Attachment 1

Resolution

Question Q199

Client Privilege in IP Professional Advice (CIPPA)

AIPPI

Considering that

the following works of Q199 - the Working Guidelines, the Questionnaire, the Responses of the NRGs, the Epitomes, the Graphs, the Synthesis and the commentary in Section 7 of the of Report to the Bureau and the ExCo under the heading – 'Indications for the Study of Remedies', which together comprise the AIPPI resources relating to the need for study of remedies to the problems of protection from forcible disclosure of IP professional advice ('the AIPPI resources'), should be made available to the Secretariat of WIPO in relation to its work on remedies as it may be mandated to carry out, by the SCP.

Having due regard to

(i) the work done by WIPO and the SCP in relation to Client Attorney Privilege which has already defined the problems and some of the matters requiring study in relation to remedies, and

(ii) the constructive indications from the AIPPI resources of matters which should be considered in any study of remedies for the problems of protection from forcible disclosure of IP professional advice.

Resolves

1. through WIPO to urge the Member States in the SCP to mandate WIPO to conduct the necessary studies to identify remedies to the problems of the protection and to define a preferred solution from the options for remedies which it so identifies, and that this work should proceed urgently following the closure of the SCP 15 meeting, and

2. to make available to WIPO and to its Member States, the AIPPI resources for WIPO to use in relation to its work on remedies as it may be mandated by the SCP to carry out.
15 January 2010
(extended 2 February 2010)

Attachment 2

Question Q199
Privilege Task Force

Working Guidelines and Questionnaire
Remedies to protect the right of clients against forcible disclosure of their IP professional advice

by Michael Dowling, Steven Garland, Wouter Pors and Jochen Buehling

1. The context of these Guidelines

1.1 The National and Regional Groups (the Groups) are requested to consider the following Guidelines on the topic of 'privilege' and similar protection. The main issue is what remedy or remedies should apply to the problem of the lack and loss of protection against forcible disclosure of IP professional advice.

1.2 These Guidelines describe issues relating to remedies which the Groups need to consider along with their own thoughts as to what remedies it may be appropriate to adopt. The description refers mainly to patents IP advisers but the outcome is intended to be used as to client rights with advisers on IP generally. To obtain the views of the Groups so that a Resolution can be proposed for adoption at the AIPPI Congress in Paris in October 2010, there is a Questionnaire in this paper. The Groups' answers and views are requested in accordance with the Questionnaire, please.

2. Introduction to remedies – the problem to be overcome

2.1 The problem underlying the need for 'Remedies' has two parts – first the lack of adequate protection of clients in some countries against being forced to disclose their IP professional advice and secondly, where such protection does apply, the loss of that protection when that advice is communicated between countries.

2.2 Obviously enough, individual countries can legislate to provide adequate protection from forcible disclosure within their own borders. However, they cannot legislate to avoid the adverse effect of the loss of the protection which applies within their own borders when advice is communicated to other countries in which the protection is lost.
2.3 The threat of forced disclosure most often arises during litigation involving an IP right and typically in countries having some level of documentary or oral discovery.

Loss of protection – an acute problem for IP

2.4 There are particular effects subjective to IP which make the application of protection against forcible disclosure of advice in relation to IP matters, an acute problem. Those effects arise from the following.

(i) IP tends to be owned in a number of countries by the same owner or legally related owners.

(ii) IP owners and third parties who assess the ownership or validity of IP, need to obtain professional services and advice in relation to IP, from country to country.

(iii) The professionals consulted by IP owners and third parties who assess IP rights are broadly speaking in two categories – lawyers and non-lawyers. Persons from both categories may need to be consulted in many countries where IP rights are in issue. This relates in particular to external professionals.

(iv) For both IP owners and third parties who assess IP rights, there are frequently differences of substance between the advice so obtained in the one country and another, and the respective persons involved have to resolve those differences. To do that the advice obtained may need to be transmitted from one country to another.

(v) Protection from disclosure applies most frequently in relation to their communications with lawyers but less so in relation to non-lawyer advisers.

(vi) Lawyer and non-lawyer advisers frequently need to obtain advice from third parties (like independent technical experts). The communications between such advisers and such third parties are frequently not subject to protection from forcible disclosure in a particular country. Further if they are protected in one country, frequently they are not in another country which they may need to involve in the communications.

(vii) There are differences in the provision and application of protection from disclosure of communications relating to IP professional advice as to common law countries on the one hand and civil law countries on the other.

(viii) No country is immune from the potential that IP advice (including technical advice on which the legal advice may be based) which is protected from disclosure within its own borders, can be required to be disclosed in another country or countries. The reasons can be various but frequently the reasons include that the one country does not recognise the IP advisers in another country as having a relationship with the client which involves privilege.

(ix) A client in a common law country can be forced to disclose its IP professional advice obtained in a civil law country because the civil law country does not provide privilege from disclosure. The disclosure in the common law country is required even though in the civil law country, disclosure will not occur. It will not
occur in the civil law country if there is no discovery there and professional secrecy applies.

The rationale for having protection from forcible disclosure

2.5 The rationale is that both for the benefit of the administration and enforcement of the law on the one hand and providing correct advice to the persons who seek advice on the other, circumstances must be created in which there can be full and frank sharing of all relevant information between clients and their respective IP professional advisers.

2.6 For the right 'circumstances' for sharing of information to apply, there must be reasonable certainty that protection from forcible disclosure will apply to the relevant communications. A judicial comment supporting the need for certainty was made by Rehnquist J. in *Upjohn Co v United States*, 449 US 383 (1981).

> 'If the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.'

2.7 Such certainty may seem difficult to achieve because protection against forcible disclosure may not apply absolutely. In common law countries, there are established limitations and exceptions on the application of protection from disclosure, such as where an allegation of crime or fraud is involved. Further, in some common law countries there may be a discretion as to whether privilege should apply if it would prevent the court from doing justice between the parties. However, such a discretion would in its exercise in some common law countries, normally be limited to the established exceptions to the application of privilege. Thus, it is unreasonable to expect that a minimum standard or agreed principle of protection against forcible disclosure will be acceptable to as many countries as possible if it does not allow in a country which already provides privilege locally, for such limitations and reasonable exceptions as are already established there.

2.8 The difference between civil law and common law in relation to protection against forcible disclosure for the 'clients' of internal legal counsel also needs to be remedied. Such protection applies in common law but generally not in civil law countries. Both common law and most civil law systems would not apply protection from disclosure to communications between a lawyer and client of any category (be that an employer of the lawyer or not) unless the lawyer was independent of the client. But in most civil law countries, employment of a lawyer is generally regarded as in itself denying independence whereas common law does not. This difference adversely affects numerous multi-national and other companies which employ lawyers and whose businesses are conducted in both civil and common law countries, both as to the legal and related third party technical advices they obtain from or through internal (in-house employee) lawyers there.
3. Previous work of AIPPI – Q163

3.1 Special Committee Q163 was set up in about 2000 to investigate whether lawyer-client privilege applied to communications between patent and trade mark attorneys and their clients. As a result of the work of Q163, AIPPI passed a Resolution at the EXCO meeting in Lucerne in 2003 the centrepiece of which was as follows.

AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognise that the protections and obligations of the attorney client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.

3.2 Thus the crux of the AIPPI Resolution was that the clients of patent and trademark attorneys should be afforded the same protection as communications between lawyers and their clients.

4. Remedies

4.1 The nature of the remedy required to meet the needs of clients using the IP systems is easy enough to state. There needs to be the one "device" agreed and applied within and between countries to achieve reasonable certainty of the application of protection against forcible disclosure of communications between clients and their IP advisers in relation to IP professional advice.

4.2 It seems to be generally accepted that the "reasonable certainty" factor is critical if protection against forcible disclosure is to be effective. That acceptance occurs because absent "reasonable certainty" the persons between whom full and frank disclosures should be made to achieve the public interests of enforcement of the law and correct advice, are not relieved of their inhibition against making full disclosure, particularly as to facts that may be negative to their positions.

4.3 At one end of the scale, potentially the "device" could involve each country applying a particular standard which deals with national and overseas issues irrespective of what any other country does in relation to the required protection. This is a unilateral approach. That is the direction in which Australia is now going and which for New Zealand is now a fait accompli. This 'solution' achieves recognition locally of privilege that applies to communications between overseas IP advisers and clients but not recognition overseas of
the protection against disclosure that applies in New Zealand and will apply in Australia. For that some form of international agreement is required.

4.4 At the other end of the scale, the particular 'device' could be a treaty by which the signatories would agree to recognise each others' protection against forcible disclosure in particular circumstances, whether it is actually 'privilege' as such or not.

4.5 In between the unilateral approach and a treaty, there could be a recommendation by WIPO of a standard or standards to be adopted by Member States. Further, there could be bilateral, multi or even pluri-lateral agreements on standards to be applied between the signatories to those agreements.

4.6 The main issue to be resolved in reaching a consensus on remedies is the standard or principle which will govern what is required to be achieved by national law and international agreements in order to remedy the problems both at the national and international levels. The AIPPI proposal to WIPO of July 2005 provides a convenient starting point. Whilst that proposal was suggested to WIPO as a working paper for study of a treaty, the proposal can as well serve the purpose of study of a potential WIPO recommendation or of any other instrument, such as an agreement between countries. The Groups are invited by the Questionnaire in this paper to comment on the application of the AIPPI 2005 proposal including in modified forms, or to propose potential alternative solutions.

