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INTENTIONAL WAIVERS OF PRIVILEGE AND THE OPINION OF COUNSEL: CAN THE SCOPE OF DISCLOSURE BE MANAGED?

Amy L. Landers†

In any given patent dispute, the protections afforded by the attorney-client privilege and work product doctrines are foundational assumptions when documentation is created and client communications take place. The purpose of each doctrine is to encourage “full and frank communication” between lawyer and client,¹ and afford attorneys the opportunity to permit thorough trial preparation without the fear that such material will become available to opposing counsel through discovery.² Therefore, memorandum, e-mails and transcribed voicemails often contain sensitive information created based on the parties’ belief that the sensitive information will not become available to opposing counsel. However, when creating such sensitive documentation, attorneys may not always carefully consider the fact that the sensitive material may later be displayed—larger than life—to a jury examining whether their client has engaged in willful patent infringement.

At first blush, it may be difficult to conceive of circumstances under which such protections would be voluntarily waived. However, an accused infringer seeking to rely on an “advice of counsel” defense to a charge of willful infringement may choose to do so as a necessary price to pay to obtain the benefits of an advice of counsel defense. Generally, prior to invoking an advice of counsel defense, a client will engage opinion counsel, who is asked to consider the patent claims and the potentially infringing process, method or device, and

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1. *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981) (“The privilege recognizes that sound legal advice or advocacy serves public ends and that such advice or advocacy depends upon the lawyer’s being fully informed by the client.”).

2. *Hickman v. Taylor*, 329 U.S. 495, 510–11 (1947) (“In performing his various duties, however, it is essential that a lawyer work with a certain degree of privacy, free from unnecessary intrusion by opposing parties and their counsel.”).

to provide an independent, informed legal opinion as to whether infringement has occurred or whether the patent will likely be held valid and enforceable. If the client has exercised diligence in obtaining a competent, independent and informed opinion of counsel indicating that there is no infringement and/or that the patent is invalid or unenforceable, the client may then assert good faith reliance on counsel's opinion when the patent-holder claims that the allegedly infringing activity is willful. According to the courts, a patent holder's good faith reliance on an opinion of counsel constitutes important evidence that an infringement was not "willful."

After litigation commences and the alleged infringer decides to rely on an opinion of counsel defense, the alleged infringer must then produce the opinion of counsel to opposing counsel. Established precedent holds that the "deliberate injection of the advice of counsel defense into a case waives the attorney-client privilege."³ The issue then becomes the court's determination of the scope of the waiver. Does the waiver of attorney-client privilege extend solely to counsel's opinion? Does it include all communications with the client concerning the opinion? Does the waiver extend to trial counsel? Is the protection afforded to work product created in anticipation of litigation, such as trial strategy memoranda, also waived? Answers to these questions can be found in a number of district court decisions, each of which evidence the court's increasingly fractionalized view on the scope of waiver. In fact, even trial courts within the same district have reached strikingly different results.⁴ To make matters worse, the Federal Circuit has yet to provide any definitive ruling on the issue.⁵

Once litigation commences and the advice of counsel defense is invoked, rarely are agreements on the scope of waiver of privilege reached between the parties because patent holders typically have little incentive to agree to anything less than the fullest disclosure permitted by law. The potential to mine the alleged infringer's files

3. *Nitinol Med. Techs., Inc. v. AGA Med. Corp.*, 135 F. Supp. 2d 212, 217 (D. Mass. 2000).

4. *See Mosel Vitelic Corp. v. Micron Technology, Inc.*, 162 F. Supp. 2d 307, 311 (D. Del. 2000) (rejecting analysis of another district court within the same district as to the discoverability of draft opinions, stating "while the opinion of one district judge may be found to be persuasive, it is not binding on another district judge (even if that judge happens to sit in the same district)").

