



**Licensing Executives Society – Arab Countries**

Advancing the Business of Intellectual Property Globally

Member of TAG-Foundation

عضو في طلال أبوغزاله فاؤنڊيشن

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**LES-Arab Countries Newsletter**

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## LES-AC Participates in Job Fairs at Jordanian



AMMAN - The Licensing Executives Society - Arab Countries (LES - AC), took part in the Career Days organized by the Applied Science Private University, Al-Ahliyya Amman University and Al-Zaytoonah University. Through such participation, LES - AC aims at briefing the attendees on its services and training courses that qualify graduates and job seekers, develop their capabilities and improve their chances of getting jobs that meet their skills and aspirations. The Career Days also provided the chance of direct contact between employers and job seekers that in return provided the youth with an outlook about the latest available job vacancies and trends in the labor market.

LES's participation played a positive role in helping job seekers get the looked-for jobs.

# LES - AC will hold a Workshop in the occasion of the World IP Day



المجمع العربي للملكية الفكرية  
محمود في طلال أبوغزاله فاؤندينشن

جمعية خبراء التراخيص - الدول العربية  
تطوير قطاع أعمال الملكية الفكرية عالمياً

تحت رعاية سعادة الدكتور طلال أبوغزاله  
يتشرف المجمع العربي للملكية الفكرية  
بالتعاون مع  
جمعية خبراء التراخيص - الدول العربية

بدعوتكم لحضور ورشة عمل والتي تعقد بمناسبة  
اليوم العالمي للملكية الفكرية  
تحت عنوان  
**العلامات التجارية المشهورة**

وذلك يوم الأحد الموافق ٢٠١٩/٤/٢٨ من الساعة العاشرة صباحاً ولغاية الساعة الواحدة ظهراً  
في ملتقى طلال أبوغزاله المعرفي، الشميساني - شارع عبدالرحيم الواكد - عمارة رقم ٤٦  
Email: [info@aspip.org](mailto:info@aspip.org) للتأكيد هاتف: ٥٠٠٢٥٠ (٠٦) ، فرعي: ٥٢٩

LES - AC intend to hold a workshop on the occasion of the World IP day entitled Well-known trademarks on May 5, 2019, at Talal Abu Ghazaleh Forum.

The host of experts will tackle a number of trademark related issues including the importance of trademarks and rights of trademark holders. Mr. Charles Shaban, executive director of Abu-Ghazaleh for Intellectual Property (AGIP), will brief attendees on concept of Famous Trademarks, their Values, in addition to Domain Names, while Dr. Mohammad Al Jaghbeer, head of Organizations and International Agreements at the Ministry of Industry and Trade and Supply / Industrial Property Directorate, will talk about the national and international legal framework for the protection of well-known trademarks.

## LES - AC intend to Hold Training Course in May

The Licensing Executives Society - Arab Countries (LES - AC) will be holding a training course titled “Intellectual Property Valuation” in May 2019, the most important subjects to be tackled in this course are:

- Introduction of Case Study: Overview of a Valuation Report
- What is the Opportunity Worth? Analysis of Value Drivers
- Case Study Application: Developing Support for Value Drivers
- Analysis of Risk Adjustment Methods, Identifying and Adjusting for the Unknown
- Case Study Application: Considering Reasonableness of Assumptions Using the Valuation Report in Negotiation

# **The attorney-client privilege and attorney work-product doctrine may prevent an adverse party from obtaining documents related to patent analysis conducted before the patents were acquired by a patent owner.**

By John Paul, Brian Kacedon, Cecilia Sanabria, Clara Jimenez and Alexander Poonai

Edited by John Paul, Brian Kacedon, Cecilia Sanabria, and Clara Jimenez

**Abstract:** A patent owner refused to produce documents related to a patent analysis it performed prior to purchasing the patents based on the attorney-client privilege and the work-product doctrine. After reviewing the documents, the district court found that some of the documents were entitled to protection and ordered the parties to submit declarations as to the nature of the remaining documents.

## **Background**

Acacia had an exclusive option to purchase certain patents from a third party, and Acacia's subsidiary, Limestone Memory Systems, acquired title to the patents under that option.

Limestone then sued Micron Technology for patent infringement in the Central District of California. During discovery, a dispute arose between the parties regarding the production of certain documents created prior to Limestone's acquisition of the patents that related to Limestone's and Acacia's analysis of the patents. Limestone refused to produce the documents on the grounds that the documents were protected from disclosure under the attorney-client privilege and the work-product doctrine.

Micron then requested that the court review 72 of the documents Limestone withheld on this basis and order Limestone to produce the documents. The case centered on the proper legal standard to determine whether specific documents were entitled to protection under the attorney-client privilege and the work-product doctrine.

The attorney-client privilege applies when a client seeks legal advice from a professional legal adviser. In such instance, the client can prevent confidential communications between the client and legal advisor from being disclosed to others unless the client waives privilege. The work product doctrine applies in a similar fashion to materials obtained and prepared by an attorney or the attorney's agent in anticipation of litigation or preparation for trial.

Micron argued Limestone could not withhold any documents made for a "business purpose," even if they touched on legal issues, because the attorney-client privilege applies only to documents created with a "primary purpose" of seeking or providing legal advice. Micron also argued Limestone had no standing to invoke the work-product doctrine because the documents were created on or before the date Limestone acquired the patents.

Limestone argued it could prevent disclosure of the documents to Micron because Limestone's parent company, Acacia, had an exclusive option to acquire the patents when

the documents were created. Limestone also contended the proper legal standard for work-product protection is whether, under the totality of the circumstances, the document was created because of anticipated litigation, and argued the document is entitled to protection so long as one purpose for creating the document was anticipated litigation.

### **Discovery Master Report**

The court reviewed the different standards for determining when the attorney-client privilege and the work-product doctrine may be invoked to prevent disclosure of documents in the litigation discovery process in the Ninth Circuit.

To be protected under the attorney-client privilege, a communication must have been for the purpose of seeking or providing legal advice. And when the communication involves in-house counsel who perform both a business and a legal role, the “primary purpose” of the communication must be to obtain or provide legal advice. The court explained that Limestone’s proposed “totality of the circumstances” test involved claims under the work-product doctrine, not the attorney-client privilege and refused to extend the “totality of the circumstances” test to the attorney-client privilege in district courts within the Ninth Circuit.

To be protected under the work-product doctrine, a document prepared in anticipation of litigation, based on the totality of the circumstances, is entitled to protection from discovery, even when the document had more than one purpose. The court then found Limestone could invoke the work-product protection for materials generated before acquiring the patents.

When reviewing the documents under these standards, the court explained that, although a business evaluation of the patents may have occurred simultaneously, the attorney-client privilege applied to documents generated primarily for the purpose of obtaining legal advice and the work-product doctrine applied to documents involving a business purpose inextricably intertwined with the legal purpose of the document. Given Acacia’s intention to enforce the patents, the legal analysis outside counsel conducted to determine whether to acquire the patents permeated the subject of the communications and gave rise to work-product protection.

As for the remaining communications, the court ordered Limestone to provide declarations by the people who authored or received the communications or other information supporting a claim of privilege so the court could have the information needed to determine whether attorney client privilege or work-product doctrine applied to those documents.

### **Strategy and Conclusion**

In determining whether a communication is entitled to protection from disclosure and discovery in litigation, courts may look to different standards under the attorney-client privilege and the work-product doctrine to determine what information is necessary to support a claim of protection under either the privilege or the doctrine. This can be particularly important in the context of documents created as part of a commercial transaction or negotiation where there can be a mixture of legal and business purposes for creating such documents.

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