AIPPI proposal to WIPO of 2005 (the AIPPI 2005 proposal)

4.7 The standard or principle which AIPPI proposed was as follows.

A communication to or from an intellectual property adviser which is made in relation to intellectual property advice, and any document or other record made in relation to intellectual property advice, shall be confidential to the person for whom the communication is made and shall be protected from disclosure to third parties, unless it has been disclosed with the authority of that person.

'Intellectual property advice' is information provided by an intellectual property adviser in relation to intellectual property rights.

'Intellectual property adviser' means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person qualified under the law of the country where the advice is given, to give that advice.

'Intellectual property rights' includes any matters relating to such rights.
4.8 Three of the main issues considered in the AIPPI proposal, were as follows.

- The nature and meaning of the protection.
- The scope of the protection.
- The qualifications of 'IP advisers' in relation to whom the protection of the client from forcible disclosure would arise.

4.9 The AIPPI proposal avoided using the word 'privilege'. Instead the proposal refers to the elements of the remedy ie confidentiality of the communications related to the obtaining of IP advice and protection from disclosure of that advice to third parties. Communications to or from an IP adviser made in relation to IP advice, are in effect deemed to be confidential and not to be subject to disclosure to third parties.

**Scope of protection – the 'dominant purpose' limitation**

4.10 The scope of the protection so proposed is wider than would be accepted in many common law countries where privilege now applies. In such countries, for example, a communication between an IP adviser and the relevant client would be discoverable if it was material in the litigation (ie relates to a matter in issue) and relevant (ie affects the meaning of a material matter). However, if it was made for the 'dominant purpose' of obtaining or giving legal advice, it would not normally have to be produced to the court or the other party. The 'dominant purpose' test is narrower than the words used in the proposal ie "in relation to intellectual property advice". So an issue arises for the Groups whether the protection against disclosure of documents should be limited to those which answer the 'dominant purpose test'. On one view this does not make sense in relation to a country which does not now apply the dominant purpose test. For all countries the preferred approach may be to provide that they may limit the documents to which protection applies by the dominant purpose test or such other test as reasonably defines the relationship of the documents protected with the IP advice which is to be protected from disclosure.

**Qualifications**

4.11 The main issue here is caused by clients needing IP legal advice from lawyers and non-lawyer patent attorneys and patent agents, or non-lawyer trade marks attorneys and agents. Some countries have embraced the concept that such non-lawyer IP advisers have in their own field, similar learning, and duties and liabilities to their clients, as do the relevant lawyers. In the relationship between non-lawyer IP advisers and their clients, similar imbalances exist which are a principal factor in creating the relationship of trust that the client and the lawyer have between them. For example, the patent attorney knows the law within the scope of the patent attorney's training and can apply it to the client's situation. The client is relying on that. The imbalance on the client's side is that the client knows the facts. The patent attorney has to rely on the client to disclose all of the relevant facts known by the client to enable the patent attorney to give the best advice. It is similar for trade mark attorneys and agents and their clients, and other IP advisers and clients.
4.12 Lawyers may have duties to the law and duties to the court which the patent attorney does not have. Such duties are important in common law countries. But should they or their absence be vital to the existence of protection of the client from forcible disclosure? They do not apply, at least not in any relevant way, in most civil law countries. To be practical, should not the issue of protection from forcible disclosure be looked at from the point of view of the client? The client has to and does rely upon the advice which is obtained from a non-lawyer patent attorney in the country in which the client happens to be doing business. That patent attorney has to rely upon the client for instructions. It is this relationship that creates the needs for full and frank sharing of information on both sides, and the reliance there has to be of the one upon the other for what they contribute to the outcome required. The relationship demands the need for confidentiality because of the needs, dependencies, and trust which apply as between the persons involved.

4.13 The content and even the existence of non-lawyer IP adviser qualifications are matters for the particular country where the client and the IP adviser happen to be. What can the client do about the IP adviser's qualifications including whether or not that IP adviser has the same layers of obligations to the law and the courts as does a lawyer?

4.14 Accordingly, the AIPPI proposal defines the 'intellectual property adviser' to whom the proposed standard would apply as requiring no more than to be qualified locally to give the advice in relation to which the question of disclosure arises (see the definition in paragraph 4.7 above). Other descriptions are possible. For example, the Australian IP authority has proposed – 'permitted to engage in intellectual property practice before the Intellectual Property Office in Australia or another jurisdiction'. The Groups may consider that a more specific reference to a qualification of some kind should be required. In the Australian proposal, "permitted" could be substituted by the word "qualified" to achieve that effect. A further and more fundamental reason for requiring a qualification would be that for privilege to be justified, the elements of mutual reliance between client and adviser, trust and the expectation of confidentiality must apply in the relationship. Thus the Groups may consider that merely being 'permitted to engage in intellectual property practice etc' (without any formal qualification) would not have each of these elements and thus would not give rise to 'advice' worthy of protection from disclosure. As well, AIPPI may need to be practical here. What prospect can there reasonably be of persuading the lawyers of Member States to accept the clients of unqualified agents as needing or being deserving of privilege?

4.15 The definition of 'intellectual property adviser' avoids the need for anyone to determine whether an IP adviser in a particular country has qualifications equivalent to those of an IP adviser in another country. That is irrelevant to the client.

4.16 Nonetheless, there are many potential issues in defining 'intellectual property adviser' such as the following. What if there are no qualifications that apply to a person who gives intellectual property advice in a particular country? What if the IP advisers are in no way regulated? What if by the local law, the IP adviser has no duty of care to the client? An
advantage of a duty of care in this context would be that the IP adviser would be bound by
duty owed to the client to advise how the law will apply to the client's circumstances.

4.17 In a helpful critique of the AIPPI proposal, one commentator (Prof. John Cross of the
University of Louisville Law School) included points in favour of the proposal in his paper
delivered at the main INTA meeting in 2009 entitled 'Evidentiary Privileges in International
Intellectual Property Practice', along the following lines.

(i) By making the governing standard established by the law of the forum, the local
courts (and one might add, the parties) are relieved of having to ascertain the
particulars of other nations' laws in working out whether protection from disclosure
applies to overseas documents, locally.

(ii) The proposal provides predictability of the protection applying to clients and their
representatives. If the standard is widely adopted, the predictability of the
application of the standard would encourage full candour between clients and their
representatives.

(iii) The broad scope of the proposal which covers all communications in relation to IP
advice and third parties so consulted (including overseas representatives), is highly
attractive to IP clients and their representatives.

(iv) The protection of communications between IP professional advisers and their
counterparts elsewhere thus provided reflects the realities of international IP
practice involving in effect a team or teams of legal representatives in different
countries.

4.18 However, Prof. Cross also raised two problems with the AIPPI proposal. First, the
protection proposed is broader than that currently available in common law countries. In
those countries, the protection currently available is privilege, but such privilege is in two
forms which have different scope. One of those forms has various names like "attorney-
client privilege" or "legal advice privilege". In these Guidelines, that category of privilege is
called "lawyer-client privilege". The other form of privilege is reasonably universally known
as "litigation privilege". Prof. Cross anticipates resistance to the AIPPI proposal because it
does not preserve the differences and limitations of those two forms of privilege.

4.19 Secondly, Prof. Cross points out that the AIPPI proposal does not provide for any
exceptions. These Guidelines have in effect raised the need for the Groups to consider
and decide what provision should be made for existing law and practice which limit claims
for protection from disclosure – the crime-fraud exception (para 2.7), judicial discretion to
disallow claims for protection (para 2.7), and limitations on the scope of protection by
requiring a particular relationship of the documents which are protected (the 'dominant
purpose' test – para 4.10) with the IP advice sought to be protected. The foregoing does
not purport to define what exclusions and limitations exist now. The 'solution' will have to
take all existing limitations, exclusions and waivers into account.
4.20 The Groups are invited to consider and answer the questions in the Questionnaire on the topics of "Scope of protection" and "Exceptions" taking into account the further background on those subjects stated below.

**Scope of protection against forcible disclosure – are the differences between lawyer-client privilege and litigation privilege relevant?**

**Lawyer-client privilege**

4.21 Lawyer-client privilege applies to communications between a client and lawyer for the purposes of the latter advising the former. Subject to the client waiving the right to privilege, the term of privilege is forever, ie it applies following termination of the lawyer/client relationship and the death of the client. In most common law countries, lawyer-client privilege does not apply to communications between the lawyer and third parties (such as technical experts the lawyer may engage) even if such communications are required to enable the lawyer to advise the client. Australia and the United Kingdom are exceptions – privilege does apply to such communications subject of course to the 'dominant purpose' test.

**Litigation privilege**

4.22 Litigation privilege applies to communications between a client and lawyer for the purposes of the latter advising the former where litigation exists or is contemplated. It also applies to communications with third parties in relation to litigation where the lawyer needs information from a third party (for example, an independent technical expert) to enable the lawyer to advise the client.

4.23 In litigation, both forms of privilege (lawyer-client and litigation) can apply to particular communications.

4.24 These 'privileges' ie, against disclosure including to the court, the opponent in litigation or third parties, are subject in common law countries to the court denying protection from disclosure if the person seeking discovery can show the application of any of the matters described in para. 2.7 above. In civil law countries, this is not generally an issue because they do not have forcible disclosure or discovery. The word 'generally' in the previous sentence is deliberately cautious. In France for example, a Civil or Criminal judge may enjoin a party (or a third party) to disclose a specific document in any case including an IP case.

4.25 The Groups should consider, particularly those in civil law countries, whether there is for them any good purpose in requiring as a part of any remedy that the two forms of privilege be distinguished – is there any good reason for them to take on a standard of protection from forcible disclosure which requires the differences between lawyer-client privilege and litigation privilege to become part of their law? What would be achieved by that?
4.26 The Groups should weigh the following other factors in deciding what scope of protection should apply under the standard which is to be adopted.

