Protection from Forcible Disclosure of Intellectual Property (IP) Professional Advice (the protection)

Perspective and history of development of the protection conducted by and on behalf of the International Association for the Protection of Intellectual Property (AIPPI) and AIPPI-Australia (AIPPI-A) from 2003 to 2019 (the privilege project or the project).

Attachment 43

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SCP/14/1 Prov.
ORIGINAL: English
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WIPO

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

Fourteenth Session
Geneva, January 25 to 29, 2010

DRAFT AGENDA

prepared by the Secretariat

1. Opening of the session

2. Election of a Chair and two Vice-Chairs

3. Adoption of the agenda
   See the present document.

4. Adoption of the draft report of the thirteenth session
   See document SCP/13/8 Prov.1

5. Report on the Conference on Intellectual Property and Public Policy Issues

6. Report on the International Patent System
   See documents SCP/12/3 Rev.2 and SCP/14/6

7. Preliminary studies on selected issues:
   (a) Standards and Patents
   see document SCP/13/2;
   (b) Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights
   see document SCP/13/3;

(c) The Client-Attorney Privilege
see documents SCP/13/4 and SCP/14/2;
(d) Dissemination of Patent Information
see documents SCP/13/5 and SCP/14/3;
(e) Transfer of Technology
see document SCP/14/4;
(f) Opposition Systems
see document SCP/14/5.

8. Work program and future work of the Standing Committee on the Law of Patents (SCP)

9. Summary by the Chair

10. Closing of the session

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SCP/14/10
ORIGINAL: ENGLISH
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Standing Committee on the Law of Patents

Fourteenth Session
Geneva, January 25 to 29, 2010

REPORT

adopted by the Standing Committee

INTRODUCTION

1. The Standing Committee on the Law of Patents ("the Committee" or "the SCP") held its fourteenth session in Geneva from January 25 to 29, 2010.

2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Algeria, Angola, Argentina, Australia, Austria, Barbados, Belarus, Belgium, Bolivia (Plurinational State of), Brazil, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Burundi, Cambodia, Cameroon, Chile, China, Colombia, Congo, Costa Rica, Côte d'Ivoire, Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, France, Germany, Ghana, Guatemala, Guinea, Hungary, India, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Israel, Italy, Japan, Jordan, Kenya, Kuwait, Kyrgyzstan, Lao People's Democratic Republic, Latvia, Lebanon, Libyan Arab Jamahiriya, Lesotho, Lithuania, Madagascar, Malaysia, Mauritius, Mexico, Morocco, Myanmar, Netherlands, Nigeria, Norway, Oman, Pakistan, Panama, Paraguay, Peru, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Senegal, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Syrian Arab Republic, Thailand, The former Yugoslav Republic of Macedonia, Tunisia, Turkey, Uganda, Ukraine, United Kingdom, United States of America, Uruguay, Venezuela (Bolivarian Republic of), Viet Nam, Yemen, Zambia and Zimbabwe (103).

3. Representatives of the Eurasian Patent Office (EAPO), the European Commission (EC), the Council of the European Union, the European Patent Office (EPO), the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC), South Centre (SC), the

World Health Organization (WHO) and the World Trade Organization (WTO) took part in the meeting in an observer capacity (8).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: Asian Patent Attorneys Association (APAA), Center for International Environmental Law (CIEL), Centre for International Intellectual Property Studies (CEIPI), Chamber of Commerce of the United States of America (CCUSA), Chartered Institute of Patent Attorneys (CIPA), CropLife International, European Committee for Interoperable Systems (ECIS), European Communities Trade Mark Association (ECTA), European Law Students' Association (ELSA International), Foundation for a Free Information Infrastructure (FFII e.v.), Free Software Foundation Europe (FSF-Europe), Fridtjof Nansen Institute (FNI), German Association for Industrial Property and Copyright Law (GRUR), Institute of Professional Representatives before the European Patent Office (EPI), Intellectual Property Institute of Canada (IPIC), International Association for the Protection of Industrial Property (AIPPI), International Centre for Trade and Sustainable Development (ICTSD), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Federation of Pharmaceutical Manufacturers Association (IFPMA), IQSensato, Japan Patent Attorneys Association (JPAA), Knowledge Ecology International, Inc. (KEI), Latin American Association of Pharmaceutical Industries (ALIFAR), Max Plank Institute for Intellectual Property, Competition and Tax Law (MPI), and Third World Network (TWN) (26).

5. The list of participants is contained in the Annex to this report.

6. The following documents prepared by the Secretariat had been submitted to the SCP prior to the session: "Draft Agenda" (SCP/14/1 Prov.), "The Client-Patent Advisor Privilege" (SCP/14/2), "Technical Solutions to Improve Access to, and Dissemination of, Patent Information" (SCP/14/3), "Transfer of Technology" (SCP/14/4), "Opposition Systems" (SCP/14/5), "Report on the International Patent System: Revised Annex II of document SCP/12/3 Rev.2" (SCP/14/6), "Proposal from Brazil" (SCP/14/7) and "Conference on Intellectual Property and Public Policy Issues" (SCP/14/8).

7. In addition, the following documents prepared by the Secretariat were also considered by the Committee: "Report on the International Patent System" (SCP/12/3 Rev.2); "Addendum to the Report on the International Patent System" (SCP/12/3 Rev.2 Add.); "Standards and Patents" (SCP/13/2); "Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights" (SCP/13/3); "The Client-Attorney Privilege" (SCP/13/4) and "Dissemination of patent information" (SCP/13/5).

8. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions reflecting all the observations made.

GENERAL DISCUSSION

Agenda item 1: Opening of the session

9. The fourteenth session of the Standing Committee on the Law of Patents (SCP) was opened by the Director General, Mr. Francis Gurry, who welcomed the participants and introduced Mr. James Pooley, Deputy Director General. Mr. Philippe Baechtold (WIPO) acted as Secretary.

Agenda item 2: Election of a chair and two vice-chairs

10. The SCP unanimously elected, for one year, Mr. Maximiliano Santa Cruz (Chile) as Chair and Mrs. Dong Cheng (China) and Mrs. Bucura Ionescu (Romania) as Vice-Chairs.

effective existing technologies and new non-commercial technologies. The private sector had been, and would continue to be, responsible for the vast majority of investments and the development and diffusion of the new and improved technologies that would be essential to meet those challenges. The Representative observed that the ability to amortize those investments and assure a return to those who supplied the necessary capital was secured by intellectual property protection of the inventions that would result from the private sector research and development effort. The patent system was intended to correct the underprovision of innovation due to free-rider effects by providing innovators with limited exclusive rights to prevent others from exploiting their invention, and thereby enabling the innovators to appropriate the returns on their investment. At the same time, the patent system required innovators to disclose fully their inventions to the public. The Representative noted that those fundamental elements of the patent system played an important role in the dissemination of knowledge and the transfer of technology. In addition, the Representative noted that open innovation was becoming an increasingly popular model for organizations working in complex technological fields. In its view, intellectual property played a critical role in supporting open innovation, because it provided the legal certainty necessary for broader sharing of technical information and know-how. The Representative stated that, in particular, patents played an essential role in supporting collaborations and partnerships between different organizations involved in developing such technologies. When the SCP contemplated potential mechanisms to foster transfer of technology, the Representative was of the opinion that it should consider carefully the practical impact of its decisions on innovative activity and not resort to solutions that might jeopardize the essential role of patents by creating additional uncertainties for intellectual property owners.

56. The Representative of FICPI stated that, since his Federation's members did not only represent right owners, but also third parties, he had a good understanding of both sides of the coin, namely of the interests and needs of the patent owners, as well as of the interests of the public and all those who did not possess patent protection for their products. FICPI was closely following the progress in the harmonization of patent laws, since that was to the benefit of all users of the system. FICPI was also prepared to assist any study or work relating to the client-attorney privilege. The Representative confirmed that, from a practical point of view, the dissemination of patent information was important for all users, including patent offices dealing with the examination of patents.

57. The Representative of AIPPI stated that his association represented more than 8,000 IP professionals with more than 60 national and regional groups and concentrated on studying IP laws for their improvement. The Representative, as Chairman of the AIPPI Committee on Privilege, stated that the subject dealt with was protection of clients from the forcible disclosure of their IP advice, which was broader than "privilege". He observed that documents SCP13/4 and SCP14/2 identified what the problems were: lack of protection and loss of protection, in which lack of protection assumed a more minor position, and loss of protection was the more serious, almost universal issue. The Representative also agreed that the protection served the public interests foremost. Loss of protection meant that national laws providing protection were frustrated. In his view, the SCP was wise not to study solutions to those problems, because such a study was not justified until the SCP was on top of the problems. The Representative noted that AIPPI had contributed three major efforts to assist in defining the problems: the WIPO-AIPPI Conference on Client Privilege in IP Professional Advice in May 2008, and two AIPPI submissions, in October 2008 and in August 2009. Anticipating the completion of the first phase of studying client-attorney privilege in the SCP, i.e., defining the problems, AIPPI had commenced to study the options for remedies based, in part, on the work done by the SCP. The Representative stated that AIPPI had issued working guidelines to all national and regional groups to ascertain the options for remedies through a questionnaire, referring to what were the limitations, exceptions and other

details of national protection for which provision needed to be made if any agreement was to be reached to solve the problems. The answers from AIPPI members were requested by March 31, 2010, and the analysis would be presented at the AIPPI Congress in October 2010 in Paris. The Representative stressed that, in his view, the work had reached the point where help from Member States was needed to study options for remedies. The issues to be taken into account for any viable agreement to be reached were: existing limitations and exceptions, issues relating to the qualifications of IP professionals, the preservation of judicial discretion, the necessity of disclosure that was needed for justice, and the limits of the scope of protection, i.e., to the third parties and lawyers transacting with third parties, and non-lawyers doing likewise in order to give advice. Moreover, the Representative stated that the questions as to whether the dominant purpose test, which had been well explained in the documents, be part of the international regime and how waver of privilege was determined should be addressed. The Representative hoped that AIPPI would be able to present its further analysis of the issue by the SCP's following session.

