

## Questionnaire Q199

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

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**National Group:** Estonian National Group

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#### 1. Q.199 - Questionnaire

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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? When was this protection introduced into your law?

*§ 6. Guarantees to professional activities of patent agents \**

...

*(2) Information disclosed to a patent agent shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses with regard to information which became known to them in the provision of legal services nor shall explanations be requested from them with regard to such information.*

*(3) Media received in the course of provision of legal services shall not be confiscated from patent agents or the employees of a company of patent agents, or from a company of patent agents. (Patent Agents Act, entered into force on 20 April 2001.)*

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**\* Most of the Estonian patent/trade mark attorneys are non lawyer patent agents.**

- 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?

*Taking into account the above mentioned case, protection of clients against forcible disclosure of communications is missing in the Estonian Act.*

- 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?

**See paragraph 1.1.**

#### **Overseas communications**

- 1.4 What protection of clients 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 clients and overseas IP professionals ?

*(a) Communications between local patent agents in Estonia and overseas IP professionals shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses and media received in the course of their services shall not be confiscated.*

*(b) Communications between clients and overseas IP professionals are not protected against forcible disclosure.*

#### **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?

*The guarantees against forcible disclosure of communications apply to the registered Estonian patent attorneys and registered Estonian trade mark attorneys.*

- (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?

*The guarantees against forcible disclosure of communications do not apply to the communications between IP professionals' clients and third parties.*

- (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?

*The guarantees against forcible disclosure of communications between IP professionals and third parties apply only to the registered Estonian patent attorneys and registered Estonian trade mark attorneys. Protection of third parties against forcible disclosure of the communications is not guaranteed by a specific point of 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?

*(a) Protection against forcible disclosure of communications between registered Estonian patent attorneys or registered Estonian trade mark attorneys and overseas IP professionals is guaranteed.*

*(b) Forcible disclosure of communications between local clients and overseas IP professionals is not guaranteed by a specific point of law.*

### **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?

*No limitations apply.*

- (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?

*Protection against forcible disclosure of communications is not guaranteed.*

- (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?

*Dominant purpose test applies.*

- (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?

*(a) Dominant purpose test applies.*

*(b) Protection against forcible disclosure of communications is not guaranteed.*

## **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?

*Estonian patent attorneys have not had any forcible disclosure problems at the State level.*

- (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?

*Extensive patent litigation experience for conclusions is missing.*

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?

*Extensive patent litigation experience for conclusions is missing.*

### **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?

*Extensive patent litigation experience for conclusions is missing.*

## **2. Remedies**

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### **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?

*No provision should be made to limit the documents to which protection applies.*

- 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?

##### **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?

*Our group considers that the limitation in relation to judicial discretion of the documents to which protection applies would not be acceptable.*

- 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?

- 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?

##### **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. Quality of advice should be improved.*

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?

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

(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? *No.*

(iii) As to your answer to sub-para (ii), why?

*In the interests of quality and legal certainty of the Court decisions.*

**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? *No.*

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?

*Limitations do not facilitate open and frank communications between IP adviser and client.*

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?

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?

**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.*

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, in particular should e.g. the

limitation for the “3-point-exception” as discussed in para 4.28 above also set limits in this case?

*The “3-point exception” provision, which would be similar to Article 30 of TRIPS is too general. In order to achieve consensus it would be acceptable if there is no other solution.*

- 2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

*Extensive patent litigation experience for conclusions is missing.*

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

- 2.17 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?

*Alternative proposal may be taken as a basis of the discussions.*

### **Proposals from your Group**

- 2.18 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.

*Our group supports alternative in Section 5 in general, but does not support nomination of the in-house IP advisers (incl. lawyers and EPA's) equally with the private practice legal advisers to the category of IP advisers who should have a privilege.*

- 2.19 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.

- 2.20 With the introduction of protection against forcible disclosure of IP professional advice or any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

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### **Note:**

**It will be helpful and appreciated if Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.**

## **Summary**

In Estonia, information disclosed to a patent agent (registered Estonian patent/trade mark attorney) shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses with regard to their professional advice and media received in the course of their legal services shall not be confiscated. Limitation in relation to judicial discretion of the documents to which protection applies would not be acceptable. IP advisers (local and overseas) to whom lawyer-client privilege and litigation privilege applies, should have approved qualification in the field of IP protection. An alternative proposal made under Section 5 of the Working Guidelines is favored in general, however nomination of the in-house IP advisers (incl. lawyers and EPA's) equally with the privileged private practice IP advisers is not supported.