(i) The AIPPI proposal qualifies as good law under the Rehnquist J requirement of 'certainty'.

(ii) The AIPPI proposal has the other virtues specified by Prof. Cross as stated in paragraph 4.17 above.

(iii) The historic reasons for having differences between lawyer-client privilege and litigation privilege as to third parties do not seem justifiable where the lawyer needs third party advice to enable correct advice to be given to the client.

(iv) No common law country has written the differences between lawyer-client privilege and litigation privilege out of its law as yet.

(v) For both civil and common law countries, there is no point in AIPPI putting forward any proposal for reform where the reform is too far ahead of existing law.

The Groups may conclude that the existence of differences between lawyer-client privilege and litigation privilege will be provided for in any event by modifying the AIPPI proposal to allow for limitations and exceptions (see below).

**Limitations on and exceptions to protection from forcible disclosure**

4.27 As previously indicated in these Guidelines, many common law countries apply limitations on, exceptions to, and waiver of privilege from disclosure of IP legal advice. The Groups need to consider how to import into the AIPPI proposal allowance for those countries which require to have them, of appropriate limitations and exceptions. Prof. Cross suggests that AIPPI should look to current IP treaties for guidance, for example, the '3-point' exceptions in TRIPS.

4.28 The '3-point' exception provision in Article 30 of TRIPS states as follows.

"**Exceptions to Rights Conferred**

Members may provide limited exceptions to the exclusive rights conferred by a patent provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties"

4.29 The following wording is not intended to be anything but an indication of how AIPPI's proposal can allow for limitations, exceptions and waiver if the Groups answer the Questionnaire positively on the principle of allowing for them. Generally speaking, the Questionnaire aims to obtain views on the acceptability of principles. Debate on the suitability of particular wording will come later. The exception provisions in the AIPPI proposal might, for example, state as follows.
Any country may except from such protection in relation to legal advice or proceedings, any communication, document or other record on the basis of a limitation on, or exception to, or waiver of the application of protection from forcible disclosure of IP legal advice (including any technical advice on which it is based) which applied in its law as at the signing of this instrument.

Any country which did not apply in its law any such limitation on, exception, or waiver referred to in the previous paragraph, may hereafter adopt and apply in its law at any time any of the limitations or exceptions, or waivers to which the previous paragraph applies.

However, the Groups may decide that a broader formulation which allows not only for existing limitations, exceptions and waivers to continue in force but as well for the possibility of including new ones in the future provided that they do not erode the fundamental undertaking to provide the protection from forcible disclosure except as may be required by the particular circumstances of a particular case. It is important to create protection which if it is applicable will be accepted by other countries as a protection they must themselves recognise and support. Such recognition and support cannot reasonably be expected to apply if in the particular circumstances of the case, non disclosure could effect a substantial harm to doing justice. The Groups may sense that in the great majority of cases, the benefit of the protection against disclosure required by the standard will be clearly greater than that of the disclosure of otherwise protected communications. That would be the case where the subjects of the particular documents in dispute could be proven from another source. That is often the case because the protection from disclosure is essentially confined to communications relating to IP professional advice, not the facts of the case.

4.30 Other limitations and exceptions for which provision may need to be made should be considered in due course on the basis of the answers given to the Questionnaire in this paper.

5. An alternative proposal focussing particularly on the issue of in-house counsel in civil law countries

5.1 These Guidelines have acknowledged this issue as a serious one (see para. 2.8). A proposal has been made to WIPO as stated in paras. 5.2 and 5.3 following.

(i) A WIPO Treaty should require each Contracting State to specify categories of adviser whose clients will have privilege before the State’s Courts, intellectual property offices, tribunals, and investigators. These should be all such local general lawyers and local specialist IP advisers as the State considers to be
adequately regulated, plus (in the case of EPC members) locally-resident European Patent Attorneys (EPAs) (both in private practice and in-house).

(ii) Within each Contracting State, the following communications from or to the specified categories of adviser should be privileged (together with documents, material, and information preparatory to or otherwise related to such communications).

'Communications as to any matter relating to any invention, design, technical information, trade secret, trade mark, geographical indication, domain name, literary or artistic work, performance, software, plant variety, database, or semiconductor topography, or relating to passing off or unfair competition'.

(iii) Each Contracting State's Courts, intellectual property offices, tribunals, and investigators should respect the privilege of communications as defined in (ii) (plus preparatory/related documents, material, and information) from or to advisers specified under (i) by other States (both private practice and in-house), and in any case from or to EPAs resident in EPC States (both private practice and in-house).

5.2 The proposal made to WIPO comments as follows.

Special status is proposed for European Patent Attorneys (EPAs). [The cross-references in the following wording are to the sub-paragraphs in the previous paragraph 5.1] A high and increasing proportion of IP advisers in the EPC states are in practice EPAs as well as possibly having local national qualifications. Therefore, even if the governments of EPC member states are uneasy about the sufficiency of regulation of certain local IP advisers, and therefore do not want to specify them under (i), much of the existing problem will be solved by the specification of locally-resident EPAs under (i) together with the requirement relating to EPAs under (iii).

5.3 The proposed instrument would

(i)

(a) require each country to specify those legal advisers whose clients would benefit from the treaty

(it is expected for instance that USA would nominate, at least, all US attorneys; UK would nominate, at least, all UK solicitors, all UK barristers, all UK patent attorneys, all UK trade mark attorneys, and all UK-resident European Patent Attorneys; Japan would nominate, at least, all Japanese general lawyers and also all Japanese patent attorneys; and each EPC country other than UK would nominate, at least, all locally-resident European Patent Attorneys); and

(b) (so far as intellectual property disputes are concerned) require each country, to the extent it has a doctrine of discovery and privilege, to apply its existing doctrine of privilege equally to the clients of legal advisers
nominated by itself and to the clients of legal advisers nominated by any other country and in any case to European patent attorneys resident in EPC countries.

(The instrument would require all countries to treat equally under (a) or (b) all European Patent Attorneys, regardless of whether they work in-house or in private practice. Also if one country chooses not to discriminate under (a) between its locally-qualified in-house and private practice legal advisers, then that non-discrimination has to be respected by all other countries under (b), regardless of whether those countries choose to discriminate among their own locally-qualified legal advisers.)

(ii) The instrument summarised in the previous paragraph would have little or no effect on court actions in civil law countries where there is little or no discovery. However, it would have a major effect on court actions concerning intellectual property in common law countries, benefiting any party who has taken advice from a legal adviser nominated by a foreign country.

AIPPI commentary

5.4 The Groups will see that this proposal has particular features as follows. First, the proposal is in effect one which applies the doctrine of national treatment with additions. It does not (like the AIPPI proposal) require a particular standard to be applied by all countries. Thus the current imbalance within countries as to the application of privilege to clients of non-lawyer patent attorneys and as to communications with third parties to enable legal advice to be given, would continue. Therefore the risk of loss of protection when IP professional advice obtained in a particular country is transmitted internationally would continue.

5.5 Under this proposal, clients would still have the uncertainty of different standards applying country by country and the need to know what those different standards are in order to have the security needed to make full and frank disclosures to the IP professional advisers in any particular country.

5.6 The only non-lawyer patent attorneys for whom the instrument would require privilege are European Patent Attorneys. The Groups may consider that the clients of non-lawyer patent attorneys of a wider category should have privilege.

5.7 The proposal requires change in every country in relation to the requirements that privilege will apply equally to the clients of IP advisers nominated by any other country and in any case to European Patent Attorneys resident in EPC countries. The Groups may consider that if all countries are challenged by having to change their laws in this way, the opportunity should be taken to achieve a particular standard of protection from disclosure globally, and the benefits which that would achieve (see paras 5.4 and 5.5 above).
5.8 On the issue of in-house counsel, the AIPPI proposal includes in-house counsel. The definition of ‘intellectual property adviser’ is not limited to lawyers of any particular category. Of course, if the wording of the standard which is proposed allows for current limitations to be continued (as discussed in paras 4.27 to 4.31 above), the current European view that in-house lawyers are not independent, would continue to apply. That ‘European’ view referred to in the previous sentence does not necessarily reflect the law in particular European countries. In France, for example, when litigation is actual or contemplated, professional advice relating to that is protected against forcible disclosure under professional secrecy laws and that includes the client and those of its employees in charge of or involved in the litigation, including its in-house counsel. Such protection does not however have recognition overseas (where the local law for recognition of protection overseas requires reciprocity) as the equal of privilege.

5.9 The issue of in-house counsel is the subject of Q 206 and has not yet been studied by AIPPI. However, the problem of forcible disclosure which the current treatment of in-house counsel in most civil law countries (particularly in Europe) causes, is well known and seriously negative for the efficient operation of protection against forcible disclosure of IP professional advice. The Groups therefore may consider that if the AIPPI proposal makes provision for current limitations to be continued, it should specifically provide for the extension of the protection proposed as it relates to in-house counsel so that their ‘clients’ are treated in the same way as are those of external advisers. It could exclude any limitation on that extension which is to the effect that clients of in-house IP advisers do not have privilege from forcible disclosure of the advice of those advisers because they are employed by the client.

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?
1.2 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?

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?

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?

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?
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?

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts)
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?

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?

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?

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?

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?
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?

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?

**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’?

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?

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?

**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?

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?

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?
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?

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.

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?

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?

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?

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?

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.

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.
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?