58. The Representative of ALIFAR stated that her Association represented more than 400 pharmaceutical laboratories in 15 countries of Latin America. Referring to one of the conclusions of a recent WIPO symposium that had found that backlogs in terms of processing patent applications had reached an unsustainable record level in 2007, the Representative observed that it might be useful to discuss some of the reasons that had led to that situation, which might have resulted from some defects in the patent system. Standards of patentability used by patent offices of some countries might well be one of the causes. As the requirements for novelty, inventive step and industrial applicability appeared to be diffused with respect to patent applications and granted patents, there was more incentive to file patent applications that did not represent genuine innovation, but rather were filed to obstruct competition. In a report on the pharmaceutical sector published in July 2009, the European Commission had identified some difficulties in industrialized countries in the way the patent system was used and which slowed down the access of competitive products onto the market. The European Commission's inquiry noted that a generally applied strategy was to submit many patent applications for the same medicine which could reach up to 1,300 patents and applications in Member States. In her view, that could lead to legal uncertainties and high cost for the patent system, and the same scenario started to occur in developing countries. The Representative therefore considered that the work of the SCP could explore mechanisms to avoid the patent system being used for reasons that were not intended and to provide incentives for innovation. The Representative stated that any initiative to harmonize substantive aspects of patent law could be viewed with concern as it could reduce the room for maneuver for the patent offices from Latin America in determining their own standards and criteria for patentability and to keep the patent system from producing effects such as those described by the report of the European Commission. She was of the opinion that the Committee had explored the difficulties encountered in the patent system from the standpoint of the impact that it had on matters of public interest, such as health, and its work would facilitate the linkage of various issues under discussion with the 45 recommendations of the Development Agenda. The Representative expressed her hope that the Committee's work would overcome the difficulties without weakening the TRIPS flexibilities in areas such as novelty, inventive step and industrial applicability, patentable subject matter and the definition of prior art, among other matters.

59. The Representative of KEI indicated that his comments would focus on the proposal by the Delegation of Brazil on patent limitations and exceptions, as set out in document SCP/14/7. The Representative supported all of the elements of work set out in paragraphs 25 to 27 of document SCP/14/7, which he considered as logical and useful steps to begin an empirically based discussion of patent limitations and exceptions, focused on practical concerns. To that end, and considering also the several reports

requested to take those comments into account in preparing the study. The Chair proposed to set a date to receive such comments.

(c) The client-attorney privilege

115. Discussions were based on documents SCP/13/4 and SCP/14/2.

116. The Delegation of Morocco noted that its country was modifying the current legislation in order to standardize the patent profession in its country, taking into account the professional privilege. It further noted that national and regional patent offices were bound by professional secrecy, and explained that the Moroccan Industrial and Intellectual Property Office was bound by provisions requiring secrecy. The relevant statute prohibited disseminating, using or publishing documents that the Office received through its services. The Delegation clarified that such a treatment gave reassurance to patent applicants while the Office was examining their applications.

117. The Delegation of Argentina was of the view that the client-patent advisor privilege was a matter of private law which belonged to national jurisdiction. As a result, the Delegation considered it appropriate to continue relying on Article 2(3) of the Paris Convention and Article 1.1 of the TRIPS Agreement.

118. The Delegation of Australia stated that the topic of the client-patent advisor privilege had recently received considerable attention in its country, and legislative changes in that area were currently considered. The Delegation, however, believed that international development was necessary to adequately address the issue. For that reason, it supported further discussion about the client-attorney privilege and professional secrecy in the Committee with the view to identifying common objectives and potential solutions.

119. The Delegation of India stated that the client-attorney privilege was regulated neither under the Paris Convention nor in the TRIPS Agreement. Therefore, it considered that each country should be allowed to set its level of privilege and extent of disclosure that suited its social or economic circumstances and its particular level of development. The Delegation was of the opinion that harmonizing the client-attorney privilege implied harmonizing the exceptions to the disclosure. It observed that, since the disclosure was a substantive element of the patent system, harmonization of the client-attorney privilege could have substantive implications and involve elements regarding substantive harmonization. It concluded that such harmonization would also keep more information out of the public domain, adversely affecting the quality of patents and access to information and innovation, especially for developing countries.

120. The Delegation of Spain, speaking on behalf of the European Union and its 27 Member States, stated that, in the framework of industrial property, freedom of communication between professional representatives and their clients was needed to apply for patent rights, prosecute patent applications to grant and when an opinion was requested regarding infringement or annulment of rights. In its view, the freedom of communication required necessarily that confidentiality of the communications was granted to them both with respect to third parties and particularly in the event of judicial proceedings. As a conclusion, the Delegation endorsed the recommendation for the next steps consisting of a detailed study on the treatment of the confidential information revealed to the professional representatives as granted by the different States. It noted that the questions that could be addressed were how confidentiality of communications between professional representatives and their clients in one country was recognized in other jurisdictions and what were possible options for a better recognition of the confidentiality of communications between the representatives and their clients beyond national borders. In addition, the Delegation was of the view that the detailed study to be prepared by the Secretariat should also be focused on the feasibility of international

Delegation further noted that similar professional secrecy applied to journalists who had to protect the source of their information, as well as religious leaders, such as catholic priests. The Delegation stated that professional secrecy was further extended to certain professional positions related to the ethical and personal behavior of people and not the economic subject, as in the case of patents. Therefore, the Delegation supported the view that the issue should remain a subject to be dealt with under national laws.

131. The Delegation of Germany associated itself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. The Delegation supported those delegations who had requested further study on the issue, especially with respect to the recognition of professional secrecy and privilege in foreign jurisdictions.

132. The Representative of the EPO associated herself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. The Representative noted that, as mentioned on page 19 of document SCP/14/2, the EPC 2000 contained a mechanism in Rule 153 aiming to safeguard the obligation of confidentiality and the privilege from disclosure of communications between professional representatives and their clients.