5. *Chiron Corp. v. Genentech, Inc.*, 179 F. Supp. 2d 1182, 1186 (E.D. Cal. 2001) ("[T]he Federal Circuit has been silent on the discovery issue of the extent of attorney-client/work product waiver primarily because such discovery issues have not surfaced in post-trial appeals to the knowledge of the parties or the undersigned").

in the hopes of obtaining a glimpse into its trial strategy or of discovering a “smoking gun” admission that would eliminate or substantially impair the alleged infringer’s defenses at trial creates a powerful incentive to hold out for maximum disclosure. On the other hand, alleged infringers will fight to keep the scope of the waived privileged information as narrow as possible. However, where the accused infringer has retained the same counsel for both opinion work and trial, trial strategy memoranda may be particularly at risk for production to the opponent.

Two recent district court decisions, *Aspex Eyewear, Inc. v. E’lite Optik, Inc.*,⁶ and *BASF Aktiengesellschaft v. Reilly Industries, Inc.*,⁷ demonstrate the courts’ difficulty in arriving at a uniform position on the scope of waiver and uncertainty facing patent holders and their counsel. *Aspex Eyewear* and *BASF* both illustrate the courts’ willingness to examine the specific facts and circumstances of each case when determining the scope of the waiver. Because the scope of the waiver question depends on the circumstances present in a particular case, both *Aspex Eyewear* and *BASF* demonstrate a troublesome lack of predictability for those involved in drafting opinions of counsel.

Given the uncertainty as to whether information held or obtained by opinion counsel will ultimately become discoverable by opposing counsel and admissible at trial, counsel preparing an opinion must exercise great care.⁸ This challenge is especially difficult, given that as a temporal matter, an opinion is typically generated well in advance⁹ of a court’s determination of the precise scope of the waiver in any particular case. Because of the possibility that the court might compel a broad scope of disclosure that may contain damaging admissions, additional consideration must be given to whether to proffer the advice of counsel opinion after litigation has commenced.

BASF and *Aspex Eyewear* illustrate the risks inherent in relying on an opinion of counsel at trial and provide lessons to those accused

6. 276 F. Supp. 2d 1084 (D. Nev. 2003).

7. 283 F. Supp. 2d 1000 (S.D. Ind. 2003).

8. Destruction of such documents once created may, under some case authority, open the door to sanctions. See generally *Mosel Vitelic Corp.*, 162 F. Supp. 2d at 313.

9. According to some Federal Circuit case law, an opinion should be drafted before the initiation of infringing activity. *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1390 (Fed. Cir. 1983) (stating that a client could not reasonably rely on written opinion received long after infringement and notice of the patent had been provided). As a practical matter, this may be well before litigation commences and long before the district court determines the scope of the waiver in a particular case.

of patent infringement and their counsel. As both courts found, the scope of the waiver rests to some degree in the hands of the accused infringer and their counsel. Thus, reviewing these decisions is helpful to those involved patent disputes in which the patent holder may become accused of willful patent infringement.

I. THE ROLE OF AN OPINION OF COUNSEL IN DEFENDING AGAINST A WILLFULNESS CLAIM.

A brief overview of the law of willful infringement and the relevance of opinions of counsel sheds light on the backdrop against which these battles are fought. The Federal Circuit has held that patent law imposes an affirmative duty of care to avoid infringement of the known patent rights of others.¹⁰ An infringer may breach this duty by engaging in infringing activity in disregard of a patent without a reasonable basis for believing they have a right to do so.¹¹ The stakes for establishing or avoiding a finding of willfulness may be high because where willfulness is established, a patentee may obtain up to three times the damages amount,¹² as well as the patent holder's attorney fees.¹³

Whether an infringer has acted willfully depends on an examination of the infringer's state of mind.¹⁴ Alleged infringers may defend against a willfulness charge by asserting good faith, justifiable reliance on a competent opinion of counsel stating that the patent

10. See, e.g., *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1190 (Fed. Cir. 1998) ("As a general matter, a potential infringer with actual notice of another's patent has an affirmative duty of due care that usually requires the potential infringer to obtain competent legal advice before engaging in any activity that could infringe another's patent rights").

