

**In The United States Court Of Appeals
For The Federal Circuit**

No. 2014-1406

**ALEXANDER SHUKH,
Plaintiff-Appellant**

v.

**SEAGATE TECHNOLOGY, LLC, a Delaware Limited Liability Company,
SEAGATE TECHNOLOGY, INC., a Delaware corporation, SEAGATE
TECHNOLOGY, a holding company of the Cayman Islands,
Defendants-Appellees**

**UNKNOWN OWNERS AND ASSIGNEES,
Defendant**

**SEAGATE TECHNOLOGY PLC, an Irish public limited company,
Defendant-Appellee**

**APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA IN 10-CV-404
HON. JOHN R. TUNHEIM, Presiding**

**SEAGATE DEFENDANTS-APPELLEES' RESPONSE
TO APPELLANT'S PETITION FOR REHEARING EN BANC**

FAEGRE BAKER DANIELS LLP
Calvin L. Litsey
David J.F. Gross
1950 University Avenue, Suite 450
East Palo Alto, California 94303
Tel.: 650-324-6700

FAEGRE BAKER DANIELS LLP
Chad Drown
Elizabeth Cowan Wright
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, Minnesota 55402
Tel.: 612-766-7000

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CERTIFICATE OF INTEREST

Counsel for Defendants-Appellees, Seagate Technology LLC, Seagate Technology, Inc., Seagate Technology, and Seagate Technology plc certifies the following:

1. The full name of every party or amicus represented by me is:

Seagate Technology plc; Seagate Technology LLC; Seagate Technology; and Seagate Technology LLC and Seagate Technology as successors and assigns of Seagate Technology, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None.

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:

Seagate Technology (US) Holdings, Inc.; Seagate HDD Cayman; Seagate Technology HDD Holdings; Seagate Technology; Seagate Technology Public Limited Company

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

Faegre Baker Daniels LLP: Calvin L. Litsey, David J.F. Gross, Charles F. Knapp, Chad Drown, Timothy E. Grimsrud, Elizabeth Cowan Wright, Sarah E. Benjes, Lucas J. Tomsich, Jeya Paul, Joseph A. Herriges

November 13, 2015
Date

/s/ Calvin L. Litsey
Signature of Counsel

Calvin L. Litsey
Printed Name of Counsel

INTRODUCTION

Shukh's current Petition for Rehearing En Banc raises the **exact same** *FilmTec* issue that this Court already decided **not to review en banc** in this case on September 25, 2014. (Dkts. 41, 48.) Shukh's first Petition for en banc review of *FilmTec* did not raise a question of exceptional importance and neither does his current petition. *FilmTec* is not contrary to this Court's precedent, and overruling *FilmTec* would **not even change the result** in this case. In particular, Shukh would still be contractually "obligated to assign [his] inventions" to Seagate, *Chou v. Univ. of Chi.*, 254 F.3d 1347, 1356 (Fed. Cir. 2001), based on the requirement in his Employment Agreement that he "assist the Company . . . to secure the Company's rights in the Inventions and . . . patents . . . including . . . the execution of all applications, specifications, oaths, **assignments** and all other instruments which the Company shall deem necessary." (See A600-01 (emphasis added).) Thus, there is no issue of exceptional importance here because, even if *FilmTec* were overruled, Seagate would still be entitled to legal title (and every other interest) in the patents at issue, depriving Shukh of standing to challenge inventorship based on ownership.

Shukh's other argument for en banc review based on the "common interest doctrine" also does not present a question of exceptional importance. Shukh fundamentally misunderstands the doctrine and conflates it with the "joint

representation” privilege to mistakenly argue that Shukh is entitled to the Seagate documents which were withheld on the basis of attorney-client privilege. It is Shukh’s misunderstanding of the law that is exceptional—not the Panel’s decision.

Seagate respectfully requests that this Court deny Shukh’s Petition.

ARGUMENT

En banc rehearing “is not favored” and ordinarily will be ordered only when (1) “en banc consideration is necessary to secure or maintain uniformity of the court’s decisions” or (2) “the proceeding involves a question of exceptional importance.” Fed. R. App. P. 35(a). Shukh’s *FilmTec* and common interest doctrine arguments do not satisfy either requirement to grant en banc review.