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.
Q199 - Privilege Task Force

NRG Responses
to the Q199 Questionnaire
Responses received from the following NRGs:

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Questionnaire Q199

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

January 19, 2010

National Group: Argentina

Contributors: JORGE OTAMENDI

Date: April 5, 2010

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?

If the professionals are lawyers, they have the obligation to maintain the so called professional secret. This is established in law 23.187.

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?
This will depend on what kind of professional title the expert has.

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?

Again, this will depend on who received the information.

Overseas communications

1.4 What protection of clients 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?

The origin of the information does not make any difference, 1.1, 1.2 and 1.3 apply.

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?

Lawyers and patent agents.

(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?

Depending on each profession.

(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?

Same as (i) and (ii). The relation will be between the IP professional and 3\textsuperscript{rd} parties, not with the client.

(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?

Same as (i) and (ii).

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?

In cases where it applies it will be “fair” or “just cost”, or “extreme case” to avoid damages.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not -- including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

In what respects to lawyers, it looks fine. In what respects to IP agents, as we said, it is a resolution that can be challenged.

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?

See 1.7.

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?

No, countries should not be allowed to do it.

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?

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion
to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Because if such standard can be established, we shall never know when the professional secret cannot be maintained.

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?

We recommend to define 1 or 2 exceptions.

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”?

To be legally accepted as such.

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?

Registered patent agent.

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

(i) What category is that?

Anyone can give advice in IP matters.

(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?

Because if not, there would be no incentive or reason to have registered patent agent.

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?
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?

We believe there should be uniformity.

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?

No.

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?

------------------.

Exceptions and waivers

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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

Not in principle, though it will depend on each case.

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?

Not in principle. We would prefer the same rule for everybody.

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?

------------------.

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

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 AIPPI.

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.

------------------.

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.

------------------.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Australia

Contributors: Matthew Swinn

Date: 31 March 2010

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.

In the responses below:

Lawyer IP Professionals means IP Professionals who are lawyers (and includes an Australian patent attorney or trade mark attorney who is also an Australian lawyer).

Non Lawyer IP Professionals means registered Australian patent attorneys and trade mark attorneys (who are not also Australian lawyers).

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?
In relation to Lawyer IP Professionals, courts recognise a common law right to legal professional privilege which protects the communication against forcible disclosure through court processes. This applies to both communications between a client, the client’s lawyer and third parties for the “dominant purpose” of, either:

1. use in or in relation to litigation which is either pending or contemplated (litigation privilege); or
2. obtaining or giving legal advice (legal advice privilege).

The common law right referred to above has applied in Australia for at least decades.

In relation to Non-Lawyer IP Professionals, the Patents Act 1990 (Cth) (Patents Act) and Trade Marks Act 1995 (Cth) (Trade Marks Act) both provide for a limited privilege which applies to communications made in intellectual property matters to the same extent as privilege would attach between a lawyer and client under the common law doctrine of legal professional privilege.

Section 200 of the Patents Act provides:

(2) A communication between a registered patent attorney and the attorney’s client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client.

(4) In this section:

intellectual property matters means:
(a) matters relating to patents; or
(b) matters relating to trade marks; or
(c) matters relating to designs; or
(d) any related matters.

Similarly, section 229 of the Trade Marks Act provides a corresponding privilege in respect of registered trade marks attorneys.

A statutory privilege for patent attorneys has been part of Australian law since the original Commonwealth patents legislation was enacted in 1903, save for the period from the enactment of the Patents Act 1952 to 1960, at which time the privilege was reintroduced.

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?

Communications between clients and third parties will only attract the protection of legal professional privilege if they were made for the “dominant purpose” of either:

1. use in or in relation to litigation which is either pending or contemplated (litigation privilege); or
2. obtaining or giving legal advice (legal advice privilege).
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?

In relation to Lawyer IP Professionals, the common law doctrine of legal professional privilege applies to communications between Lawyer IP Professionals and third parties, subject to the communications satisfying the “dominant purpose” test.

In relation to Non-Lawyer IP Professionals, commentators have suggested that third party communications would not be protected as the statutory privilege is expressed only to apply to communications between the IP professional and their client.

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?

Where an Australian lawyer communicates with an overseas IP professional (whether lawyer or non-lawyer) and the communication satisfies the “dominant purpose” test, that communication will be protected under legal professional privilege.

Where a Non-Lawyer IP Professional or client communicates with an overseas IP professional who is a lawyer and the “dominant purpose test” is satisfied then legal professional privilege will apply.1

Where a Non-Lawyer IP Professional in Australia communicates with an overseas patent or trade mark attorney (who is not a lawyer), those communications will not attract the protection of the statutory privilege in Australia as the statutory protection is expressed to only apply to communications between the IP Professionals and their clients.

Where a client communicates with an overseas patent or trade mark attorney (who is not a lawyer), those communications will not be privileged in Australia.2

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?

1 Arrow v Merck; Kennedy v Wallace
2 Eli Lilly & Co v. Pfizer Ireland Pharmaceuticals (2004) 137 FCR 573, in which the Court held that the Patents Act privilege applied only to communications from/to a patent attorney registered in Australia under that Act.
(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?

See the responses given above. There is no distinction drawn between external advisers and in-house advisers provided that an in-house adviser is truly acting in the capacity of an adviser (rather than as an executive within the business).

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?
In relation to both Lawyer IP Professionals and Non Lawyer IP Professionals (and in respect of all the kinds of communications to which privilege applies in (i) to (iv), as discussed above), the limitations to privilege at common law apply equally to the statutory privileges. This is because the relevant sections of the Patents Act and Trade Marks Acts provide that communications that attract the statutory privilege “are privileged to the same extent as a communication between a solicitor and his or her client”. Therefore, in relation to both Lawyer IP Professionals and Non Lawyers IP Professionals, a number of limitations and exceptions apply.

(a) Privilege may be waived by the client performing an act (express or implied, deliberate or inadvertent) which is inconsistent with the confidence being preserved by the privilege.

(b) An exception applies to communications to facilitate crime, fraud or for an illegal purpose.

(c) Facts discovered by the adviser in the course of the adviser/client relationship are not privileged. This is because the discovery of facts through observation is not a "communication" which receives the protection of privilege.

(d) There are a number of specific instances where the protection of the privilege has been abrogated by statute.

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?

The Group considers that the protection of communications between clients and both Lawyer IP Professionals and Non Lawyer IP Professionals is of appropriate quality.

(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?

The Group considers that the protection of communications between clients and third parties to enable legal advice to be given by a Lawyer IP Professional needs to be confirmed by statute as applying to oral as well as documentary communications, but is otherwise adequate.

However, the Group considers that the protection of communications between clients and third parties to enable advice to be given by a Non Lawyer IP Professional is not of appropriate quality as the statutory privileges may not apply to communications between clients and third parties, even if for the dominant purpose of enabling 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?

The Group considers that the protection of communications between Lawyer IP Professionals and third parties, where their advice is required to enable IP legal advice to be given, needs to be confirmed by statute to apply to oral as well as documentary communications but is otherwise adequate.

However, the Group considers that the protection of communications between Non Lawyer IP Professionals and third parties, where their advice is required to enable IP legal advice to be given, is not of appropriate quality as the statutory privileges may not apply to communications between clients and third parties.

(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?

See 1.8 below.

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?

The Group considers that the protection of legal professional privilege with respect to communications between a:

1. Lawyer IP Professional and overseas IP Professional (whether or not a lawyer); and
2. client and overseas IP Professional (who is a lawyer);

applies to the same extent as it would between a solicitor and client in Australia and is therefore of appropriate quality.

The Group considers that privilege applying to communications between Non-Lawyer IP Professionals and overseas IP Professionals needs to be established or made certain by statute. The lack of privilege as to Non-Lawyer IP Professionals and overseas IP Professionals (where they are not lawyers) is of substantial concern.

These concerns are illustrated by the Eli Lilly case. There was a call for production in Australian infringement/revocation proceedings of documents passing between the inventor and the in-house patent attorney (who was registered as a European Patent Attorney but was not a lawyer), both of whom were in the UK. The documents included instructions on the preparation of the specification of the priority document of the patent in suit, including a discussion of some of the relevant prior art. Although those documents were protected by privilege in the UK, that privilege was not recognised by the Australian court because the in-house attorney was not an Australian patent attorney registered under the Patents Act. The documents were ordered to be produced. This had a flow-on effect to other jurisdictions – the loss of privilege in Australia resulted in the documents losing privilege in the US, where corresponding litigation was also pending.

3 See n. 2.
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?

The Group agrees that countries should be able to limit the degree of protection that applies to IP advice in their country but not so that it is more limited than applies to documents containing communications between lawyer and client.

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?

Any principle or standard that prescribes greater protection to communications between a client and an IP Professional than would otherwise be given to communications between a lawyer and a client in that country is likely to be met with staunch opposition. Accordingly, if any agreed principle or standard is to have any practical hope of widespread adoption, the Group considers that it should be capable of limitation by member states such that it corresponds with the level of protection given to communications between a lawyer and a client in that country. This might well extend to limitations on the relationship between the document and the IP advice such as the “dominant purpose” test which prevails in Australia.

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?

Yes. See 2.1 and 2.2 above.

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?
See 2.2 above.

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?

The Group considers that the limitation is acceptable if it is made to the extent that judicial discretion applies to the protection from disclosure in respect of communications between lawyers and clients in the relevant country.

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’?

Noting that in Australia patent and trade mark attorneys are required to be registered, the Group agrees with the way in which the standard is expressed above.

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?

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?

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes. See 2.1 above.