11. See *Am. Med. Sys., Inc. v. Med. Eng'g Corp.*, 6 F.3d 1523, 1531 (Fed. Cir. 1993) ("A finding of willfulness requires the fact-finder to find that clear and convincing evidence shows 'that the infringer acted in disregard of the patent . . . [and] had no reasonable basis for believing it had a right to do the acts.'" (quoting *Stickle v. Heublein, Inc.*, 716 F.2d 1550, 1565 (Fed. Cir. 1983)).

12. 35 U.S.C. § 284 (2002) (authorizing the court to increase the damages up to three times the amount found or assessed). See also *Modine Mfg Co. v. Allen Group, Inc.*, 917 F.2d 538, 543 (Fed. Cir. 1990) ("The decision to increase damages is committed to the discretion of the trial judge . . .").

13. The Patent Act provides that "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party." 35 U.S.C. § 285 (2002).

14. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996) ("Whether an infringer acted willfully is a question of fact that rests on a determination of the infringer's state of mind."); see also *Underwater Devices*, 717 F.2d at 1390 ("A potential infringer has 'an affirmative duty' to seek and obtain competent legal advice from counsel before the initiation of any infringing activity.").

holder's rights either not infringed, invalid, unenforceable, or some combination of these.¹⁵

The test for determining whether an opinion of counsel is competent and adequate is whether the legal advice contained in the opinion of non-infringement is, under the totality of the circumstances, sufficient such that the client was reasonable in relying on it.¹⁶ The significance of obtaining an opinion of counsel is underscored by the Federal Circuit's determination that the jury may draw an adverse, albeit rebuttable, inference of willfulness from the defendant's failure to provide a competent opinion of counsel.¹⁷ As explained in *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*,¹⁸ "when an infringer refuses to produce an exculpatory opinion of counsel in response to a charge of willful infringement, an inference may be drawn that either no opinion was obtained or, if an opinion was obtained, it was unfavorable."¹⁹ Although the Federal Circuit's view on this adverse inference is subject to change,²⁰ the incentives for defendants to obtain and rely on an opinion of counsel as evidence of good faith in order to avoid the possibility of paying both treble damages and their opponent's attorney fees are likely to remain.

II. THE SCOPE OF THE WAIVER OF THE ATTORNEY-CLIENT PRIVILEGE AND WORK-PRODUCT PROTECTION

Although there is no question that there is a waiver of privilege when an opinion of counsel defense is asserted, there is considerable disagreement on the scope of the waiver. Some district courts require discovery only to the extent that the information has been actually

15. *Mahurkar*, 79 F.3d at 1579.

16. *Sri Int'l, Inc. v. Advanced Tech. Labs.*, 127 F.3d 1462, 1465 (Fed. Cir. 1997) ("When this defense is raised the court may consider the nature of the advice, the thoroughness and competence of the legal opinion presented, and its objectivity.").

17. *See Underwater Devices*, 717 F.2d at 1390.

18. 34 F.3d 1048 (Fed. Cir. 1994).

19. *Id.* at 1056; *see also Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 745 F.2d 11, 20 (Fed. Cir. 1984).

20. Although the Federal Circuit has permitted this adverse inference for approximately two decades, the continued viability of the doctrines is presently uncertain. Recently, the Federal Circuit has *sua sponte* granted en banc review in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GMBH v. Dana Corporation*. In *Knorr-Bremse*, the Federal Circuit requested briefing of whether it is "appropriate to draw an adverse inference with respect to willful infringement." 344 F.3d 1336, 1336-37 (Fed. Cir. 2003). The Federal Circuit also requested briefing on the questions of: 1) whether the adverse inference was appropriate when the attorney-client privilege and/or work product privileges were invoked; and 2) the application of any change in the current state of the law to the facts of the *Knorr-Bremse* case. *Id.*

disclosed to the client. These courts base their reasoning on substantive patent law, which examines willfulness by analyzing the client's state of mind to determine whether reliance on the opinion of counsel was reasonable.²¹ For example, in *Thorn EMI North America, Inc. v. Micron Technology, Inc.*,²² the court determined that work product that had never been disclosed to the client was not discoverable, reasoning:

