

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

01 COMMUNIQUE)	CASE NO. 1:06-cv-00253
LABORATORY, INC.,)	
)	JUDGE SARA LIOI
)	
Plaintiff,)	MAGISTRATE JUDGE
)	KATHLEEN B. BURKE
v.)	
)	
CITRIX SYSTEMS, INC., et al.,)	MEMORANDUM
)	OPINION AND ORDER
)	
)	
Defendants.)	

Plaintiff 01 Communique Laboratory, Inc. (“Plaintiff” or “Communique”) has filed a notice of discovery dispute in which it challenges assertions of attorney-client privilege by Defendants Citrix Systems, Inc. and Citrix Online, LLC (collectively, “Defendants” or “Citrix”). As a sanction for the alleged improper assertions of privilege, Communique seeks to bar Citrix from relying at trial on a patent license that its damages expert uses as a basis for his opinion as to what a reasonable royalty for the technology at issue in this case would be.

The underlying privilege issues raised by the dispute include whether a corporate party, when asked about its “beliefs” as to legal conclusions (in this case, whether the licensed patents were valid and infringed), may properly refuse to answer based on testimony by its [Fed. R. Civ. P. 30\(b\)\(6\)](#) witness that the corporation’s “beliefs” on those issues are inseparable from the legal advice it received from its attorneys. The issues raised also include whether a party in an infringement action, by relying on a license it has negotiated with a third party to establish a reasonable royalty, thereby waives its attorney-client privilege with respect to legal advice it

received related to the patents that are the subject of the license. For the reasons set forth below, the undersigned answers “Yes” to the first question and “No” to the second. The Court concludes that Citrix properly invoked the attorney-client privilege with respect to its “beliefs” as to whether the licensed patents were valid and infringed and as to two related documents and that Citrix has neither expressly nor impliedly waived the privilege with respect to the matters raised by Communique. Accordingly, Communique’s request for a sanction is denied.

I. Background

This Order is the second in this case to address a discovery dispute related to damages. Pursuant to the first such Order, entered on December 29, 2014 (Doc. 325), Communique was afforded discovery, including deposition testimony and documents, regarding seven licenses entered into by Defendants. The prior Order expressly cautioned that it did not authorize Communique to obtain information protected by the attorney-client privilege and/or the work-product doctrine. Doc. 325, p. 8.

The present dispute raises privilege issues with respect to one of the seven licenses, the Tridia license. In its notice of discovery dispute (Doc. 329), Communique challenges Citrix’s assertions of privilege made during the Rule 30(b)(6) deposition of Citrix’s in-house counsel, Robert Feldman, when Feldman was asked to state Citrix’s “beliefs” at the time it entered into the Tridia license as to whether the Tridia patents were valid and infringed by Citrix. Plaintiff also challenges Citrix’s assertions of privilege and/or attorney work-product with respect to two documents pertaining to Tridia.¹ Communique argues that the information withheld by Citrix is not privileged and/or that Citrix has either expressly or impliedly waived the privilege. The crux

¹ Plaintiff identified the documents as CTX-COL0492134 (Revised Privilege Log Entry #98) and Revised Privilege Log Entry #2. Citrix produced Revised Privilege Log Entry #98 but later claimed the right to “claw back” that document pursuant to the terms of the Protective Order (Doc. 28) because Citrix contends it is privileged and was inadvertently produced.

of Communique's argument is that, because Citrix has chosen to rely on the Tridia license for purposes of its reasonable royalty damages analysis,² it has waived attorney-client privilege with respect to the Tridia license. Doc. 332, Doc. 335. As a sanction for the alleged improper assertions of privilege, Communique seeks to preclude Citrix from continuing to rely on the Tridia license in this case. Doc. 329, p. 2, Doc. 332, pp. 3-4.

Citrix's response to Communique's Notice of Discovery Dispute asserts that it has produced all non-privileged information requested of it and that it is not required to waive privilege in order to rely on the Tridia license. Doc. 330. Further, Citrix argues that Plaintiff's request to exclude the Tridia license is premature and not a discovery matter. Doc. 330.

