AIPPI

e-News

No.19

July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat ¦ Toedistrasse 16 ¦ P. O. Box ¦ CH-8027 Zurich
Tel. +41 44 280 58 80 ¦ Fax +41 44 280 58 85
enews@aippi.org ¦ www.aippi.org

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

AIPPI participation in Chinese IP events

Stephan Freischem, Secretary General of AIPPI

On Monday 20 June 2011, Lipu TIAN, Commissioner of the State Intellectual Property Office (SIPO), and President of the Chinese Group of AIPPI invited the President and the Secretary General of AIPPI, Mr. Yoon Bae Kim and Mr. Stephan Freischem, together with the Vice-Presidents and the Secretary of the Chinese Group of AIPPI, to discuss the latest developments in the field of IP.

Mr. Tian reported on international collaboration initiatives, like the Patent Prosecution Highway and the Common Citation Document initiative, as well as national efforts to improve the Chinese IP system. China has started a successful initiative to improve the national system for IP enforcement. Currently, SIPO has approximately 5000 patent examiners, and there are about 6000 patent attorneys in private practice in China. Application filings were well over 1 million last year, with approximately 400,000 patent applications and similar numbers of utility models and design patents. A dramatic increase is expected in coming years. In order to process the expected increase in patent applications, SIPO plans to double the number of patent examiners in five years, and the number of patent attorneys is expected to increase as well. A training programme will be launched shortly with the goal of significantly improving the skills of the IP profession in China and to develop a deeper understanding of international IP protection systems.

The Vice-Presidents and the Secretary of the Chinese National Group reported that the Chinese Group has invited AIPPI to host the AIPPI Forum and ExCo meeting in 2015 in Beijing. They further plan to set up a Seminar in April 2012 in conjunction with a meeting of the Bureau of AIPPI. Mr. Tian stated that SIPO strongly supports these initiatives. Mr. Kim and Mr. Freischem, on behalf of AIPPI, stated that AIPPI is impressed by the increased level of activity in the Chinese IP community and, in particular, within the Chinese Group of AIPPI. The AIPPI representatives offered AIPPI's resources for international IP training of the Chinese IP experts.

The Forum organized by AIPPI's media partner, Managing IP, presented an excellent opportunity for introducing AIPPI to the IP community in China, especially to in-house counsels. The forum was very well attended with over 300 participants. High profile key note speakers, including

- Lipu Tian, Commissioner of SIPO
- Robert Stoll, Commissioner for Patents, USPTO
- James Pooley, Deputy Director General, WIPO
- Valentin Mir, Director International Affairs, EPO,

opened different blocks of the Forum programme, which offered presentations on IP systems in different regions of the world. AIPPI was pleased to participate in a panel discussion of IP experts focussing on IP management strategies.

The Secretary General of AIPPI travelled on to Shanghai to attend the China Intellectual Property Symposium 2011 organised by FICPI and the All China Patent Attorneys Association (ACPAA). The international key note speakers of the MIP event also participated in this event. A highlight of the program was the announcement by Commissioner Stoll that the US House of Representatives had passed a patent reform bill the night before. The new Act, which is likely to enter into force before the end of this year, changes the US from a first to invent to a first inventor to file system, and introduces a new post grant opposition proceeding in the US patent system.

Discussions with officers of our sister association FICPI revealed the existence of a significant number of cooperation opportunities between FICPI and AIPPI. Both associations will offer a large variety of activities in the near future with a FICPI Forum in Seoul in December 2011, the FICPI Congress in Melbourne in April 2012, an AIPPI Symposium in Beijing in April 2012 and the AIPPI Congress in Seoul in October 2012.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Opinion of the Advocate General in Case C-34/10 (Brüstle v. Greenpeace e.V.), Court of Justice of the European Union: Human embryos and patents. Interpretation of the term "human embryo" used in the European Biotech Directive 98/44/EC