I. SHUKH’S ARGUMENTS FOR OVERTURNING *FILMTEC* DO NOT MERIT EN BANC REVIEW.

A. This Court Already Has Considered and Rejected Each of Shukh’s *FilmTec* Arguments.

Over a year ago, Shukh unsuccessfully petitioned this Court seeking en banc review of his argument that this Court should overrule *FilmTec Corp. v. Allied-Signal, Inc.*, 939 F.2d 1568 (Fed. Cir. 1991). (Dkt. 41.) His earlier Petition contained virtually the same arguments regarding *FilmTec* that he now repeats in his current Petition. (*Compare* Dkt. 41, *with* Dkt. 98 at 1-3, 5-13.) Both Petitions include the following four sections with similar (in some cases, word-for-word) supporting argument: (1) “*FilmTec* Should Be Reconsidered and Overruled” (Dkt.

41 at 4-6; Dkt. 98 at 5-6); (2) “*FilmTec* Has Been Questioned by the Supreme Court” (Dkt. 41 at 6-7; Dkt. 98 at 7-8); (3) “*FilmTec* conflicts with other decisions of this court” (Dkt. 41 at 11-13; Dkt. 98 at 11-13); and (4) “*FilmTec* is contrary to the rules of equity and law” (Dkt. 41 at 7-10; Dkt. 98 at 8-11). Shukh’s current Petition does not contain a single argument regarding *FilmTec* that was not already considered and rejected by this Court when denying his first Petition for hearing *en banc*.

There is no suggestion in the Per Curiam denial of Shukh’s first Petition that a single judge on this Court thought his Petition presented a question of exceptional importance or found Shukh’s arguments identifying purported precedential conflicts persuasive. (*See* Dkt. 48.) There has been no change in the law or facts of this case that justifies a different conclusion now. This Court’s denial of Shukh’s earlier Petition confirms that his current Petition—which makes the very same arguments—should also be denied. *See Sony Elec., Inc. v. United States*, 382 F.3d 1337, 1339-40 (2004) (“We must be mindful that our full court has already thrice deemed this very issue not sufficiently important to merit *en banc* treatment . . .”).

Judicial restraint and economy weigh against granting Shukh’s latest Petition for the same reasons that underpin the law of the case doctrine: (1) “to prevent relitigation of issues that have been decided,” (2) “to protect the settled

expectations of the parties and promote orderly development of the case,” (3) to “ensure[] judicial efficiency and prevent[] endless litigation,” and (4) “elementary fairness—a litigant given one good bite at the apple should not have a second.” *Suel v. Sec’y of Health & Human Servs.*, 192 F.3d 981, 984-85 (Fed. Cir. 1999).

This Court has already decided Shukh’s *FilmTec* arguments do not warrant en banc review, and Shukh has identified no reason why that decision should not stand.

B. Overruling *FilmTec* Would Not Change the Result of this Case.

Shukh asserts that *FilmTec* should be overruled because “The Panel’s Refusal to Deal with *FilmTec* wrongly denies Dr. Shukh’s claims to ownership.” (Dkt. 98 at 5.) Nothing could be further from the truth.

According to Shukh, the Panel’s application of *FilmTec* “wrongly denies [him] his ownership interest in the inventions and patents” because, under *FilmTec*, the words “I hereby assign” in his Employment Agreement effected an automatic assignment of his inventions not yet made. (*Id.* at 5-6.) But there is no question that even if *FilmTec* were overruled, Shukh’s Employment Agreement would still immediately transfer to Seagate “equitable rights” to Shukh’s inventions, (*see id.* at 12), and as in *Chou*, Shukh would be contractually “obligated to assign [his] inventions” to Seagate once the inventions existed, giving Seagate “legal title” (*see id.* at 12) and any other interests, *Chou*, 254 F.3d at 1356. Thus, overruling *FilmTec* would not change the outcome in this case because as Shukh concedes, all

Seagate would need to do to perfect its legal title in Shukh's inventions would be to "merely obtain a formal assignment from" Shukh. (Dkt. 98 at 12.)

