

Questionnaire Q199

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

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National Group: Poland

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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?**

Polish law does not know the institution of discovery or similar. Therefore it does not directly regulate any protection of clients against forcible disclosure of communications relating to IP professional advice. The law only protects legal professionals against forcible disclosure of their professional secrecy. The attempt to forcibly disclose communications relating IP professional advice could be regarded as an attempt to circumvent the provisions protecting professional secrecy.

Polish law recognizes a protection of confidentiality of IP professional advisors working with clients on the protection of their IPR rights. The protection of IP advisors against forcible

disclosure of information received during providing advise to a client is set forth in various regulations with regards to different professional groups. In Poland there are several groups of professionals working on the protection of IPR rights:

- *Patent attorneys (lawyers and non-lawyers)*
- *Advocates*
- *legal advisers.*

All these groups has a internal law which provides a duty to keep secret any information obtained in the course of providing legal advice.

The Act of 26 May 1982 - the Bar Law (Journal of Laws of 2002 No. 123, item 1058):

Article 6. 1. An advocate is under a duty to keep secret everything he has learnt in the course of providing legal assistance.

2. A duty to keep secret cannot be restricted to any period of time.

3. An advocate may not be relieved from the duty to keep professional secrets with regard to facts which came to his/her knowledge whilst providing legal assistance or whilst conducting a case.

4. A duty to keep professional secrets does not concern any information available in accordance with provisions of the Act of 16 November 2000 on Anti-money laundering and terrorist financing (Journal of Laws of 2003 No. 153, item 1505) to the extent regulated by the this Act.

The Act of 6 July 1982 on Legal Advisers (Journal of Laws of 2002 No. 123, item 1059):

Article 3. 3. A legal adviser is obliged not to reveal any information which he/she acquired in the process of providing legal service.

4. A duty to keep secret cannot be restricted to any period of time.

5. A legal adviser cannot be freed from keeping confidential the information he/she acquired in the process of providing legal service or representing the client's case

6. A duty to keep professional secrets does not concern any information available in accordance with provisions of the Act of 16 November 2000 on Anti-money laundering and terrorist financing (Journal of Laws of 2003 No. 153, item 1505) to the extent regulated by the this Act.

The Act of 11 April 2001 on Patent Attorneys (Journal of Laws of 2001 No. 49, item 509):

Article 14. Patent Attorney is under a duty to keep secret everything he has learnt in the course of his/her professional activity.

- 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?

No Polish regulations.

- 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?

No Polish regulations.

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 ?]

No Polish regulations.

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?

Applies to all categories of IP professional advisers described in 1.1.no matter if external or in-house adviser.

- (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?

N/A

- (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?

N/A

- (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?

N/A

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 possibility of relieving legal adviser from an obligation of keeping a secret is provided only in Code of Criminal Proceedings. Legal advisers can be exanimated in facts under secret only if it is necessary for good of jurisdiction and circumstance can not be established on basis of different evidence. Only judge can relief legal advisers from keeping a secret.

The Act of 4 August 1997 - Code of Criminal Proceedings (Journal of Laws of 1997 No. 89, item 555):

Article 180 § 1. Person under a duty to keep official or professional secret may refuse to testify as to the facts covered by a duty, unless relieved from the duty by the court or by a prosecutor.

§ 2. Person under a duty to keep professional secret of a notary public, an advocate, a legal adviser, a physician or a journalist may be interrogated as to the facts covered by a duty only when necessary for the good of justice system, and the facts cannot be established by any other evidence. In preliminary proceedings the court decides the interrogation or permission for interrogation, in an in camera session, no longer than 7 days of the date of receipt of a motion from a prosecutor. A complaint may be filed against court decision.

In addition, Code of Criminal Proceedings provides in Article 178 that the hearing of a witness may not be allowed, if the witness is:

- 1) *a counsel for the defense or an advocate acting under Article 245 § 1, as to the facts he become aware of, whilst providing legal assistance or whilst conducting a case.*

In Poland, the problem of relieving the attorney of the duty to keep secret raises a lot of controversy. The majority of the attorneys in Poland, specifically the advocates, are willing to enhance their confidential duty, so that they cannot be relieved from a duty by the court. It is widely argued that the attorney, obliged to testify before the court against his/her client (by disclosure of the information received from a client) expose himself/herself to a disciplinary liability of the legal practitioner. Consequently, the attorney is forced to make a difficult choice between bearing the responsibility for obstructing proceedings (as a result of refusing to testify) and bearing a disciplinary liability of the legal practitioner.

- (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?

N/A

- (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?

N/A

- (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?

N/A

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?

Although the protection of IP professionals is broad, its impact is only national. There is also a problem of legal relationship between Code of Criminal Proceedings law and regulations of the specific professions. Few years ago, the advocates were defending the non-applicability of Code of Criminal Proceedings law to them, therefore there was no possibility of relieving them from a duty to keep secret.

- (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?

There is no legal basis of protection.

- (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?

There is no legal basis of protection.

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?

N/A

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?

There is very different practices as to privilege between countries that do have such a concept. It appears that introducing the principle or standard as a first step should not force to much uniformity in this area.

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?

The attorney should not be obliged to testify against his client. The profession of an attorney is the profession of public confidence and the situations where the priority is given to the protection of client's interests should be always taken into consideration. Client should feel safe confiding in his/her attorney.

- 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, definition is wide enough to give best scope of protection.

- 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?

n/a

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

No

- (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.

- 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 standard or principle being a very new vehicle we agree that some flexibility has to be left to the member states.

- 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?

No limitation.

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.

No.

- 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.

- 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?

"3-point-exception" is acceptable. The most important issue is not to prejudice the legitimate interests of the patent owner who IP adviser represent or advising.

- 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?

No

The AIPPI proposal compared with the alternative described in Section 5 above

- 2.16 **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?**

Polish group prefers the AIPPI proposal, because of its general character. General provisions fit better within diverging legal systems.

Proposals from your Group

- 2.17 **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

2.18 **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?

n/a