

Questionnaire Q199

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

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National Group: Norway

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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?

Answer: No protection applies to IP professional advice as such. Protection applies to communications between clients and lawyers in private practice. There is no distinct litigation privilege. As to communications between client and in-house lawyers, there is some case law from the last decade or so supporting the view that they can be protected if the in-house lawyer has a role that, were it not for the fact that he is an employee of the client, would equal that of an independent lawyer.

The general rules on privilege were introduced at least as early as 1927.

- 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?

Answer: None, unless such technical experts are employed or retained by a lawyer the communications with whom would be covered by protection, see answer to Question 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?

Answer: None, unless such technical experts are employed or retained by a lawyer the communications with whom would be covered by protection, see answer to Question 1.1

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 ?

Answer:

(a) Communications relating to advice sought by a client from a foreign IP professional via a local IP professional would be protected by if:

(i) the foreign IP professional is a lawyer in private practice, and

(ii) the local IP professional is a lawyer or is employed or retained by a lawyer

(b) Communications relating to advice sought by a client from a foreign IP professional directly would likewise be protected if the foreign IP professional is a lawyer

Generally, it is thought that a Norwegian court would avoid ordering a foreign IP professional to disclose communications which he or she would be prevented from disclosing under the laws governing their professional activities in the jurisdiction where they conduct them.

However, there is no case law dealing with this.

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?

Answer: Client protection applies to lawyers, lawyer/patent attorneys, lawyer/trade marks attorneys, provided they are practicing lawyers, i.e. are registered with the Control authority for legal practices. Client protection does not apply to communications between the client and his In-house advisers, with the exception of in-house lawyers on certain conditions, see the answer to 1.1 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?
 - (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?

Answer: The protections mentioned have the following exceptions/limitations

- a) Money laundering legislation (EU/EEA based legislation)
- b) Communications for which the client has waived protection or the contents of which he has disclosed.

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?

Answer: the general level of protection is thought to be adequate in quality. There have not been many problems in practice from the point of view of the clients. However, it would appear that protection should be available to communications between clients and IP professionals that are not practicing lawyers or employed or retained by a practicing lawyer. There would no longer be a need to ensure that non-lawyer IP professionals and technical experts are employed or retained by lawyers for protection to apply to communications between them and clients. Competition between lawyer and non-lawyer IP professionals would be fairer.

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?

Answer: No. Although there are no recorded cases of loss of protection in Norway for communications relating to advice sought by a client from a foreign IP professional, there is clearly a risk of this occurring, and the general uncertainty and unpredictability of the present situation is not satisfactory.

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?

Answer: Probably they should.

- 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?

Answer: Some minimum relationship with the seeking of advice should probably apply for protection to be available.

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?

Answer: 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?

Answer: It is in the best interest of all parties and of society at large that IP advice, similarly to legal advice, should be sought and given under full disclosure of all relevant facts and that opinions and advice should be candid and frank. For this to happen, the communications between client and adviser need to be protected, so that they can be made in confidence that they will be confidential, and that such protection will apply globally and at all times.

- 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?

Answer: 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'?

Answer: No

- 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?

Answer: A license by the patent or trademark office, or a form of registration that confirms the adviser is qualified to give the IP advice, combined with a control authority supervising the conduct of IP advisers practices should be required.

- 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?

Answer: (i) None applies

(ii) and (iii) N/A

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?

Answer: Probably no

- 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?

Answer: Norway has no discovery. A court may order a party (or a third party) to disclose a specific document, but not if that means setting the principle of lawyer-client privilege aside. There appears to be little need to introduce a specific litigation privilege in Norway.

- 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?

Answer: There should be liberty to abolish a limitation.

- 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?

Answer: It should not be possible for any country to introduce any limitations or to expand the scope of any existing limitations to privilege. It is especially important that no country should have the liberty to introduce or expand the scope of any limitations to privilege with retroactive effect, i.e. with effect on communications that have already been exchanged between client and adviser or third party when the limitations in questions are enacted and made public.

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.

Answer: 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?

Answer: Yes, as long as its scope is not expanded or the conditions for applying the exception are not eased..

- 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?

Answer: The “3-point-exception” may be a useful approach.

- 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?

Answer: 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?

Answer: The AIPPI proposal, because it is the only one of the two that deals with the problem of different standards in different countries. Also, it widens the scope of application of the protection to other categories of IP advisers than European Patent Attorneys.

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.

Answer: The Norwegian group generally favours the AIPPI proposal. However, within the group, there are different opinions as to whether communications between client and in-house counsel and in-house IP advisers should be protected.

- 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.

Answer: One should try to achieve a general recognition and enactment where necessary of the principle in each jurisdiction that, if communications between a client and its IP adviser belonging to an identified group or category are protected from forcible disclosure, then it shall not matter if that IP adviser is foreign or operates or is qualified to give advice in a different jurisdiction than that of the client: the communications shall be privileged.

- 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?

Answer: We do not anticipate such adverse effect.