The Court ordered the parties to conduct a meet and confer in an attempt to resolve the dispute. Doc. 331. On March 13, 2015, the parties filed a joint status report indicating that they were unable to resolve the discovery dispute. Doc. 332. The Court thereafter ordered the parties to file memoranda in support of their respective positions (Doc. 333) and the parties have since filed their memoranda in support (Doc. 334, Doc. 335).³

II. Law and Analysis

With respect to discovery issues, "Federal Circuit law applies when deciding whether particular written or other materials are discoverable in a patent case, if those materials relate to an issue of substantive patent law." *In re MSTG, Inc.*, 675 F.3d 1337, 1341 (Fed. Cir.

² Damages in a patent infringement case may be determined based on evidence as to what a reasonable royalty would be under the circumstances. *See* 35 U.S.C. § 284. In conducting a reasonable royalty analysis, courts may consider "rates paid by the licensee for the use of other patents comparable to the patent in suit." *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F.Supp. 1116, 1120-1121 (S.D.N.Y. 1970), judgment modified on other grounds, 446 F.2d 295 (2d Cir. 1971).

³ Per the Court's March 13, 2015, order (Doc. 333), the parties have submitted the two documents at issue, Revised Privilege Log Entry # 2 (Doc. 334-5) and Revised Privilege Log Entry # 98 (Doc. 334-3), for an *in camera* review; the relevant privilege log sheets (Doc. 334-4, Doc. 334-6); and Feldman's deposition or portions thereof (Doc. 334-1, Doc. 335-2). Also, per the Court's April 13, 2015, order, on April 15, 2015, the parties filed redacted versions of Doc. 334 (redacted version Doc. 336) and Doc. 335 (redacted version Doc. 337).

2012)(quoting *Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc.*, 265 F.3d 1294, 1307 (Fed. Cir. 2001)). Information related to reasonable royalties has a “significant bearing on the substantive issue of patent damages.” *Id.* (citing *Advanced Cardiovascular Sys.*, 265 F.3d at 1303 and *In re EchoStar Commc’ns Corp.*, 448 F.3d 1294, 1298 (Fed. Cir. 2006)). Since this dispute pertains to the substantive issue of patent damages, it is appropriate to apply Federal Circuit law and law developed in other Circuits that is consistent with Federal Circuit law to determine whether the information sought by Plaintiff is privileged.⁴

The Attorney-Client Privilege

“The attorney-client privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice.” *Genentech, Inc. v. United States ITC*, 122 F.3d 1409, 1415 (Fed. Cir. 1997) (citing *American Standard Inc. v. Pfizer, Inc.*, 828 F.2d 734, 745 (Fed. Cir. 1987)). The privilege is an exception to the general rule that a party may obtain discovery regarding any matter that is relevant to any party’s claim or defense. The burden of demonstrating that privilege applies rests with the party claiming privilege. *Davis v. Drake*, 2014 WL 5795554, * 3-4 (N.D. Ohio Nov. 6, 2014). The exception for privileged information has long been recognized in case law and is incorporated in Fed. R. Civ. P. 26(b)(1). The leading case regarding the application of the attorney-client privilege in the context of a corporate client is *Upjohn Co. v. United States*, 449 U.S. 383 (1981). In *Upjohn*, the Supreme Court explained the rationale for the privilege:

Its purpose is to encourage full and frank communication between attorneys and their clients and thereby promote broader public interests in the observance of law and administration of justice. The privilege recognizes that sound legal advice or advocacy serves public ends and that such advice or advocacy depends upon the

⁴ See also Fed R. Evid. 501 (“The common law – as interpreted by United States courts in the light of reason and experience – governs a claim of privilege . . .”). Plaintiff agrees that Federal Circuit law applies but notes that there is limited relevant Federal Circuit case law. Doc. 335, p. 3, n. 6. Defendant does not clearly state a position with respect to whether Federal Circuit law applies.

lawyer's being fully informed by the client. . . . Admittedly complications in the application of the privilege arise when the client is a corporation . . . but this Court has assumed that the privilege applies when the client is a corporation . . .