Karolina Schöler, German Group Reporter

Mr. Brüstle holds the German patent DE 1975864 concerning isolated and purified neural precursor cells derived from embryonic stem cells and methods for producing neural precursor cells for use in the treatment of neural defects, in particular, Parkinson's disease. Greenpeace e.V. had started a nullity action before the Federal Patent Court (Bundespatentgericht) based on Section 2 para. 1 in combination with Section 2 para. 2, No. 3, German Patent Act, prohibiting the commercial use of human embryos. This exclusion was implemented by the German Patent Act on the basis of Article 6(2)(c) of the Directive 98/44/EC. Upon Mr. Brüstle's appeal to the Federal Court of Justice (Bundesgerichtshof), the proceedings were stayed and the Federal Court of Justice referred questions on the scope of the non-patentability of human embryos to the Court of Justice. This was necessary because the term "human embryo" was left undefined by the Directive. The questions are essentially about the interpretation of the term "human embryo", particularly whether the term "human embryo" concerns all stages of life starting with the fertilisation of the ovum or whether a certain stage of development is required.

As a preliminary matter, the Advocate General pointed out that he was aware of the extreme sensitivity and the high importance of the not only philosophical and moral but also economic and financial implications of that question. The Advocate General is of the opinion that, in the light of the purpose of the Directive 98/44/EC to establish effective and harmonised legal protection of biotechnological inventions, the word "embryo" needs to be given an autonomous definition in EU law.

According to the Advocate General, totipotent stem cells having the capacity to develop into a complete human being must be understood as the first stage of the human body and, thus, legally classified as embryos. This definition covers the entire process from fertilisation to initial totipotent cells and the development of the human body including the blastocyst. Unfertilised ova into which a cell nucleus from a mature human cell has been transplanted or whose division has been stimulated by parthenogenesis shall be included in so far as these techniques aim at obtaining totipotent stem cells.

As regards pluripotent embryonic stem cells taken in isolation, the Advocate General takes the view that these cells do not fall under the scope of the definition of "human embryo" since they do not have the capacity to develop into a complete human being.

If, however, the application of a technical process requires the prior destruction of human embryos or their use as base material, the invention must be excluded from patentability, even if the description of that process does not contain any reference to the use of human embryos.

Uses of human embryos for industrial and commercial purposes shall, however, not be excluded from patentability where the invention is for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it.

The decision of the Court of Justice of the European Union is expected in late summer 2011.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

New gTLDs and IP Protection Mechanisms

Matthew Swinn,Chair of Q160

On 20 June 2011, ICANN's Board of Directors approved the new gTLD program. The Board ratified the latest version of the Applicant Guidebook which, as its name suggests, sets out the rules for applying for a new gTLD. A copy of the Applicant Guidebook (and useful information about the program) can be found via ICANN's web page for the new gTLD program at http://www.icann.org/en/topics/new-gtld-program.htm.

The timetable for the program is as follows.

- 12 January 2012 - Launch Program (Application Window Opens)
- 12 April 2012 - Application Window Closes
- November 2012 - Planned publication of Initial Evaluation Results

ICANN will immediately launch a “global communications program” to inform the public about the opportunities of the new gTLD program.

The new gTLD program will present both risks and opportunities for brand owners. Accordingly, brand owners should be advised of the IP protection mechanisms that are established by the Applicant Guidebook. These mechanisms include the Trademark Clearinghouse's Trade Mark Claims and Sunrise services. The Trademark Clearinghouse will contain a list of word trade marks registered in different countries. It has not yet been determined who will run the Trademark Clearinghouse and it is unclear when trade marks can be included on it.

The Trademark Claims service operates to notify the owner of a trade mark contained in the Trademark Clearinghouse if a trade mark in the clearing house is registered as a domain name (i.e. [trade mark].[new gTLD]). The trade mark owner will only receive notice of a registration where the domain name is an “identical match”.The registration of plurals (e.g. [trade mark]s. [new gTLD]) and [marks contained] will not trigger a notice to issue to the trade mark owner. This service must operate for at least 60 days from the launch of a new gTLD (i.e. from when domain names can be registered within the gTLD).

Clearly, however, the Trademark Clearinghouse will not be a substitute for an independent watching service if brand owners wish to identify problematic registrations.

The Sunrise service will allow owners of trade marks contained in the Trademark Clearinghouse to register a domain name in the gTLD for their trade mark before general registration opens. This service will be available for at least 30 days prior to the launch of a new gTLD. Accordingly, brand owners should consider defensive filing strategies in appropriate new gTLDs.

