

Questionnaire Q199

Remedies to protect the right of clients against forcible disclosure of their IP professional advice

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National Group: Austria
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1. Q.199 - Questionnaire

The Groups are asked to reply to the following questions in the context of what applies or what they may consider ought to apply in their own country or by agreement between their country and others, as may be appropriate to the particular question. The responses of each Group need to be endorsed by that Group. It will be helpful and appreciated if the Groups follow the order of the questions in their reports and use the questions and numbers for their responses.

Present position

Local position

- 1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and IP professionals within your country?

The members of the qualified independent professions of attorneys-at-law and patent attorneys encribed in the list of their respective institutes are protected against forcible disclosure of any kind of communication with a client made in the course of their professional activity by any kind of administrative body and civil or penal courts even when the client released the attorney from his secrecy obligation.

- 1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

There are third parties which also have secrecy obligations such as civil engineers, official test institutes (technical and otherwise), administrative agencies, so that the communication of clients with them is also protected. Otherwise, communication of clients with knowledgable individual persons of firms or public institutions, like universities, who could serve as experts, are not protected. If such a third party is from another country, the answer of this question depends on the law in the respective other country. As far as such communications are sent to IP professionals under 1.1, they are of course also protected.

- 1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

There are third parties which also have secrecy obligations such as civil engineers, official test institutes (technical and otherwise), administrative agencies, so that the communication of clients with them is also protected. Otherwise, communication of clients with knowledgeable individual persons of firms or public institutions, like universities, who could serve as experts, are not protected. If such a third party is from another country, the answer of this question depends on the law in the respective other country. As far as such communications are sent to IP professionals under 1.1, they are of course also protected.

Overseas communications

- 1.4 What protection of clients applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Whether the communication received or issued by overseas professionals is protected depends first and for all on the law in that country. But the client itself cannot refer to any secrecy obligation of himself before administrative offices or courts, while any communication by a qualified professional as defined under 1.1 with a foreign person is also protected.

Scope of protection – qualifications of IP professional advisers

- 1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to in-house advisers?

- (i) as to 1.1. ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

It applies to attorney-at-law and non-lawyer patent attorney (who are automatically also trade mark attorneys) both in independent profession (or employed by independent professional firms). It does not apply for in-house attorneys employed by industry. It does also not apply to European Patent Attorneys if they are not fully locally qualified as attorneys-at-law or patent attorneys since their EPO qualification does not extend to litigation (except for EPO oppositions). Trade mark attorneys do not exist as independent profession.

- (ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

Communication between clients and third parties are not protected except where the third party happens to also underlie by law to secrecy obligations.

- (iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

Communication between attorneys-at-law or patent attorneys both members of the legal independent profession and third parties are protected as far as they are concerned and for those third parties who have also secrecy obligations by law.

- (iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

All acts by local IP professionals in the sense of (i) are protected, clients themselves are not protected. As concerns foreign IP professionals themselves their protection depends on the law applicable to them.

Limitations and exceptions

- 1.6 What limitations (eg dominant purpose test, judges' discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

- (i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
- (ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
- (iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
- (iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

ad (i) – (iv)

Protection is absolute. There is only now one very limited exception, and that is money–laundering which is applicable in IP laws where piracy goods are used for that purpose.

Quality of protection
Local communications

- 1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?
- (i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
 - (ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
 - (iii) as to 1.3 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
 - (iv) as to 1.4 ie the protection applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

ad (i) – (iv)

Appropriate quality.

Communications with overseas IP advisers

- 1.8 Does your Group consider that the protection described in answer to question 1.4 above is of appropriate quality or not, and if not, why not – what are the problems in practice?

Appropriate.

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

- 2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes, if it englobes advice as to grant and opposition procedure and potential litigation and not narrowed down to actual litigation.

- 2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Yes, if it englobes advice as to grant and opposition procedure and potential litigation and not narrowed down to actual litigation.

Judicial discretion to deny protection

- 2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No.

- 2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Because discretion is not a reliable, secure standard.

- 2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

Not applicable.

Qualifications required of IP advisers

- 2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes.

- 2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

Not applicable.

- 2.8 If for some category of IP adviser in your country, no qualification is required –

Not applicable since non-qualified IP advisors are not allowed; private advice by non-qualified persons is and should not be protected.

- (i) What category is that?
- (ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?
- (iii) As to your answer to sub-para (ii), why?

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

- 2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes, if not too narrow (see 2.1 above).

- 2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

Not applicable.

- 2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?

Yes, but no extension of existing limitations should be possible.

- 2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it?

Yes, but no extension of existing limitations should be possible.

Exceptions and waivers

- 2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

Yes.

- 2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPPI, does your Group agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such an exception or waiver should it wish to do so in the future, in other words, that there should be liberty to vary or abolish a presently applied exception or waiver?

Yes, but no new or larger exceptions as hitherto.

- 2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it?

See 2.14

The AIPPI proposal compared with the alternative described in Section 5 above

- 2.16 Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section 5 above), does your Group prefer and if so why?

Preference is given to the AIPPI proposal as recited in 4.7 of the Guidelines. The reason is that the proposal in 5.1 of the Guidelines would give EP representatives only qualified to practice before the EPO an enhanced status concerning advice for which they are not qualified, which enhanced qualification they could acquire if they so want.

However, if the last half sentence „plus ...“ is canceled from 5.1 (i) and the last half sentence „and in any case ...“ from 5.1 (iii), we would prefer the new proposal of 5.1 since it is clearer. This under the understanding that privilege for in-house attorneys cannot be required in those countries which do not provide for it locally and will not have to accept if from other countries which likewise do not provide it.

Proposals from your Group

- 2.17 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

Preference is given to the AIPPI proposal as recited in 4.7 of the Guidelines. The reason is that the proposal in 5.1 of the Guidelines would give EP representatives only qualified to practice before the EPO an enhanced status concerning advice for which they are no qualified, which enhanced qualification they can acquire if they so want.

However, if the last half sentence „plus ...“ is canceled from 5.1 (i) and the last half sentence „and in any case ...“ from 5.1 (iii), we would prefer the new proposal of 5.1 since it is clearer. This under the understanding that privilege for in-house attorneys cannot be required in those countries which do not provide for it locally and will not have to accept if from other countries which likewise do not provide it.

- 2.18 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

None.