Upjohn, 449 U.S. at 389-390.

Upjohn also emphasized the link between the purpose of the privilege and the need for certainty in its application:

[I]f the purpose of the attorney-client privilege is to be served, the attorney and the client must be able to predict with some degree of certainty whether particular discussions will be protected.

449 U.S. at 393.

The Work-Product Doctrine

The work-product doctrine is a second exception to the general rule of discovery. “The work-product privilege protects the attorney’s thought processes and legal recommendations” made in anticipation of litigation. *Genentech*, 122 F.3d at 1415. (quoting *Zenith Radio Corp. v. United States*, 764 F.2d 1577, 1580 (Fed. Cir. 1985)); Fed. R. Civ. P. 26(b)(3). “In contrast to the attorney-client privilege, [t]he work-product doctrine . . . can protect ‘documents and tangible things’ prepared in anticipation of litigation that are both non-privileged and relevant.” *In re EchoStar*, 448 F.3d at 1301. A party seeking discovery may overcome the work-product doctrine by showing (1) substantial need and (2) that the party cannot obtain the requested information by other means without undue hardship. Fed. R. Civ. P. 26(b)(3)(A)(ii).

Waiver of Privilege

A party may expressly waive the attorney-client privilege through “disclosure of confidential communications or attorney work-product to a third party, such as an adversary in litigation.” *Genentech*, 122 F.3d at 1415. However, “if a party has used reasonable effort to protect a confidence, courts may find a subsequent disclosure ‘inadvertent’ and, thus not a

waiver of privilege.” *Id.* Fed. R. Evidence 502(b) recognizes that inadvertent disclosure does not operate as a waiver in certain circumstances, permitting a party to “claw back” a document inadvertently produced. The Protective Order in this case contains a clawback provision. Doc. 28, p. 5.

A party may impliedly “waive the attorney-client privilege when, for instance, it uses the advice to establish a defense.” *In re EchoStar*, 448 F.3d at 1301 (discussing the extent of waiver in a case where the defendant asserted advice of counsel as a defense to a claim of willful infringement). In instances where a party selectively waives the attorney-client privilege for favorable advice but asserts its privilege on unfavorable advice, the party may be said to be using the attorney-client privilege as both a “sword and a shield,” which may lead to an inequitable result. *Id.* Thus, waiver may be found “when a party defends its actions by disclosing an attorney-client communication.” *Id.*

A. Feldman deposition

Plaintiff refers to five portions of the Rule30(b)(6) deposition of Robert Feldman (the “Feldman deposition”) during which it contends Defendants improperly invoked attorney-client privilege. Doc. 332, p. 2; Doc. 335, p. 3, n. 7. The sections identified by Plaintiff involve the following questions:

Question 1: Feldman deposition (Doc. 335-2) lines 25:11-26:7 - “What motivated Citrix to license the Tridia patents?”

Question 2: Feldman deposition (Doc. 335-2) lines 29:1-23 - “What products or services did Citrix believe would be covered by the Tridia license at the time it entered into the license?;

Question 3: Feldman deposition (Doc. 335-2) lines 29:24-30:22 - “Did Citrix believe the Tridia patents to be infringed by Citrix’s products at the time it entered into the license?”;

Question 4: Feldman deposition (Doc. 335-2) lines 30:23-31:19 - “Mr. Feldman, the question, as posed, simply requests Citrix’s subjective belief as to whether or not its products were covered by the Tridia patents at the time it entered into the license?”; and

Question 5: Feldman deposition (Doc. 335-2) lines 56:21-61:22 - “Did Citrix believe the Tridia patents to be valid at the time it entered into the license?”

