



Morgan Lewis

IP WEBINAR SERIES

BETTER SAFE THAN SORRY

Attorney Client Privilege

May 22 |

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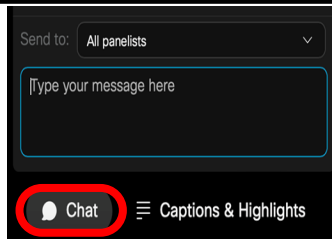
Webinar開始の前に

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CLE

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技術的なサポートが必要な場合

- Webex ヘルプセンターをご参照ください
<https://help.webex.com/ja-jp>
- 音声が聞こえない場合
https://help.webex.com/ja-jp/article/ela6i8/ミーティングまたはウェビナーに参加する前に音声とビデオの設定を選択する#id_138213
- 上記で解決できない場合は、貴社 IT 部門にお問い合わせください

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ATTORNEY-CLIENT PRIVILEGE



FRCP Rule 26. Duty to Disclose; General Provisions Governing Discovery

(b) DISCOVERY SCOPE AND LIMITS.

(1) *Scope in General.* Unless otherwise limited by court order, the scope of discovery is as follows:

Parties may obtain discovery regarding any **nonprivileged matter** that is **relevant to any party's claim or defense and proportional to the needs of the case**, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.

Basic Policy

- By assuring confidentiality, the privilege encourages clients to make **"full and frank"** disclosures to their attorneys, who are then better able to provide candid advice and effective representation, "thereby promote **broader public interests** in the observance of law and administration of justice."
- Privilege is an **evidentiary matter rather than duty of confidentiality**. The privilege only protects communications reflecting a request for or a provision of legal advice, but **"does not protect disclosure of facts"**

- *Upjohn Co. v. U.S.*, 449 U.S. 383 (1981)

Attorney Client Privilege

Restatement of the Law Governing Lawyers

- (i) A **communication**;
- (ii) made between **privileged persons**;
- (ii) in **confidence**;
- (iii) for the purpose of seeking, obtaining or **providing legal assistance** to the client

What is “CONFIDENTIALITY”?

“Need to Know” Test

- “The key concept here is need to know. While involvement of an unnecessary third person in attorney-client communications destroys confidentiality, involvement of third persons to whom **disclosure is reasonably necessary** to further the purpose of the legal consultation preserves confidentiality of communication.”
– *U.S. v. United Shoe Machinery Corp.*, 391 U.S. 244 (1968)

Bengoshi/Benrishi Privilege

Amendment of Code of Civil Procedure (1998)

第九十七條 次に掲げる場合には、証人は、証言を拒むことができる。

二 医師、歯科医師、薬剤師、医薬品販売業者、助産師、**弁護士（外国法事務弁護士を含む。）**、**弁理士**、**弁護人**、**公証人**、**宗教**、**祈禱若しくは祭祀の職にある者又はこれらの職にあった者が職務上知り得た事実で黙秘すべきものについて尋問を受ける場合**

第二百二十條 次に掲げる場合には、文書の所持者は、その提出を拒むことができない。

四 前三号に掲げる場合のほか、文書が次に掲げるもののいずれにも**該当しないとき**。

ハ **第九十七條第一項第二号**に規定する事実又は同項第三号に規定する事項で、**黙秘の義務が免除されていないものが記載されている文書**

In re Queen's Univ. at Kingston (Fed. Cir. 2017)

- We find, consistent with Rule 501 of the Federal Rules of Evidence, that a **patent-agent privilege is justified** “in the light of reason and experience.”
- We therefore recognize a patent-agent privilege extending to communications with non-attorney patent agents when those agents are acting **within the agent's authorized practice of law before the Patent Office.**

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WORK PRODUCT DOCTRINE

Work Product Doctrine

26(b)(3) Trial Preparation: Materials.

(A) *Documents and Tangible Things*. Ordinarily, a party may not discover documents and tangible things **that are prepared in anticipation of litigation or for trial by or for another party or its representative** (including the other party's attorney, consultant, surety, indemnitor, insurer, or agent). But, subject to Rule 26(b)(4), those materials may be discovered if:

- (i) they are otherwise discoverable under Rule 26(b)(1); and
- (ii) the party shows that it has substantial need for the materials to prepare its case and **cannot, without undue hardship, obtain their substantial equivalent by other means.**

Work Product Doctrine

- Ordinarily, a party **may not discover** documents and tangible things of another party that are **prepared in anticipation of impending or ongoing litigation**
- Materials are otherwise discoverable under Rule 26(b)(2); [if] it has **substantial need** for the materials to prepare its case; and cannot, **without undue hardship**, obtain their substantial equivalent by other means.
- Court “must protect against disclosure of the **mental impressions, conclusions, opinions, or legal theories** of a party’s attorney or other representative concerning the litigation.”