A further “protection mechanism” that will be available to brand owners in the new gTLDs is the Uniform Rapid Suspension dispute resolution policy (URS) which will operate parallel and as an alternative to the UDRP. While under the URS the UDRP requirements must be established (including bad faith), it is hoped that it will be a faster and cheaper way for brand owners to bring complaints against registrants. However, the burden of proof under the URS is higher than that under the UDRP, as the URS requires that the complaint must be supported by “clear and convincing evidence”, so it will probably only be used in “clear-cut” instances of bad faith.

Within two weeks of the application window closing (i.e. after 12 April 2012), ICANN will publish all applications for gTLDs. Brand owners should be advised to review the applications published by ICANN and consider whether they would like to oppose the registration of any of the proposed gTLDs. An objection may be made to the registration of a proposed new gTLD on the ground that it infringes trade mark or common law rights (amongst other grounds).

In order to address the risks presented by the new gTLD program, brand owners should become familar with the protection mechanisms available under the Applicant Guidebook including the availability of the Trademark Clearinghouse, and the strategies, both defensive and offensive, for approaching the introduction of new gTLDs.

There are numerous web sites with further information on the new gTLD program. One example is http://newgtldsite.com.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Report on the public hearing of user organizations of the trade mark system in Europe (European Commission, Brussels, 26 May 2011)

Dominique Kaesmacher, President of AIPPI Belgium, and Bartosz Krakowiak, Secretary of AIPPI Poland and member of the Special Committee

The main purpose of the hearing was to discuss, between the European Commission and the interested user organizations, a number of issues previously covered or touched upon by the Max Planck Institute's study on the overall functioning of the trade mark system in Europe (the final report was made available to the public in March 2011). As stressed by the Commission, although the study is deemed to be a useful contribution to the Commission's evaluation of the functioning of the European trade mark system, its results do not pre-judge any proposals which the Commission might make on the basis of its overall analysis of the system and of an impact assessment of different conceivable options of a legislative or non-legislative nature. Generally speaking, the Commission is of the opinion that no major changes are needed but only "fine-tuning". Accordingly, the Commission wished to get the views, needs and wishes of the user organizations on some selected topics covered by the MPI Study. The following issues were put on the hearing's agenda:

1. **Requirement for a CTM to be put to genuine use in the Community –** to what extent do users agree with the relevant findings and proposals of the MPI Study?

   The vast majority of the represented organizations supported the first part of the proposal of the MPI Study, which is to maintain Article 15 as it is, considering that the requirement of genuine use of CTMs, including the question of the territorial extent of such use, should be developed on a case–by–case basis. Amongst other factors, requiring use in more than one Member State is not appropriate because it would establish an arbitrary criterion; in addition, use of the mark on exported goods would fall outside such an approach, which is not sustainable. However, most of the represented organizations were against the second part of the proposal of the MPI Study, which is to provide for the possible (under conditions) "coexistence" between an earlier CTM – registered for a period of at least 15 years – and a subsequent national trade mark, provided the last one was applied for in good faith in a Member State remote from the part of the Community where the earlier conflicting CTM was used.

2. **Distribution of 50% of renewal fees by national offices –** what do users think of the position of the MPI Study concerning the objectives and the recommended key of distribution (in particular, the suggestion to take the number of national applications filed each year as a measure)?

   *All represented organizations found the proposal of the MPI Study acceptable, in particular the **objectives** of the distribution being the maintaining of the coexistence of the CTM and national trade mark systems and the improvement of the infrastructure of the national offices and of the qualification of the staff and personnel. With respect to the recommended **key of distribution**, required to be "fair, equitable and relevant" according to the Council conclusions of 25 May 2010, the proposal to have one half of the global amount equally granted to each Member State (irrespective of their size) and the other half granted according to the number of applications by country was globally well accepted by the represented organizations.*

3. **Simplification of CTM procedures by shortening deadlines –** to what extent do users agree with:

   a. the abandonment of the 1 month deadline for payment of the application fee and its substitution by a system according to which at least the order for payment must be made together with the application?

      All represented organizations were against the abandonment of the 1 month deadline for payment of the CTM application fee.

   b. the shortening of the opposition period?

      Most of the represented organizations were against the shortening of the opposition period, even if such a solution could result in acceleration of the CTM registration procedure. Many organizations pointed out the necessity to harmonize the national laws on this point since the differences are important and difficult to explain to clients.

   c. the deletion of the (extra) 2 months period for setting out the grounds of appeal?

