

Question Q199

National Group : AIPPI Indonesia

Title : **Remedies to protect the right of client against forcible disclosure of their IP professional advice**

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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? When was this protection introduced into your law?

The protection of clients against forcible disclosure of communications relating to IP professional advice as to such communications between clients and IP professionals is protected under article 19 paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate, and article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant.

Article 19 paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate stipulates:

- (1) advocate shall not disclose any thing that is known or obtained from the client because the professional relationship, unless stipulated otherwise by the Act.*
- (2) lawyers are entitled to maintain confidentiality with clients, including the protection of files and documents against wiretapping on electronic advocate's communications.*

This protection introduced into our law and became effective on April 5, 2003.

and,

Article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant stipulates:

“(4) Consultant of Intellectual Property Rights are obliged:

- a. To obey the laws in the field of Intellectual Property Rights and other legal provisions;*
- b. To protect the client’s interests, by maintaining the confidentiality of information relating to the application of Intellectual Property Rights foreclosed to him; and*
- c. To provide consulting services and socialization in the field of Intellectual Property Rights, including procedures for filing applications in the field of Intellectual Property Rights.”*

This protection introduced into our law and became effective on January 4, 2005.

Further, protection of clients against forcible disclosure is also provided by Patent Law No.: 14/2001 in Art. 4, par (2):

Article 4

- (2) An Invention shall also not be deemed to have been published, if, within a period of 12 (twelve) months before the Filing Date, it was announced by any other person by way of breaching an obligation to preserve the confidentiality of the relevant Invention.

Thus, the client is still protected and has the right to file a patent application in case there is leak of the genuine information pertaining the invention itself and the novelty requirement of this invention would still be fulfilled.

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?

Not Applicable, but it could be covered from agreements (contract) between clients and third parties (such as technical experts).

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 clients could be protected against forcible disclosure of communications relating to IP professional advice between IP Professionals and third parties (such as technical experts) through agreement (contract). And the contract itself is necessary for evidentiary purpose, in case there is a breach and lead to the leak of confidential information to public.

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) Local IP professionals are protected by Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant. Hence, there are no specific regulation concerning protection to IP professional advice between local IP professionals in our country and overseas IP professionals.

(b) There are no specific Indonesian Law and Provisions regarding to Protection of clients applies in our country against forcible disclosure of communications relating to IP professional advice. However, it could be covered through agreement (contract) which made by clients and overseas IP professionals.

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 (e.g. 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. i.e. 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 protection of clients against forcible disclosure of communications relating to IP professional advice is applied between clients and IP Consultants.

(ii) **as to 1.2 i.e. 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?**

Should the third parties are not IP consultants, therefore, the protection of clients against forcible disclosure of communications relating to IP professional advice will take into effect based on agreement (contract).

(iii) **as to 1.3 i.e. 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 protection of clients against forcible disclosure of communications between IP professional and third party will take into effect based on agreement (contract).

- (iv) **as to 1.4 i.e. 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?**

The only protection for communications provided to local IP consultants, however, the protection for communications (a) between local IP professionals and overseas IP professionals, and (b) between the clients and overseas IP professionals, will take into effect based on agreement (contract).

Limitations and exceptions

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

- (i) **as to 1.1 i.e. 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 limitations and/or exceptions and/or waivers apply to the protection of clients against forcible disclosure of communications namely interest for the security and defence, health, or safety of the public Criminal and/or Civil Court Proceedings and also by judges' discretion to do justice.

- (ii) **as to 1.2 i.e. 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 (i) above.

- (iii) **as to 1.3 i.e. 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?**

See (i) above.

- (iv) as to 1.4 i.e. 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?

See (i) above.

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 i.e. 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?

Yes, the protection of clients against forcible disclosure of communications relating to IP professional advice is appropriate according article 19 Paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate and article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant.

- (ii) as to 1.2 i.e. 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?

No it is not appropriate quality. There should have provisions that regulate third party to disclose clients' information, and maintain the secrecy. The third party might be applied to Article 1365 of Indonesian Civil Code concerning Tort.

- (iii) as to 1.3 i.e. 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?

See (ii)

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?

No, it is not appropriate quality, because there are no applicable Law and Provisions in Indonesia regarding to Protection of clients against forcible disclosure of communications relating to IP professional advice where those communications are between clients and overseas IP professional

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, we agree that new provision should be made in the agreed principle or standard that countries may limit the documents such as clinical test.

- 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?**

It is mandatory to have such a limitation.

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, we do not agree that countries should be bounded in judicial discretion.

- 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?**

No, it is mandatory.

- 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?**

N/A.

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, there's should be standard requirements for IP adviser 'to be qualified to give the IP advice.

- 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 –**

- (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, we do agree the protection is provided in IP Law (such as: Trade Secret Law, Industrial Design Law, Layout Design of Integrated Circuit Law, Patent Law, Mark Law, Copyright Law) and also Advocate Law.

- 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?**

The main idea from lawyer-client privilege and litigation privilege are similar whereas both privileges (lawyer-client privilege and litigation privilege) are to protect client's information.

- 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?**

We, do not agree.

- 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?**

N/A.

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, we agree.

- 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, we agree.

- 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?**

N/A.

- 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?**

N/A.

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?**

The Indonesian Group is in favour of 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.**

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.

N/A.

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 expect the development on national law regarding the protection of clients.

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.