

## Questionnaire Q199

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

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**National Group:** Singapore

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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?

##### **Answer –**

##### **Professional communication between a lawyer and his client**

**Section 128 of the Singapore Evidence Act** provides that:

No advocate and solicitor ( Singapore lawyer) shall at any time be permitted, unless with his client's express consent, to disclose any communication made to him in the course and for the purpose of his employment as such advocate or solicitor by or behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment

Confidential communications covering all IP related matters (i.e. patent, trademark, design copyright and passing off) are covered by the professional privilege between a lawyer and his

client. The privilege belongs to the client and not the lawyer and can be waived by the client but not the lawyer (unless consent is given by his client)

**Section 94 of the Singapore Patents Act** declared that the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an advocate and solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to and advocate and solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in Singapore extends to such communications so made for the purpose of any pending or contemplated proceedings before the (Patent) Registrar.

In the section, “legal proceedings” and “pending or contemplated proceedings” include references to application for a patent and to international applications for a patent.

### **Common Law**

Litigation privilege, which can be said to be a sub-head of legal professional privilege, attaches to confidential communication between a lawyer and his client or between a lawyer or his client and a 3<sup>rd</sup> party where the communications came into existence in connection with pending or contemplated legal proceedings.

### **Privilege for communication with patent agents**

**Section 95 of the Singapore Patents Act** provides that a communication with respect to any matter relating to patents –

- (a) between a person and a registered patent agent 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 his patent agent,

is privilege from disclosure in legal proceedings in Singapore 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.

The Singapore Patents Act mandates the registering of suitably qualified persons as patent agents. Hence confidential communication with respect to any matter relating to a patent between a registered patent agent and his client is privilege from disclosure in the same way as though the communication was with between a lawyer and his client.

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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-**

Communications between a client and 3<sup>rd</sup> parties (including technical experts) are not privileged. However, where the advice of 3<sup>rd</sup> party experts are sought to enable legal advice related to IP to be obtained then it would be prudent for the communications to be made between the 3<sup>rd</sup> party experts and the lawyer or patent agent (relating to any patent matters in the latter case) on behalf of his client so that the statutory privilege protection can apply to such communication. (Section 128 Evidence Act and Sections 94 & 95 Patents Act)

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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 -**

There are two categories of IP professionals – (a) lawyers and (b) patent agents.

**(a) Lawyers**

**Section 128 of the Evidence Act** accords legal professional privilege (which includes litigation privilege) to communication between a client and a lawyer or between a 3<sup>rd</sup> party such as a technical expert and a lawyer on behalf of his client.

**(b) Patent Agents**

**Section 95 of the Singapore Patents Act** provides that a communication with respect to any matter relating to patents –

(c) between a person and a registered patent agent or

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

is privilege from disclosure in legal proceedings in Singapore 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.

The Singapore Patents Act mandates the registering of suitably qualified persons as patent agents. Hence confidential communication with respect to any matter relating to a patent between a registered patent agent and his client is privilege from disclosure in the same way as though the communication was with between a lawyer and his client.

The statutory privilege covering confidential communications between a client and his patent agent is restricted to patent matters only whereas the statutory legal professional privilege between a client and his lawyer would cover all IP related advice.

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**Overseas communications**

1.4 What protection of clients applies in your country against forcible disclosure of communications applies to clients 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) Confidential communication between local IP professionals (lawyers and patent agents) and overseas IP professionals are privilege bearing in mind the more restricted privilege of patent agents and their clients.

**(b) Confidential communications with legal advisers**

**Section 131 of the Evidence Act states:** No one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional adviser unless he offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others.

Communication between the client and foreign professional lawyers would come within the scope of the section. There is no Singapore case law to clearly establish if a foreign patent agent who is not a lawyer would come within the ambit of the section.

It would be prudent therefore for the client to take the view that communication between the Singapore client and the foreign patent agent may not be covered by privilege.

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### **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 inhouse 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**

There are two classes of IP professionals: (a) lawyers and (b) patent agents. Applying English common law principles section 131 of the Evidence Act would apply to extension the privilege to communication between the client and his in-house counsel.

Outside the context of litigation privilege, it would be prudent to assume that communication between the client and foreign 3<sup>rd</sup> parties who are not lawyers would not qualify for protection from disclosure. Please refer also to the answer to Q 1.4 above.

