

01-1357, -1376, 02-1221, -1256

In The
**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

KNORR-BREMSE SYSTEME FUER NUTZFAHRZEUGE GMBH

Plaintiff-Cross Appellant,

v.

DANA CORPORATION,

Defendant-Appellant,

and

HALDEX BRAKE PRODUCTS CORPORATION,
and HALDEX BRAKE PRODUCTS AB

Defendants-Appellants.

On Appeal from United States District Court for the Eastern District of Virginia in
Case No. 00-CV-803-A, Judge Thomas Selby Ellis III

**BRIEF FOR AMICUS CURIAE ASSOCIATION OF CORPORATE
COUNSEL AGAINST FINDING AN ADVERSE INFERENCE UPON
ASSERTION OF ATTORNEY-CLIENT PRIVILEGE**

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Knorr-Bremse Systeme Fuer Nutzfahrzeuge Gmbh

v.

Dana Corporation, et. al.,

Appeal Nos. 01-1357, -1376, 02-1221, -1256

Certificate of Interest and Corporate Disclosure Statement

Counsel for Amicus Curiae the Association of Corporate Counsel, pursuant to Federal Circuit Rule 47.4 and Federal Rule of Appellate Procedure 26.1, certify the following:

1. The full name of every party or amicus represented by me is the Association of Corporate Counsel, formerly known as the American Corporate Counsel Association (ACCA).

Please note that ACC's Board of Directors includes Michel Cloes, the European Counsel for Dana Corporation. Dana Corporation is a party to the underlying action. Mr. Cloes, however, has no knowledge that ACC is filing amicus in this action. He has not been in any way involved in any kind of solicitation to file, the decision to file, or the development of the content of our arguments. ACC's amicus decisions are made by the Advocacy Committee of its Board, on which Mr. Cloes does not sit and with whom he did not deliberate or communicate. The decision to file was made by the Committee without knowledge or approval of the larger board consistent with the Committee's regular authority, and without even the knowledge by the Advocacy Committee members of the identity of any of the parties to this underlying action.

2. The name of the real party in interest represented by me is the amicus curiae.

3. All 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. There is no such corporation as listed in paragraph 3.

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

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ISSUE PRESENTED

When the attorney-client privilege and/or work product privilege is invoked by a defendant in an infringement suit, is it appropriate for the trier of fact to draw an adverse inference with respect to willful infringement?

STATEMENT OF INTEREST OF AMICUS CURIAE

The Association of Corporate Counsel (“ACC”), formerly the American Corporate Counsel Association, is a bar association of attorneys practicing in the legal departments of corporations and other private sector organizations worldwide. ACC promotes the common interests of its members, contributes to their continuing education, seeks to improve understanding of the role of in-house attorneys, and encourages advancements in standards of corporate legal practice. ACC includes a diverse mix of over 15,000 in-house attorneys who represent over 7,000 companies with operations in the United States and around the world. ACC’s members include counsel to corporations that both defend against patent infringement allegations and enforce patent rights. ACC’s Intellectual Property Law Committee has over 3,500 members, many of whom have direct responsibility for patent matters for their corporate clients.

ACC takes no position on the underlying merits of the parties' appeal. ACC's primary concern is with the pernicious effects that the adverse inference rule has had upon the attorney-client relationship and the protections necessary to the effective functioning of that relationship. ACC desires to ensure that its members' clients can obtain the full benefit of consultation with their chosen counsel. Candid consultation will only be sought and provided when the advice falls within the attorney-client privilege and work product doctrine. Neither are given their full and appropriate effect in patent matters so long as the fruits of such consultation may be probed by an adversary who can use the threat of an adverse inference instruction to access privileged communications concerning patent matters. To ensure consistent application of the attorney-client privilege and work-product doctrine and to ensure that corporate clients confronted with infringement claims may candidly consult with their chosen counsel, ACC opposes the adverse inference rule.

ARGUMENT

I. ACC's Members Rely on the Important Policy Considerations Underlying the Attorney-Client Privilege and Work Product Doctrine.

ACC's members daily rely upon the attorney-client privilege and work product doctrine in addressing their corporate clients' complex legal needs.