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?
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 only limitation should be to ensure that any applicable categories of privilege are varied or abolished in respect of IP advisers only if similarly varied or abolished in respect of lawyers.

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. See 2.1

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?

The only limitation should be to ensure that any applicable categories of privilege are varied or abolished in respect of IP advisers only if similarly varied or abolished in respect of lawyers.

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?

The Group is not aware of any adverse effects.
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?

Broadly speaking, the Group prefers the AIPPI proposal. However, the AIPPI proposal will need to permit limitations and exceptions on a country-by-country basis if it is to have any hope of adoption. If this proposition is accepted then, like the Section 5 proposal, clients will continue to have the uncertainty of different standards applying in different countries. The Group considers that consequence to be unavoidable, from a practical perspective.

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.

The AIPPI proposal suffers the same ambiguity as the Australian statutory privileges in that it is not entirely apparent whether the privilege is intended to extend to communications between an IP adviser and a third party or a client and a third party, for the purpose of obtaining or providing IP advice. The proposal should state this unambiguously.

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.

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?

No.
Questionnaire Q199

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

January 19, 2010

National Group: Austria
Contributors: Helmut Sonn
Date: 20 July 2010

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?

The members of the qualified independent professions of attorneys–at–law and patent attorneys enscribed in the list of their respective institutes are protected against forcible disclosure of any kind of communication with a client made in the course of their professional activity by any kind of administrative body and civil or penal courts even when the client released the attorney from his secrecy obligation.

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?

There are third parties which also have secrecy obligations such as civil engineers, official test institutes (technical and otherwise), administrative agencies, so that the communication of clients with them is also protected. Otherwise, communication of clients with knowledgable individual persons of firms or public institutions, like universities, who could serve as experts, are not protected. If such a third party is from another country, the answer of this question depends on the law in the respective other country. As far as such communications are sent to IP professionals under 1.1, they are of course also protected.
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?

There are third parties which also have secrecy obligations such as civil engineers, official test institutes (technical and otherwise), administrative agencies, so that the communication of clients with them is also protected. Otherwise, communication of clients with knowledgable individual persons of firms or public institutions, like universities, who could serve as experts, are not protected. If such a third party is from another country, the answer of this question depends on the law in the respective other country. As far as such communications are sent to IP professionals under 1.1, they are of course also protected.

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?

Whether the communication received or issued by overseas professionals is protected depends first and for all on the law in that country. But the client itself cannot refer to any secrecy obligation of himself before administrative offices or courts, while any communication by a qualified professional as defined under 1.1 with a foreign person is also protected.

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?

It applies to attorney–at–law and non–lawyer patent attorney (who are automatically also trade mark attorneys) both in independent profession (or employed by independent professional firms). It does not apply for in–house attorneys employed by industry. It does also not apply to European Patent Attorneys if they are not fully locally qualified as attorneys–at–law or patent attorneys since their EPO qualification does not extend to litigation (except for EPO oppositions). Trade mark attorneys do not exists as independent profession.
(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?

Communication between clients and third parties are not protected except where the third party happens to also underlie by law to secrecy obligations.

(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?

Communication between attorneys–at–law or patent attorneys both members of the legal independent profession and third parties are protected as far as they are concerned and for those third parties who have also secrecy obligations by law.

(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?

All acts by local IP professionals in the sense of (i) are protected, clients themselves are not protected. As concerns foreign IP professionals themselves their protection depends on the law applicable to them.

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?
Protection is absolute. There is only now one very limited exception, and that is money-laundering which is applicable in IP laws where piracy goods are used for that purpose.

Quality of protection
Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

Ad (i) – (iv)

Appropriate quality.

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?

Appropriate.

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).
Limitations
Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

   Yes, if it englobes advice as to grant and opposition procedure and potential litigation and not narrowed down to actual litigation.

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?

   Yes, if it englobes advice as to grant and opposition procedure and potential litigation and not narrowed down to actual litigation.

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

   No.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

   Because discretion is not a reliable, secure standard.

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?

   Not applicable.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

   Yes.

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?

   Not applicable.

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

   Not applicable since non–qualified IP advisors are not allowed; private advice by non–qualified persons is and should not be protected.
(i) What category is that?
(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?
(iii) As to your answer to sub-para (ii), why?

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes, if not too narrow (see 2.1 above).

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?

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?

Yes, but no extension of existing limitations should be possible.

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?

Yes, but no extension of existing limitations should be possible.

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, but no new or larger exceptions as hitherto.

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?

See 2.14
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?

Preference is given to the AIPPI proposal as recited in 4.7 of the Guidelines. The reason is that the proposal in 5.1 of the Guidelines would give EP representatives only qualified to practice before the EPO an enhanced status concerning advice for which they are not qualified, which enhanced qualification they could acquire if they so want.

However, if the last half sentence „plus ...“ is canceled from 5.1 (i) and the last half sentence „and in any case ...“ from 5.1 (iii), we would prefer the new proposal of 5.1 since it is clearer. This under the understanding that privilege for in–house attorneys cannot be required in those countries which do not provide for it locally and will not have to accept if from other countries which likewise do not provide it.

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.

Preference is given to the AIPPI proposal as recited in 4.7 of the Guidelines. The reason is that the proposal in 5.1 of the Guidelines would give EP representatives only qualified to practice before the EPO an enhanced status concerning advice for which they are no qualified, which enhanced qualification they can acquire if they so want.

However, if the last half sentence „plus ...“ is canceled from 5.1 (i) and the last half sentence „and in any case ...“ from 5.1 (iii), we would prefer the new proposal of 5.1 since it is clearer. This under the understanding that privilege for in–house attorneys cannot be required in those countries which do not provide for it locally and will not have to accept if from other countries which likewise do not provide it.

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.

None.
Questionnaire Q19

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

January 19, 2010

Answers - Belarus

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?
Patent attorney’s activity in Belarus is governed by the Regulations on Patent Attorneys of the Republic of Belarus, approved by the resolution of the Council of Ministers No. 379 of March 11, 1998 (with the latest amendments of December 23, 2008). According to paragraph 7 of the Regulations on Patent Attorneys information, which the patent attorney gets from the client in connection with performing client’s instructions, is deemed to be confidential, unless otherwise stated by the client. Thus, a patent attorney of the Republic of Belarus is obliged not to disclose information, submitted by the client, to third persons. The Law of Advocacy of the Republic of Belarus (Art. 16) provides advocate secrecy.

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?
These relations can be regulated by the agreement only. There are no legal restrictions. However, a patent attorney of the Republic of Belarus and an advocate are obliged not to disclose information, submitted by the client, to third persons.

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?
These relations can be regulated by the agreement only. There are no legal restrictions. As far as we can judge a patent attorney of the Republic of Belarus and an advocate should not disclose this type of information to third persons.
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?

(a) These relations can be regulated by the agreement only. There are no legal restrictions. As far as we can judge a patent attorney of the Republic of Belarus and an advocate should not disclose this type of information to third persons.

(b) These relations can be regulated by the agreement only. There are no correspondent legal norms. A patent attorney of the Republic of Belarus and an advocate should not disclose this type of information to third persons.

(c) Scope of protection – qualifications of IP professional advisers
1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to inhouse advisers?

Patent attorney passes a qualification exam at the National Center of Intellectual Property and after getting a certificate he/she can deal with any object of the industrial property. An advocate can represent the client in the court.

(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?
Patent attorneys, advocates (please, see comments above)

(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?
Patent attorneys, advocates (please, see comments above)

(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?
Patent attorneys, advocates (please, see comments above)

(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?
Patent attorneys, advocates (please, see comments above)

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?

The information, which the patent attorney gets from the client, is not considered to be a legally protected secret (like, for example, medical or advocate secrecy). That is why a patent attorney, who is engaged in any court proceedings as a witness, will be obliged to speak honestly and fully on
everything he knows about the case, as well as answer all the questions, even if the information he is asked about, is confidential in accordance with the Regulations. Corresponding witness’s obligation is set out in Article 93 of Civil Procedural Code, Article 60 of Criminal Procedural Code, Article 4.6. of Administrative Procedural Code and Article 72 of Business Procedural Code. Responsibility for failure to give evidence and false evidence is set out in the Criminal Code of the Republic of Belarus. This information is applicable to (1) – (IV).

(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?

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? The Group finds it reasonable to adopt legal acts in order to have a clear regulation on the correspondent issues. This information is applicable to (1) – (III).
(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

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? The Group finds it reasonable to adopt legal acts in order to have a clear regulation on the correspondent issues. This information is applicable to (1) – (III).

2. Remedies
The 'device' to be agreed and applied within and between countries
The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

**Limitations**

**Tests such as the 'dominant purpose' test.**

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed? **Yes, it does.**

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?

**Clear regulation.**

**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? **Yes, it does.**

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

*The Republic of Belarus has already included these provisions in the legislation.*

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?

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**Qualifications required of IP advisers**

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

*Yes, it does.*

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?

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2.8 If for some category of IP adviser in your country, no qualification is required – (i) What category is that?

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(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?

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**Scope of protection against forcible disclosure – the differences between lawyer/client privilege and litigation privilege**

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

*Yes, it does.*
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?

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, we agree.

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?

For the moment it is difficult to formulate.

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, it does.

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, it does.

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?

For the moment it is difficult to formulate.

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No, we have not.

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?

The AIPPI proposal seems to be more flexible.

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.

For the moment it is difficult to formulate.

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.

For the moment it is difficult to formulate.

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?
It is difficult to foresee adverse effect at the moment.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Brazil

Contributors: Luiz Henrique do Amaral; Claudio R. Barbosa; Maitê Moro

Date: May 19, 2010.

