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Questionnaire Q199

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

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National Group: SE

Contributors: Margareta Linderöth
 Bo Davidsson

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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: The answer depends at present on the IP professional.

(a) Legal professional privilege gives an independent lawyer the right to withhold from disclosure communications between the lawyer and his client. This only applies to members of the Swedish Bar Association (advokater). An in house lawyer has no such right nor an intellectual property advisor. 2

(b) There is however a law on its way in Sweden that will change the situation. The law will according to the Governmental Bill of April 8, Prop. 2009/10:202 come into force on September 1, 2010. According to the proposal evaluation of the patentability of an invention, preparation and filing of patent applications at an authority or organisation, evaluation of the validity, scope of protection, possible infringement in and rights to a patent as well as preparing for acting in a court in relation to patents are the subject of the client attorney privilege. Thus the privilege is narrower than that for "advokater". The rule can also apply to in house lawyers, but restricted to information in relation to patent matters. Business figures will normally not be privileged. In order for the privilege to apply the persons receiving the information must be an authorised patent attorney (auktoriserat patentombud). The proposal is that persons on the European Patent Office list of professional representatives as well as persons at present authorised by IPS (Sveriges IP Samfund arranging the present authorisation in Sweden which has no legal impact) and who have worked for at least five years with patent matters will be authorised during the first year after the law has come into force upon filing an application and paying a fee. After that a special exam will be necessary. At present in house Trade mark attorneys are not included.

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 the "client" within an organisation and other employees of the same organisation may be regarded as communications with third parties and will normally not be privileged.

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: No protection is available at present. In the future see 1.1 (b) above.

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? 3

Answer:

There is no explicit statute in Sweden regarding this. However if such a legislation applies in a foreign country between an attorney in that country and a Swedish client the Swedish client will benefit from the privilege afforded under the foreign law.

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?

Answers: The questions (i)- (iv) above apply as follows to the different classes of IP professionals

(a) The communication from “advokater” with their clients is privileged.

(b) For IP advisors and for in house lawyers privilege will apply for communications in relation to patent matters as defined in question 1.1 (b) when the new law comes into force and provided that the IP advisors and in house lawyers are registered as authorised Swedish patent attorneys

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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?

Answers: The protections above are limited in the following respects:

(a) Crime/fraud exception. Communications relating to a criminal or fraudulent purpose cannot be shielded by legal professional privilege.

(b) Waiver. Communications which are read out in open court, or otherwise cease to be confidential, will generally cease to be protected as will those disclosed to the other side (unless the Court orders to the contrary).

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? **5**

(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?

(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?

Answers:

(i) Not at present regarding IP advisors, but will probably be in relation to authorised patent attorneys when the proposed law comes into force.

(ii) No

(iii) No .

(iv) No.

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 the point has not recently been tested, it appears likely that the advice of non-lawyer foreign IP professionals is not privileged.

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). **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.

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: Countries should be able to limit the extent to which privilege applies in accordance with their established rules of privilege.

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: The rationale for legal advice privilege is that honest advice will be sought and given where there is a well-placed confidence that the subject-matter of the communications will be kept confidential. Opening the possibility that this will not occur removes that confidence, for at the time of giving and seeking advice it will not be possible to anticipate the thinking of an unknown Court of an unknown country in an unknown case many years later.

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: We believe that the crime/fraud exception adequately covers the case where the immediate interests of justice in the case prevail over the long term interests of justice in ensuring the provision of legal advice. **7**

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: Pursuant to 2.4 and 2.5, we believe that the advisor should be licensed by a court, the patent or trade mark office or equivalent government body, so as to imply a control relationship justifying public trust in the advisor. According to the proposal in Sweden the IP advisors not being "advokater" must be authorised by a new governmental body.

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?

Answers:

(i) In Sweden any person will be able to give IP advice also in the future. However, it will only be those authorised by the new governmental body that will be allowed to call themselves Authorised patent attorneys.

(ii) No. As outlined in 1.1 above, in the SE, privilege protection is limited at present limited to lawyers and will be extended to authorised patent attorneys in the future.

(iii) See 2.7 above.

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: Yes. Whilst harmonization is to be encouraged, countries should be able to apply their distinct categories of privilege to IP cases as to other cases. 8

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.

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.

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: Any treaty should include a protocol allowing a country to make a reservation varying or abolishing a previously applied limitation. The reservation must only allow a country to widen the privilege protection it affords, and must not allow a country to narrow any existing privilege protection as that would detract from the good faith expectations of parties seeking advice.

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

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: As with 2.12, any treaty should include a protocol allowing a country to make a reservation varying or abolishing a previously applied exception or waiver. The reservation must only allow a country to widen the privilege protection it affords, and must not allow a country to narrow any existing privilege protection as that would detract from the good faith expectations of parties seeking advice. 9

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: Neither per se – elements of both.

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: A country which applies legal professional privilege (whether attorney-client privilege or litigation privilege) in the field of intellectual property to its domestic non-lawyer intellectual property advisors, should extend the same privilege to equivalent intellectual property advisors specially qualified and licensed to act before regional, international or foreign national courts or intellectual property registration offices. "Intellectual property" should be defined widely, with reference to WIPO treaties or as per the ICC submission to WIPO on August 27, 2009.

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: For Sweden we expect that the proposal described above under 1.1 will come into law and that other countries will follow. For Sweden a solution is still lacking for attorneys handling trade mark and design protection and more work is needed to include also them.

In relation to the difference between advisors in a country and foreign the aim should be not to define privilege but to extend what already exists in a country to a defined group of foreign advisors in just the same way as is done for lawyers, on the basis of comity.

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.