The facts of consequence to the determination of a claim of willful infringement relate to the infringer's state of mind. Counsel's mental impressions, conclusions, opinions or legal theories are not probative of that state of mind unless they have been communicated to that client.²³

However, other district courts take a more expansive view of the information that must be produced, requiring production of all attorney-client and work product generated or relied upon by opinion counsel. These courts reason that "fundamental fairness" requires that such documents be produced to test the alleged infringer's positions, the basis and competency of the opinion and the reasonableness of the alleged infringer's reliance on the opinion. For example, in *Electro Scientific Industries, Inc. v. General Scanning, Inc.*,²⁴ the court drew the inference that the possibility of inconsistencies in an attorney's files—whether communicated to the client or not—was a sufficient grounds to establish the relevance and discoverability of such documents, stating:

It is possible that documents in opinion counsel's work product file could reflect very different analyses and conclusions than were set forth in the one disclosed [opinion] letter. The fact that the analyses and conclusions in the lawyer's private file were clearly at odds with the content of the disclosed opinion would tend to support an inference that there were additional communications between client and counsel and that in those communications the

21. See, e.g., *Micron Separations, Inc. v. Pall Corp.*, 159 F.R.D. 361, 363 (D. Mass. 1995); *Steelcase, Inc. v. Haworth*, 954 F. Supp. 1195, 1198 (W.D. Mich. 1997) ("[T]he infringer's 'intent and reasonable beliefs are the primary focus of the willful infringement inquiry'" (quoting *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 944 (Fed. Cir. 1992)). Indeed, the *Steelcase* court held that discovery addressed to the "legal correctness" of the opinion was irrelevant. *Id.* at 1199.

22. 837 F. Supp. 616 (D. Del. 1993).

23. *Id.* at 622.

24. 175 F.R.D. 539 (N.D. Cal. 1997).

client received opinions that were not consistent with the views expressed in the disclosed letter.²⁵

Further splits of authority exist as to whether material generated after litigation commences should be treated differently than pre-litigation material. Although some courts hold that post-litigation material should be treated no differently and is thus discoverable,²⁶ other courts limit disclosure to only communications and documents created prior to the commencement of the lawsuit, permitting greater protection for litigation work-product.²⁷

It is against this backdrop that clients and counsel must make their daily decisions—the significance of which may not become known until years down the road when both are embroiled in litigation. Therefore, awareness of critical points and decisions, as illustrated in *Aspex Eyewear* and *BASF*, provide some useful guidelines for the issues that must be considered when such decisions are made.

III. *ASPEX EYEWEAR, INC. v. E'LITE OPTIK, INC.*: OPINION COUNSEL IN DUAL ROLES AND THE EXPANDED SCOPE OF WAIVER

In *Aspex Eyewear, Inc. v. E'lite Optik, Inc.*, the court considered a plaintiff patent-holder's motion to compel production of documents after the defendant asserted good faith reliance on two opinions of counsel, each drafted by a different attorney.²⁸ Each opinion counsel had undertaken at least two roles for the defendant. The first opinion counsel provided the defendant with an oral opinion, and he was also defendant's former trial counsel in the litigation.²⁹ However, this first opinion counsel could not recall what information had been

25. *Id.* at 545.

26. *See, e.g.,* *Chiron Corp. v. Genentech, Inc.*, 179 F. Supp. 1182, 1188 (E.D. Cal. 2001) ("While there is some authority that cuts off the waiver at the time of the filing of the action, the better authority requires that *all* communications, both pre and post-complaint filing, should be disclosed.") (emphasis in original). The *Chiron* court relied in part of the fact that the defendant continued to engage in the conduct that was accused of infringement. "Therefore, [the defendant]'s state of mind throughout the trial, i.e., the reasonableness of its reliance on the advice of counsel, is pertinent throughout the litigation." *Id.*

27. *Dunhall Pharms., Inc. v. Discus Dental, Inc.*, 994 F. Supp. 1202, 1205–06 (C.D. Cal. 1998) (balancing the plaintiff's need for discovery against the defendant's interest in protecting work product and finding that "[a]lthough defendants have waived work product protection by asserting the advice of counsel defense, that waiver is not absolute" and "[o]nce the lawsuit is filed, the waiver of work product protection ends.").

