

199 – Questionnaire

Answers Germany

- 1.1 Under Section 39a (2) of the German Patent Attorneys Act a German patent attorney has to keep all information he/she gets secret. Under Section 203 of the German Criminal Act breach of clients secrecy is a criminal offence. To guarantee the clients' secrets a patent attorney has the right to refuse testimony under Section 53 of the German Code of Criminal Procedure and under Section 383 of the German Code of Civil Procedure. This applies to the employees of a patent attorney as well. We do not know when the privileges for patent attorneys were introduced in the German law but it has been introduced in 1968 at the latest.

However, in Germany sole European patent attorneys (if they are not German patent attorneys at the same time) are not qualified to give legal advice in infringement matters or licensing. They are allowed to draft and prosecute European patent applications and oppositions. As a result they do not enjoy privilege in Germany for the time being. There is only a very limited privilege in respect to the European Patent Office under Rule 153 EPC.

- 1.2 There is now protection against forcible disclosure of communications with third parties unless the third party acts as an assistant to a patent attorney or lawyer.
- 1.3 The communication between patent attorneys and third parties such as technical experts are privileged if the technical expert acts under the supervision of the patent attorney.
- 1.4 The communication between German patent attorneys and foreign attorneys is privileged as well if the foreign attorney acts in behalf of the client. That applies to communication between foreign attorneys and the clients as well. However, there must be a chain of communication between German attorney, foreign attorney (if any) and the foreign client to enjoy privilege.
- 1.5 The answers are included above.
- 1.6 Generally there are no limitations or exceptions. However, a German attorney must not act or argue contrary to his own knowledge. Otherwise the attorney might be considered as an accessory.
- 1.7 As far as communication between clients and their attorneys is concerned the protection is fully sufficient (i). It is the opinion of the German Chamber of Patent Attorneys that the protection of communications between clients and third parties (ii) should not be granted unless the third party acts as an assistant under the supervision of an attorney (iii). Otherwise the enforcement of IPRs could be impeded disproportionately. There must be a limit.
- 1.8 So far we have not yet faced any problems. As far as we know German courts have granted full privilege to foreign attorneys as well, as long as they had acted on behalf of the client.

2.1 to 2.5 Any principle or standard should guarantee full and frank communication between clients and their attorneys. Therefore there should be no limitation unless the advisor (attorney) contributes to a criminal act or a fraud himself. This limitation is German standard.

2.6 and 2.7 The privileged should be limited to those persons (IP advisers) which are qualified to give legal advice under their national law. Otherwise a client could probably claim privilege for any witness alleging he/she has given legal advice. Therefore any country had to define who is a qualified legal advisor.

2.8 In Germany exclusively patent attorneys and attorneys at law are qualified to give legal advice in IP matters. Sole European Patent Attorneys are allowed to represent clients and to give legal advice only in prosecution before the EPO (see above 1.1).

2.9 to 2.15 see above 2.1 to 2.5

2.16 No

2.17 We would support the standard as under 5.1. It looks like this is very equivalent to German standard. However, the privilege shall apply only as far as the IP advisor gives advice within the legal area covered his/her qualification, e.g. trademark attorneys for trademark matters only, European patent attorneys in patent prosecution and opposition before the EPO only.

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