133. The Delegation of Argentina reiterated that the client-patent advisor privilege or professional secrecy was a private law matter which was to be left to national legislation. Therefore, the Delegation did not understand the inclusion of the issue in the discussion in the SCP, particularly given the competencies of WIPO. The Delegation stated that it would not therefore support any future work on the subject.

134. The Representative of AIPPI stated that, in relation to the argument that the issue of client-attorney privilege should not be debated in the SCP because it was a private law matter, national laws were inadequate to solve international problems. AIPPI was very interested in solving the international problems with minimal intervention in national laws, and it considered that national laws needed to be protected and individual countries should look after their own interest. The Representative noted, however, that national laws did not contribute to solving the international problem of the loss of their own nationals' advice privilege in another territory. The Representative stated that AIPPI was starting the process of studying those and related matters in parallel with the SCP, and would share its findings and recommendations at the following session of the SCP.

135. The Representative of FICPI was of the opinion that the client-attorney privilege was a very important aspect in the cooperation between a counsel and a client. In his view, the client should be free to discuss IP related matters with his IP advisor without running the risk that such communication would later become public against the client's will. The Representative considered that that should be true for both legal counsels and other IP advisors. FICPI was of the opinion that a secrecy obligation for IP advisors was insufficient, since that did not protect the client against disclosure in litigation. Furthermore, he observed that parties in litigation should have the same rights irrespective of the country they resided in, the country in which they litigated and the IP advisors they had consulted, which was not necessarily the case at present. According to a recent survey conducted by FICPI, only a limited number of countries accepted a client-attorney privilege between the client and a non-lawyer IP advisor. The Representative considered that, since privilege for clients of IP advisors would enable clients to seek advice on, for example, technical aspects of circumventing or invalidating IP rights without running the risk of the advice becoming public, it was not only relevant for IP right holders, but also for third parties. As patents were generally not easy to understand, clients should be able to freely seek advice about, for example, the scope of protection provided by those patents in their country or other countries and the possibility of protecting their own inventions. The Representative observed that understanding the scope of patents would promote technical progress and transfer of technology, and IP

advisors, especially patent and trademark attorneys, were trained to give such technical and legal advice. In addition, the Representative stated that client-attorney privilege for IP advisors might further reduce costs for clients in seeking technical advice, because a lawyer would no longer needed to be involved. In his view, that was important especially for developing countries and small- and medium-sized enterprises. In summary, FICPI was of the opinion that the client-attorney privilege for communications between clients and their IP advisors was essential in international practice involving IP rights. He considered that it would facilitate the understanding of inventions disclosed in patents and of transfer of technology, and increase cost effectiveness of IP advice essential to a proper working of the IP system, both for right holders and for third parties.

136. The Representative of APAA stated that it had adopted Resolutions in 2008 and in 2009, expressing an international consensus on setting minimum international standards for a client privilege against the forcible disclosure of confidential communications between clients and intellectual property professionals. He explained that the Resolutions were adopted in consideration of the fact that, due to the international character of intellectual property, a client needed to have a full and frank communication not only with domestic IP professionals, but also with IP professionals in other countries. However, confidential communications between clients and IP professionals which were protected in their own country were sometimes forced to be disclosed in another country during litigation. In his view, an increasing number of international litigations had exposed the clients to a higher risk of forcible disclosure, thereby undermining the clients' ability to obtain professional legal advice on intellectual property related matters. The Representative further stated that, for example, in one discovery motion before a United States judicial court, the US judge had reviewed the communication between the plaintiff and the foreign patent professionals in relation to the filing and prosecution of a patent in 47 patent offices around the world. The US judge found that communications relating to some of the jurisdictions were privileged, but the others were not. The document would have been protected against such a forcible disclosure if the IP professionals involved in the communications were United States lawyers. The Representative was of the view that, as noted in paragraph 256 of document SCP/14/2, the client-attorney privilege in common law countries and the professional secrecy obligation in civil law countries aimed at a very similar practical result, i.e., non-disclosure of confidential information exchanged between a client and an attorney. Nevertheless in reality, the Representative observed that the privilege in one country was not properly respected by courts in other countries. The Representative believed that the SCP was the right forum to address such a rapidly growing and complicated international concern involving intellectual property, in particular, patents. The Representative noted that the two WIPO documents, namely SCP/13/4 and SCP/14/2, were excellent summaries of the current status in the area and of the related international concerns. In view of the increasing international concerns, he suggested that the issue be studied within a WIPO working group dedicated to client-attorney privilege issues concerning confidential communications between clients and IP professionals. The Representative further stated that the working group should assess current and future problems under the various legal systems, and study the feasibility of setting minimum international standards for the mutual recognition of the client privilege in an accelerated manner.

137. The Representative of CEIPI recognized the importance of the problem of secrecy of communications among clients and patent advisors. He noted that the problem, due to the international nature of the issue, was part of the competences of WIPO. The Representative considered that the discussion taking place in the Committee well demonstrated the need to delve into certain aspects of the problem. For example, it would be useful that the Secretariat clarified the scope of Article 2(3) of the Paris Convention and the TRIPS Agreement, which referred to that provision. In his view, that provision did not prevent the Paris Union to agree on issues which were reserved for

national law, and created neither obligation nor obstacles in that respect. The Representative further noted that the disclosure of communications between the client and his advisor and the disclosure of an invention in a patent application were two different issues, and all they had in common was the word "disclosure". In conclusion, the Representative supported the follow-up of the studies by the Secretariat.

