

Questionnaire Q199

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

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National Group: Thailand

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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?

1. Clauses 4 and 11 of the Regulations of the Lawyers Council of Thailand on Lawyers' Ethics B.E. 2529 (A.D.1986) enacted under Lawyer Act B.E. 2528 (A.D. 1985)

Any lawyer who discloses a client's confidential information obtained while acting as a lawyer (unless with a permission from the client or with a court order) shall be deemed guilty of misbehavior which is subject to any of the three types of penalties being under the provisions of Sections 51 and 52 of the

Lawyers Act B.E. 2528 (A.D. 1985), i.e. probation, suspension of practice not exceeding three years or deletion of the name from the lawyers' registrar.

Under the Lawyer Act B.E. 2528 (A.D. 1985), "Lawyer" means those who have been registered with the Lawyers Council of Thailand.

Thus, the above provisions apply only to lawyers who are qualified and registered with the Lawyer Council of Thailand.

2. Section 323 of the Penal Code, enacted on 13 November B.E. 2499 (A.D. 1956)

Whoever knows or acquires a private secret of another person by reason of his functions as a competent official or his profession as a medical doctor, pharmacist, drug dealer, midwife, nurse, priest, advocate, lawyer or auditor, or by reason of being an assistant in such profession, and then discloses such private secret in a manner likely to cause injury to any person, shall be punished with imprisonment not exceeding 6 months or a fine not exceeding 1,000 baht or both.

The above provision applies to both lawyers who are qualified and registered with the Lawyer Council of Thailand and lawyers who provide their advice but are not qualified and registered with the Lawyer Council of Thailand.

3. Section 324 of the Penal Code, enacted on 13 November B.E. 2499 (A.D. 1956)

Whoever knows or acquires a secret related to industrial, discovery or scientific knowledge by reason of his position, profession or trusted career, and discloses such information for his or other person benefit shall be punished with imprisonment not exceeding 6 months or a fine not exceeding 1,000 baht, or both.

The above provision applies to both lawyers and non-lawyers.

4. Section 420 of the Civil and Commercial Code, enacted on 11 November B.E. 2468 (A.D. 1925)

A person who, willfully or negligently, unlawfully injures the life, body, health, liberty, property, or any right of another person is said to commit a wrongful act and is bound to make compensation therefor.

The above provision applies to both lawyers and non-lawyers.

5. Section 92 of the Civil Procedure Code, enacted on 15 June B.E. 2478 (A.D. 1935)

Where any party or person is required to give testimony or produce any kind of evidence, and such testimony or evidence may entail the disclosure of

(1)

(2) any confidential document or information which was entrusted or imparted by a client to him in his capacity as a lawyer;

(3) any invention, design or other work protected for non-disclosure by law.

The said party or person is entitled to refuse to give such testimony or to produce such evidence unless with permission from the competent official or the person concerned.

Where any party or person refuses to give testimony or produce evidence as aforesaid, the court shall have the power to summon the competent official or person concerned to appear in court and give such explanation as the court may require in order to decide whether the refusal is well-grounded or not. Where the court is satisfied that the refusal is not well-grounded, it shall have the power to issue an order so that such party or person can not take advantage of this section and must give such testimony or produce such evidence.

For the above items (2), it applies to lawyers only. For item (3), it applies to both lawyers and non-lawyers.

6. Section 231 of the Criminal Procedure Code, enacted on 5 June B.E. 2478 (A.D. 1935)

Where any party or person is to give testimony or produce any evidence as follows:

(1)

(2) any confidential document or information which has been acquired or made known to him by virtue of his profession or duty;

(3) process, method or any other work which was protected for non-disclosure by law, the said party or person shall be empowered not to give testimony or produce evidence unless a permission is obtained from the competent official or the person concerned.

Where any party or person refuses to give or produce evidence as aforesaid, the court has summoned an authority or a person concerned with such secret to appear and give an explanation in order that the court may decide whether or not there is any ground to support such refusal. Where the court is of opinion that the refusal is groundless, it shall order such party or person to give or produce such evidence.

The above provision applies to both lawyers and non-lawyers.

- 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?

Technical experts have privileges under Section 92 of the Civil Procedure Code and Section 231 of the Criminal Procedure Code and can rely on Section 324 of the Penal Code and Section 420 of the Civil and Commercial Code.

- 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?

Please see the answers in 1.1 and 1.2 above

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?