Shukh's contractual obligation to execute such a "formal assignment" is indisputable. His Employment Agreement requires him to "assist the Company" including "the execution of all applications, specifications, oaths, **assignments** and all other instruments which the Company shall deem necessary" to secure Seagate's "rights in the Inventions and any copyrights, patents, mask work rights or other intellectual property rights." (A600-01 (emphasis added).) Shukh's "**obligation** to execute" such papers "shall continue after the termination of this Agreement." (A601 (emphasis added).) If Shukh refused, Seagate could obtain a court order requiring Shukh to execute all documents necessary to perfect Seagate's legal title. *See United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 187 (1933) ("If not yet issued, an agreement to assign [a patent] when issued, if valid as a contract, will be specifically enforced."); *Chou*, 254 F.3d at 1357 (finding putative inventor "would be obligated to assign those inventions" based on language requiring assignment of "[e]very patentable invention or discovery"). Furthermore, Shukh cannot argue that equity should intervene to relieve him of his obligations where the district court dismissed his fraud and other state law claims and this Court affirmed the judgment because those claims had "no merit." (Dkt. 97 at 14-15.) Therefore, regardless of *FilmTec*'s automatic assignment rule,

Seagate would be legally entitled to all interests in Shukh’s inventions, including legal title, and the result in this case—Shukh cannot have standing to challenge inventorship based on an ownership interest—ultimately would not change. Shukh’s Petition does not present a question of exceptional importance for this reason alone.

In addition, even if *FilmTec* were overruled, the fact that Seagate would only have equitable title until Shukh executed a subsequent assignment would not impart Shukh with any standing based on ownership. In *Chou*, the University only had equitable title to Chou’s “patentable invention[s] or discover[ies]” because Chou was only subject to an obligation to assign. *Chou*, 254 F.3d at 1357. Nonetheless, this Court explained that Chou did not have standing based on her temporary legal title because she was obligated to assign such legal title to the University. *Id.* Instead, Chou had to rely on her “concrete financial interest” in the patents. *Id.* at 1359. Under *Chou*, overruling *FilmTec* would not vest Shukh with any ownership standing, and he still would be limited to his potential reputational interest. The fact that Shukh’s ephemeral legal title would not alter his position with respect to standing is another reason why his Petition does not present a question of exceptional importance regarding *FilmTec*.

C. *FilmTec* Is Not Contrary to *Arachnid* or *U.S. Test*.

Shukh’s Petition also asserts (again) that *FilmTec* conflicts with *Arachnid*,

Inc. v. Merit Indus., 939 F.2d 1574 (Fed. Cir. 1991) and *U.S. Test, Inc. v. NDE Envtl. Corp.*, 196 F.3d 1376 (Fed. Cir. 1999). Shukh is wrong as to both cases.

First, there is no conflict between *FilmTec* and *Arachnid* for the simple reason that the agreement in *Arachnid* was not a present assignment (like the one in *FilmTec*) but merely an agreement to assign. The agreement in *Arachnid* stated that “any inventions conceived by IDEA or its employees . . . in the course of the project covered by this agreement, shall be the property of CLIENT [Arachnid], and all rights thereto *will be assigned* by IDEA . . . to CLIENT.” 939 F.2d at 1575 (italics in original). *Arachnid* explained that the “provision that all rights to inventions developed during the consulting period ‘will be assigned’ by IDEA to Arachnid does not rise to the level of a present assignment of an existing invention, effective to transfer all legal and equitable rights therein to Arachnid and extinguish any rights of IDEA.” *Id.* at 1580. *Arachnid* cited *FilmTec* when explaining that the agreement’s “will be assigned” language did not “amount to a present assignment of an expectant interest.” *Id.* at 1580-81. *Arachnid* is entirely consistent with *FilmTec*, and there is no conflict that requires en banc review.