Corporate counsel are asked to provide advice on whether patents are valid, enforceable, and infringed, as well as to provide more qualitative assessments of the practical risks of their client's conduct. As with any other substantive legal area, these communications are encouraged by the attorney-client privilege and work product doctrine.

“The attorney-client privilege is the oldest of the privileges for confidential communications known to the common law.” *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981). It is a time-tested and fundamental principle because the privilege “encourage[s] full and frank communication between attorneys and their clients and thereby promote[s] broader public interests in the observance of law and administration of justice.” *Id.* The privilege recognizes such communication requires the client be “free from the consequences or the apprehension of disclosure.”” *Id.*

Both Federal common law and Fed. R. Civ. P. 26 embody the work product doctrine which acknowledges that “it is essential that a lawyer work with a certain degree of privacy, free from unnecessary intrusion by opposing parties and their counsel” and that without protection of attorney work product, counsel cannot “act within the framework of our system of jurisprudence to promote justice and protect their clients’ interests.” *Hickman v. Taylor*, 329 U.S. 495, 510-11 (1946).

Without these protections, neither client nor counsel can be sure that their communications will remain confidential. At a minimum, uncertainty over applicability of the privilege constrains the clarity of communication; even worse, candid communication between client and counsel will be foreclosed. Without certain and predictable privilege rules, companies would not invest the time and effort necessary to investigate the facts and seek and obtain related legal advice. More resources would be shifted to remedial “damage control” rather than preventive investigation that seeks to minimize legal problems.

II. The Adverse Inference Has Resulted in Opinion Drafting Practices Inconsistent with the Free and Candid Communication the Attorney-Client Privilege and Work Product Doctrine Aim to Facilitate.

ACC’s members desire the candid communication that the privileges allow. But patent practitioners asked to provide such advice know that their opinions may serve to rebut a charge of willful infringement. Patent counsel understand that, even if the client does not choose to waive privilege in an opinion, the adverse inference may effectively compel such waiver and thereby place their opinions at issue.

Caught between clients’ need for candid counsel, and this Court’s adverse inference rule that results in a strong likelihood that any opinion will become a trial exhibit, opinions of counsel have evolved both “to (1) inform and advise the client

about the legal ramifications of certain courses of conduct, and how to avoid legal difficulties; and (2) insulate the client from a finding of willful infringement, and hopefully even a finding of infringement at all.” Pamela I. Banner, *Willful Infringement and ‘Clearance’ Opinions of Counsel – Strategies and Pitfalls for Trial Counsel*, 619 PLI 989, 998 (PLI Patent, Copyrights and Literary Property Course, Handbook Series No. GO-00BN, 2000) (emphasis original). These two purposes “are not always aligned” and, indeed, the second purpose has evolved to drive everything from choice of counsel to the content and structure of opinion letters. *Id.*

In choosing counsel, clients are urged to carefully select the opinion drafter, not just to ensure that the chosen counsel will write a competent opinion, but also to identify counsel who will present well as a witness. *Id.* at 1007-08. Such counsel may not be the same trusted advisor the client normally would use for patent litigation and, lacking an established relationship with the client, may not be as effective in counseling the client concerning the true risk of infringement.

The scrutiny given to the content of opinions may further handicap counsel’s ability to “inform and advise” concerning patent matters. While “[a]n honest opinion is more likely to speak of probabilities than of certainties,” *Read Corp. v. Portec Inc.*, 970 F.2d 816, 829 n. 9 (Fed. Cir. 1986), this Court has also upheld

willfulness findings where counsel's opinion expressed some level of uncertainty. *E.g., Stryker Corp. v. Davol Inc.*, 234 F.3d 1252, 1256 (Fed. Cir. 2000). Faced with the need to insulate a client from a willful infringement finding, and understanding that the adverse inference rule may effectively compel a waiver concerning their advice, sophisticated counsel attempt to state unqualified opinions concerning the patent in question. *See* John F. Lynch, *Risky Business: Coping with a Charge of Willful Infringement*, 4 Sedona Conf. J. 31, n. 41 (2003) ("Lynch"); M. Patricia Thayer and Eliabeth Brown, *Tendering Advice of Counsel in Patent Litigation: Damned if You Do, Damned if You Don't*, 3 Sedona Conf. J. 111, 116 (2002) ("giving realistic, tempered advice can be tantamount to aiding the plaintiff in its proof of willfulness") ("Thayer, et al."). Thus, "attorney opinions addressing potential patent liability are now fashioned not as balanced analyses of the likely infringement exposure, but as future court exhibits intended to be displayed before a jury." Lynch, *supra*, at 37.