      Most of the represented organizations were against the deletion of the (extra) 2 months period for setting out the grounds of appeal. General feeling among the stakeholders was that the shortening of various deadlines is not the best way of accelerating the CTM registration procedure.

   d. the reduction of the term from which the three month opposition period is calculated for Madrid Protocol marks designating the EU?

      Most of the represented organizations initially supported the idea of the reduction of the term

from which the opposition period is calculated for international marks designating the EU – from 6 to 3 months from the publication of extension/designation, as proposed in the MPI Study.

4. **Current regime on searches** (including both mandatory CTM searches and optional national searches) – would the provision of equivalent, automated priority search tools by OHIM, free of charge, constitute an adequate substitute for the current system?

   There was an agreement among the represented organizations that the current regime on searches is not very effective and helpful. However, there may be some reasons for keeping it as it is (e.g. mandatory CTM searches are favourable to the owners of earlier CTMs). Most of the represented organizations, including AIPPI, were against entrusting OHIM with additional search and consultancy services.

5. **Filing of CTM applications through national offices –** should this option be kept, even though relevant applications have become near extinct (0,5%)?; could it be replaced by the possibility of direct, assisted e-filing of CTMs at national offices?

   Most of the represented organizations, including AIPPI, expressed the belief that, as long as the option of CTM filing through national offices is in any use, it should be kept. The reasons why there are applicants who still prefer to use this option (although their number is quite small) should be further examined.

6. **Further legislative harmonization beyond the current scope of the Trademark Directive**

   a. what do users think of the proposals of the MPI Study for further **substantive harmonization** regarding a body of rules addressing trade marks as objects of property (covering transfers and assignment, licenses, rights in rem, levy of execution and insolvency)?

      The represented organizations, including AIPPI, expressed their general support for further substantive harmonization regarding the rules addressing trade marks as objects of property (in particular transfers, assignments and licenses). It was observed that such harmonization may not be possible if these aspects which are strongly linked with other areas of national laws (levy of execution, insolvency).

   b. which **provisions of procedural law** are considered of major priority to be included, such as those concerning the conditions with which the application must comply, date of filing, representation of the sign, classification, (gradual) disappearance of ex-officio examination of relative grounds, observations by third parties, administrative opposition procedure, defence of absence of genuine use in opposition proceedings, administrative procedure for cancellation, defence of absence of genuine use in proceedings seeking invalidation, duration and renewal of registration, and division?

      The represented organizations expressed a general belief that further harmonization of procedural rules addressing trade marks, if possible, introduced step by step, would be desired. Top 3 priorities should be: (1) no ex-officio examination of relative grounds; (2) harmonization of the opposition procedure (duration and grounds); and, (3) cancellation action before the offices.

7. **Use of class headings –** what do users think of the proposals of the MPI Study to resolve this issue?

   Taking into consideration the different approach of OHIM and national offices to the use of class headings issue, all the represented organizations agreed that harmonization in this field is crucial. Most of the stakeholders, including AIPPI, supported the approach " it means what it says" , contrary to the current approach of OHIM, which is " the class heading covers all goods" . However, class heading applications should remain admissible.

8. **Class fees –** how do users see the MPI Study proposal of having a separate class fee from the beginning, and not merely starting from the fourth class (both at EU and national levels)?

   Most of the represented organizations did not support the MPI Study proposal of having a separate class fee from the beginning and were in favour of maintaining the current system (many businesses simply need to apply for multi-class trade mark registrations). Some of the stakeholders would accept the proposal, provided that application fees were generally lowered.

9. **Certification mark –** what do users think of creating a Community system for certification marks?

   Most of the represented organizations were not against creating a Community system for certification marks (within the current CTM system). Some kind of support was expressed; however, all stakeholders agreed that a further study on this issue would be required.

10. **E-Business –** to what extent do users encounter legal difficulties with e-certificate? Does this need a clear legal basis in the Community Trade Mark Regulation?

    The represented organizations expressed their general appreciation for the new E-Business initiatives introduced by OHIM, including the e-certificate. It was agreed that a clear legal basis for the recognition of e-certificates, in the Community Trade Mark Regulation, would be very useful.