Similarly, there is no conflict between *FilmTec* and *U.S. Test*. Shukh suggests these cases “cannot be reconciled” because *FilmTec* states that “patents today have the attributes of personal property” while “*U.S. Test* instructs that a patent is not a ‘good,’ but only a ‘general intangible.’” (Dkt. 98 at 11.) It appears

that Shukh thinks that “general intangibles” are not “personal property” or that “personal property” only includes “goods.” But as *FilmTec* itself makes clear, “personal property” includes “general[] intangible[s]” such as intellectual property, including patents. 939 F.2d at 1572 & nn.3-6. To the extent Shukh quibbles with *FilmTec*’s description of patents as “hav[ing] the attributes of personal property,” that characterization is taken straight from the Patent Act. *Id.* at 1572 n.6 (citing 35 U.S.C. § 261 (“Subject to the provisions of this title, patents shall have the attributes of personal property.”)). These cases simply do not conflict in their characterization of patents, let alone conflict in a way requiring en banc review.

D. The *Stanford* Decision Was Specific to the Bayh-Dole Act.

Shukh’s Petition also repeats his argument that Justice Breyer’s dissent and Justice Sotomayor’s concurrence in *Trustees of Stanford University v. Roche Molecular Systems*, 131 S. Ct. 2188 (2011) somehow call *FilmTec* into question such that en banc review is needed. The opinions in *Stanford* do not make reviewing the *FilmTec* rule a question of exceptional importance.

Stanford involved the question of patent ownership as between Stanford and a private third party under the Bayh-Dole Act, which “promote[s] the utilization of inventions arising from federally supported research” and “ensure[s] that the Government obtains sufficient rights in federally supported inventions.” 35 U.S.C. § 200; *see Stanford*, 131 S. Ct. at 2192-93. Justice Breyer’s “tentative” criticism in

Stanford, id. at 2204, was directed to the application of the *FilmTec* rule in the context of an invention subject to the Bayh-Dole Act, *see id.* at 2203 (noting that “[t]he Federal Circuit’s *FilmTec* rule undercuts the objectives of the Bayh-Dole Act” and observing that “[i]t is unclear to me why, **where the Bayh-Dole Act is at issue**, we should prefer the Federal Circuit’s *FilmTec* rule to the rule, of apparently much longer vintage, that would treat both agreements in this case as creating merely equitable rights.”) (emphasis added). Justice Sotomayor’s concurrence was similarly directed to the “application of [*FilmTec*] principles to agreements **that implicate the Bayh-Dole Act.**” *Id.* at 2199 (emphasis added). No Justice advanced the position put forth by Shukh in his Petition—that legal title should remain with the employee until conveyed by an “additional act.” (Dkt. 98 at 12.)

In fact, the Supreme Court has since **denied** a petition for writ of certiorari seeking resolution of “whether *FilmTec*’s ‘automatic assignment’ rule should be overruled given the doubts about its validity expressed by three Justices of the United States Supreme Court in [*Stanford*].” Brief of Petitioner at i, *Picture Patents, LLC v. Aeropostale, Inc.*, No. 12-339, 2012 WL 4181988, at *1 (U.S. July 26, 2012); *Picture Patents LLC v. Aeropostale, Inc.*, 133 S. Ct. 652 (2012) (denying petition). That certiorari petition made the same arguments Shukh makes in his current Petition—the *Picture Patents* petition was filed by Shukh’s current counsel. *Picture Patents*, 2012 WL 4181988 at *1, *23-29. The Supreme Court’s

denial of that certiorari petition further supports the lack of a question of exceptional importance here.

Finally, this case is not an appropriate case for resolving Justice Breyer’s “tentative” concerns regarding ownership in the context of the Bayh-Dole Act because this case does not involve that Act or ownership of federally-funded inventions. And reading Shukh’s Employment Agreement differently would not alter the outcome in this case. The *Stanford* case’s “tentative” dissent involving a statute not at issue here does not raise a question of exceptional importance, especially in the context of this case and especially where the Supreme Court has already denied certiorari on the issues raised in Shukh’s Petition.

E. The Supposed Inconsistency Between *FilmTec* and “the Rules of Equity and Law” Is Not a Question of Exceptional Importance.

