

## Questionnaire Q199

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

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**National Group:** The Finnish Group of AIPPI

**Contributors:** Rainer Hilli, Marja-Leena Mansala, Tapio Äkräs

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#### 1. Q.199 - Questionnaire

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The answers and opinions of the Finnish Group of AIPPI are presented in italic after the questions.

##### **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?

*Provisions concerning the legal position and situation of IP professionals in Finland are found in two acts. The Act on Advocates (496/1958) regulates the Finnish Bar Association and its members and the Code of Judicial Procedure (4/1734) governs the representation of clients before the court, pertaining both to procedural questions and qualification of the representatives in question. Furthermore, also the Act on Patent Agents (552/1967) and the Decree on patent agents (636/1969) and the Decree amending said decree (52/1996) concern the registration of patent agents. However, said act and decrees do not contain any regulations as regards the privilege of communications between clients and IP professionals in matters concerning IP advice. The Finnish Bar Association is an organization pertaining to public law, which is regulated by the Act on Advocates. The organization was preceded by a*

*registered association with the same name. All members of both organizations are and always have been lawyers.*

*Anyone applying for membership in the Bar Association must have completed a Master of Laws degree (LL.M.), entitling him/her to hold a judicial office, and he/she must be known to be a person of integrity. Furthermore, he/she must have several years of experience in the legal profession and other judicial duties. He/she must also pass an examination covering the basic elements of the legal profession and professional ethics. An advocate must be independent and autonomous in relation to the government and all other parties except for his client.*

*Only members of the Bar Association are entitled to use the professional titles "asianajaja" or "advokat".*

*Section 5c of the the Act on Advocates states that an advocate or his assistant shall not, without due permission, disclose the secrets of an individual or family; or business or professional secrets which have come to his knowledge in the course of his professional activity. Breach of this obligation of confidentiality shall be punishable in accordance with Chapter 38 Section 1 or 2 of the Criminal Code (39/1889), unless a more severe punishment is stipulated elsewhere in the law. Said section in the Act on Advocates was given on 21 April 1995 and came into force on 1 September 1995 as Section 5b and was afterwards changed to Section 5c in 1999; initially, however, the obligation of an advocate or an agent not to disclose his or her client's confidential information was incorporated and stipulated in the Criminal Code in the 19<sup>th</sup> century following Central European tradition.*

*Pursuant to Chapter 15 Section 2 of the Code of Judicial Procedure, only an advocate or a counsel who has a Master of Laws degree is entitled to serve as an attorney or counsel and represent person / companies before the court; the degree is not required if said attorney or counsel is a direct ascendant or descendant, a sibling or a spouse of the party. According to Section 17 in the same Chapter, a representant and his/hers assistant are under the same obligation to confidentiality as an advocate as described above and as stipulated under Section 5c of the Act on Advocates. This privilege of confidential communication by the client includes issues and documentation related to court proceedings during the course of which the patent attorney / agent can assist an advocate. Section 17 in the Chapter 15 was given on 21 April 1995 and it entered into force on 1 September 1995.*

- 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 is no explicit protection concerning communication between clients and third parties under statutory law in the absence of an advocate or attorney at law. If the communication is mediated or transmitted through an advocate or attorney at law, the statement from a third party is protected under the laws and provisions as stated in 1.1.*

- 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 the answers to 1.1 and 1.2.*

#### **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 ?

*See the answer to 1.1.*

#### **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?
  - (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 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?

*As demonstrated in the answer to 1.1, the Finnish legislation concerning the privilege of the client's confidential information is scarce and limited in its scope. Only advocates have their attorney-client privilege explicitly stipulated and regulated in a separate act. The other groups of IP specialists and their communication (i.e. patent agent/attorney, trademark agent/attorney,*

*design agent/attorney) may be granted privilege in situations related to certain court proceedings where the privilege concerns issues relating to said proceedings.*

### **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?

*Under de lege lata, to our knowledge, there are no limitations or exceptions to the rules stated in our answer to 1.1.*

### **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?

*Based on knowledge and understanding on said matters, we have no material or empirical experience that the quality of protection provided by the Finnish legislation would not be sufficient.*

### **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?

*With reference to our answer to 1.4, we have no experience of such problems in practice.*

## **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?

*Finland is a civil law country and as such, like in other civil law countries, the most important question is that the privilege granted to the confidential information and documentation of the client is accepted and acknowledged internationally. Said privilege serves the purpose to reject any demand of discovery. According to the Finnish legislation, the Court may order in a matter, upon the request of any one party, that the other party in said proceeding shall submit and provide certain document(s) which otherwise would be kept secret for the pursuit of study by the other party..*

- 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?

*We are not convinced that limiting the documents to which protection applies would be the right answer to the international acceptance of client privilege. This could lead to a variety of limitations that would not improve harmonization.*

**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?

*See the answer to 2.2.*

- 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?

*See answer to 2.2.*

- 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'?

*In our opinion, in its current form and scope the qualification in question is somewhat too extensive and overly wide and a more limited scope would be better aligned with the purpose of the qualification.*

- 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?

*With reference to our answer to 2.6, we suggest that the wording and definition of the qualification would be amended as follows: "the qualification of an IP expert should be based on an examination or registration that shows his/her experience in the IP field".*

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

- (i) What category is that?

*Trademark attorneys*

- (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?

Yes

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

- 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?

- 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

- 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.

- 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?

- 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?

- 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?

**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?

*Out of said two options, in their current form, we favor the AIPPI proposal.*

**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.
- 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.**