The Commission representatives summarized the hearing as having been very interesting and productive, but they refrained from expressing the Commission's current views on the discussed topics. The Commission intends now to consult internally over the summer and then announce a set of legislative (and other) proposals in mid-October 2011, on the basis of MPI study's recommendations, consultations with user organizations (i.e. results of the hearing) and with various other institutions, as well as on its own findings and an impact assessment.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Confidential Data in the Approval of a "Similar" Pharmaceutical Product

Jorge Otamendi, President of Argentine Group

A recent case decided by the Federal Civil and Commercial Court of Appeals in Argentina ("**NOVARTIS PHARMA AG c/ MONTE VERDE SA s/ varios propiedad industrial e intelectual**", Case No. 5.619/05) has resolved an important debated issue: the application of clause 39.3 of the TRIPS *vis a vis* the "similarity of approval procedure" established in the Confidentiality Law No. 24.766 of Argentina.

While the TRIPS Agreement establishes a basis for the protection of data filed for new chemical entities in order to obtain marketing approval of pharmaceutical and agro-chemical products, the Argentine Law provides that there is no need to file such data in the case where similar products have been approved in one of several countries.

Plaintiff asked the Court to stop the use of such information, and to declare that the corresponding clauses of the law and of the ruling decree are unconstitutional because they are contrary to the National Constitution and to the TRIPS Agreement.

The Court of Appeals confirmed the first instance court's decision that rejected the complaint. The most important points in the decision of the Court were:

1. Plaintiff previously used the similarity procedure to seek approval of "tenths" of its products.
2. In seeking the approval of its product, plaintiff did not file in Argentina the data it claims was used by the defendant.
3. Plaintiff did not prove that the data was filed by defendant.
4. It is an abstract question, and this makes it unnecessary to decide if the Argentine regulation is against the Constitution, since the plaintiff did not attack the validity of the administrative act that, under such law, granted the approval to the defendant's product.
5. Plaintiff has no "standing" in the case as long as the data was filed in other countries, but not in Argentina, and the corporate relation with other NOVARTIS corporations was not proven.
6. Defendant acted in compliance with the law and this "constituted the regular exercise of the right".
7. The approval of "similar products" does not imply, by itself, the non-compliance with the guaranty assumed by Argentina to protect the unfair commercial use of the data in question.
8. The Court also confirmed that the abridged procedure has a justification in clause 39.3 of the TRIPS Agreement since it permits all national authorities to rely on the data in their control because of their duties, in order to analyze a second and future application related to the same product, and that this is not unfair commercial use.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

A new law for French country–code Top–level domains

Christophe Caron, French Group Reporter

In 2010, the allocation terms of ".fr" domain names, which was assigned to AFNIC (French Domain name Registry), had been strongly criticized and the government has been asked to create a real legal framework for this matter.

On March 22, 2011, a new law implementing European regulations relating to electronic communications has been promulgated. Article 19 of this law specifies or even changes the previous allocation terms of ".fr" domain names and offers new perspectives for European Union members.

Concerning the allocation terms, the following are the key points of the new law:

- The law confirmed the traditional principle "First come, first served," which means that the domain names will be allocated to the first person who properly asks for it.
- Registrars are accredited by the Registry and exercise their activity under its control. Fund prices for allocation and administration of domain names have to be made public and the Registry has to publish a list of the new registered domain names on a daily basis.
- The allocation of domain names must comply with certain fundamental rights and liberties, such as freedom of communication, freedom of economic initiative and intellectual property rights.
- The allocation or renewal of a domain name can be refused, or a domain name cancelled, under certain conditions:
  - If it is contrary to law and order or morals, or other rights guaranteed by the Constitution or law.
  - If it infringes intellectual property rights or personality rights, except where the registrant has a legitimate interest or acts in good faith.
  - If it is identical or related to the French Republic, or any other French public institution, except where the registrant has a legitimate interest or acts in good faith.
- The law specifies that a new litigation procedure, based on adversarial principles, will be introduced after being promulgated by the Minister in charge of Electronic Communication. Anyone demonstrating a standing under the procedure can ask for the cancellation or transfer of the Domain name, and the Registry must decide within 2 months.
- Pre-empting the change in the French legislation, two procedures have been suspended:
  - The PARL procedure before the WIPO, since April 15, 2011; and
  - The PREDEC procedure before the AFNIC, since May 15, 2011.