138. The Representative of ICC noted that, in most countries, communications between clients and their legal advisors were withheld from the other party when the clients were in litigation locally. In his view, this was good for trade because it encouraged clients to seek full legal advice, which, in general, meant that they were more likely to act lawfully and to avoid litigation. On the international scale, however, the Representative was of the view that such situation did not exist, specifically in the area of intellectual property. He explained that, at present, judges in common law countries were required to apply complex and expensive rules on whether communications with foreign advisers were privileged. Repeatedly, they had ordered disclosure of communications with foreign advisers which would not have been disclosed in the local courts of those advisers, for example, of advisers in Australia, France, Japan, the Netherlands, Pakistan, South Africa and the United Kingdom. The Representative observed that, even between two common law countries, there was remarkably little mutual respect. He said that the above problem had occurred in intellectual property litigation, because, for instance, patent owners might have taken advice on patentability in many countries, and trade mark owners and those launching new products and brands might have taken advice on infringement risks in many countries. The Representative therefore believed that an international framework for mutual respect of communications with legal advisers on intellectual property matters was needed. He believed that achievement of such mutual respect was supportive of businesses engaging in international trade, regardless of the state of development of their home country, and was also consistent with the mission of WIPO. The Representative suggested a workable framework as described in paragraphs 22 and 23 of its position paper dated October 9, 2008. Moreover, after careful consideration, as articulated in its position paper dated August 27, 2009, the ICC had concluded that its proposed framework would work notwithstanding potential difficulties raised by the delegations at the SCP in March 2009. In addition, the ICC believed that its proposal did not need further research or study of existing national laws on privilege or professional secrecy. The Representative urged the Committee to start considering possible solutions to the privilege problem, along the lines of its proposal. He also urged WIPO to evaluate the advantages and disadvantages of possible solutions, and to do only such further research or study as was necessary for such evaluation.

139. The Representative of IPIC stated that the issue of client privilege for IP advisors was an issue of great interest and importance to IPIC. The Representative considered that mutual recognition would be of great benefit to users of the IP system in Canada, particularly as its courts had failed to recognize privilege for non-lawyer agents, be they Canadian or foreign agents. Since there had also been a Canadian court decision which did not recognize the common law privilege of lawyers when acting as patent agents, she was of the view that mutual recognition might lead the Canadian Government to take steps to provide for privilege for agents regardless of their legal qualification so that their Canadian clients would benefit from mutual recognition when obtaining and enforcing rights outside of Canada. The Representative urged WIPO to begin devising suitable solutions for the problem, such as those that had been proposed by the ICC, and conduct the required research and study for their evaluation.

140. The Representative of JPAA noted that his organization had submitted its position paper recognizing the necessity of establishing solutions to the issue of client-patent attorney privilege at the international level. In his view, due to the lack of international or mutual recognition of privilege for a client, be it an IP owner or a third party, in each and every

country, the client still faced a risk of losing confidentiality in communications with IP advisors. The Representative observed that that would be significantly detrimental to the interests of clients, the quality of IP rights and any associated cost. Acknowledging the fruitful work that had been conducted in the SCP, the Representative considered it necessary to move to the next stage for further elaboration of possible remedies and solutions from a practical standpoint. For that purpose, he encouraged the SCP to continue studying and discussing the issue as suggested in Section 5 of document SCP/14/2, especially in paragraph 263. In parallel, the Representative strongly encouraged the establishment of a working group for investigating and analyzing the experiences of various countries, thereby seeking the best solution that would be beneficial to the stakeholders of all Member States. The Representative expressed his organization's willingness to assist the SCP and the Secretariat in any possible way, based on its experience as a body of legal professionals.

141. The Representative of GRUR stated that GRUR was always ready to defend and improve the international recognition of the legal status of the patent attorneys' profession. He further informed the Committee that, in Germany, the status of patent attorneys were in many respects identical with that of lawyers, with a few exceptions as contained in document SCP/14/2. German patent attorneys could represent their clients directly before the German Patent and Trademark Office, the German Patents Court and, in nullity proceedings, even before the Federal Supreme Court. In proceedings before the ordinary courts, for example in infringement litigation, they might appear before courts of ordinary jurisdiction together with an attorney-at-law only, but they had an important role in the preparation and control of such litigation, not to speak about the preparation and prosecution of patent applications. Referring to paragraph 148 of document SCP/14/2, the Representative questioned the clarity of the text. In particular, the Representative clarified that the professional training period of approximately three years comprised also eight months of training at the German Patent and Trademark Office and the German Federal Patents Court. The Representative stressed the high quality standards of the final qualifying examination that the candidates had to pass. The Representative observed that the confidentiality from professional communications and the professional advice given by attorneys protected under Article 6 of the European Human Rights Convention were an essential element of fair proceedings, due process of law and the right of the defense. The Representative expressed the view that that protection should also be applicable to patent attorneys having qualifications similar to those of lawyers and other professional advisors. The Representative considered that the view referred to in paragraph 244 of the document was irreconcilable with that approach. From that point of view, the Representative stated that there was a justified interest for the profession to enjoy in the United States of America, or in other common law countries, the same privilege for their confidential communication as was accorded to lawyers of the general legal profession. While noting that no acute problems had been reported affecting German patent attorneys by that time, the Representative raised the question of how judges in common law countries would decide in the future. The more transnational litigation was expected in globalized markets, the more acute the question would become for patent attorneys and agents in foreign countries who had close commercial relations with the United States of America or other common law countries that applied the legal privilege approach in pre-trial discovery proceedings. Therefore, the Representative supported the efforts by AIPPI and the ICC to resolve problems caused by the legal uncertainties which were created by the case law of, for instance, the US courts. The Representative suggested that the work forward should be guided by making a distinction between the professional secrecy obligation and the evidentiary privilege for legal advisors. Referring to a matter of international comity, where the court looked at the national law of the home country of the foreign patent attorney concerned, the Representative stated that the result was sometimes a matter of good luck. In that