The Court’s review of the portions of the Feldman deposition transcript cited by Communique is summarized below. It shows that, while Feldman did refuse to answer some of Plaintiff’s questions, citing attorney-client privilege, he did in fact answer others without disclosing privileged information.

Question 1: A review of the cited portions of the Feldman deposition shows that Feldman did not refuse to answer Question 1. Rather, after being cautioned by Citrix’s counsel not to disclose any privileged information in his responses, Feldman did provide an answer to that question. Doc. 335-2, lines 25:24-26:7.

Question 2: After being cautioned by Citrix’s counsel not to disclose privileged information, Feldman described statements Tridia made as to Citrix products Tridia contended were relevant to its patents. Doc. 335-2, lines 29:11-23.

Questions 3 and 4: Feldman did refuse to answer Questions 3 and 4 pertaining to Citrix’s belief regarding whether its products infringed the Tridia patents. In doing so, he stated that he could not answer those questions without disclosing privileged communications. Doc. 335-2, lines 30:6-19 and lines 31:5-19.

In response to Question 3, Feldman stated:

I’m not sure how I could answer that question without disclosing what I believe would be legal advice rendered to the company with respect to this matter. . . . my response would reveal attorney-client privileged information

Doc. 335-2, lines 30:8-18.

In response to Question 4, he stated:

I'm not sure how I could articulate Citrix's belief about a question, about a legal question, such as infringement or noninfringement, without necessarily revealing – because it's a legal question. It's a question the company got legal advice on.

I'm not sure how I could render an answer that would not expose the legal advice the company received.

Doc. 335-2, lines 31:10-19.

Question 5: The transcript cite provided by Communique for questions and responses regarding whether Citrix believed the Tridia patents to be valid actually encompasses several different questions posed by Communique's counsel, some of which Feldman said he could not answer without disclosing privileged information, e.g., Doc. 335-2, lines 58:8-13 and lines 61:2-5, and others as to which he provided substantive answers, e.g., Doc. 335-2, lines 57:8-12, and lines 61:6-22. In asserting privilege, Feldman stated:

So the company's belief about validity of the Tridia patents is exclusively - - the company relies exclusively on the advice of counsel for such legal determinations.

Doc. 335-2, lines 61:2-5.

Communique relies upon [Davis v. PMA Companies, Inc., 2012 WL 3922967, * 8 \(W.D.Okla. Sept. 7, 2012\)](#) to support its argument that the attorney-client privilege does not cover "beliefs." Doc. 335, p. 3, n. 8. *Davis* was an employment termination action in which a natural person, an officer of the defendant company, was asked questions regarding his handling of the plaintiff's ethical complaints. *Id.* at * 8. When asked about his personal belief as to whether he should have documented and reported the plaintiff's complaints, the deponent refused to answer based on privilege. In finding that no privilege applied to the deponent's

personal beliefs, the court noted that the plaintiff had not asked the deponent whether he had received legal advice or the content of the advice. *Id.* at *8.

Davis is inapposite. Communique's argument fails to recognize the difference between a corporate entity such as Citrix and a natural person such as the deponent in *Davis*. See [Upjohn](#), 449 U.S. at 389-390 (recognizing that a corporation "is an artificial creature of the law and not an individual"). A corporation does not have personal beliefs in the same way that a natural person does. Here, when asked about Citrix's "beliefs" as to whether its products infringed the Tridia patents and whether Tridia's patents were valid, Citrix's in-house counsel Robert Feldman made clear that Citrix's beliefs on such legal questions were inseparable from its counsel's advice because Citrix "relies exclusively on the advice of counsel for such legal determinations." Doc. 335-2, lines 61:3-5. Thus, Communique's questions were aimed squarely at confidential attorney-client communications protected by the attorney-client privilege.