Other examples exist of the corrosive effect of the adverse inference upon the manner in which patent opinions are commissioned and drafted. *See* Mathew D. Powers and Steven C. Carlson, *The Evolution and Impact of the Doctrine of Willful Patent Infringement*, 51 Syracuse L. Rev. 53, 105, 113 (2001) (indicating that opinion letters may be drafted to confuse or with less than full candor).

Overall, the adverse inference rule encourages opinion-drafting practices inconsistent with the fundamental purpose of the attorney-client privilege and work product doctrine – candid discussion between attorney and client.

III. ACC Supports Abolishing the Adverse Inference Because it Undercuts Clients' Free Assertion of the Privilege, Leading to Burdensome Discovery of Collateral Issues and Impeding their Choice of Counsel.

The impact of the adverse inference upon counsel's advice is unfortunate; clients not only desire fully confidential and unhampered advice of counsel, they have come to expect it. Clients seek counsel's advice in a myriad of legal contexts. Consider trademark law, under which trademark infringers can be declared willful based on the totality of circumstances, including any proffered advice of counsel. However, no adverse inference arises from assertion of privilege over advice from trademark counsel because, as the Second Circuit explained:

[P]rivilege is designed to encourage persons to seek legal advice, and lawyers to give candid advice, all without adverse effect. If refusal to produce an attorney's opinion letter based on claim of the privilege supported an adverse inference, persons would be discouraged from seeking opinions, or lawyers would be discouraged from giving honest opinions. Such a penalty for invocation of the privilege would have seriously harmful consequences.

Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 226 (2d Cir. 1999).

Thus, clients understand that the privileges ensure that candid advice of counsel will remain confidential without an adverse inference being drawn.

Clients are thus able to reconsider their chosen course with the benefit of full and frank legal advice. *See generally* Deborah Stavile Bartel, *Drawing Negative Inferences Upon a Claim of the Attorney-Client Privilege*, 60 Brooklyn L. Rev. 1355, 1384-92 (1995) (“Bartel”).

That expectation cannot squarely apply, however, when clients receive advice concerning patents. Unaware that the normative privilege rules are inapplicable, clients may not appreciate that patent counsel’s opinion may omit a candid discussion of all risks of the clients’ chosen course. Even worse, others accused of infringement might seek to withhold key facts from opinion counsel, with the result that the client does not receive appropriate advice and the opinion is worthless. *See e.g.*, Thayer, et al., *supra*, at 116-17. Either way, the adverse inference indirectly encourages provision of incomplete advice to clients.

Indeed, this Court has recognized the “dilemma” faced by the accused infringer “who must choose between the lawful assertion of the attorney-client privilege and avoidance of a willfulness finding.” *Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 643 (Fed. Cir. 1991). For example, this Court has suggested that bifurcation may ameliorate the dilemma faced by the accused infringer. *Id.* at 644. Bifurcation is not a practical solution to the dilemma. Many trial courts will not bifurcate given concerns over efficiency and delay. *See* Ira V. Heffan, *Willful*

Patent Infringement, 7 Fed. Cir. B.J. 115, 147 (1997) (hereafter, “Heffan”). Where bifurcation is not sought or granted, and where the adverse inference results in waiver of privilege, the client’s choice of counsel may be impaired if opinion counsel is also trial counsel. *Id.* at 144-45.

