

Questionnaire Q199

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

January 19, 2010

National Group: [ASOCIACION PANAMEÑA DE PROPIEDAD INTELLECTUAL (APADEPI), The Panamanian Intellectual Property Association]

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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?

[PANAMA]

There are two different kinds of protection of clients against forcible disclosure of communications.

1. Regarding to any kind of professional advice given by lawyers to clients (including IP matters), with regards to the process at hand, the lawyer is not obliged to declare with regards to the confidences received from his clients. And the advises given with regards to a process

handled by the lawyer. The said protection is general, it is included in the Article 912 of the judicial code, and refers to testimonies.

2. Additionally the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

In Panama there are no exclusive regulations to the matter of “forcible disclosure of communications” relating to attorney client communication, our rules for discovery are of general application.

A Pre-trial discovery is possible (it can be granted upon a court decision based in the fact that without it, evidence might be lost), but it is seldom granted in Panama, and it cannot be targeted to a client attorney communication.

Courts do not grant pre trial discovery disclosure to “fishing expeditions” as they are called in the country and refer to those where the applicant request all kind of documents without any rationale behind the search of a specific document.

Additionally Panama does not have privilege or protection for communications related to clients and any other non lawyer IP adviser. Therefore the risk of disclosure either forcible or caused by lack of sufficient measures to protect the information is imminent.

- 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?

[PANAMA]

The Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Unless the lawyer participates in the communication the same is not deemed protected.

- 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?

[PANAMA]

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Unless the lawyer participates in the communication the same is not deemed protected.

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?

[PANAMA]

There are two different kind of protection of clients against forcible disclosure of communications relating to any kind of professional advice given by lawyers to clients (including IP matters), with regards to the process handled. Said protection is general, it is included in the Article 912 of the judicial code, it regards to testimonies.

Additionally the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Any disclosure made by a Panamanian Lawyer, in other country, as long as evidenced here in Panama, can be subject to the application of the Ethics Code of the National Bar Association.

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?

[PANAMA]

To Lawyers, there is no distinction whether outside or in house counsel, of any kind of Law Practice (including IP Law).

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

- (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?

[PANAMA]

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client's lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.

- (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?

[PANAMA]

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client's lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.

- (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?

[PANAMA]

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client's lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.

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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”

Additionally the attorney or its employees, that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client's authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

- (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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”

Additionally the employee of the lawyer, keeping a confidence or secret that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client's authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

- (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?

[PANAMA]

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- (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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure "forcible disclosure", according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the "the interest or fear justifying the pre trial discovery"

Additionally the employee of the lawyer, keeping a confidence or secret that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client's authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

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?

[PANAMA]

The protection is not appropriate, it shall be more specific and related only to IP matters and relationships, where not only lawyer employees participate in advise giving, but other IP professional, such as engineers, doctors, agents, technicians, etc. shall be included.

- (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?

[PANAMA]

There is not protection given to clients to this kind of disclosure, unless an attorney o lawyer has requested the advice from the third party, and in that case, the privilege set forth in answers below apply.

- (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?

[PANAMA]

There is not protection given to clients to this kind of disclosure, unless an attorney or lawyer has requested the advice from the third party, and in that case, the privilege set forth in answers below apply.

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?

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?

[PANAMA]

No, we agree that a general provision should be made, and shall be kept as simple as possible to be applicable to all countries, no matter if common or civil law applies, a main rule shall be created and each country shall develop and define their own tests to apply to.

- 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?

[PANAMA]

In Panama the forcible disclosure seldom occurs in IP related matters, furthermore, our law does consider all communications between lawyer client to be privileged, why would we want

to limit the same? Meaning that the dominant purpose test only will limit the scope of our protection.

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?

[PANAMA]

Courts do have that discretion here. As explained in 1.1 and 1.6; but we consider that judicial discretion in the IP subject matter although shall have limitation, should not rely solely on court's 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?

[PANAMA]

Courts in Civil Law countries do not have the same power as Common Law countries, and granting a power seldom given without proper training and control can generate a huge problem in IP related matters, where client secrets are at stake..

- 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?

Not applicable

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'?

[PANAMA]

Yes, we consider that all communications related to IP advice, given by qualified IP advisers shall be kept protected, without entering into the kind of communication given.

- 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?

[PANAMA]

Not applicable

- 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?

[PANAMA]

Not applicable

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?

[PANAMA]

No, all communications between lawyer client, and advisor client, related to IP matters shall be kept protected.

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?

[PANAMA]

It will definitely limit the scope of our protection.

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?

[PANAMA]

Yes, any country should have the right to apply the standard or not.

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?

[PANAMA]

The liberty to abolish the privilege distinction or any other limitation shall only be limited by the definitions set forth in the proposed and then approved treaty, in the sense that it would not limit the right of protection that a client has won with this agreed standard.

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.

[PANAMA]

At least self defence rule, the crime fraud rule too, the public domain theory (when applicable) or the client's consent.

- 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?

[PANAMA]

Yes any State shall have the right to vary the limitations or exceptions to any rule, as long as the principal right protected by the treaty lies unprotected.

- 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?

[PANAMA]

The liberty to abolish the privilege distinction or any other limitation shall only be limited to the definitions set forth in the proposed and then approved treaty, in the sense that it would not limit the right of protection that a client has won with this agreed standard.

- 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?

[PANAMA]

Not applicable.

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?

[PANAMA]

We find the WIPO proposal to be more in accordance with Panamanian Civil Law System, where a definition of the IP Adviser will be brought, where all communication pertaining any matters of IP (defining the matters) would be included, where no difference of in house or private practice attorneys are brought, where no standards to communications shall be applied and the client and solely the client shall decide whether a communication can and will be disclosed.

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.

[PANAMA]

We rather the WIPO approach; it poses fewer changes to the system, yet gets the same protection acquired by the AIPPI proposal.

- 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.

[PANAMA]

No further comments

- 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?

[PANAMA]

We do not foresee any adverse effects.

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.