Alternatively, Plaintiff contends that Citrix expressly waived its attorney-client privilege with respect to legal advice provided with respect to the Tridia patents because it provided testimony regarding the Tridia license that was "culled from discussions with counsel" and made "selective disclosures during deposition" and because its damages expert talked with its in-house counsel. Doc. 335, pp. 4-5.⁵ Communique provides no evidence that would support its contention that an express waiver occurred. While Feldman testified as to certain aspects of the Tridia negotiations based on historical information he received from other Citrix counsel, his testimony did not disclose privileged attorney-client communications.⁶ In fact, Feldman was careful to protect the privilege as is made plain by his responses to Communique's deposition

⁵ Communique also speculates that Citrix's "counsel's discussions with Tridia . . . likely included the matters contained in [Privilege Log] Entry #2." Doc. 335, p. 5.

⁶ Feldman was not employed by Citrix at the time the Tridia license was negotiated. Thus, in preparing for the 30(b)(6) deposition, he spoke with other counsel for Citrix to obtain information about the Tridia negotiations.

questions. Nor does the deposition testimony of Citrix's damages expert that is cited by Communique (Doc. 335, p.6 n. 18) demonstrate that Citrix's counsel disclosed confidential attorney-client communications to the expert. Thus, the Court finds no express waiver of the attorney-client privilege.

Communique also asserts that Citrix has impliedly waived privilege with respect to attorney-client communications related to the Tridia license and Tridia patents. Communique contends that, because Citrix and its expert chose to use Tridia as a comparable license for purposes of determining a reasonable royalty in this case, Citrix waived privilege as to attorney-client communications bearing on whether the Tridia license was a "non-coercive" license and "put[] its motivation for entering into the Tridia license and its valuation thereof at issue." Doc. 335, p. 6. Communique also contends that it needs access to Citrix's privileged communications regarding whether Tridia's patents were valid, whether Defendants' products infringed Tridia's patents, whether Defendants anticipated litigation with Tridia, and whether Defendants believed the Tridia license would assist them in the present litigation. Doc. 335, pp. 5-6. It argues that this Court "must allow that assertion [that Tridia was a non-coercive license] to be fully tested" by finding that Citrix waived its privilege. Doc. 335, p. 6.

The doctrine of "implied waiver" is well recognized. It has been applied where a party "assert[s] claims or defenses that put his or her attorney's advice in issue in the litigation." *Rhone-Poulenc Rorer, Inc. v. Home Indem. Co.*, 32 F.3d 851, 863 (3rd Cir. 1994) (finding no implied waiver but recognizing that "a client may waive the privilege as to certain communications with a lawyer by filing a malpractice action" or "by asserting advice of counsel as an affirmative defense"); see also *Davis v. Drake*, 2014 WL 5795554, * 4 (N.D. Ohio Nov. 6, 2014) (finding no waiver but discussing cases finding waiver). In patent infringement cases, the

implied waiver doctrine is applied when a party asserts, in response to a claim of willful infringement, that it relied on the advice of its counsel. *In re EchoStar*, 448 F.3d at 130.

Communique relies on a pre-*Upjohn* case, *Hearn v. Rhay*, 68 F.R.D. 574 (E.D.Wash. 1975) and several other cases in which courts have found an implied waiver. Doc. 335, pp. 5 and 6 n. 23. Communique quotes the *Hearn* court's description of three factors it found to be shared by cases in which an implied waiver was found ("the *Hearn* test"):

(1)[A]ssertion of the privilege was the result of some affirmative act, such as filing suit, by the asserting party; (2) through this affirmative act, the asserting party put the protected information at issue by making it relevant to the case; and (3) application of the privilege would have denied the opposing party access to information vital to his defense.