Shukh argues that *FilmTec* is contrary to rules of law and equity primarily based on select quotations from various treatises on equity and contract law and the Minnesota UCC. (Dkt. 98 at 8-11.) It is unclear whether Shukh believes the authority he cites actually reflects the “[m]odern law of contracts and personal property,” and at times, he appears to be conflating patents—“general intangible[s]”—with “chattel[s]” and “goods.” (*Id.* at 8-10.) Regardless, this argument does not amount to a question of exceptional importance for the reasons discussed throughout this brief, including the fact that the result would not change.

To the extent Shukh is trying to suggest that en banc rehearing is warranted

because *FilmTec* created an automatic assignment rule that is unique to patent law, he is wrong. As one example, federal copyright law specifically provides for the automatic assignment of copyrights “[i]n the case of a work made for hire.” 17 U.S.C. § 201(b). As one federal court recently recognized, “**assignments of copyrights for work yet to be created are commonplace** in the entertainment industry and have repeatedly been held enforceable in federal courts.” *Contractual Obligation Prods., LLC v. AMC Networks, Inc.*, 546 F. Supp. 2d 120, 126-27 (S.D.N.Y. 2008) (emphasis added) (“[B]ecause the Assignment expressly extended to works ‘that are, or will be, written, created, or developed’ by Plaintiff, any copyright interest that Plaintiff did not have at the time of the Assignment’s execution was necessarily assigned to AMCC at the time any such future copyright interest arose.”). *FilmTec* does not warrant en banc review.

F. *Stare Decisis* Weighs Against Reviewing *FilmTec* En Banc.

Shukh’s Petition also should be denied because overruling *FilmTec* would frustrate the principles underlying *stare decisis*. *Stare decisis* is of “fundamental importance” as it “promotes the evenhanded, predictable, and consistent development of legal principles, fosters reliance on judicial decisions, and contributes to the actual and perceived integrity of the judicial process.” *Randall v. Sorrell*, 548 U.S. 230, 243-44 (2006). Moreover, “[c]onsiderations in favor of *stare decisis* are at their acme in cases involving property and contract rights,

where reliance interests are involved.” *Pearson v. Callahan*, 555 U.S. 223, 233 (2009).

That is precisely the case here. Seagate—presumably along with other employers and employees across the United States—entered into employment agreements with the settled expectation of how intellectual property rights were being assigned under *FilmTec*. And as this Court knows, Shukh was paid well for his work at Seagate. (A9421-22.) Shukh has not identified anything that would justify altering the rule in *FilmTec* and incurring the “instability and unfairness that accompany disruption of settled legal expectations.” *Randall*, 548 U.S. at 244. Nor has Shukh identified any “lessons of accumulated experience” that might counsel in favor of abandoning precedent in favor of the rule proposed by Shukh. *See State Oil Co. v. Khan*, 522 U.S. 3, 20 (1997). On the contrary, adopting the “only equitable rights” rule proposed by Shukh would permit disgruntled current and former employees to hold their employers hostage with respect to patenting inventions that were made by employees using the employers’ resources and funding. This is another reason why Shukh’s Petition should be denied.

II. SHUKH’S “COMMON INTEREST” ARGUMENT DOES NOT PRESENT A QUESTION OF EXCEPTIONAL IMPORTANCE.

Shukh also seeks en banc review of the Panel’s affirmance of the district court’s denial of Shukh’s motion to compel production of Seagate’s attorney-client

privileged documents.¹ Shukh claims the Panel’s decision is contrary to *In re Regents of Univ. of Cal.*, 101 F.3d 1386, 1389 (Fed. Cir. 1996).

Shukh’s Petition continues to incorrectly invoke the “common interest” doctrine and conflate it with the “joint representation” privilege to mistakenly argue that Shukh is entitled to the Seagate documents which were withheld on the basis of attorney-client privilege. Although both the “common interest” doctrine and the “joint representation” privilege require a “common interest,” the doctrine and privilege are entirely distinct. *See* 24 Charles Alan Wright et al., *Fed. Practice & Procedure* § 5505 (2012). More importantly, neither entitles Shukh to privileged documents. Shukh’s argument implicates patent law, so Federal Circuit law applies, although the result is the same under established federal privilege law. *See In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 803-04 (Fed. Cir. 2000).