The previous terms will be effective on July 1, 2011.

For the European Union members, the French legislators decided to enlarge the category of registrants entitled to reserve these top level domains. As from December 31, 2011, the registration of ".fr" domain names will be opened to:

- Individuals domiciled in the European Union territory.
- Companies having their headquarters or principal establishment located in one of the European Union territory.

AIPPI
e-News

No. 19
July 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | P.O.Box |CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Overview of Internal Privilege

Ashley Roughton, United Kingdom Group Reporter

On 23rd May, 2011, the UK Group of AIPPI held an event in London to discuss the topical and difficult issue of privilege and its applicability in an international context. The discussion was led by Michael Dowling of the Australian law firm, Allens Arthur Robinson, who is Chairman of AIPPI Committee Q199 (privilege task force).

The conduct of modern litigation is prefaced on the principle that no party may take the other by surprise. Usually and often, this surprise could take many different forms such as the emergence of a late witness or evidence, often part way through a trial or even after it; but, whilst it was accepted that in some cases such things can happen through no person's fault, it is desirable to minimise this as far as possible. This provided the basis for disclosure. Parties have to be entitled, however, to say that certain documents ought not to be disclosed; broadly speaking that which involved lawyers and getting legal advice. This countervailing policy was that legal proceedings are less likely or lengthy if a lawyer has been properly instructed and that those proper instructions must be kept within the inner core of confidentiality. Actually, this countervailing policy should descend to any communication of any sort so that a client can feel confident that he or she can unburden themselves to their lawyers. Thus, such communications are said to be privileged from disclosure. In most cases it was not hard to say when the privilege arose and when it did not. However, circumstances often arose where it was uncertain or unclear whether such privilege arose or not and a recent lecture organised by the UK AIPPI group examined in some detail the circumstances where privilege arose. Importantly, where international intellectual property portfolios are concerned then a great deal of case must be exercised before entrusting advice to foreign lawyers.

Three principal areas were covered: privilege in England; privilege in the USA; and, the work of AIPPI to make the rules of privilege uniform especially so far as intellectual property questions were concerned.

The line-up was impressive: Michael Dowling of Allens Arthur Robinson in Melbourne, Australia, was first to speak on the attempts by AIPPI to bring about a uniform set of rules concerning privilege. He outlined one principal issue which was that in some jurisdictions disclosure is not (rightly or wrongly) regarded as important. It follows that if disclosure is not important then privilege from disclosure is less important. Hence there was a cultural difference of opinion concerning whether the problems associated with disclosure were worth thinking seriously about at all. This cultural difficulty also pervaded the question (not regarded as important in many jurisdictions where disclosure was not regarded as important) of standardisation. One way forward which he suggested was to accord privilege to foreign lawyers or Patent or Trade Mark attorneys if those lawyers or attorneys were accorded privilege in their own jurisdiction. This would be immensely important as far as clients who had international IP portfolios were concerned.

The next speaker was Philip Croall of Freshfields in London. He was the solicitor who was instructed in the Bank of England supervisory negligence litigation which involved a number of hearings (including some to the Supreme Court) concerning privilege in England. He emphasised that in reality privilege is essentially a matter of fact but he also gave some interesting examples of how to apply the various rules. Two interesting points emerged being (1) what constitutes a “client” - privilege is not simply attained just because an employee of a client writes to a lawyer; there has to be a corpus within the client which is concerned with the legal questions involved and (2) whether the communications in question are for the purpose of attaining legal advice as opposed to business advice and what to do if the two are bound up with each other. Emerging from this was the question of whether to “award” privilege to people who are nearly lawyers, such as tax accountants. Litigation is currently underway in which this question has been tested. The current position is that accountants do not get privilege but the Supreme Court has recently decided to hear the appeal so there might be a change in this position.

Finally Tim May of Finnegan from the USA gave an outline of the position in the USA. Concerning communications with foreign counsel then US law applies to questions involving US law (such as if the communication concerns a US patent) but foreign law applies to foreign communications (say, if a foreign patent application is involved), which differs from the approach in the UK. Tim gave some examples such as where a patent was rejected for want of novelty then advice given in relation to another patent application (say, in Japan) then that is not privileged.

In general, if foreign law does not recognise privilege then the US will not do so.