Hearn, 68 F.R.D. at 58, quoted in Doc. 335, p.5. ⁷

Hearn has been criticized, including by the Sixth Circuit. See *Ross v. City of Memphis*, 423 F.3d 596, 604 n.4 (6th Cir. 2005) (criticizing *Hearn* as being inconsistent with the certainty in application of the privilege required by *Upjohn*); see also *Rhone-Poulenc*, *supra*, 32 F.3d at 864 (*Hearn* is "of dubious validity"). Moreover, *Hearn* and the other implied waiver cases cited by Communique are all quite distinguishable on their facts from this case. *Hearn* was a prisoner civil rights action in which the court said it was "compelled to recognize a new and narrowly limited exception to the attorney-client privilege, which applies to civil rights suits against state officials under 42 U.S.C. § 1983, wherein the defendant asserts the affirmative defense of good faith immunity." 68 F.R.D. at 580. The other implied waiver cases cited by Communique (Doc.

⁷Plaintiff states that the *Hearn* test has been applied by the Federal Circuit. Doc. 335, p. 5, n. 17 (citing *Afro-Lecon, Inc. v. U.S.*, 820 F.2d 1198, 1205 (Fed. Cir. 1987)). In *Afro-Lecon*, the Federal Circuit dealt not with an attorney-client privilege issue but with a question regarding Fifth Amendment privilege, specifically whether the General Services Board of Contract Appeals should have stayed a civil action pending before it until after related criminal proceedings were concluded. The Federal Circuit described the *Hearn* test along with two other tests for handling privileges generally and found that the balancing approach suggested by *Hearn* was more appropriate than the "automatic waiver" theory applied by the Board of Contract Appeals. *Id.*

335, p. 6 n. 23) are all ones in which the party who brought suit was found to have put its attorney's advice at issue regarding an element of its claim.⁸

In *Rhone-Poulenc*, the Third Circuit, in finding no waiver of privilege, noted that cases like *Hearn* “appear to rest on a conclusion that the information sought is relevant and should in fairness be disclosed [but] [r]elevance is not the standard for determining whether or not evidence should be protected from disclosure as privileged, and that remains the case even if one might conclude the facts to be disclosed are vital, highly probative, directly relevant or even go to the heart of the issue.”⁹ 32 F.3d 851, 864 (3rd Cir. 1994). Moreover, “[a]dvice is not in issue merely because it is relevant, and does not necessarily become in issue merely because the attorney's advice might affect the client's state of mind in a relevant matter.” See *Rhone-Poulenc*, 32 F.3d at 863; see also *Davis*, 2014 WL 5795554, * 5 (quoting *Rhone-Poulenc* when discussing implied waiver based on a claim that a party had put an attorney's legal advice in issue). Rather, “advice of counsel is placed in issue where the client asserts a claim or defense, and attempts to prove that claim or defense by disclosing or describing an attorney client communication.” *Id.*; see also *Davis*, 2014 WL 5795554, * 5 (quoting *Rhone-Poulenc*).

In this case, unlike the cases cited by *Communique*, Citrix does not rely on the advice of its counsel to prove a claim or defense. While the legal advice Citrix received with respect to the Tridia patents may be relevant, Citrix is not relying on that advice to show that the Tridia license is evidence of what a reasonable royalty for the technology at issue in this case would be. See

⁸ See *Minebea Co., Ltd. v. Papst*, 355 F. Supp. 2d 518 (D.D.C. 2005) (fraud case in which the court found the contents of plaintiff's attorney's advice to be “inextricably merged” with the issue of reliance, an essential element of plaintiff's case); *Sanofi-Synthelabo v. Apotex, Inc.*, 299 F. Sup. 2d 303 (S.D.N.Y. 2004) (plaintiff waived its privilege when its 30(b)(6) witness testified to advice given by a European patent attorney); *Black & Decker, Inc. v. Hoover Service Center*, 1990 WL 181523 (D. Conn. 1990) (plaintiff waived privilege by having its witnesses testify as to attorney opinions regarding patent validity and other issues) and *Pitney-Bowes, Inc. v. Mestre*, 86 F.R.D. 444 (S.D. Fl. 1980) (plaintiff seeking a declaration of its rights and liabilities under a contract injected the issue of the intent of the parties in entering into the contract and thereby waived privilege).