28. 276 F. Supp. 2d 1084 (D. Nev. 2003).

29. *Id.* at 1086.

transmitted to the client.³⁰ Defendant's second opinion counsel had been also designated as an expert witness in the case.³¹

As for the oral opinion of counsel, *Aspex Eyewear* held that fairness required disclosure of all documents that the attorney had reviewed, considered or authored relating to infringement, validity or enforceability of the patent. The court reasoned:

By designating its former litigation counsel as a witness to support its advice of counsel defense, [the defendant] has waived the attorney-client privilege as to all of [its counsel]'s communications and documents relating to the advice he rendered on infringement, validity and enforceability of the Patents-in-suit. . . . Without discovery of his work product, plaintiffs will be unable to ascertain the basis and facts upon which his opinions are based and will be impaired in their ability to effectively cross-examine on these critical issues.³²

This holding broadened the scope of discovery to include all communications between client and counsel concerning patent issues, regardless of whether or not such issues directly concerned the opinion. The *Aspex Eyewear* court then went further, requiring disclosure of material generated after the litigation had commenced. Acknowledging that the court "would ordinarily be inclined to impose a temporal limitation on the waiver at the point the lawsuit was filed in the absence of the allegation that the defendant's willful infringement was ongoing,"³³ *Aspex Eyewear* found the waiver had a broader temporal scope. Specifically, the court determined that the oral opinion's lack of specificity, counsel's inability to recall what was reviewed and the basis of his opinions justified permitting the plaintiff more leeway into the willfulness, infringement, validity and enforceability of the disputed patents.³⁴ However, the court stopped short of requiring the defendant to produce materials generated by the defendant's current litigation counsel.³⁵

As for the second opinion drafted by the attorney, later designated as an expert witness, *Aspex Eyewear* held that the defendant had waived the attorney-client privilege for all communications and documents relating to any advice concerning

30. *Id.* at 1087.

31. *Id.* at 1086.

32. *Id.* at 1096.

33. *Id.* at 1095.

34. *Aspex Eyewear*, 276 F. Supp. at 1095-96.

35. *Id.*

patent infringement, validity or enforceability regardless of whether such information had been communicated to the defendant.³⁶ This portion of the *Aspex Eyewear* opinion is consistent with the weight of existing authority, which holds that all materials relied up or considered by testifying experts are discoverable.³⁷

The breadth of disclosure required by *Aspex Eyewear* is significant to both those obtaining an opinion of counsel and to those involved in patent litigation in which willfulness is asserted. Fundamentally, the *Aspex Eyewear* court was persuaded by the reasoning set forth in the line of cases broadening the scope of waiver. In addition, *Aspex Eyewear* scrutinized the defendant's actions and broadened the scope of discoverable documents based on the roles that both opinion counsel had undertaken. Further, the *Aspex Eyewear* court essentially concluded the defendant bore the brunt of its counsel's inability to recall and separate which material had and had not been communicated to the client and compelled the defendant to produce a broader range of otherwise protected material.

In asking opinion counsel to perform additional tasks, particularly tasks in which sensitive information may be conveyed, a careful assessment should be made of the possibility that documents and information exchanged in all relationships relating to counsel's opinion may become discoverable. Despite the economic efficiencies of exploiting counsel's familiarity with a particular patent and/or infringement scenario by asking counsel to take on multiple roles in the dispute, increasing the scope of counsel's representation will likely increase the type and quantity of harmful documentation and information that may later be compelled for disclosure.³⁸ Further, communications between opinion and trial counsel should be curtailed to minimize the risk that trial counsel's files may become discoverable.

36. *Id.* at 1096.

