



Confidentiality of communications between clients and their patent advisors

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Work in progress

- Joint Proposal – AIPLA/AIPPI/FICPI Colloquium on Privilege, June 2013
 - FICPI Resolution
- SCP/25/4 - COMPILATION OF COURT CASES WITH RESPECT TO CLIENT-PATENT ADVISOR PRIVILEGE , November 15, 2016
- SCP/29/5 - CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS: COMPILATION OF LAWS, PRACTICES AND OTHER INFORMATION, November 15, 2018



Topics

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Introduction (1/3)

- Intellectual property rights (IPRs), such as patents, trademarks, designs, etc., exist globally
- Global trade requires and is supported by IPRs
- Persons, i.e. clients, need to be able to obtain frank and full legal advice (IP professional advice) in confidence on IPRs from intellectual property (IP) advisors nationally and trans-nationally (cross-border)
- Therefore communications, including documents and other related records drafted therefor, to and from such IP advisors need to be protected from forcible disclosure to third parties



Introduction (2/3)

- Providing confidentiality for communicating full and frank legal advice (IP professional advice) supports both public and private interests in that (i) the persons so advised obtain correct advice and in that (ii) the advice is compliant with law and administration of justice
- Nations need to support and maintain confidentiality in such communications and to extend the protection which applies nationally also to legal advice (IP professional advice) given by IP advisors in other nations in view of the global dimension of IPRs



Introduction (3/3)

- Extending the protection trans-nationally avoids causing or allowing confidential advice to be published and thus confidentiality in that legal advice (IP professional advice) to be lost everywhere
- If the confidentiality of legal advice (IP professional advice) is lost in a particular nation, it can be used against the person both locally and internationally
- The adverse consequences of such loss of protection include owners of IPRs deciding not to trade or invest in particular nations or not to enforce IPRs in such nations, where protection is lost



Definitions (1/4)

- Client
 - A principal on whose behalf an IP advisor acts, either national or foreign
- IP advisors
 - IP advisors are IP professionals, such as a patent attorneys, trademark attorneys, design attorneys
 - IP professionals are often nationally or regionally (e.g. European patent attorneys before the EPO) qualified and registered
 - Some jurisdictions have publicly accessible registers for such IP professionals
 - Registered IP professionals are in general subject to a Code of Conduct (alternatively regulations or legislation) including provisions on professional secrecy obligation



Definitions (2/4)

- Generally this only applies to the IP professionals on their respective national levels
- IP professionals can be, but most often are not, attorneys-at-law/lawyers
- Communications
 - Communications in this context include oral and written IP professional advice, documents created for the purposes of such advice and other records related to such advice transferred between the IP advisors and the persons so advised
 - IP professional advice includes legal advice; which e.g. concerning patents may concern technical matters
 - The term “**advice**” is **specific** in the sense that it does **NOT** include e.g. prior art documents, laboratory note books, other documents containing data, or the like



Definitions (3/4)

- Privilege
 - Client privilege is a mechanism in common law jurisdictions which allows clients to resist discovery of confidential advice given to the client by an attorney-at-law/lawyer; *i.e. protection from forcible disclosure to a third party/court*
 - “In law of evidence, client’s privilege to refuse to disclose and to prevent any other person from disclosing confidential communications between him and his attorney. Such privilege protects communications between attorney and client made for purpose of furnishing or obtaining professional legal advice or assistance.” [Black's Law Dictionary, (6th ed. 1990), ISBN 0-314-76271-X]
 - Some common law countries give privilege to patent attorneys/IP attorneys



Definitions (4/4)

- Professional secrecy obligation
 - In civil law jurisdictions attorneys-at-law/lawyers are bound by an obligation of professional secrecy (the term privilege is not used); *i.e. the professional's obligation to keep information received secret*
 - Patent attorneys/IP attorneys in most countries are subject to professional secrecy obligation
 - **Generally** privilege or professional secrecy obligation **applies only** on a **national** level both in common law jurisdictions and civil law jurisdictions
 - In some jurisdictions privilege or professional secrecy obligation applies also for foreign attorneys-at-law/lawyers



Confidentiality (1/2)

- The purpose of providing privilege or obligation of professional secrecy is to encourage those who seek legal advice (IP professional advice) and those who provide advice to be fully transparent and honest in the process of communicating such advice
- If the communication is publicly disclosed, there is a disadvantage for those who seek advice
- In other words, the purposes of protection from forcible disclosure of legal advice (IP professional advice) given by IP advisors is to (i) achieve the public interest of having clients correctly advised and (ii) the law being enforced in the process



Confidentiality (2/2)

- In order to ensure high quality of advice, communication of such legal advice (IP professional advice) should not be restricted due to fear of disclosure of the communication
- Due to the global nature of IPRs, the privilege or the professional secrecy obligation should apply trans-nationally (cross-border)
- Confidentiality of communications should thus be recognized also when legal advice (IP professional advice) is provided by foreign IP advisors