⁹ *Rhone-Poulenc* was decided subsequent to *Afro-Lecon*. Like *Hearn* and *Afro-Lecon*, *Rhone-Poulenc* did not involve a patent claim.

[Davis, 2014 WL 5795554](#), * 5 (finding no waiver of attorney-client privilege notwithstanding defendants' claim that plaintiff had put a decedent's estate plan at issue).

Communique's argument that waiver should be found because Plaintiff needs access to Citrix's privileged information is unpersuasive. Even if the Court were to apply a balancing test such as that set forth in *Hearn*, a finding of waiver would not be warranted. Here, Communique has received non-privileged discovery with respect to Tridia and other Citrix licenses, including not only the license agreements themselves but all non-privileged documents regarding the negotiation of the licenses, as well as a 30(b)(6) deposition regarding the licenses.

Communique has not cited, nor is the Court aware of, precedent for finding a waiver of privilege under facts analogous to this case and the Court declines to create such precedent. *See* [Davis, 2014 WL 5795554](#), * 6 (noting that, although the defendant had argued that the plaintiff put attorney-client privileged information at issue, the defendant had not cited and the court was not aware of legal precedent finding waiver under the same or similar circumstances).¹⁰

For the reasons set forth herein, the Court concludes that the Defendants properly asserted privilege during Feldman's deposition. Further, the Court finds that Defendants have not put advice of counsel at issue and/or that Defendants' assertion of privilege will not unduly prejudice Plaintiff in prosecuting this case. Accordingly, the Court concludes that a finding of waiver of the attorney-client privilege is not warranted.

B. Revised Citrix Privilege Log Entry # 98

The document identified in Revised Privilege Log Entry #98 is a communication dated November 21, 2006, from Citrix's in-house counsel to its outside counsel. The privilege log indicates that Citrix is asserting that it is privileged as an "Attorney-Client Communication."

¹⁰In its Memorandum Regarding Defendants' Improper Assertion of Attorney-Client Privilege, Communique indicates that the issue it presents is one of first impression. Doc. 335, p. 2.

Doc. 334-4. The log describes the document as “confidential communication requesting legal advice.” *Id.* Citrix originally produced the document to Communique as CTX-COL0492134 .

Doc. 332, pp. 2-3. Citrix seeks to claw back the document pursuant to paragraph 5 of the Protective Order as having been inadvertently produced and subject to the attorney-client privilege. Doc. 332, pp. 2-3, Doc. 334, p. 5.¹¹

Communique contends that Citrix’s assertion of privilege is improper, arguing that the communication was not limited to seeking legal advice but also pertained to Citrix’s business/licensing strategy. Doc. 335, p. 4. Communique also asserts that Citrix has failed to meet the standard for inadvertence under [Fed. R. Evid. 502\(b\)](#) because Citrix’s claim that the document was “inadvertently” produced is conclusory and Citrix’s document review leading to the “inadvertent” production was inadequate. Doc. 335, p. 4, n. 10.

Citrix contends that the document is a confidential communication from a client to its attorney seeking legal advice. Doc. 334, pp. 4-5. Citrix argues that it was diligent in its review of documents and in its efforts to comply with the Court’s Order requiring production of documents pertaining to third party licenses. Citrix points out that, upon learning of the “inadvertent” production of the communication during the deposition of its damages expert, it immediately asserted privilege and provided notice of its intent to claw back the document pursuant to the Protective Order. Doc. 334, pp. 4-5. Citrix also contends that the only “evidence” of alleged contradiction identified by Plaintiff is the privileged communication itself, which may not be used for that purpose. Doc. 332, p. 3.