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?

The main protection against forcible disclosure of IP Professional Advice is the Professional Code of Conduct and Ethics of the Industrial Property Agent, established by the Brazilian Trademark and Patent Institute (hereinafter, “INPI”) by Resolution number 195/08, published December 9th, 2008. The Resolution was enacted due to article 4 of Decree-Law n. 8,933 of January 26, 1946 and Ordinance n. 32 of March 19, 1998.
Although the Professional Code of Conduct is not a Federal Statute, it is able to provide argument for an Industrial Property Agent against forcible disclosure of IP Professional Advice based on article 5th, X and XIV from the Brazilian Federal Constitution; as well as article 347, II and sole paragraph; article 363, IV; and article 406, II, all from the Brazilian Code of Civil Procedure. These provisions state, generally that one may excuse himself to present evidence in Court if such evidence will disclose facts that by profession it should be kept secret.

Please note that Brazil, as a Civil Law Country, has few and limited forcible disclosure procedures and the Professional Confidentiality exception/protection is applicable to all of them. It is important to stress that the information is considered confidential based on the status of the professional (i.e. only the professional advice between client and the IP professional is deemed confidential), not on the quality of information.

The fact that the information itself is not considered in order to establish its confidentiality the discussion of ‘dominant purpose’ is not applicable under the Brazilian Legal System.

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?

There is no protection against forcible disclosure of such communications but for a professional confidentiality protection arising from the professional status of such third party.

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?

There is no protection against forcible disclosure of such communications but for a professional confidentiality protection arising from the professional status of such third party.

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?

Within the few situations of forcible disclosure in Brazil, it is likely that IP Professionals shall present an exception based on professional confidentiality in the first premise of the question (between their local IP professional and overseas IP professionals); and,
concerning the second premise, the protection against forcible disclosure of an IP Professional Advice from overseas IP professionals will be based on the qualification of such communication by the law of the country in which the Professional Advice was given. The local provisions concerning the professional confidentiality will be likely applied by a Brazilian Court of Justice. Therefore, the same situation would be considered in both hypothesis, but the first would be based on the protection provided by the Brazilian law, and the second will depend on the protection granted by the foreign law (if available).

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?

The protection of clients against forcible disclosure of communications related to IP Professional Advice, as mentioned in item 1.1, must be considered applicable to industrial property agents (i.e. non lawyer patent and trademark attorneys). Please note that any professional advice from a lawyer (either external or in-house) must be considered privileged, based on a different statute (Law n. 8.906/94).

(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?

The protection will depend on the professional status of such third party.

(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?

The protection will depend on the professional status of such third party.

(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?
Local IP Professionals could be industrial property agents (i.e. non lawyer patent and trademark attorneys) or lawyers in order to claim a protection against forcible disclosure of IP professional advice. Overseas IP professionals would likely depend on the protection of their countries (see item 1.4).

Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The limitations would be a crime-fraud exception (see Brazilian Supreme Court, HC 94173, Judge Min. Celso de Mello, 2nd Chamber, October 10, 2009; and Brazilian Superior Court of Justice, RHC 22.200/SP, Judge Min. Arnaldo Esteves Lima, 5th Chamber, March 9, 2010), or a life threatening situation (INPI Resolution 195/08).

(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?

As the protection will depend on the professional status of such third party, if there is a limitation it will be the same as the preceding item.

(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?

As the protection will depend on the professional status of such third party, if there is a limitation it will be the same as the preceding items.

(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?

As mentioned, there is an exception concerning information used in a criminal activity (crime-fraud exception) and in life threatening situations. As also mentioned, although there is no case law regarding this issue in Brazil, it is likely that the confidentiality concerning privileged information related to foreign IP professionals will be treated according its own local regulations.
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?

The protection available, although useful and sufficient whenever considered the limited situations of forcible disclosure under Brazilian Law, could be threatening to clients under a common law disclosure proceeding. The situation is specially aggravated when there is an intervention of third parties in the “IP Advice” process.

Moreover, the Brazilian Group considers that the protection is not appropriate due to the limitation of qualification of IP Advisers (lawyers and industrial property agents) and not embracing third parties that could not be qualified to provide “intellectual property advice”, but could provide essential information to the “intellectual property adviser” reaches his conclusions (and protected advice). Such a breach could not persist as it will jeopardize the aimed protection.

This answer is applicable to the items bellow.

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

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?

There is no information (or case law) sufficient to provide analysis or opinion of this situation.
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?

The Brazilian Group considers that IP legal advice should be broadly considered, therefore a test or limitation should not be considered.

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?

IP legal advices embraces advices in many areas (technical and legal) being difficult to one foresees clearly and objectively possible limitations or tests. Such limitations would bring undesirable uncertainty and possibly breaches to access protected (or confidential) information.

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?

This issue would not be applicable within the Brazilian Legal System, however the Brazilian Group does not agree that any provision should allow judicial discretion.

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?

Not only public facts and IP rights themselves could provide adequate elements to assess the particulars of a case, but certainty is an essential element to any system.
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?

Not applicable, as a broad judicial discretion would not be allowed within the Brazilian Legal System.

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'?

The Brazilian Group understands that any person that provides a relevant information within an “IP Legal Advice” should be considered an “IP Legal Adviser”.

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?

Please, see the previous answer.

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

The main “category” of IP Adviser is the “Industrial Property Agent” professionals and this category, but for a public admission exam, requires no previous technical qualification or background. However, it is likely that third party orientation, such as the provided by experts in any area of knowledge, used by “IP Advisers” should be protected.

As mentioned, if a third party expert has no professional confidentiality this situation could be a breach in the protection chain. This answer applies to the following items (i), (ii) and (iii).

(i) What category is that?

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?
The Brazilian Group considers that countries should limit the protection they provide according to categories of privilege which are currently part of their law.

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?

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?

Not applicable.

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?

Not applicable.

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. The Brazilian Group agrees that the standard or principle should be subject to crime-fraud exception in order to validate the concept of the privileged information itself.

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?

The Brazilian Group agrees that a country should have the right to vary or to abolish any exception.

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?

The “3-point-exception” could be a limitation.
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?

There is no case law concerning any forcible disclosure of IP professional advice that the Brazilian Group is aware.

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?

The AIPPI proposal would be preferable. However, as mentioned, a broader definition of “intellectual property adviser” could be considered.

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.

Not applicable.

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.

Not applicable.

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?

Not applicable.
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?

In Canada, the legal doctrine of privilege provides that certain communications or documents are prohibited from forced public disclosure during the litigation process or other legal or quasi-legal proceedings. There are two generally recognized categories of privileged communications in Canada, namely, communications that are protected by a “class privilege” (where there is a presumption that the privilege attaches because of the nature of the relationship between the communicating parties) and communications that are not protected by a class privilege but that may still be
considered privileged depending on the particular circumstances (determined on a “case-by-case” basis).¹

Solicitor-client privilege is a “class privilege” in Canada and it provides a blanket privilege with a prima facie presumption that confidential communications between a qualified legal advisor in Canada (sometimes referred to as a solicitor, barrister, or lawyer) and a client in respect of the provision of legal advice (including legal advice in respect of intellectual property rights) are protected. This applies to legal advice provided by in-house counsel.

Another form of “class privilege” that is closely related to solicitor-client privilege is what is sometimes referred to as “litigation privilege”. This can be asserted over communications made in respect of pending or contemplated litigation and is not limited necessarily to communications between a lawyer and a client, but can extend to communications between the client or the lawyer and third parties.

Communications which do not fall into one of the recognized class-privileges may still be eligible for privilege. They will be considered on a case-by-case basis, with the presumption being that they are not privileged and therefore should be disclosed unless under the circumstances, the applicable policy considerations require their exclusion.

While privilege can attach to non-lawyer Patent or Trade-mark Agent communications in appropriate circumstances, most particularly by way of litigation privilege², the Federal Court of Canada has consistently held that communications between clients and agents are not, per se, protected by privilege³.

In Canada, privilege is primarily a common law (non-statutory) based principle and would have been in effect upon Canada becoming a country in 1867 having been a colony of the United Kingdom.

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?

As indicated in 1.1 above, litigation privilege can be asserted over communications made in respect of pending or contemplated litigation. Provided that the “dominant purpose” of the communication is for litigation, then litigation privilege can be asserted over communications between the client (or the client’s agent) and third parties for the purpose of obtaining information to be given to the client’s solicitors to obtain legal advice; between the solicitor and third parties to assist with the giving of legal advice; or documents created at their inception by the client for litigation⁴. This would include, for example, communications with technical experts. However, unlike solicitor-client privilege, litigation privilege lasts only for the duration of the litigation⁵.

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

² See, for example, ABC Extrusion Co. v. Signtech Inc. (1990), 33 C.P.R. (3d) 474 (Federal Court, Trial Division).
³ For further examples see also Sperry Corporation v. John Deere Ltd. et al. (1984), 82 C.P.R. (2d) 1 (Federal Court, Trial Division); Scientific Games, Inc. v. Pollard Banknote Ltd. (1997), 76 C.P.R. (3d) 22 (Federal Court, Trial Division); and Whirlpool Corp. v. Camco Inc. (1997), 72 C.P.R. (3d) 444 (Federal Court, Trial Division).
⁵ Blank v. Canada (Department of Justice) (2006), 51 C.P.R. (4th) 1 (Supreme Court of Canada) at 13.
parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

See answer to 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?

Communications between Canadian IP providers and overseas IP professionals in respect of Canadian legal matters will generally be subject to the principles outlined above.