regard, the Representative referred to paragraph 233 of document SCP/14/2 which made a reference to Article 43 of the TRIPS Agreement, and agreed with the statement of the Secretariat that that reference might be relevant to the issue of the client-attorney privilege. While observing that the language of the provision was very vague, and therefore, the Members of WTO might have a wide discretion to set the conditions of such protection, the Representative noted that further analysis of the potential of the provision would be worthwhile and interesting. Against that background, the Representative believed that the legal certainty for patent owners and their patent attorneys could only be achieved through some sort of a legally binding international instrument obliging the Contracting Parties to protect the confidentiality of written or oral communications between patent or trademark attorneys and their clients made in the context of, or dealing with, actual or future proceedings in the field of intellectual property rights before national or regional courts and authorities, in particular in trans-border actions. In conclusion, the Representative urged the Committee to maintain the issue on the agenda.

142. The Delegation of Indonesia reiterated that the issue of the client-attorney privilege needed sufficient analysis particularly on the possible adverse implications of having uniform legal standards internationally. While noting that under the legal system of Indonesia, the term "privilege" was not recognized, the Delegation stated that that was one of the predicted adverse impacts in further going with the subject matter. The Delegation noticed from the study that there were no uniform laws on the application of privilege to communications between IP advisors and their clients even within the same legal system. The Delegation was pleased that the study acknowledged that absolute privilege for client-attorney communications might be detrimental to the public interest of ensuring that all relevant information was made available to the responsible authorities for investigating truth for the sake of justice. The Delegation stated that more information and clarification on the subject matter was needed, in particular concerning the adverse implications of having such uniform legal standards.

143. The Representative of EPI and CIPA stated that both organizations were strongly supportive of a worldwide unified client-IP advisor privilege, which should include advice given by patent attorneys qualified to act before regional offices, such as European patent attorneys entitled to represent before the European Patent Office, and suitably qualified in-house patent advisors. The Representative urged the Committee to continue working on the subject matter and to allow the Secretariat to progress matters as was suggested in the last chapter of document SCP/14/2.

144. The Representative of AIPPI clarified two points which came up in the discussion. In relation to the first point, the Representative stated that "privilege" meant to be protection against forcible disclosure. Referring to concerns raised by some delegations that the protection might be used to disguise information and thus be detrimental to public information, the Representative noted that one should be aware of the fact that privilege, in the sense of protection against forcible disclosure, had been globally accepted for lawyers a long time ago. The Representative observed that there had been no dispute over the problem of disguising information which might arise in the context of privilege for lawyers. He noted that there was a sufficient regulatory framework around that protection, which guaranteed that the privilege was balanced with all the public interest that was raised in that context. In relation to IP advisors, the Representative stated that legal advice was no longer a pure domain for lawyers. The complexity of technical and legal advice in connection with IP and, in particular, with patents, made it necessary to spread the work from lawyers to other IP advisors, and it had been globally accepted that IP advisors also gave legal advice in the context of their work. The legal advice was necessarily intertwined with technical advice. In this situation, the question arose whether the application of protection against forcible disclosure to non-lawyer patent

advisors was an expansion of the privilege. The Representative was of the view that the answer to that question was negative for countries which already had protection for lawyers, because the patent attorneys were offering in effect the same legal advice which formerly came from lawyers only. The Representative stated that in modern economies, the profession of patent attorneys had been developed to provide the best legal and technical advice to clients, which had been formerly given by lawyers in cooperation with technical experts. The Representative stated that thus one could not speak of an expansion of privilege, since it was simply the application of the same matter done by other people. The Representative believed that the studies being discussed were not aiming at creating new, but accepting the same matter which had been accepted for lawyers and was undisputed for other advisors who were allowed to give legal advice. The second point was in relation to the Paris Convention and to the TRIPS Agreement, in particular on the issue whether those Agreements would support the view that the issue of privilege and protection belonged to national law only. In that regard, while noting that the TRIPS Agreement as well as the Paris Convention did not affect national laws relating to judicial and administrative procedures and jurisdiction, the Representative, however, observed that the issue at stake was not raising or questioning the right of national jurisdictions or national legislations to make their laws nationally. What it did raise, according to his view, was the question of how the effect of national laws regarding the existing protection against forcible disclosure could be maintained internationally. That was a purely international dimension, which national solutions could not sufficiently cover. The Representative therefore believed that the SCP was the right forum for dealing with the matter. He further stated that the problem of loss of the existing protection could not be resolved purely by national law and that the need for the discussion about the issue had become evident in the studies prepared by the Secretariat. He further informed the Committee that AIPPI was conducting studies by looking at various aspects of the issue, such as remedies, limitations, exceptions and effects that the privilege on IP advisors might have on the entire system.