Even if a client has the foresight and resources to choose different counsel for arguably similar tasks, discovery into opining counsel’s opinions raises complex, and as yet unresolved, issues concerning the scope of the waiver. *Id.*, at 142-43; Lynch, *supra*, at 43-46. For example, even within a district, judges diverge in the scope of waiver applied to attorney work product. *Compare Thorn EMI North America, Inc. v. Micron Tech., Inc.*, 837 F. Supp. 616 (D. Del. 1993) (waiver of privilege does not extend to work-product not communicated to client), with *Mosel Vitelic Corp. v. Micron Technology, Inc.*, 162 F. Supp.2d 307, 312-13 (D. Del. 2000) (work-product may be discoverable to some extent) and *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.*, 206 F.R.D. 396, 398 (D. Del. 2002) (reliance on counsel’s advice waives both attorney-client privilege and attorney work-product). Courts also dramatically diverge as to whether the waiver extends to trial counsel (*E.g.*, *VLT, Inc. v. Artesyn Tech., Inc.*, 198 F. Supp.2d 56, 58 (D. Mass 2002); *Aspex Eyewear, Inc. v. Elite Optik, Inc.*, 276 F. Supp. 2d 1084, 1092-1095 (D. Nev. 2003); and *Michlin v. Canon, Inc.*, 208 F.R.D. 172 (E. D. Mich. 2002)

(applying different standards of waiver to trial counsel), and the temporal scope of the waiver (*compare VLT*, 198 F.Supp. at 58 *with Akeva v. Mizuno Corp.*, 243 F. Supp.2d 418 (M.D.N.C. 2003)).

Regardless of how future courts address these issues, at minimum, all parties are forced to the expense of discovery into the opinion and the relationship between counsel and client. Such discovery, and the attendant collateral disputes occasioned by it, will occur in virtually every case given the minimal standards for pleading willful infringement. Heffan, *supra*, at 140.

IV. Abolishing the Adverse Inference Appropriately Validates the Attorney-Client Privilege and Work Product Doctrine While Simultaneously Advancing the Policy of Ensuring Respect For Valid Patent Rights.

Early cases did not explain the policy rationale for drawing an adverse inference from invocation of the privilege or doctrine. *See, e.g., Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1579-1580 (Fed. Cir. 1986). The apparent basis for the inference is the affirmative duty of due care to avoid infringing patent rights. *See e.g., Powers et al., supra* at 81. That duty flows from the need to discourage infringers from intentionally disregarding the exclusive rights granted to a patent owner. *Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389 (Fed. Cir. 1983).

But this Court has never explained the justification for drawing an adverse inference from a party's invocation of the attorney-client privilege or work product doctrine once an opinion has been obtained. Myriad reasons may exist for invoking these protections – ranging from a desire to have opining counsel try the case to avoiding complications of a waiver. Many of these reasons will have little or nothing to do with the merits of the opinion itself. *See Bartel, supra*, at 1399-1401. If the adverse inference aims to encourage compliance with the duty of due care, it does not do so where the privilege may be asserted for reasons other than that the opinion was unfavorable.

To the contrary, the adverse inference rule discourages compliance with the duty of due care. Its existence may result in at least some clients foregoing obtaining opinions of counsel. Thayer, et al., *supra*, at 111. It also undermines clients' ability to candidly and carefully weigh the risks of proceeding. Companies are thus encouraged to adopt “don't ask, don't tell” policies concerning patent rights, a situation that can actually damage compliance with the duty of due care. If encouraging compliance is important, it is far better to ensure candid communication between clients and attorneys so companies know when and how to invest resources to avoid patent infringement. Abolishing the adverse inference

further that goal, while simultaneously reinforcing the underlying principles justifying the privilege and doctrine.

CONCLUSION

Because the application of the adverse inference has resulted in substantial complexities and the rule is only weakly limited to applicable patent policy, this Court should abolish the rule. *See* Fed. R. Evid. 501 (privileges are to be construed “in light of reason and experience”). Doing so restores the balance by validating the attorney-client privilege and work product doctrine and the policies advanced by those protections.

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) and the Order of Appeal of September 26, 2003 (01-1357) because this brief contains 2,496 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).
2. This brief has been prepared in a proportionally spaced typeface using Microsoft Windows 2000 Word, in Times New Roman, 14 font.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that two copies of the foregoing BRIEF FOR AMICUS CURIAE ASSOCIATION OF CORPORATE COUNSEL AGAINST FINDING AN ADVERSE INFERENCE UPON ASSERTION OF ATTORNEY-CLIENT PRIVILEGE upon all counsel of record by depositing the same in the United States Mail, proper postage affixed and addressed as follows:

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