Work Product Doctrine

- Treat any documents prepared in anticipation of litigation or for trial involving “Attorneys” as Work Products
- Documents prepared in-house under instructions by “Attorneys” prepared in anticipation of litigation or for trial may also qualify as Work Products, as long as the Confidentiality is not waived
- Make sure to evidence involvement or instructions of “Attorneys” in order to later claim application of Work Product Doctrine

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DOCUMENT REVIEW

Document Review

The screenshot displays a document review application interface. The main document content is an email titled "Williams Energy News Live -- today's video newscast" sent on Wed 10/24/2001 11:32:20 PM (UTC) from Jay Rickerts to Daily Wrap (HTML Registered Users). The email body contains several paragraphs of text, with words like "energy", "nuclear", and "power" highlighted in green. The interface includes a top navigation bar with "Exit viewer" and "Documents" buttons, a document ID "AZIPPER_0011378", and a search bar. A left sidebar shows "Persistent Highlight Sets" with categories like Primary, Industry, and Investments. A right sidebar shows "Coding Layout" with options for Responsive, Privilege, and Confidential. A bottom right section shows "Family Group" and "Document History" with a table of document actions.

1 Native Image Extracted Text No Production No PDF

2 Search within Document

3 AZIPPER_0011378 /634

4 Coding Layout

5 Document History

6 Persistent Highlight Sets

Primary
There are no terms to show.

Industry
 power 2
 energy 19
 nuclear 2

Investments
 financial 1

Your recent searches
There are no terms to show.

Williams Energy News Live -- today's video newscast Sent: Wed 10/24/2001 11:32:20 PM (UTC)

From: Jay Rickerts
To: Daily Wrap (HTML Registered Users)

<http://www.energynewslive.com/ImageLogServlet/content/email/graphic/s/header.jpg?email=andy.zipper@enron.com>

Dear Andrew,

The Washington bureau will bring us more on the EPA decision to recommend changes to the nation's fuel specifications on Thursday. Washington Bureau Chief Peter Cook says the proposal to reduce the number of boutique fuels across the country will likely draw mixed reaction.

We'll have the latest on **energy** legislation from the Senate. There continues to be mixed signals coming from both parties on the likelihood of a deal that could pave the way for a comprehensive **energy** bill to reach the floor.

Also in Washington, a long list of **energy** influentials will speak at the Alliance to Save **Energy** Summit on **Energy** Efficiency. **Energy** Secretary Spencer Abraham, Senate **Energy** Committee Chairman Jeff Bingaman and S. David Freeman, the Chairman of California's new state **power** authority are among the scheduled participants. We'll have coverage of the Summit from the Washington bureau on Thursday.

Houston has long been called the **energy** capital of the world and downtown Houston has always been considered the **energy** corridor. Now the Woodlands, a community located north of Houston, is staking its claim as the next **energy** corridor of the area. On Thursday the Woodlands Chamber of Commerce is hosting an **energy** forum to discuss the area's growth and ways to attract more companies. We'll bring you details from the Houston bureau tomorrow.

We'll take a rare look Thursday into the largest **nuclear power** plant in Texas. South Texas Project Electric Generating Station invited members of the news media to tour secured areas as **nuclear** plants around the country upgrade security in light of the threats and attacks on America.

Also from the Houston bureau on Thursday, Simmons & Company International Vice President of Research Mark Meyer will drop by to discuss how oil stocks are doing this quarter. Catch Meyer during the 10:00 a.m. ET newscast.

The California Public Utilities Commission is meeting on Thursday. West Coast Correspondent Kym McNicholas says the agenda may include the Rate Agreement between the CDWR and the PUC along with the Issue of Direct Access.

Kym also reports, the Sacramento Municipal Utility District is boosting its capacity. This move will add to what is already the largest utility-owned distributed photovoltaic system in the world. Kym will bring us details on Thursday.

Coding Layout

Save & Next Save Copy Cancel Review Co...

