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Federal Circuit Patent Bulletin: *Waymo LLC v. Uber Techs., Inc.*

September 26, 2017

"Once a party has disclosed work product to one adversary, it waives work-product protection as to all other adversaries."

On September 13, 2017, in *Waymo LLC v. Uber Techs., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Newman, Wallach,* Stoll) dismissed intervenor Anthony Levandowski's appeal and petition for a writ of mandamus seeking to prevent discovery in Waymo's suit against Uber for patent infringement and trade secret misappropriation, which related to driverless vehicle technology. The Federal Circuit stated:

The common law writ of mandamus is codified at 28 U.S.C. § 1651(a), which provides that "all courts established by [an] Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law." "[T] hewrit of mandamus is an extraordinary remedy[] to be reserved for extraordinary situations." "The traditional use of the writ in aid of appellate jurisdiction both at common law and in the federal courts has been to confine the court against which mandamus is sought to a lawful exercise of its prescribed jurisdiction." The petitioner bears the burden of showing entitlement to a writ of mandamus. To meet its burden, a petitioner must satisfy each of the following "prerequisites": First, the party seeking issuance of the writ must have no other adequate means to attain the relief he desires—a condition designed to ensure that the writ will not be used as a substitute for the regular appeals process. Second, the petitioner must satisfy the burden of showing that his right to issuance of the writ is clear and indisputable. Third, even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances. Failure to establish any of these

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three prerequisites may suffice to deny a petition. . . .

Mr. Levandowski contends that he lacks such alternative means of relief because "an appeal after disclosure of the privileged communication is an inadequate remedy." We disagree. Appellate courts "generally den[y] review of pretrial discovery orders," because "postjudgment appeals generally suffice to protect the rights of litigants and ensure the vitality of the attorney-client privilege . . . by vacating an adverse judgment and remanding for a new trial in which the protected material and its fruits are excluded from evidence." Although Mr. Levandowski is an intervenor, he is not precluded from appealing a final judgment even if the parties decline to do so. While Mr. Levandowski contends that "disclosure of privileged information would irreparably taint the adversary process" because "[c]ourts cannot force litigants to unlearn information," he has not specified why that general argument applies with greater force here than in any other case. Therefore, we conclude that a post-judgment appeal by either Uber or Mr. Levandowski would "suffice to protect the rights of [Mr. Levandowski] and ensure the vitality of attorney-client privilege," as to this civil action. . . .

Mr. Levandowski cannot establish a "clear and indisputable" right to mandamus relief solely by identifying ordinary error at the District Court. Instead, something more is required to grant a petition for writ of mandamus because "only exceptional circumstances amounting to a judicial usurpation of power, or a clear abuse of discretion, will justify the invocation of this extraordinary remedy." . . .

"Rather than a separate privilege, the common interest or joint defense rule is an exception to ordinary waiver rules designed to allow attorneys for different clients pursuing a common legal strategy to communicate with each other." It is insufficient "to justify a claim of privilege simply by demonstrating that a confidential communication took place between parties who purportedly share a common interest." Instead, "the party seeking to invoke the doctrine must first establish that the communicated information would otherwise be protected from disclosure by a claim of privilege." Therefore, to invoke the common interest doctrine, a party first must demonstrate the elements of privilege and then must demonstrate that the communication was made in pursuit of common legal claims including common defenses. . . . [The] undisputed facts are sufficient to uphold the District Court's conclusion that Mr. Levandowski did not share a common interest with Uber. . . .

The work-product doctrine protects from discovery documents, tangible things, or compilations of materials that were prepared in anticipation of litigation by a party or its representative. Documents that "w[ere] not prepared exclusively for litigation," known as "[d]ual purpose documents," may be entitled to work-product protection if they were prepared "because of" litigation, meaning "the document[s] can be fairly said to have been prepared or obtained because of the prospect of litigation." Even if a party has demonstrated that documents are entitled to work-product protection, that protection may be waived through disclosure to a third person. The common interest doctrine, however, may serve as "an exception" to a waiver of privilege, including work-product protection, that "allow[s] attorneys for different clients pursuing a common legal strategy to communicate with each other." The Magistrate Judge explained that, "[o]nce a party has disclosed work product to one adversary, it waives work-product protection as to all other adversaries. As Uber disclosed its Stroz [Report] work product to its adversaries Otto[motto and Mr.] Levandowski . . . , it must disclose the same work product to Waymo." . . .

The Fifth Amendment provides, in relevant part, that "[n]o person . . . shall be compelled in any criminal case tobe a witness against himself." "[T]he Fifth Amendment privilege is a personal privilege: it adheres basically to the person, not to information that may incriminate him." The District Court determined that compelling Uber or Stroz to produce the Stroz Report would not violate Mr. Levandowski's Fifth Amendment privilege, because he had not met his burden of showing that he retained any privilege over the Stroz Report. We agree that Mr. Levandowski is not entitled to Fifth Amendment privilege with respect to disclosure in this civil case. . . .

Mr. Levandowski has not satisfied his burden as to the first two Cheney prerequisites, and he has not persuaded us to exercise our discretion here and overrule the District Court. We thus decline to do so.