properly extended to communications with trial counsel. Trial counsel may well have a great deal of work product that was never communicated to the client, and some of that work product could be quite central to the proper functioning of the adversarial process. Trial counsel may develop, for example, a number of possible theories or themes for some part of the case, but ultimately discuss with the client those ideas that seemed strongest. Forcing a party to disclose these types of trial counsel materials would seriously undermine the adversarial process for no good reason. Again, it is the accused infringer's state of mind that is at issue, not trial counsel's state of mind.

The district court in this case held that the work product waiver was limited to communicated materials. That was a correct application of the law. This Court reached essentially the same conclusion in *EchoStar*, where the Court provided a careful explanation of the work product waiver issue. *EchoStar*, 448 F.3d at 1299-

1303. HIPLA believes the rationale and result in *EchoStar* are correct and should be endorsed by the en banc Court. We recognize that *EchoStar* did not purport to resolve all the possible work product waiver issues that may arise, but this case falls squarely within the bounds of the issues resolved in *EchoStar*. For this reason, we do not believe any change to the law is justified on the work product waiver issue.

V. CONCLUSION

For the reasons set forth above, HIPLA respectfully suggests that a Writ of Mandamus should issue in this case vacating the decision of the district court and instructing the district court to reconsider the attorney-client waiver issue using the standard presented above.

Respectfully submitted,

3/19/07

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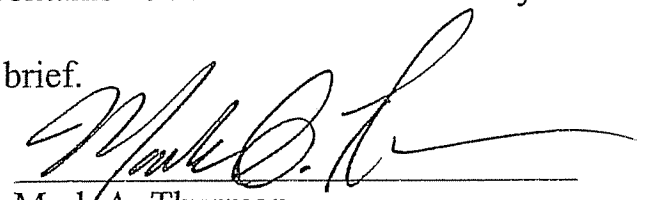
CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Apellate Procedure, the undersigned hereby certifies that this BRIEF OF AMICUS CURIAE HOUSTON INTELLECTUAL PROPERTY LAW ASSOCIATION complies with the type-volume limitation of Rule 32. This brief contains 4970 words as counted by the word processing system used to prepare the brief.



Mark A. Thurmon

CERTIFICATE OF SERVICE

United States Court of Appeals
for the Federal Circuit
Misc. Docket No. 830

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In Re Seagate Technology, LLC
Petitioner.
----------)

I, John C. Kruesi, Jr., being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

I am retained by Roy, Kiesel, Keegan & DeNicola, Attorneys for Amicus Curiae.

That on the **19th day of March, 2007**, I served the 2 copies of the within **amicus Curiae Brief on Behalf of the Houston Intellectual Property Law Association** in the above captioned matter upon:

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via FedEx, overnight delivery, by causing those documents to be deposited in an official depository of FedEx.

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March 19, 2007