First Pass Review

Control Number AZIPPER_0011378

Responsive
 Non-Responsive
 Responsive
 Responsive - Privileged Redacted
 Privileged
 Needs Further Review
 Technical Issue
[Manage](#)

Privilege
 Attorney Client Communication
 Attorney Work Product
[Manage](#)

Confidential
 Confidential
 Highly Confidential
 Attorneys' Eyes Only
 Confidential Subject to Protective Order
 Highly Confidential Subject to Protective Order
[Manage](#)

Family Group **Document History**

1 - 20 of 20 10 per page

Timestamp	Action	User Name	Old Value
(All)	(All)	(All)	
19/11/2020, 16:12 (UTC-6)	View	Lanter, Jeff	
19/11/2020, 16:04 (UTC-6)	View	Lanter, Jeff	
19/11/2020, 15:57 (UTC-6)	View	Lanter, Jeff	

Show terms with zero hits:

View Similar Documents

Document Review

The screenshot shows a document review interface. At the top, there is a navigation bar with a back arrow, the text 'Exit viewer', and 'Documents'. Below this is a document title 'AZIPPER_0011378' and a dropdown menu. A red box labeled '1' highlights the viewer tabs: 'Native', 'Image', 'Extracted Text', 'No Production', and 'No PDF'. Below the tabs is a toolbar with a zoom slider set to 100% and various navigation icons. A red box labeled '2' highlights the main document content area, which displays an email titled 'Williams Energy News Live -- today's video newscast' sent on Wed 10/24/2001 11:32:20 PM (UTC). The email body contains text about energy news, with several words highlighted in green (e.g., 'energy', 'nuclear', 'power'). A red box labeled '6' highlights the 'Persistent Highlight Sets' sidebar on the left. This sidebar has a search bar and lists categories: 'Primary' (no terms), 'Industry' (power: 2, energy: 19, nuclear: 2), 'Investments' (financial: 1), and 'Your recent searches' (no terms). At the bottom of the sidebar is a checkbox for 'Show terms with zero hits:'. At the bottom of the main content area, there is a 'View Similar Documents' link.

1. Viewer tabs
2. Viewer
6. Persistent Highlight card

Privilege and Confidential Mark

**Confidential Document
Attorney-Client Privilege**

- Mark itself does not have imminent legal effect
- Mark will be useful to extract potential privileged documents
- Mark may be used to show the party's intent to protect as privileged document

Document Review

The screenshot shows a software interface for document review. At the top, a navigation bar contains several icons and the text '13 /634'. A red circle with the number '3' points to this navigation bar. Below the navigation bar is a section titled 'Coding Layout'. This section contains several buttons: 'Save & Next', 'Save', 'Copy', 'Cancel', and a dropdown menu labeled 'Review Co...'. Below these buttons is a section titled 'First Pass Review'. This section contains three main categories of options: 'Responsive', 'Privilege', and 'Confidential'. Each category has several radio button options. A red circle with the number '4' points to the right side of the 'First Pass Review' section.

3

Navigation

4

Coding card

3. Navigation

4. Coding card

Document Review

The screenshot shows a software interface for document review. At the top, a navigation bar contains a search icon, a text input field with '13', a page indicator '/634', and a settings gear icon. A red circle with the number '3' is positioned above the search and page indicator area. Below this is a 'Coding Layout' section with buttons for 'Save & Next', 'Save', 'Copy', 'Cancel', and a dropdown menu labeled 'Review Co...'. Underneath is a 'First Pass Review' section with the following fields:

- Control Number:** AZIPPER_0011378
- Responsive:** A list of radio button options: Non-Responsive, Responsive, Responsive - Privileged Redacted, Privileged, Needs Further Review, and Technical Issue. A 'Manage' link is below the list.
- Privilege:** A list of checkbox options: Attorney Client Communication and Attorney Work Product. A 'Manage' link is below the list.
- Confidential:** A list of radio button options: Confidential, Highly Confidential, Attorneys' Eyes Only, Confidential Subject to Protective Order, and Highly Confidential Subject to Protective Order. A 'Manage' link is below the list.

A red circle with the number '4' is positioned to the right of the 'First Pass Review' section, pointing to the right edge of the form area.