Having conducted an *in camera* review of the document identified in Revised Privilege Log Entry #98, the Court finds that the communication was sent by Citrix as a client to its

¹¹ Defendants indicate that the protective order is Doc. 27. Doc. 334, p. 5, n. 12. The order entering the Protective Order is filed as Doc. 28.

outside legal counsel for the purpose of requesting legal advice. Thus, the document contains communications protected by the attorney-client privilege. Further, the Court finds that, although disclosed to Communique during document production, Citrix's production was inadvertent, Citrix took reasonable steps to prevent disclosure, and, upon learning of the inadvertent production during its expert's deposition, Citrix promptly asserted privilege and stated its intention to claw back the document pursuant to the Protective Order (Doc. 28). Doc. 334-2, p. 4 (Martinez Depo. 64:7-12);¹² *see also* Fed. R. Evid. R. 502(b). Also, for the reasons set forth above with respect to the Feldman deposition, the Court finds no waiver of privilege with respect to confidential attorney-client communications concerning the Tridia license. Accordingly, the Court finds Defendants' assertion of privilege with respect to the document identified in Revised Privilege Log Entry #98 was proper and Defendants are entitled to claw-back the document.

C. Revised Citrix Privilege Log Entry #2

The document identified in Revised Privilege Log Entry #2 is a communication dated November 28, 2006, from Citrix's outside counsel to its in-house counsel. The privilege asserted for the document in the privilege log is "Attorney-Client Communication." Doc. 334-6. The log describes the document as "confidential communication with counsel providing or reflecting legal advice and analysis in anticipation of, or in the course of, litigation." *Id.*

Citrix contends that, notwithstanding the description of the document on the privilege log, which is phrased in terms of anticipation of litigation, the document is a confidential communication from outside counsel to Citrix rendering legal advice, i.e., it is protected by the attorney-client privilege. Doc. 334, pp. 5-6. Communique argues that, to the extent that the

¹² In the interest of expediency, Plaintiff proceeded to question Martinez with the parties' understanding that Defendants were asserting privilege and intending to proceed with clawing the document back. Doc. 334-2, pp. 4-5 (Martinez Depo. 64:13-65:17).

document involves outside counsel's analysis of the Tridia patent relying only on public facts, and does not reflect communications from Citrix, the communication is not protected by the attorney-client privilege. Doc. 335, p. 4 (relying on *American Standard v. Pfizer, Inc.*, 828 F.2d 734, 745 (Fed. Cir. 1987)). Communique also argues that Citrix may not rely on the work-product doctrine to protect the document because Citrix has taken the position that the Tridia license was not entered into in anticipation of litigation nor because of the litigation in this case and that the communication contains direct evidence of Citrix's view of the Tridia patents, which information is not obtainable elsewhere. Doc. 335, pp.4-5.

The Revised Privilege Log shows that the privilege asserted by Citrix for Entry # 2 is "Attorney-Client Communication." Doc. 334-6, p. 2. Thus, the Court finds Communique's arguments based on the work-product doctrine unpersuasive. Further, having conducted an *in camera* review of the document identified in Revised Privilege Log #2, the Court finds that the document reflects Citrix's confidential communications with counsel and provides legal analysis and advice that does not rely solely on public facts. See e.g. *American Standard Inc.*, 828 F.2d at 745 (finding no error in the lower court's determination that an opinion letter was not entitled to attorney-client privilege protection but indicating that the attorney-client privilege applies "to lawyer-to-client communications that reveal, directly or indirectly, the substance of confidential communication by the client."). Also, for the reasons set forth above with respect to questions asked during the Feldman deposition, the Court concludes that Citrix did not waive privilege with respect to confidential attorney-client communications concerning the Tridia license. Accordingly, the Court finds that Defendants' assertion of privilege with respect to the document identified in Revised Privilege Log Entry #2 was proper.

III. Conclusion

Based on the foregoing, the Court finds that Defendants properly asserted attorney-client privilege with respect both to questions asked during the Feldman deposition and the documents identified in Revised Privilege Log Entries # 2 and #98.

IT IS SO ORDERED.

April 17, 2015

A handwritten signature in black ink, reading "Kathleen B. Burke". The signature is written in a cursive style with a horizontal line underneath.

Kathleen B. Burke
United States Magistrate Judge