Confidential communications between an IP owner and a foreign IP advisor who is a lawyer will generally be considered privileged by a court in Canada provided that the communications were made in respect of the provision of legal advice, and on matters for which the foreign lawyer was qualified to provide that advice. Further, as indicated in 1.2 and 1.3 above, litigation privilege may also apply.

However, the full extent of the Canadian law is uncertain in respect of communications between IP owners and foreign, non-lawyer IP advisors. In a recent case, the Federal Court of Canada held that communications between the inventors and their U.K. Patent Attorneys (non-lawyer patent agents) were not privileged and were required to be produced in Canadian litigation, even though a statutory privilege existed in the U.K. in respect of such communications. Thus, confidential communications between an IP owner and a foreign, non-lawyer agent may not be considered privileged in Canada, depending on the circumstances.

**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?

Pleas see above answers.

Additionally, it should be noted that there have been a number of Canadian decisions that have held that privilege will not necessarily extend to communications between a client and a lawyer who is also a Patent or Trademark Agent where that person is acting in his or her capacity as an agent and not as a lawyer. Similarly, the Canadian Federal Court of Appeal has also ruled that communications from an in-house counsel who is also a patent agent will

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be privileged only where the in-house counsel is acting in his capacity as a lawyer. 

(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?

Please see above answers.

(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?

Please see above answers.

(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?

Please see above answers.

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?

In regards to solicitor-client privilege, current exceptions include the following: 

- where the innocence of an accused person is at stake and the information subject to privilege may prevent a full defence;
- where the communications between the solicitor and client constitute criminal communications;
- where there is a risk to public safety and a breach of solicitor-client privilege may prevent harm.

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7 IBM Canada Ltd. v. Xerox of Canada Ltd. et al (1977), 32 C.P.R. (2d) 205 (Federal Court of Appeal).
With respect to litigation privilege in Canada, it may only be asserted where the dominant purpose of such communications is litigation, whether contemplated, anticipated, or ongoing.  

(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?

Please refer to 1.6(i).

(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?

Please refer to 1.6(i).

(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?

Please see above answers in regards to protection afforded to communications between Canadian IP professionals and foreign IP professionals as well as communications between the clients and overseas IP professionals.

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?

The Canadian group is of the view that the lack of privilege for communications between IP owners and non-lawyer agents (foreign and domestic), or lawyers

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9 Ibid. at 12-3.
acting in their capacity as agents is a problem that needs to be addressed both at the national and international level.

In the absence of privilege, there is concern that communications between non-lawyer agents and their clients would be unduly constrained where litigation privilege would not attach. Clients may be reluctant to provide material information to their non-lawyer agents and may exclude relevant facts to prevent their subsequent disclosure. Limiting communications between clients and their IP advisors in such a manner is likely to adversely affect the advice provided.

Other potential consequences include, amongst other things, an IP owner deciding not to enforce its intellectual property rights, choosing not to seek intellectual property rights in certain jurisdictions, or choosing not to seek IP advice at all, with an overall negative result on research, development, and/or trade in goods or services such that the loss of privilege acts as a barrier to trade.

There is also the concern in respect of the difficulties that may arise (as has been seen in Canada in the *Lily Icos v. Pfizer* decision) from an international perspective in view of the approach by Canadian courts that privilege does not apply to communications between IP owners and non-lawyer agents.

(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?

Please refer to 1.7(i) above.

(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?

Please refer to 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?

Please see the answer to 1.7(i) above
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?

The scope of the privilege included in the agreed principle or standard should be akin to solicitor-client privilege which applies to communications between a client and their IP Advisor (i.e. a lawyer, patent attorney or patent agent, or trade mark attorney or trade-mark agent or other person legally qualified in the country where the IP advice is provided). While there may be differing views in Canada as to the extent of services to which the privilege should apply, the Canadian group substantially supports a privilege comparable to solicitor/client privilege, and would include any record or document made for the purposes of, or relating to, such communication.

Litigation privilege should also apply.

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?

To define as privileged all communications given in relation to IP matters is potentially too wide. However, given the inherent limitations of, for example, litigation privilege, any restriction on the particular types of communications that should be protected would relate to legal advice pertaining to intellectual property rights as indicated in 2.1 above.

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?
The manner in which the privilege would apply, and its scope, would be left too uncertain.

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?

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes.

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?

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

(i) What category is that?

Not applicable.

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes. It should be noted, however, that unlike solicitor-client privilege, litigation privilege is a rule of evidence and does not constitute an absolute privilege.\(^\text{10}\) It is recommended, therefore, that the level of protection for IP advice should be no less than that accorded to the lawyer/solicitor-client privilege that may apply to such advice in that Member State.

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?

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

\(^\text{10}\) Ibid. at 12-4.
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?

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?

No.

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?

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No.

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

2.17 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?

Our group prefers the AIPPI proposal for the following reasons:
- The AIPPI proposal requires a particular standard to be applied by all countries thereby addressing the current imbalance within countries as to the application
of privilege to clients of non-lawyer patent agents and non-lawyer trade-mark agents.

- The AIPPI proposal includes in-house counsel. As a result, this would address the issues that arise in respect of communications from an in-house counsel who is also a patent agent and/or trade-mark agent.

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.

N/A

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.

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?

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.
Questionnaire Q199

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

January 19, 2010

National Group: CHILE
Contributors: Cristóbal PORZIO
Date: June 10, 2010

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?

Full protection

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?

Full protection when assimilated to professional relationship
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?

Full protection when assimilated to professional relationship

**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?

Full protection when it can be proved it is professional relationship

**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?

Lawyer, lawyer/patent attorney; lawyer /trademark attorney

(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?

Lawyer, lawyer/patent attorney; lawyer /trademark attorney

(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?

Lawyer, lawyer/patent attorney; lawyer /trademark attorney

(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?

Lawyer, lawyer/patent attorney; lawyer /trademark attorney
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?
Crime / fraud

(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?
Crime / fraud

(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?
Crime / fraud

(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?
Crime / fraud

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?

Yes

(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?

Yes

(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?

Yes

(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?

Yes

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?

Yes

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).
Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

To ensure protection will apply only to serious cases

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?

Yes

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?

To ensure protection will apply only to serious cases

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?

As situation drafted in 2.3

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'?

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?

By limiting it to IP professionals

2.8 If for some category of IP adviser in your country, no qualification is required –
(i) What category is that?

All non professionals

(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?

No

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

Unlimited protection may result in no protection

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

No

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?

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 exceptions (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?

No

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?
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?

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.

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.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Chinese Group of AIPPI

Contributors: CCPIT Patent and Trademark Law Office

Date: June 10, 2010

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.

Answers in General:

We have considered and studied the questions listed in the “Questionnaire Q199” in view of the differences in the law concepts and practises between common law countries and civil law countries, and makes the following answers and comments:

1. In China there is not any law or regulation that particularly and specifically provides for protection of the client against forcible disclosure of communications between client and IP professionals.

2. The Constitution of the People’s Republic of China does, however, provide for protection for correspondence among the citizens of China. Under Article 40 of the Constitution, “Freedom and privacy of correspondence of citizens of the People's Republic of China are protected by law. No organization or individual may, on any ground, infringe upon citizens freedom and privacy of correspondence, except in cases where, to meet the needs of state security or of criminal investigation, public security or procuratorial organs are permitted to censor correspondence in accordance with procedures prescribed by law."

As may be generally understood and in light of dictionaries, the term “communication” is a generic (upper level) term while “correspondence” is a specific (lower level) term. In such a
sense that communications between client and IP professionals may be comprehended to comprise of “correspondence”, and the client and IP professionals fall within the term of “citizen”, as termed in the Constitution, the communication between client and IP professionals is then regarded as protected by the Chinese law.

However, as may have been noted, such protection of communications between client and IP professionals is subject to some exceptions, i.e. “in cases where, to meet the needs of state security or of criminal investigation, public security or procuratorial organs are permitted to censor correspondence in accordance with procedures prescribed by law." Consequently, if the act “to censor correspondence” may be understood as “forcible disclosure” of communication as termed in the Q199, then there will not be protection of client against such a “forcible disclosure” in this connection.

3. Under the Chinese laws and practises, IP professionals are categorized into the following groups of people: lawyers, lawyers with patent agent licenses, patent agents, trademark agents, and those law professionals who provide services concerning recordation of copyright and computer software etc.. Such IP professionals of China shall, under the Chinese laws and regulations, work under a lawyer's firm or an agent office, exclusive of enterprises or companies. Ordinarily technical experts may not be deemed as IP professional in China.

For these categories of IP professionals, China enacted and issued some laws and regulations, requiring the IP professionals to keep secret the information that they obtained during their service for their clients, e.g. Article 38 of the Law of Lawyers, Article 19 of the Patent Law, Art. 23 of the Regulations on Patent Commissioning, Art. 10 of the "Rules of Career Ethics and Professional Discipline for Patent Agent, Articles 7 & 8 of the Disciplinary Rules for Patent Agency (tentative) and Article 11 of Regulations on Trademark Commissions. In the case when these professionals are required or "forced" to disclose the information that may be contained in the "communication" with their clients, they are literally bound by the above provisions in the laws and regulations. Though such an obligation of keeping secret on the part of IP professionals may not understandably be regarded as the protection of the client against forcible disclosure of communications with his IP professionals, but rather the content of information that may or may not be contained in the communications forced to be disclosed, in a sense, the protection of client against the forcible disclosure of communications may be achieved to some extent.