- Responsive Review

- Determine based on the **Scope** of Request for Production (“RFP”) of documents received from opposing party

- Privilege Review

- Determine based on **Involvement of legal counsel**

- Confidentiality Review

- Determine based on **Confidentiality** of the document and **Protective Order**

Privilege Review

Model Categorical Privilege Log

Category No.	Date Range ¹	Document Type	Sender(s)/Recipient(s)/Copies(s)	Category Description	Privilege Justification	Documents Withheld (Total Documents: 454) ²	Documents Withheld, Including Families ³
1	3/11/2012 - 6/30/2012	Email, PDF	Attorneys: K. Currie, Esq.; S. Salem, Esq.; E. Mendola, Esq.; F. Fernandez, Esq.; J. Driscoll, Esq.; T. Dunbury, Esq. (Smith and Kline LLP); K. Currie, Esq. Client: M. Salem, K. O'Shea; J. Martin; C. Dew; F. Zeigler; M. Moore; E. Andrews; A. Skar; A. Chen; J. Ginter; F. Treglia; B. Parks; R. Thomas; V. Anderson; H. Dickey; C. Vega; M. McIntosh; B. Carroll; E. Schmidt; B. Newburn; S. Tamer; J. Rose; C. Whalen; C. Acton; D. Holmes; K. Stewart; J. Ginter; F. Treglia Qualified Third-Parties: H. Smith (Accountants LLP), D. Jones (Consultant)	Communications with outside counsel providing, requesting or reflecting legal advice regarding easement and operating agreement negotiations with Heights Building Ltd.	Attorney-Client Privilege; Attorney Work Product	325	415

Privilege Review

Row #	Description	Date	Pgs	Int/RFP	Privilege Asserted	UNITED STATES OF AMERICA ET AL V. SF ET AL PRIVILEGE LOG
1	Box 1 of zone litigation file for McIntosh claim - 24-z178-602	10/30/06 - 04/09	2467	RFP 01	Prepared in anticipation of litigation	USARIGSBY00000114PRIV - USARIGSBY00002580PRIV
2	Box 2 of zone litigation file for McIntosh claim - 24-z178-602	10/30/06 - 04/09	2728	RFP 01	Prepared in anticipation of litigation	USARIGSBY00002581PRIV - USARIGSBY00005308PRIV
3	Box 3 of zone litigation file for McIntosh claim - 24-z178-602	10/30/06 - 04/09	2766	RFP 01	Prepared in anticipation of litigation	USARIGSBY00005309PRIV - USARIGSBY00008074PRIV

Practical Tip

- Be mindful how your document may be protected under privilege and how it may be listed on the **Privilege Log**
- **Get an US attorney involved as soon as there is a possibility the conflict may escalate into litigation**
- Involvement of US attorney on daily basis (where litigation is imminent) may be useful in securing privilege by establishing Attorney-Agent relationship
- Involve Benrishi employee in the process as much as possible

Designing FTO Policies

What does an ideal FTO look like to minimize the risk?

- a) Perform prior art search on **products under R&D** and identify relevant claims
- b) Perform detailed non-infringement and invalidity analysis on the relevant claims **involving attorneys (A-C Privilege)**
- c) Obtain **attorney opinions** of non-infringement and invalidity on the relevant claims **(willful infringement)**
- d) Consider **design around options** on the relevant claims
- e) Consider **obtaining a license** on the relevant claims

Designing FTO

Perform detailed non-infringement and invalidity analysis on the relevant claims **involving attorneys** (a-c privilege)

- ✓ Schedule annual or semi-annual meeting with attorneys where the non-infringement and invalidity analysis are reported.
- ❖ **The analysis and reports may be covered by Attorney-Client Privilege**
- ❖ Inputs from attorneys would serve to improve the analysis
- ❖ Judgement could be made together with the attorney as to which relevant patent should be further analyzed (i.e. attorney opinion)

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ANNOUNCEMENTS

MAY. 2023

發明

THE INVENTION



Special Interview
待映画で知財を知る!? 日越合作映画に向けて

ニッポンのモノづくりと知財部と応援する 月刊「發明」

(5) マーキングされていない物品を発見した場合

「被疑侵害者は、自身の特許を実施していると考える物品が特許権者またはそのライセンサーによってマーキングされていない状態で販売されている事実を特許権者に対して通知すれば足り、……被疑侵害者がその責任を果たした場合には、特定された製品が特許実施を実施していないことを証明する責任は特許権者が負うことになる」²⁴

