

**15 January 2010  
(extended 2 February 2010)**

**Question Q199  
Privilege Task Force**

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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**

Preliminar remark :

French group would like to emphasize the main conceptual differences between “professional secrecy” and “legal privilege”.

Professional secrecy is not in France equivalent to the legal advice privilege benefiting the client.

The French criminal code prohibits professionals who are under an obligation of professional secrecy, such as “Avocats” from revealing secrets entrusted to them because of their profession.

Therefore this is not so much a privilege for the client as an obligation for the professional to keep secret all the information received from his client.

The client is free to decide whether or not to disclose the advice provided by the professional, but he cannot order the professional to provide information to a court;

So, professional secrecy is an obligation on the adviser, contrary to privilege which is a right of the client in a common law country to withhold details of confidential communications with a legal adviser without losing his case as a result.

## 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?

For IP professional advice prepared by in-house IP advisers: protection under rule 153 of the Munich Convention (European patent convention), no other specific protection beyond the corporation trade secret protection

For IP professional advice prepared by IP advisers (“Conseils en propriété industrielle”) working in private practice: similar protection as the protection recognised to lawyers admitted to a bar, since the Law of February 11, 2004.

For lawyers admitted to a bar (“avocats”): broad scope of professional secrecy, last law change in April 1997 to extend the protection “in all matters; whether contentious or non-contentious”

- 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?

No specific protection

- 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?

The protection existing under professional secrecy extends to all documents relating to a given matter (see 2.9 of AIPPI Submission to WIPO dated 28/08/2009)

Consequently, such documentation

- Is protected if the IP professional is a lawyer admitted to a bar (avocat) or a “Conseil en propriété industrielle”,
- if the IP professional is an in-house IP adviser no specific protection beyond the corporation trade secret protection and the rights granted under the Munich convention

## 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?

The protection existing under professional secrecy extends to all documents relating to a given matter (see 2.9 of AIPPI Submission to WIPO dated 28/08/2009).

a) between local IP professionals and overseas IP professionals

a-1 Local professional is an "avocat"

(i) in Europe

cf art 19-5-3 Règlement interieur

(ii) with non EU Member States

cf art 3-4 RI

a-2 Local professional is a "Conseil en propriété industrielle"

same rules

b) between clients and overseas IP professionals

- can be protected if the local IP professional is an in-house IP adviser and the overseas IP professional can claim privilege and supervises said the local IP professional,
- is not protected if the local IP professional is an in-house IP adviser and the overseas IP professional can not claim privilege or similar protection. Practice indicates that even in the certain countries (US for example) some courts or authorities recognize protection and some don't.

### **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?

Apply to “avocats”, ;”conseils en propriété industrielle” iworking in private practice;

Does not apply to non lawyer patent attorney, non lawyer trade marks attorney For in-house qualified IP advisers see 1 4) b above.

NB. Non-lawyer patent or trademark attorney is unknown in France

- (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?

See 1 3) and 1 4) b above

- (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?

Apply to “avocats”, ”conseils en propriété industrielle”. For IP attorneys working in private practice see 1 3) and 1 4) b above.

NB. Non-lawyer patent or trademark attorney is unknown in France

- (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?

Apply to the different IP professionals under the conditions described in 1.4;

See 1 4) b above.

### **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?

Where protection exists, no limitation, no exception, no waiver except within the provisions against money laundering, and criminal offences made by the IP professionals themselves

- (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?

See 1 3) and 1 4) b above

- (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?

Where protection exists, no limitation, no exception, no waiver except as in (i) above

- (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?

Where protection exists, no limitation, no exception, no waiver except as in (i) above

### **Quality of protection**

#### **Loc**

#### **al 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?

Our group considers that the protection is not appropriate because unclear.

- (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?

Our group considers that the protection is not appropriate because unclear

- (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?

Our group considers that the protection is not appropriate because unclear

### **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?

Our group considers that the protection is not appropriate because unclear

## **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?

Our group does not agree that countries may 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?

Our group considers that it is dangerous to establish a standard based on the relationship between documents and the IP legal advice because some documents in relation with the IP legal advice could be disclosed; it includes those which may contradict the IP advice.

**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?

See 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'?

This open standard may lead some common law countries to oppose the international 'device'.

- 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?

Our group considers that a specific reference to a qualification, such as admission to practise before his/her national patent/design/trademark office, may be desirable.

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

(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?

Our group considers that the treaty should not allow countries to adopt or maintain a difference between lawyer-client privilege and litigation privilege.

- 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?

Because most if not all of the work of IP adviser is at least indirectly related to litigation; any opinion is about the freedom to act and its limits and would covers very often different options or take different views on specific matters and when litigation arrises, the client and the IP adviser have to work under the new circumstances without running the risk of being jeopardised by earlier advices.

- 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?

There should be a liberty to lower or abolish the limitation.

**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.

**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?**

- 2.14 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?

Our group does not understand the link of this question with the content of article 30 of the TRIPS.

- 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?

NO

#### **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?

Our group prefers the alternative of Section 5, as it enhances the likelihood to be adopted by the most sophisticated countries while solving the most detrimental issues existing in most of the civil law countries, including ours.

#### **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.

N/A.

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?

We do not expect any adverse effect on our national law, on the IP systems or on any IP practitioner already enjoying protection.

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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.**