37. *In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1375 (Fed. Cir. 2001) ("[T]he 1993 amendments to the Rule 26 of the Federal Rules of Civil Procedure make clear that documents and information disclosed to a testifying expert in connection with his testimony are discoverable by the opposing party, whether or not the expert relies on the documents and information in preparing his report.").

38. The additional risk of disqualification of trial counsel should also be considered. *See Rohm and Hass Co. v. Lonza, Inc.*, 1999 U.S. Dist. LEXIS 13919 (E.D. Pa. 1999) (entering disqualification order for trial counsel who had authored a written opinion, based on state rules of professional conduct which prohibited trial counsel from testifying before a jury); *but see Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 55 U.S.P.Q. 2d 1662 (S.D.N.Y. 2000) (denying motion to disqualify opinion counsel).

Communications between the opinion counsel and the client should be carefully catalogued, so that material that had been disclosed to the client may be readily identified. Such a catalogue may create a persuasive record that only certain material must be disclosed and that, ultimately, the scope of discoverable documents should be narrow. Additionally, as *Aspex Eyewear* points out, careful examination of all work product and attorney client communications should be performed before the decision is made to disclose an opinion counsel as a testifying expert witness.

IV. *BASF AKTIENGESELLSCHAFT V. REILLY INDUSTRIES, INC.*: OPINION COUNSEL'S DUAL ROLE AND INCONSISTENT POSITIONS.

In *BASF Aktiengesellschaft v. Reilly Industries, Inc.*, (“BASF”), the court considered the scope of production required after the defendant disclosed a written opinion of counsel.³⁹ The breadth of the plaintiff patent holder’s request encompassed all documents, regardless of when such documents were created and regardless of whether such documents had been sent to the client.⁴⁰ Because the defendant retained the same lawyers for the written opinion and for trial,⁴¹ as a practical matter the plaintiff’s request sought trial counsel’s internal notes and memoranda regarding at least portions of the litigation defense. The potential impact of the plaintiff’s request was likely to have placed at least some significant documents at risk, such as trial strategy or analysis regarding perceived weaknesses in the defense’s case. As the defendant argued in the *BASF* case, the plaintiff’s request threatened to “needlessly and unfairly interfere with trial counsel’s defense of the lawsuit, and might even create an ‘ethical dilemma’ whereby trial counsel might be drawn into being a material witness.”⁴²

The plaintiff argued that full disclosure of defense counsel’s files was necessary because such documents were “highly relevant to the issue of competency and, in turn, the reasonableness of the reliance on that opinion.”⁴³ Significantly, the plaintiff also established that the

39. 283 F. Supp. 2d 1000 (S.D. Ind. 2003).

40. *Id.* at 1002.

41. *Id.* at 1003.

42. *Id.* at 1002.

43. *Id.* at 1004. This argument is consistent with some courts’ view that work product that has never been communicated to a client is discoverable as relevant to the competence of the opinion and, therefore, the reasonableness of the client’s reliance on the opinion of counsel. See, e.g., *Novartis Pharms. Corp. v. Eon Labs Mfg., Inc.*, 206 F.R.D. 396 (D. Del. 2002). The court in *Norvartis* relied on an analysis of the waiver doctrine in addition to reasoning that the

defendant had taken positions in the litigation that were inconsistent with those asserted in the written opinion. The court rejected the defendant's assertion that positions presented pre-litigation were consistent with those presented post-litigation, finding instead that the inconsistency "directly calls into question the competence of [defendant's] opinion of counsel and the reasonableness of its reliance on an opinion from which Reilly may now be attempting to distance itself."⁴⁴

For documents created before the litigation was filed, the *BASF* court followed the weight of established precedent and compelled production of all attorney-client privileged documents regarding the subject matter of the opinion letter.⁴⁵ In contrast, the court compelled production of pre-litigation work product only to the extent that such information had been disclosed to the accused infringer, reasoning that "the attorney's 'mental impressions, conclusions, opinions or legal theories' are not relevant to the effort unless they were communicated to the client."⁴⁶ *BASF* rejected the expansive view of waiver adopted by a number of courts that compelled production of all work product, rejecting the view that an attorney's private papers were probative of the client's ability to rely on the attorney's advice.⁴⁷