上記CAFC判例が示すとおり、権利行使を受けた被疑侵害者が特許権者のマーキング義務違反を指摘して過去分の損害賠償を免れるためには、マーキングされていない特許物品が販売されていた証拠をつかむことが重要となります。

前述のとおり、マーキング義務違反は先特許権者までさかのぼって検討することが有効です。特許権発生後、どこかの段階で特許権者もしくはそのライセンサーが特許物品の販売行為を行っていないか調査し、具体的な証拠（実際のマーキングされていない製品等）の特許権者に突きつけることで、過去分の損害賠償を免れられる可能性があります。

米国特許技術論争の論点整理

知的財産なぞかけ

筆者の趣味である落語は読面で演じられませんが、なぜかならば、いけるかも!! ということで、今回は自作、次回以降はセミナー受講者などから募った題材にまつわるなぞかけをご紹介します。お仕事の合間にクストッと笑っていただければ幸いです。

「落語の白うさぎ」とかかまして「落語を重むた特許出願」とききます。その心は、……どちらもホウタイが分厚いでしょう。

J.M. (法律事務所勤務)

本稿は筆者個人の資格で執筆したものであり、筆者の所属組織を代表する意見等を述べたものではありません。

もりしたじつろう

ジョージワシントン大学ロースクール卒業、米国法務博士。バイオニア(株)および富士フィルム(株)の知財部専門にて渉外・訴訟業務を担当し、両社では長年を要業。モルガンイス法律事務所東京オフィスにて特許出願、鑑定、ライセンス交渉、特許訴訟、特許調査等の知財業務を主に担当し、2021年パートナー就任。落語を演じるのの趣味としている。2021年よりIP Webinar: Better Safe Than Sorry と題したセミナーを月例で主催し、各回200人前後の参加者と共に米国特許論争に対する備えについて議論を行っている。

注1 35 U.S. Code § 287(a)

注2 35 U.S. Code § 286 - Time limitation on damages

"Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action."

注3 35 U.S. Code § 287(a)

注4 *Global Traffic Technologies LLC v. Morgan*, 620 Fed. Appx. 895, 905 (Fed. Cir. 2015)

注5 35 U.S. Code § 287(a)

注6 *Mfg. Res. Int'l v. CVI7Q Smartscopes*, 397 F. Supp. 3d 560 (D. Del. 2019)

注7 *Lubby Holdings LLC v. Chung*, 11 F.4th 1355, 1359 (Fed. Cir. 2021)

注8 <https://mri-inc.net/patents/>

注9 *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111 (Fed. Cir. 1996)

注10 *American Medical Sys. Inc. v. Medical Eng'g Corp.*, 6 F.3d 1523, 1537 (Fed. Cir. 1993)

注11 US4624,060の図1

注12 注7の判例のp.1359参照

注13 注9の判例のp.1112参照

注14 *Horatio Wash. Depot Techs. LLC v. Tolmar, Inc.*, Civil Action No. 17-1086-LPS (D. Del. 2018)

注15 35 U.S. Code § 287(a)

注16 *Grain Processing v. Am. Maize-Products*, 185 F.3d 1341 (Fed. Cir. 1999)

注17 *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 950 F.3d 860 (Fed. Cir. 2020)

注18 35 U.S. Code § 287(a)

注19 *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1345 (Fed. Cir. 2001)

注20 *Bundag, Inc. v. Gerrard Tire Co.*, 704 F.2d 1578, 1581 (Fed. Cir. 1983)

注21 US4,774,839の図12および14

注22 *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 498 F. Supp. 2d 718 (D. Del. 2007)

注23 *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308 (Fed. Cir. 2009)

注24 注7の判例のp.1359参照

Patent Litigation Bootcamp: Better Safe than Sorry 2023

2023年10月開講予定の全6回の参加型セミナー（定員20名）

10月： Pleading / Scheduling Conference

11月： Contentions / IPR / Motion to Stay

12月： Discovery / **Deposition Role Play**

01月： Markman Hearing

02月： Dispositive Motions / Pretrial Motions

03月： **Jury Trial Role Play** / Appeal

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IP Webinar Series: Better Safe than Sorry 2023

No. 1: Important IP Cases (2023.01.23)

No. 2: Preamble (2023.03.13)

No. 3: A-C Privilege (2023.05.22)

No. 4: Means Plus Function (2023.07.24)

No. 5: Extraterritorial Activity (2023.09.25)

No. 6: US Litigation Basics (2023.11.20)



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