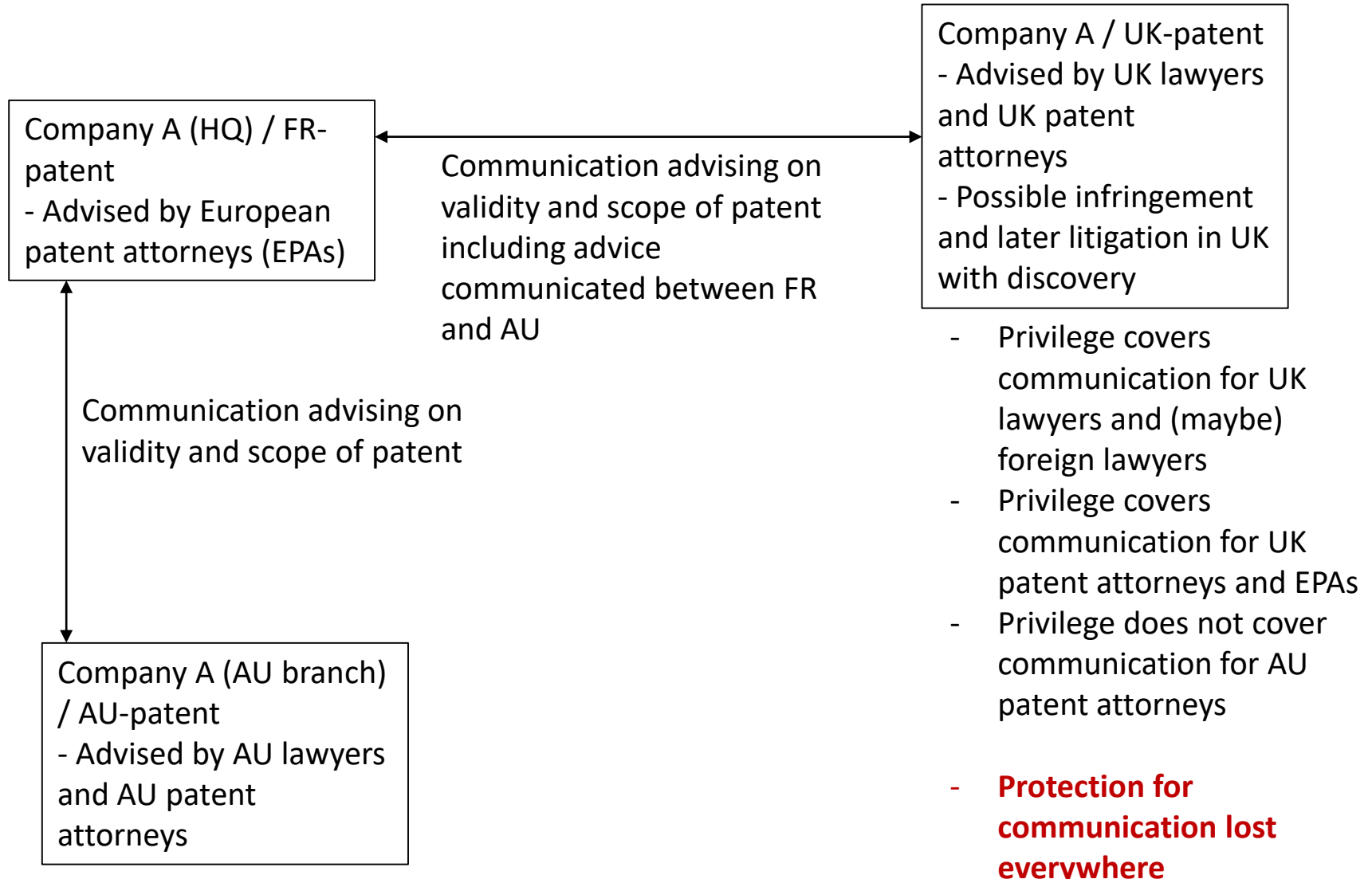


Loss of confidentiality (1/1)

- In a jurisdiction where there are provisions on privilege or professional secrecy obligations the communication of legal advice (IP legal advice) between clients and their IP advisors the communication is protected from disclosure in that jurisdiction
- However, when the communication of legal advice (IP professional advice) takes place between one jurisdiction and another, protection may be lost if privilege or professional secrecy obligations are not available in the other jurisdiction
- Further, despite privilege or professional secrecy obligation being provided in both jurisdictions, protection is lost, if privilege or professional secrecy obligation for IP advisors in one jurisdiction is not recognized for the IP advisors of another jurisdiction