The “joint representation” or “joint client” privilege provides that “[w]hen the same attorney represents the interests of two or more entities on the same matter, those represented are viewed as joint clients for purposes of privilege.” *In re United States*, 590 F.3d 1305, 1310 (Fed. Cir. 2009) (quotations omitted); *see also In re Teleglobe Commc’ns Corp.*, 493 F.3d 345, 362-63 (3d Cir. 2007).

Under the doctrine, while communications may be privileged as to outsiders, they

¹ The history of how Shukh stole 49,607 pages of documents from Seagate when he was terminated and the privilege issues surrounding this issue are detailed in Seagate’s Response Brief. (Dkt. 57 at 8-9, 54-56.)

are not between the joint clients. *Id.*; *In re United States*, 590 F.3d at 1310. But Shukh and Seagate were never joint clients of Seagate's attorneys, because Shukh was never a client of Seagate's attorneys. *See In re Regents of Univ. of Cal.*, 101 F.3d at 1389 (referring to communications between multiple clients and their "jointly retained" counsel). Indeed, it is well settled that an employee-inventor who is required to assign his rights to any inventions to a company lacks an attorney-client relationship with the company's lawyers, *Univ. of W. Va. v. Van Voorhies*, 278 F.3d 1288, 1304 (Fed. Cir. 2002), and the privilege over the employee's communications with the lawyer is "solely" the company's, *Telectronics Proprietary, Ltd. v. Medtronic, Inc.*, 836 F.2d 1332, 1336-37 (Fed. Cir. 1988). Therefore, the joint representation privilege is entirely inapplicable.

The "common interest" doctrine, on the other hand, is "**not an independent basis for privilege**, but an exception to the general rule that the attorney-client privilege is waived when privileged information is disclosed to a third party." *Cavallaro v. United States*, 284 F.3d 236, 250 (1st Cir. 2002) (emphasis added). It allows "attorneys for different clients pursuing a common legal strategy to communicate with each other" without triggering a privilege waiver. *In re Pac. Pictures Corp.*, 679 F.3d 1121, 1129 (9th Cir. 2012); *In re Teleglobe Commc'ns*, 493 F.3d at 365. Thus, while the doctrine allows privileged information to be shared with a party with a common interest without waiving privilege, it in no way

requires privileged information to be shared and in no way requires Seagate to share its privileged documents with Shukh.

In sum, there is no conflict between the Panel's affirmance and *In re Regents*. In fact, Shukh's Petition seeking production of what he describes as "his own invention records" confirms that he does not understand the law. (Dkt. 98 at 13-15.) The "invention records" were Seagate's, not Shukh's, and as an employee-inventor required to assign his rights to any inventions to Seagate, Shukh never had an attorney-client relationship with Seagate's lawyers. *Univ. of W. Va.*, 278 F.3d at 1304. Shukh's failure to understand this fact does not constitute a question of exceptional importance warranting en banc review.

CONCLUSION

Seagate requests that Shukh's request for rehearing en banc be denied.

Dated: November 13, 2013

FAEGRE BAKER DANIELS LLP
Chad Drown
Elizabeth Cowan Wright
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, Minnesota 55402
Tel.: 612-766-7000

FAEGRE BAKER DANIELS LLP

/s/ Calvin L. Litsey

FAEGRE BAKER DANIELS LLP
Calvin L. Litsey
David J.F. Gross
1950 University Avenue, Suite 450
East Palo Alto, California 94303
Tel.: 650-324-6700
*Attorneys for Defendants-Appellees,
Seagate Technology LLC, Seagate
Technology, Inc., Seagate Technology,
and Seagate Technology plc*

CERTIFICATE OF SERVICE

I hereby certify that on November 13, 2015, I electronically filed the foregoing document with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF System, which will send notice of such filing to all registered CM/ECF users.

/s/ Calvin L. Litsey
Calvin L. Litsey

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE
REQUIREMENTS**

1. This brief complies with the requirements of Federal Circuit Rule 35(e)(4), because:

The brief does not exceed 15 pages, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii) and Federal Circuit Rules 32(b) and 35(c)(2).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6) because:

The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2007 in 14 point Times New Roman font.

Dated: November 13, 2015

/s/ Calvin L. Litsey
Calvin L. Litsey