

IN RE SEAGATE TECHNOLOGY, LLC:
THE CAFC REVISITS IN RE ECHOSTAR

On January 26, 2007, the CAFC announced that the petition for writ of mandamus in *In re Seagate Tech., LLC* is appropriate for en banc consideration. In so doing, the CAFC seeks once again to clarify the proper scope of the waiver of the attorney-client privilege and work product immunity in cases where parties accused of patent infringement rely on opinions of counsel to defend against claims of willful infringement. The outcome of this case has the potential to significantly impact the manner in which attorneys conduct patent prosecution and litigation and of equal importance the scope of protected communications between attorney and client where such communications are not related to the formation and delivery of the opinion which was the subject of waiver.

The following questions will be addressed:

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? *See In re EchoStar Commc'n Corp.*, 448 F.3d 1294 (Fed. Cir. 2006).
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?

In *EchoStar*, the CAFC made clear that on the issue of waiver "we apply our own law, rather than the law of the regional circuit." *EchoStar*, 448 F.3d at 1298. Under the scope of work-product waiver enumerated in *EchoStar*, all attorney-client communications related to the subject matter of advice of counsel that are used to establish a defense are subject to discovery. *Id.* at 1302. Further, non-communicated work product that references an attorney-client communication related to the same subject matter is also discoverable. *Id.*

In Footnote 4, the CAFC noted that waiver of the attorney-client privilege extends to advice given after litigation begins, which could indicate a waiver of the attorney-client privilege as to trial counsel. *Id.* If this interpretation of the CAFC's holding is correct, it could have a chilling effect on communication with the client regarding litigation strategy. The scope of protection of counsel's communicated work-product will be addressed in *Seagate*.