

3. In *Willis Elec. Co. v. Polygroup Trading Ltd.*, No. 15-CV-3443-WMW-KMM, 2021 WL 568454, at *1 (D. Minn. Feb. 16, 2021), U.S. Magistrate Judge Katherine Mendez of the District of Minnesota found that the fact of the attachment of photos and videos to a privileged email was itself privileged, but, in light of the circumstances of the case, ordered that the photos and videos be produced.

In this patent infringement litigation, plaintiff “allege[d] that it holds patents for several innovations in the design and construction of pre-lit artificial-trees and that [defendants] infringe[d] [plaintiff’s] patent rights through the sale of its own artificial trees.” *Id.* *1. In the course of discovery, plaintiff produced an email sent from plaintiff’s employee to plaintiff’s general manager. The email did not reference legal advice but appeared to be addressed to plaintiff’s patent counsel rather than the general manager. Plaintiff later sought to clawback the email and attached photos and videos. *Id.* at *3. Defendants filed a motion seeking to compel production of the email and attachments. *Id.* at * 1.

Magistrate Judge Mendez first determined that the email sent to plaintiff’s manager was privileged. While the email was not sent to counsel, Magistrate Judge Mendez accepted that the email was addressed to and intended for patent counsel. *Id.* at *5. She concluded that the email was “most likely a draft communication that was later sent to [counsel].”

After concluding that the email was privileged, Magistrate Judge Mendez turned to whether the attachments were privileged. The attorney-client privilege protects only the “disclosure of communications, ... it does not protect disclosure of underlying facts.” *Id.* at*6 (citing *Upjohn Co. v. U.S.*, 449 U.S. 383, 395 (1981)). Magistrate Judge Mendez highlighted that “lower courts have differed with respect to how *Upjohn*’s holding applies to email attachments. ... [L]ower courts have not always been clear about what protection — if any — applies to such attachments. ... A large set of lower courts have interpreted *Upjohn* to mean that even though the underlying content of the independently discoverable attachments is not privileged, the act of sending the attachments is privileged. ... Another group of lower courts do not extend the privilege to independently discoverable email attachments. According to these cases, for the attorney-client privilege to apply to attachments, each attachment must qualify for the privilege.” *Id.* at *7.

Magistrate Judge Mendez joined the courts finding that the act of sending attachments can be privileged. She pointed out that the privilege does not shield the contents of attachments but rather “protect[s] a party from having to disclose that those specific documents were sent to counsel in connection with a request for legal advice. ... [R]equiring disclosure of the attachments themselves creates a risk that an opponent may reverse engineer the substance of a client’s request for legal advice. ... The privilege, however, extends only to the copies of the documents actually attached to an email. It does not cover identical documents that are not attached to privileged emails.

Despite finding that attachments can be privileged, Magistrate Judge Mendez ordered that plaintiff produce the photos and videos at issue. She explained that “[i]f this were an ordinary case, [defendants’] discovery requests that seek production of the photos and video files would have led to the production of the photos and videos that were attached to the ... email as independent documents located elsewhere in [plaintiff’s] repository of electronically stored information.” *Id.* at *8. Magistrate Judge Mendez ordered that plaintiff conduct a reasonable search to determine whether a version of the photos and videos exists that are not attached to a privileged email. She

further ordered that if plaintiff did not locate other versions of the photos and videos, plaintiff would be required to produce the photos and videos attached to the privileged email.