

A plaintiff, a national restaurant chain, brought a trademark infringement suit against the owner of a small eatery. The plaintiff claims that the owner willfully traded on the plaintiff's registered mark, causing customers to associate the eatery's inferior food with the plaintiff's restaurants.

The plaintiff has filed a motion to compel production of two sets of emails that were sent prior to the lawsuit. In the first set of emails, the owner notes the similarities between its logo and the plaintiff's and asks his attorney for an opinion on potential trademark infringement liability. The attorney never responded. In the second set of emails, both the owner and the attorney discuss the eatery's business potential, given its highly recognizable logo. The owner objects, citing the attorney-client privilege.

How should the court rule on the owner's privilege claim?

- A. Both sets of emails are privileged.
- B. Only the first set of emails is privileged, because the second set of emails does not provide legal advice.
- C. Only the second set of emails email is privileged, because the first set of emails does not include the attorney's response.
- D. Neither set of emails is privileged, because both tend to establish willful trading on the plaintiff's mark.

## Explanation:

### Attorney-client privileged communications

(FRE 502)

<b>Privileged</b>	Any communication between attorney & client:  made to obtain or provide legal assistance for client <i>and</i> intended to be & kept confidential
<b>Not privileged</b>	Purely factual information Client's identity (generally) Existence of attorney-client relationship Client's legal fees & other incidentals Attorney's fee records Business advice or opinions

**FRE** = Federal Rule of Evidence.

The **attorney-client privilege** protects **confidential communications\*** that are **made for** the purpose of **obtaining or providing legal assistance** for the client. This allows the client to freely and frankly communicate with an attorney (and vice versa). As a result, the first set of emails in which the owner sought legal advice regarding the eatery's potential liability for trademark infringement is protected by this privilege **(Choice C)**.

In contrast, attorney-client communications that are **made for some other purpose** are **not protected** by this privilege. This includes communications in which the client solicits, or the attorney offers, mere **business advice or opinions**. Therefore, the second set of emails about the eatery's business potential—which solicited business advice rather than legal advice—is *not* protected by this privilege **(Choice A)**.

\*Communications are confidential if they were intended to be and kept private.

**(Choice D)** The fact that both sets of emails tend to establish that the owner willfully traded on the plaintiff's mark has no bearing on the applicability of the attorney-client privilege. Instead, this privilege turns on whether the communication was made to obtain legal advice/representation.

### Educational objective:

The attorney-client privilege protects confidential communications that are made for the purpose of obtaining or providing legal assistance for the client. But communications made for other purposes—including rendering business advice or opinions—are not protected.

### References

Fed. R. Evid. 501 (federal common law privileges).

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