

December 19, 2016

Via email to: acprivilege@uspto.gov

Office of Policy and International Affairs
Director of the United States Patent and Trademark Office
Alexandria, VA 22313-1450

Attention: Soma Saha, Patent Attorney,
Patent Trial Proposed Rule on Privilege

**Re: Rule Recognizing Privileged Communications Between Clients
and Patent Practitioners at the Patent Trial and Appeal Board,
Docket No. PTO-P-2016-0029**

Dear Ms. Saha:

On behalf of the Association of Corporate Counsel (“ACC”) and its Intellectual Property Committee, we write to express our strong support for the proposed rule recognizing privileged communications between clients and patent practitioners at the Patent Trial and Appeal Board (“PTAB”). By providing certainty regarding the application of the attorney-client privilege, the proposed rule will benefit corporate legal departments by increasing cost effectiveness and simplifying international patent prosecution matters.

ACC is a global bar association that promotes the common professional and business interests of in-house counsel, with over 40,000 members employed by over 10,000 organizations in more than 75 countries. ACC’s Intellectual Property Committee represents more than 6,600 in-house lawyers who handle intellectual property matters for a broad range of companies. Many routinely engage in communications with patent agents and foreign patent practitioners. A uniform understanding of the confidentiality of those communications will improve companies’ abilities to effectively allocate legal resources, and improve enforcement of global intellectual property rights.

The proposed rule will provide a new consistency in proceedings before the PTAB. Up to now, determinations of privilege regarding communications between clients and patent practitioners have been handled on a case-by-case basis by the PTAB. This inconsistent application of the attorney-client privilege led in-house counsel to often recommend using attorney practitioners alongside patent agents for their corporate clients’ patent matters, even though a patent agent alone would be more cost-effective. The clarity the proposed rule provides will mitigate this unnecessary

expense. Moreover, the cost savings extend not just to the corporate legal departments who no longer have to guess at confidentiality, hedging risk by avoiding engagement of non-attorney patent practitioners, but also to the PTAB, which will spend less time adjudicating confidentiality issues case by case.

We are pleased that the proposed rule also includes foreign patent practitioners. Many of the most developed economies in the world recognize privilege for authorized patent agents. The proposed rule will harmonize the PTAB with international rules, an important development given the increasingly international nature of patent matters.

ACC appreciates the level of attention the USPTO has given to issues presented and the comments received to formulate the proposed rule. For the reasons stated above, ACC strongly urges the implementation of the rule as proposed. Further, we see this proposal as a valuable first step in gaining consistency with respect to attorney-client privilege across federal and state venues for patent disputes. We urge the USPTO to continue its work on this important issue.

Sincerely,



Amar D. Sarwal
Vice President & Chief Legal Strategist
Association of Corporate Counsel

Mary Blatch
Director of Advocacy and Public Policy
Association of Corporate Counsel

John Bates
Chair, Intellectual Property Committee
Association of Corporate Counsel