

Questionnaire Q199

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

National Group: Ireland

Date: 31 July 2010

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?

Forcible disclosure of communications between clients and IP professionals is protected under the following Acts in Ireland:

1. The Trade Marks Act 1996 came into effect on July 1, 1996. Section 91(1) of the Act provides: This section applies to communications in respect of any matter relating to the protection of a trade mark or in respect of any matter involving passing off.

(2) Any communication to which this section applies—

(a) between a person and his registered agent, or

(b) for the purposes of obtaining or in response to a request for information which a person is seeking for the purpose of instructing his registered agent,

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his solicitor or, as the case may be, a communication

for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his solicitor.

2. The Patents Act 1992 came into effect on August 1, 1992. Section 94 (1) of the Act provides: A communication to which this section applies shall be privileged from disclosure in any proceeding (including a proceeding before the Controller or competent authority under the European Patent Convention or the Treaty) to the same extent as a communication between client and solicitor is privileged in any proceeding before a court in the State.

(2) This section applies to a communication—

(a) between a person, or person acting on his behalf and a solicitor or patent agent, or person acting on his behalf, or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a solicitor or patent agent

in relation to any matter concerning the protection of an invention, patent, design or technical information or any matter involving passing off.

3. The Industrial Designs Act 2001 came into effect on July 1, 2002. Section 87 of the Act provides: (1) This section applies to communications in respect of any matter relating to the protection of a design.

(2) Any communication to which this section applies—

(a) between a person and his or her registered agent, or

(b) for the purposes of obtaining or in response to a request for information which a person is seeking for the purpose of instructing his or her registered agent,

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his or her solicitor or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his or her solicitor.

(3) In *subsection (2)*, “registered agent” means:

(a) a registered trade mark agent;

(b) a registered patent agent.

(4) Section 94(2) of the [Patents Act, 1992](#) , is hereby amended by the deletion of “, design” and the said subsection shall be construed and have effect accordingly.

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?

The provisions in 1.1 cover where the client is seeking information in order to instruct his registered agent, otherwise there are no specific provisions, however the general law relating to privilege may apply in appropriate circumstances.

- 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 provisions in 1.1 cover where the IP professional is seeking information in order to allow the client to instruct his registered agent, otherwise there are no specific provisions, however the general law relating to privilege may apply in appropriate circumstances.

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 ?

There is no specific legislation on this issue, however the same provisions identified at 1.1, 1.2 and 1.3 are likely to apply in Ireland. In relation to overseas, it is likely to be a matter of local law in each jurisdiction.

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?

Lawyer: In so far as a lawyer is a solicitor, the normal rules of legal professional privilege apply and depending on the nature and circumstances of the communication they may in appropriate circumstances be protected against forcible disclosure of communications relating to IP professional

advice given to clients. In addition, solicitors are specifically mentioned in the provisions relating to patents (see 1.1 above).

Lawyer/patent attorney, non-lawyer patent attorney, lawyer/trade mark attorney, non-lawyer trade mark attorney: communications between these individuals and their clients may be protected against forcible disclosure as set out in 1.1 above.

There is no distinction in Ireland law between external and in-house IP Professional advisers other than where there is a noting on the Register of Trade Marks and Patent Agents that specifically states that the agent may only represent their organisation.

- (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 1.5(i) 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?

See 1.5(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 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?

See 1.5(i) above. In relation to communications with overseas IP Professionals, it is likely to be a matter of local law in each jurisdiction.

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?

The same exceptions, limitations and waivers apply to these communications as under the general law relating to privilege, for example:

Limitations:

The dominant purpose test

If the communication is deemed to be legal assistance rather than legal advice it is not privileged.

Exceptions:

The crime/fraud exception

Privilege will not be permitted if it would injure the interests of justice where persons were guilty of moral turpitude or wrong-doing even where it does not amount to fraud.

Waiver:

A client can waive the privilege.

In relation to advice given to corporate clients, if the client shares the advice outside the corporation the privilege will be waived.

Privilege may also be lost if mistakes are made and privileged items are disclosed in error to the other side.

- (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 1.6(i) 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?

See 1.6(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?

See 1.6(i) above. In relation to communications with overseas IP Professionals, it is likely to be a matter of local law in each jurisdiction.

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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.

- (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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.

- (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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.

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?

There are no specific provisions dealing with overseas communications and therefore clarification may be advisable.

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

- 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?

Privilege has never been a blanket protection. Similar limits apply with regard to the legal professional privilege in relation to communications with solicitors.

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?

This would be very vague and subjective. Clients should be able to communicate with IP professionals without fear that this communication will be forcibly disclosed on some unclear and arbitrary basis.

- 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?

We do not foresee any wording which would address our concerns.

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.

- 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?

Not Applicable

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

- (i) What category is that?

There is no specific recognised copyright qualification.

- (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?

As there is no specific recognised copyright qualification, any communication would likely fall under general legal principles.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

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- 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. There is no reason why countries should not be allowed to limit the scope of protection to the categories of privilege which are currently part of their 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?

Not Applicable.

- 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?

It would be appropriate if limitations were varied in accordance with how the limitations under general legal principles develop.

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

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- 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?

It would be appropriate if limitations were varied in accordance with how the limitations under general legal principles develop.

- 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?

Litigation is quite rare in Ireland and there have been no major cases that have dealt with this issue that we are aware of.

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 alternative proposal in Section 5 does not provide more protection than we already have in Ireland. The AIPPI proposal is preferable, however it would need to be modified to take account of Professor Cross’ recommendations set out above.

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.

There are two ways to deal with this, namely to introduce specific provisions for all IP professionals or to apply the same provisions as apply to legal professional privilege. As the same document or communication can contain IP advice and general legal advice, it would be difficult to operate two different systems of privilege so it would be more practical to implement similar provisions to the existing legal professional privilege system.

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?

If the situation remains the same or the scope of privilege is broadened, it is unlikely that there will be any serious adverse effects. However if the scope is narrowed there are likely to be extremely prejudicial adverse effects.