Both IP professional in Thailand and overseas IP professional. Technical experts have privileges under Section 92 of the Civil Procedure Code and Section 231 of the Criminal Procedure Code and can rely on Section 324 of the Penal Code and Section 420 of the Civil and Commercial Code.

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?

Lawyers both registered and not registered with the Lawyer Council of Thailand and non-lawyers who provide their advice to client have privileges under the laws quoted in answer 1.1 above, and, hence, can protect clients against forcible disclosure of communication between them and client.

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 i.e. 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?

a) In case where the IP professional is also a registered lawyer:

Under Clause 11 of the Regulations of the Lawyers Council of Thailand on Lawyers' Ethics B.E. 2529 (A.D.1986), the limitation of non-disclosure of a registered lawyer who is an IP professional is where the client's consent has been obtained or subject to the Court's order.

b) In case where the IP professional is either a registered lawyer, non-registered lawyer or non-lawyer?

Under Section 231 of the Criminal Procedure Code, where any party or person is to give or produce any confidential document or fact which has been acquired or made known to him by virtue of his profession or duty, but the party or person refuses to give or produce such evidence, the court has the power to summon the authority or person concerned with such secret to appear and give an explanation in order that the court may decide whether or not there is any ground to support such refusal. The court may then, if it deems the refusal to be "groundless," order such party or person to give or produce such evidence.

Under Section 92 of the Civil Procedure Code, where any party or person is required to give testimony or produce any kind of evidence, and such testimony or evidence may entail the disclosure of any confidential document or fact which was entrusted or imparted by a party to him in his capacity as a lawyer, the said party or person is entitled to refuse to give such testimony or to produce such evidence unless he has obtained a permission from the competent official or the person concerned. Where a party or person refuses to give or produce such testimony or evidence, the court has the power to summon the competent official or the person concerned to appear in court and explain their reasons for refusal so that the court may consider the grounds. If it deems that the refusal is not being on well-grounded, the court then has the power to issue an order so that such party or person cannot take advantage of this Section and force such party or person to give such testimony or produce such evidence.

- (ii) as to 1.2, i.e. 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?

Please see the answer in 1.6 (i) (b) above.

- (iii) as to 1.3, i.e. 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?

Please see the answer in 1.6 (i) (b) above.

- (iv) as to 1.4, i.e. 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?

Please see the answer in 1.6 (i) (b) above.

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, i.e. 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?

Our answers in 1.1, 1.5 and 1.6 are referred.

We opine that the provisions of the current Thai laws and regulations provide sufficient protection to client against forcible disclosure of communications relating to IP professional advice between clients and IP professional.

(ii) as to 1.2, i.e. 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?

Please see the answer in 1.7 (i) above.

(iii) as to 1.3, i.e. 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?

Please see the answer in 1.7 (i) above.

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?

We opine that our current law is broad enough to protect client against forcible disclosure of communications relating to advice of IP professional both in Thailand and overseas.

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?

We do not agree that the provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their countries.

In our view, if the laws of the countries were to have such provision, the principle and standard (if necessary) should indicate only the minimum and basic obligations that the advisor (such as lawyers or IP advisors) should comply.

- 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?

It is not possible and not practical to set the list of documents which will be protected or not protect against forcible disclosure.

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?

The Thai laws have provisions which allow judicial discretion to deny protection from disclosure. The Group agrees with such provisions.

- 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?

Certain flexibility should be allowed for the court to exercise its discretion so that justice can be done between the parties.

- 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?

None

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'?

We agree.

- 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?

None

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

- (i) What category is that?

Trademark creators and developers.

- (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?

Yes.

- (iii) As to your answer to sub-para (ii), why?

Confidential information possessed by IP adviser should be protected. However, the court can exercise its discretion to order such IP adviser to disclose such information so that justice can be done.

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?

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?

IP advisers who are non-lawyer also possess confidential information of client and should receive the protection too.

- 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?

The laws in each country should be allowed to be changed following the economic and social changes and the needs of the country.

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.

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?

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?

None

- 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?

None

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?

We prefer the AIPPI's proposal. The scope of this proposal is wider than the alternative one. It also provides room to countries to create their laws which are suited to the needs of the countries.

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.

We propose that the model law, describe the scope of protection against disclosure of confidential information. The Model law should not be mandatory to countries to adopt it in their laws. The adoption should base on a voluntary basis.

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.

None

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?

None

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.