145. The Representative of TWN stated that one of the fundamental principles of patent law was the disclosure of information on technology, and non-disclosure or partial disclosure was a ground for refusing to grant, or revocation of, a patent. In his view, the extension of client-attorney privilege to patent advisors went against that fundamental principle of disclosure. Patent specifications were public documents and therefore any related records which were used in the preparation of the patent specification should also be made available to public scrutiny in order to find or verify the truth about the claims made in the specification. The Representative underlined that considering the public policy concerns associated with patent law, it was important to maintain absolute transparency around the granting of patents and litigation around patents. Society could not afford any kind of opaque layer around the patent specifications. He further stated that extension of privilege to patent advisors would compromise the transparency requirement in the administration of patents which included both patent prosecution procedures as well as litigation of patents. The Representative was of the view that there was enough documentation regarding the misuse of attorney-client privilege by corporate clients. As one of the most distinct examples of such misuse, the Representative mentioned the case of tobacco companies where they had commissioned studies to attorneys on disputes against the tobacco industry. Another cited example of such misuse was the Novelpharma case where the inventors gave their Swedish patent agent a draft patent specification which included a citation to a book written by the inventors describing the use of the invention more than two years earlier. That book was eventually held to anticipate the patent, although the patent agent had deleted all references to the 1977 book from the patent application, which was ultimately filed in Sweden and the USA. The Representative further continued that the court had found that the evidence of actual deletion by the patent agent had given the jury reasonable ground to find intent to fraud

by the patentee. The Representative noted that if that communication with the patent agent had been privileged, the patent office and court would never have known about it. In his opinion, the example clearly showed that extension of privilege would legitimize withholding of information to obtain patents, including facilitation of evergreening of patents. Extension of the attorney privilege to cover patent advisors would incapacitate patent offices and courts in developing countries from safeguarding public interest following the grant of patents. The Representative expressed his deep concern about the extension of privilege to patent advisors due to the unintended consequences of such extension and its effect on patent applications, on the TRIPS flexibilities, on patent opposition systems, and on the transparency of patent procedures.

(d) Dissemination of patent information

146. Discussions were based on documents SCP/13/5 and SCP/14/3.

147. The Delegation of Spain, speaking on behalf of the European Union and its 27 Member States, stated that patent documents constituted a valuable source of information from a technical, commercial and legal perspective. The technological data contained in such documents allowed innovators to learn about existing solutions to specific technical problems. This rich body of technical information constituted a strategic tool in research planning and management, contributing to a more efficient allocation of human and material resources. Patent documents accumulated technical information that translated into innovation and progress for the benefit of society as a whole. The Delegation stressed the importance of the dissemination and accessibility of patent documents as a source of relevant technological, commercial and legal information. Patent documents needed to be accessible to the greatest number of possible users in order to maximize their role in scientific and technical development. The Delegation was of the opinion that the international system for the dissemination of patent information should be guided by the objective of its benefit to the users. The system should therefore aim to offer structured data, safeguard consistency and operability of systems and avoid duplication of work between institutions publishing patent information. In its view, the future work to be carried out by the Secretariat in that field should focus on access to patent information in digital format, particularly accessibility of full-text data, along with the availability of the information on the legal status of patents. The improvement would offer a standard presentation of legal information for better comprehension. In this regard, the Delegation stated that the European Union and its 27 Member States acknowledged the great effort carried out by WIPO concerning the standardization of norms of bibliographic data in patent documents and the development of electronic documents in a user-friendly format enabling the easy recovery of documents by users. The use of classification systems had a particular impact on the accessibility to and dissemination of patent information. Therefore, the Delegation recalled the need to join efforts for the improvement and harmonization of the different patent classification systems. In conclusion, the Delegation made a call to strengthen international cooperation in order to make the information included in national and regional patent documents accessible in an easy and centralized way.

148. The Delegation of France supported the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. The Delegation wished to stress the importance of dissemination of information on patents. as it was an important part in determining policies and strategies in industry. In its view, the technical solutions indicated in the document prepared by the Secretariat on standardizing patent information and making legal information available, as well as extending cooperation between member countries and WIPO to centralize patent information, had to be supported, because it would make it possible to have better legal and technical information on patents. The Delegation also supported the idea of making available to

provide clear and exhaustive information regarding how many WIPO Member States' patent laws provided pre-grant opposition and how many provided post-grant opposition or sometimes both. Similar information with regard to regional patent offices should also be provided. The Representative criticized the descriptions in paragraphs 16, 22, 23 etc. which, in his view, were subjective and without empirical data. He also noted that the preliminary study did not provide clear data, such as the number of accepted and rejected oppositions in various patent offices (although it provided the percentage of oppositions instead of the number of oppositions), break-up of oppositions found in various technology areas, such as in the pharmaceutical, electrical, mechanical, software-related and biotechnological fields. He further noted that the preliminary study also needed to provide an analysis of the positive role played by opposition systems in many countries, including Japan.

Agenda item 8: Work program and future work of the Standing Committee on the Law of Patents (SCP)

211. Following a proposal by the Chair, the Committee agreed to carry on discussions at its next session on the basis of the agenda of its fourteenth session. Item 7(b) of that agenda will include the study by external experts on exclusions, exceptions and limitations, as well as the proposal by the Delegation of Brazil on exceptions and limitations to patent rights contained in document SCP/14/7. Member States may submit proposals on the work of the Committee prior to its next session.