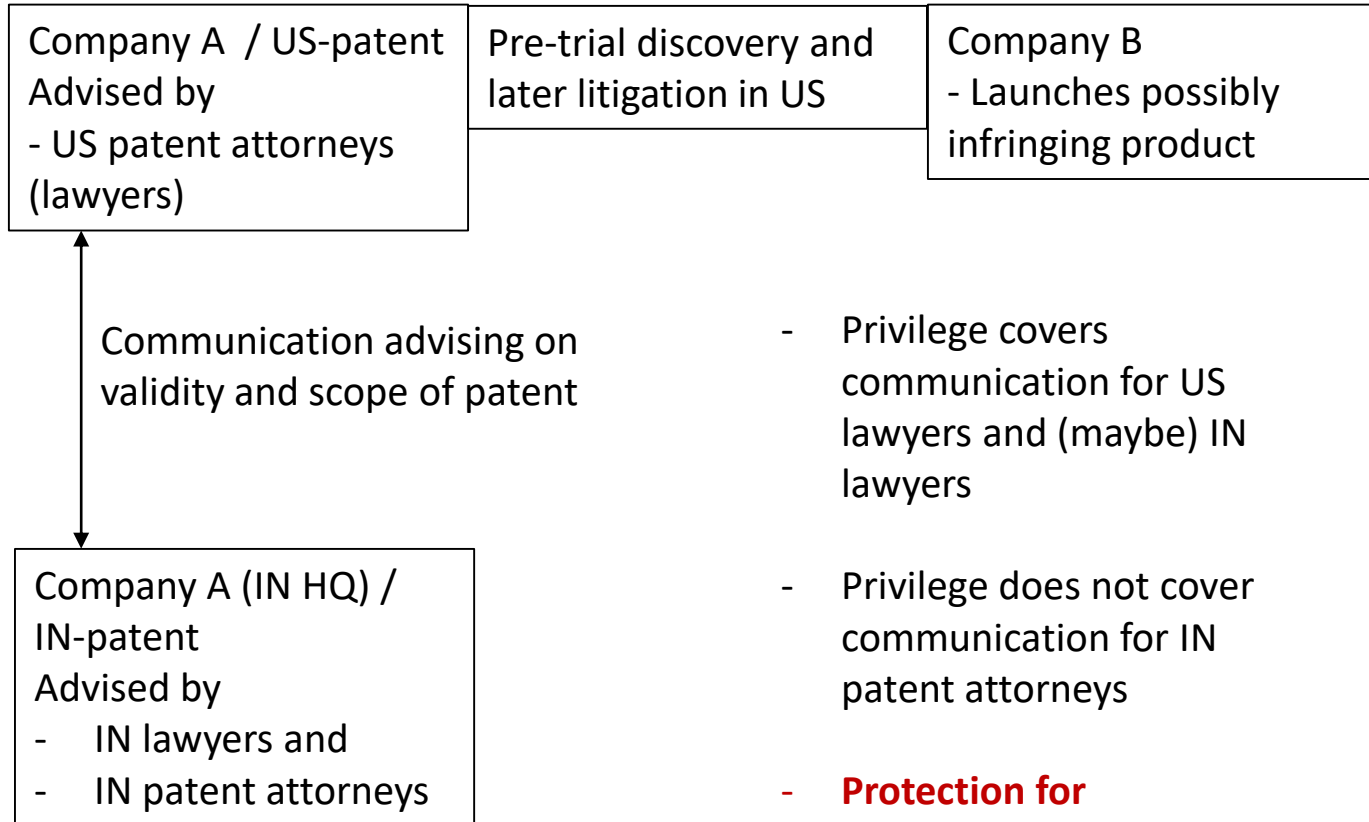


Examples (1/2)





Examples (2/2)



- Privilege covers communication for US lawyers and (maybe) IN lawyers
- Privilege does not cover communication for IN patent attorneys
- **Protection for communication lost everywhere**



Conclusions (1/3)

- The key issue is the **protection of confidentiality in IP professional advice** (legal) communicated between clients and their IP advisors against forcible disclosure by a court to an opposing party
- IP professional advice is to a large extent given by **IP advisors, such as patent attorneys, trademark attorneys, design attorneys** who to a large extent are not lawyers, whereby a traditional client-attorney privilege (e.g. based on law of evidence) is not sufficient for IPRs
- IP professional advice is most often also **communicated trans-nationally** (cross-border), whereby there presently is a problem in this respect since protection provided by **national law** for national IP professional advice **does not recognize and apply the protection to foreign IP professional advice**



Conclusions (2/3)

- The protection is called privilege in common law countries, which has a different meaning in civil law countries
- Thus the term “**protection**” is more appropriate because it applies to the outcome, i.e. non-disclosure of confidential IP professional advice



Conclusions (3/3)

- What is needed is a **minimum** standard providing:
 - that (i) IP professional advice given by IP advisors is confidential and protected from forcible disclosure to an opposite party in litigation on a **national level**;
 - that (ii) **cross-border** IP professional advice is **treated in the same way** as it is nationally;
 - a (iii) **balance between common law and civil law** in that it does not require civil law jurisdictions to adopt any common law concept or *vice-versa*; and
 - that **includes**
 - definition of IP advisor, e.g. qualified advisors in given jurisdictions
 - definition of communication
 - definition of advice



Thank you very much for kind attention!

Please do not hesitate to refer back for any information, with any questions or with any comments to

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