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### **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 privilege accorded to communications between IP professionals and clients do not apply in cases where the communications arose in connection criminal or fraudulent purposes.

Also the privilege is lost if the communications are no longer confidential; for example where the communications are disclosed to 3<sup>rd</sup> parties by the client or waived by the client.

Insofar as litigation privilege is concerned, the privilege only applies where the communications arose in respect of pending or contemplated legal proceedings.

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### **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)

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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?

(iv) as to 1.4 ie the protection applies in your country against forcible disclosure of communications applies to clients 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**

The privilege situation appears to be satisfactory as the discovery process (compulsory disclosure of documents in court) is not as extensive as say in the United States. There has been no cogent and public call to the authorities for the law on privileged communications to be urgently reviewed.

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**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**

Although there is no Singapore case law to categorically establish the point, it is generally considered that communications between a client and a foreign non-lawyer IP professional, for example a foreign patent agent who is not registered as a patent agent with the Intellectual Property Office of Singapore, would not be protected by privilege assuming the communications do not come within the ambit of litigation privilege.

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**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 – Yes**

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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 –** The law on privilege communications should generally be decided by individual countries to suit their respective local conditions and laws. It may not be appropriate for a country where the development of IP protection is different from another to dictate to that other country to march in step with the first country.

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**Judicial discretion to deny protection**

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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**

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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 preferable that there be certainty in the law as to what communication is privilege and what is not so that IP professionals and their clients have the assurance and confidence that their relevant communications enjoy protection from disclosure. This certainly enables advice to be given in light of all relevant facts. It is best therefore that Parliament be vested with the power and responsibility of mandating the law on privilege. The possibility that the exercise of judicial discretion (if allowed in law) may override what may otherwise be regarded to enjoy protection will erode confidence between the parties. In this event IP advisors may not given all relevant details and so any advice rendered may be unreliable.

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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** - The law provides for crime and/or fraud exceptions. In a sense the exceptions can be said to be an exercise of judicial discretion as it is for the court to determine if the exceptions apply and so lift the veil of protection. There is no need for the law to be further varied.

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#### **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

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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** – It is not sufficient, in the public interest, for the IP adviser to be merely qualified to render advice. The existing regime requires also that the IP advisers be registered with the court (in the case of lawyers) or patent office (in the case of patent agents) so that the professional conduct of the IP adviser is monitored. This requirement to remain in the register of the appropriate profession and answerable to the appropriate sanctioning body (court or patent office) acts as an additional safeguard that an unscrupulous person is not in a position to render professional advice to the public.

Awareness that the IP adviser is subject to rules governing his professional conduct will engender confidence in his client who can then have the assurance that the IP adviser must respect and be bound by the confidentiality of the advice rendered.

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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** - Only lawyers (who can render advice in all areas of IP) and patent agents (restricted to patent matters only) are recognized as IP professionals. Privilege from disclosure subsist as explained earlier herein.

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**Scope of protection against forcible disclosure – the differences between lawyerclient 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**- Yes. The public interest and benefits to be obtained in harmonizing the law on privilege from disclosure should not detract from the other public interest and right of countries to legislate laws to suit local conditions and concepts.

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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** – Not applicable

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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** – Yes

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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** – Signatories to a privilege from disclosure protocol should be allowed to broaden any limitation so that the protection umbrella is extended. But the converse should not be countenanced. There should not be a case where communications with IP advisers which previously enjoyed protection is then exposed to public gaze.

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**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



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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 the right to vary but not to abolish a presently applied exception or waiver.

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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?

**Answer** – Signatories to a privilege from disclosure protocol should be allowed to broaden any limitation so that the protection umbrella is extended. But the converse should not be countenanced. There should not be a case where communications with IP advisers which previously enjoyed protection is then exposed to public gaze.

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**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?

**Answer** - Section 5 as it allows for lesser generalization and greater scope for accommodating the laws of the individual countries.

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**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.

Answer – Not applicable

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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.

Answer – Singapore is a small country with an open economy and one that is reliant on foreign investment and trade. The Singapore government therefore is careful not to embark on passing legislation that may be seen as radical, preferring instead to be in step with common law countries such as UK from where most, if not almost all, of our laws are derived and adapted to the local environment. Accordingly, the Singapore government would be unlikely to be taking the lead in any reforms in this area of the law and would be more likely to await and review the results of reforms carried out, if any, in the larger common law jurisdictions.

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**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.**