212. The International Bureau informed the SCP that its fifteenth session was tentatively scheduled to be held from October 11 to 15, 2010, in Geneva.

Agenda item 9: Summary by the Chair

213. The Chair introduced the Summary by the Chair (document SCP/14/9) with some modifications.

214. The Delegations of Egypt and France proposed some further modifications to the text of document SCP/14/9.

215. The Delegation of the Plurinational State of Bolivia requested that, with respect to document SCP/14/INF/2, the external group of experts be informed about an error in paragraph 4(b)(ii) referring to "higher life form". In his view, it should read "life forms", as contained in paragraph (a).

216. The Revised Summary by the Chair (document SCP/14/9 Rev.) was noted and agreed.

217. The SCP further noted that the official record of the session would be contained in the report of the session. The report would reflect all the interventions made during the meeting, and would be adopted in accordance with the procedure agreed by the SCP at its fourth session (see document SCP/4/6, paragraph 11), which provided for the members of the SCP to comment on the draft report made available on the SCP Electronic Forum. The Committee would then be invited to adopt the draft report, including the comments received, at its following session.

Agenda item 10: Closing of the session

218. The Chair closed the session.

219. The SCP unanimously adopted this report, during its fifteenth session, on October 11, 2010.

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

Fourteenth Session
Geneva, January 25 to 29, 2010

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The fourteenth session of the Standing Committee on the Law of Patents (SCP) was opened by the Director General, Mr. Francis Gurry, who welcomed the participants and introduced Mr. James Pooley, Deputy Director General. Mr. Philippe Baechtold (WIPO) acted as Secretary.

Agenda Item 2: Election of a Chair and Two Vice-Chairs

2. The SCP unanimously elected, for one year, Mr. Maximiliano Santa Cruz (Chile) as Chair and Mrs. Dong Cheng (China) and Mrs. Bucura Ionescu (Romania) as Vice-Chairs.

Agenda Item 3: Adoption of the draft Agenda

3. The SCP adopted the draft agenda (document SCP/14/1 Prov.) with the addition of the proposal from the Delegation of Brazil (document SCP/14/7) under agenda item 7(b), to be included in the final version (document SCP/14/1).

Agenda Item 4: Adoption of the Draft Report of the Thirteenth Session

4. The Committee adopted the draft report of its thirteenth session (document SCP/13/8 Prov.1) as proposed, with amendments received from the Delegation of Japan and the Representatives of ALIFAR and CEIPI, which will be included in the final report (document SCP/13/8).

Agenda Item 5: Report on the Conference on Intellectual Property and Public Policy Issues

5. The Chair presented an oral report on the Conference on Intellectual Property and Public Policy Issues, which was held on July 13 and 14, 2009 (document SCP/14/8). Many delegations stated that the Conference had provided a good opportunity to discuss issues and challenges related to the interface of intellectual property and public policy issues.

Agenda Item 6: Report on the International Patent System

6. The discussions were based on documents SCP/14/6 and SCP/12/3 Rev.2. Some delegations requested modifications in document SCP/14/6 with respect to their national laws.

7. The SCP agreed that document SCP/12/3 Rev.2 would remain open for further discussion at the next session of the SCP. Document SCP/14/6 will be updated, based on the comments received, or that will be received, from Member States.

Agenda Item 7: Preliminary Studies on Selected Issues

8. Discussions were based on documents SCP/13/2, 3, 4 and 5, and SCP/14/2, 3, 4, 5 and 7. Many delegations stated that these documents constituted a good basis for discussions, and requested further elaborations and clarifications on various issues contained in the documents. Several delegations expressed the importance of the studies being available in all official UN languages.

9. Concerning agenda item 7(b), a proposal in respect of exceptions and limitations to patent rights was submitted by the Delegation of Brazil (document SCP/14/7), which received broad support in the Committee. Other delegations, however, expressed concern that they had not received the document in advance of the meeting, and therefore had insufficient time to consider the proposal, and expressed a wish to consider the proposal at the following session. Further, the Secretariat presented information on the external experts' study regarding exclusions, exceptions and limitations (document SCP/14/INF/2) to the Committee.

Agenda Item 8: Work Program and Future Work of the Standing Committee on the Law of Patents (SCP)

10. Following a proposal by the Chair, the Committee agreed to carry on discussions at its next session on the basis of the agenda of its fourteenth session. Item 7(b) of that agenda will include the study by external experts on exclusions, exceptions and limitations, as well as the proposal by the Delegation of Brazil on exceptions and limitations to patent rights contained in document SCP/14/7. Member States may submit proposals on the work of the Committee prior to its next session.

11. The International Bureau informed the SCP that its fifteenth session was tentatively scheduled to be held from October 11 to 15, 2010, in Geneva.

12. The SCP noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session. The report would reflect all the interventions made during the meeting, and would be adopted in accordance with the procedure agreed by the SCP at its fourth session (see document SCP/4/6, paragraph 11), which provided for the members of the SCP to comment on the draft report made available on the SCP Electronic Forum. The Committee would then be invited to adopt the draft report, including the comments received, at its following session.

13. The SCP noted the contents of this summary by the Chair.

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