The most significant holdings of *BASF* concern post-litigation material. In that regard, *BASF* compelled production of both attorney-client privilege and work product information "to the extent documents were communicated to defendants."⁴⁸ After reviewing the conflicting lines of authority, the court ultimately compelled production of post-litigation documents based on the facts presented. Specifically, the court held that inconsistencies between the written opinion of counsel and the defendant's litigation positions in the case

plaintiff needs to obtain sufficient information to test the competency and reasonableness of reliance on the opinion, stating:

In the Court's view, it is critical for the patentee to have a full opportunity to probe, not only the state of mind of the infringer, but also the mind of the infringer's lawyer upon which the infringer so firmly relied. There is no reason why the alleged infringer's waiver of the attorney-client privilege should not be considered absolute, encompassing materials typically protected by the work product doctrine.

Id. at 399.

44. *BASF*, 283 F. Supp. 2d at 1006-07.

45. *Id.*

46. *Id.* at 1004-05.

47. *Id.* at 1005.

48. *Id.* at 1006.

at bar justified broad disclosure of privileged and work product material:

Contradictions contained in the opinion of counsel revealed in the summary judgment briefs now before the Court compel this result . . . Fairness dictates that the waiver extends post-suit once a party relying on the advice-of-counsel defense changes or alters its position as stated in the earlier advice-of-counsel opinion.⁴⁹

BASF went even further with respect to attorney-client communications. Because the defendant had unsuccessfully contended in opposing the motion to compel that no inconsistent positions had been asserted, the court held that the waiver “must necessarily extend to all such post-suit communications regarding the subject matter of the opinion letter rather than just communications that contradict or cast doubt on earlier opinions.”⁵⁰ Otherwise, the court reasoned, the defendant might insist that “no such [contradictory] communications exist” and produce little documentation as a result.⁵¹ Another significant aspect of *BASF* was the court’s determination that the fact that the defendant had engaged the same counsel for the written opinion and the litigation was “not outcome determinative.”⁵² In other words, the court gave no deferential protection to work product of the opinion counsel who was also acting as trial counsel in the case.⁵³ *BASF* reasoned that the defendant had “brought this problem on itself by choosing to retain the same counsel to litigate this matter that gave the advice-of-counsel opinion.”⁵⁴

BASF underscores that the court’s attention to the specifics of the case influenced its findings on the scope of the waiver, here holding that the defendant’s inconsistencies in turn supported an inference that counsel’s work product contained contradictory and therefore relevant information. Thus, a copy of the final opinion should be provided to trial counsel so that the inconsistencies can be discovered prior to the production of the opinion. Although in a typical case, care should be taken to avoid such inconsistencies to preserve the

49. *Id.* (citation omitted).

50. *BASF*, 283 F. Supp. 2d at 1007 n.5.

51. *Id.*

52. *Id.* at 1004.

53. *Id.* at 1007. This is consistent with at least one other case, which characterized the defendant’s retention of counsel for both opinion and litigation work as an “unconventional and risky arrangement.” *Novartis Pharms. Corp. v. Eon Labs Mfg.*, 206 F.R.D. 396, 399 (D. Del. 2002).

54. *Id.* at 1007.

defense's credibility for trial, *BASF* further highlights that such discrepancies can result in a relatively broad waiver of information that might otherwise have been protected.

V. CONCLUSION

Despite the lack of harmony in court decisions regarding the scope of the waiver of the attorney-client privilege and the attorney work-product doctrines when an opinion of counsel defense is asserted in response to a charge of willful infringement, it is evident that by careful strategic planning, alleged infringers, may be able to restrict the scope of waiver. *Aspex Eyewear* and *BASF* demonstrate the significant consequences that decisions regarding opinion counsel may have, decisions that may provide plaintiffs the opportunity to obtain information and material that might otherwise remain protected. Therefore, careful management is necessary to control the scope of the waiver.