Nevertheless, while China has the above laws and regulations in place to bind the IP professionals, there is another law in China that grants authority to the courts of law in China to collect evidence and delegates to the parties in a lawsuit the obligation to provide evidence (Article 65 of the Civil Procedural Law). In the case where the evidence includes the "communications" and the client’s submission of the communications to the court forms up the "forcible disclosure", there won’t be any protection of client against forcible disclosure of the communications.

4. The above laws and rules and practises apply to the Chinese individuals and enterprises, and to the cases, circumstances and people including foreigners where the Chinese laws and rules shall apply in accordance with relevant international agreements, treaties or conventions.

Present position

Local position

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 IP professionals within your country?

1.3 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?

1.4 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?

Overseas communications

1.5 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?

Scope of protection – qualifications of IP professional advisers

1.6 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?

Limitations and exceptions

1.7 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?

Quality of protection

Local communications

1.8 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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 the clients and overseas IP professionals?

Communications with overseas IP advisers

1.9 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?
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?

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?

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?

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?

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?

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'?

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?

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?

**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?

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?

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?

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?

**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.

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?

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?

**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?

**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.
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.

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.
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?

The protection against forcible disclosure of communications relating to IP professional advice depends on the status of an IP professional providing the advice. In the Czech Republic, two groups having the legal duty of secrecy in relation to the intellectual property rights are recognized by law – the attorneys and patent attorneys. Others do not underlie any regulations in this respect. However, the protection against forcible disclosure of communications relating to IP professional advice does not have any special or privileged regime in comparison with the other field of law. In other words, general protective instruments summarized below are applicable thereto.
According to the Czech Act on Advocacy an attorney shall keep confidential all facts he learned in connection with the provision of legal services. The client, or legal successors of the client only can remove such duty of confidentiality, and such release must be in writing. The obligation of confidentiality applies also to the staff members employed by the respective attorney. The duty of secrecy is also mentioned in the Ethics Code of Advocacy having the nature of soft-law regulation.

Concerning the patent attorneys the situation is similar. The Act on Patent Attorneys states “A patent attorney must maintain confidentiality about all facts/matters that came to his knowledge while providing services as a patent attorney.” The duty is similar to that of general attorneys and it applies also to the staff members employed by the respective patent attorney.

The obligation of both attorneys and patent attorneys has certain limits, which will be discussed below.

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?

Generally, no special means of protection against forcible disclosure of communications relating to IP professional advice in the Czech Republic applies as to communications between clients and third parties. The only group affected by legal regulations are expert witnesses. An expert witness might be consulted as far as the technical issues in respect of intellectual property rights are concerned, in such case he ought to preserve confidentiality in respect of all facts learned in connection with the provision of the expert services, i.e. is obliged to maintain confidentiality in respect of facts underlying the expert performance learned, while providing the service. This obligation arises from the Expert Witnesses and Court Interpreters Act and may be deemed general having no special regulation in respect of IP and related issues.

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?

As to the communications relating to IP professional advice between IP professionals and third parties (such as technical experts) conclusions result from the answers stated in points 1.1 and 1.2 above. As far as the relationship between an IP professional (regardless whether an attorney or a patent attorney) and the expert witness (registered with the Court) is concerned, both parties have the respective duty. The same may be concluded also in case the technical expert is employed directly by an attorney (patent attorney). The other imaginable relationships are not regulated. It is, however, possible to secure the confidentiality of the communication between IP professional and a third party (falling out of the scope of the legal protection) on a contractual basis, i.e. within the framework of a contract establishing the relationship between an IP professional seeking an advice and a third party providing the advisory service.
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?

The protection against forcible disclosure of communications between local IP professionals in the Czech Republic and overseas IP professionals and/or clients and overseas IP professionals does not underlie any special legal regulation. In other words Czech legislation is completely still thereabout. As these relationships obviously include foreign elements, the legal relationship between the respective parties and especially the decisive law applicable thereto shall be determined according to the provisions of international private law. The protective measures would thus be applicable dependant on the decisive law system determined by the means of IPR.

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?

The protection applies merely to the attorneys and patent attorneys, as far as the group of IP professionals is concerned. In relationships with the other groups of advisors, regardless whether independent or in-house (lawyers, trademark advisors etc.) no specific protection applies except the case these advisors are employed by an attorney (patent attorney) having the duty of secrecy himself. In such case the obligation to preserve the confidentiality is imposed also on the employees. It is also remarkable that the confidentiality within in-house advisory services and relationships arising therefrom might be secured by the means of a contractual obligation (usually by a labour contract).

(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?

The situation is analagical to the points 1.2 and 1.5 (i) above.

(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?

The situation is analagical to the points 1.3 and 1.5 (i) above.


(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?

The situation is analogical to the points 1.4 and 1.5 (i) above.

**Limitations and exceptions**

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The attorney’s obligation of secrecy, however, has certain limitation. In particular, the duty of confidentiality shall not affect the legal duty to thwart a criminal offense (this obligation applies only to certain offenses listed in the Criminal Code). The duty does not apply in a dispute between the attorney and client, and related proceedings. The duty does not apply in tax matters of the attorney in relation to the attorneys tax-reporting obligations, however the nature of communication with the client must not be disclosed. The duty does not apply where the attorney is subject to disciplinary proceedings in front of the Bar.

Another statutory exception to the duty is resulting from the Act aimed at combating the legalisation of income from criminal conducts. This act provides that the attorneys must in certain matters formally identify and/or report persons and transactions to the Czech Bar Association. However, it is unlikely to apply in cases related to IP.

Last but not least, an attorney is not bound by the duty before a court or other authority to the necessary extent determined by the subject of litigation.

As regards the patent attorney the limitations do not substantially differ from the limitations indicated above.

(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?

The respective legislation does not contain any provision providing for a possibility of a client to release the expert witness from the duty of secrecy (and in this respect the regulation is thus stricter in comparison with attorneys/patent attorneys). The other limitations are analogical to those described above in point 1.6 (i)

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?

*The answer may be deduced from the answers above, namely from the points 1.3 and 1.6 (i,ii)*

(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?

*No specific protection is applicable for the cases specified above, as already discussed in point 1.4*

**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?

*It is worth to be mentioned that the information communicated between an attorney and client in the Czech Republic is not protected by an equivalent to the Common Law concept of attorney-client privilege. The difference is that, although the attorney indeed has a strict duty of secrecy/confidentiality, however, the client may only decline to disclose information in court and administrative proceedings (oral testimony, production of documents, and items) if such disclosure would result in criminal or administrative proceedings against the client or a “close person. This is similar to the protection from self-incrimination of the US constitution. If the client is the accused in a criminal matter then the client can refuse to testify altogether. In civil proceedings the client can refuse to testify in a position of a party to the proceedings (plaintiff or defendant).*

(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?

*As regards the expert witnesses, the law does not solve the problem of limitations and waivers explicitly as in the case of attorneys and patent attorneys. In relation to other parties than expert witnesses the protection is not solved at all. Given the reasons above it might be deemed insufficient.*

*The expert witnesses are the only group affected by the legal regulation in this respect and therefore no protection against forcible disclosure of communications relating to IP*
professional advice can be expected in relation to other parties (especially expert not registered with the court).

(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?

The main limitation consists in the fact that the duty of secrecy applies only to the employees of attorney (patent attorney). In case the attorney (patent attorney) requires an advice of a third party (other than expert witness), the secrecy of such communication is not guaranteed legally. The contract between such third party (independent advisor) and an attorney has to reflect this fact and explicitly include the duty of secrecy within its provisions.

(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?

The overseas aspects of communications between both IP professional advisors in the Czech Republic and overseas and clients and overseas IP professionals is not solved on the level of the Czech national law.

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?

Already discussed above

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 believe that a principle or standard determining limitation of the documents to which the protection applies may be established by individual countries, regardless the chosen form thereof. Nevertheless, it should be left to the discretion of the individual states, whether to apply such limitations or not.

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?

The discretion of states in this respect should be maintained namely due to significant differences between the civil law and common law systems and difficulty of finding unified solution universally applicable.

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?

Allowing judicial discretion to deny protection from disclosure, in case of reasonable grounds (particularly in order to enable the court to do justice between parties) is a necessity and this limitation should be by all means preserved by the proposed regulation. The subject limitation, as an elementary guarantee, should be adopted by all countries at a certain reasonable extent. The courts or authorities should be entitled to demand the production of evidence from the client if they deem it appropriate. However, this practice has to be compliant with the general principles of democratic legally consistent state, i.e. the scope of judicial discretion needs to be enacted.

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?

Already answered above.

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?

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes, we principally agree therewith.

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?

2.8 If for some category of IP adviser in your country, no qualification is required –
(i) What category is that?

In the Czech Republic, merely two categories of IP advisors are recognized by law (attorneys and patent attorneys). These two categories also underlie specific conditions (bar regulations) in respect of qualification. In other words a person not fulfilling the qualification requirements may not become a member of the bar and thus may also not officially practice the respective service. Of course, it is possible that the advisory services to a certain degree are provided also by other categories of advisors regardless their qualification, however these advisors are at least not on an ordinary basis admitted to represent the clients before the authorities such as the Patent Office or courts.

(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?

We are of the opinion, that the responsibility of the client to seek services of an authorized IP professional, whose duties in respect of secrecy are statutory, should be retained. It is virtually impossible apply the protection from forcible disclosure of IP (professional?) advice to all conceivable categories of advisors.

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

Answered 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?

Yes, we agree.

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?

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 liberty to vary or abolish a previously applied limitation should not threaten the purport of the proposed regulation and should comply with the minimum standards agreed.

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, we agree.

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?

No limitation is necessary. Moreover, it is hardly imaginable that the proposed regulation would prevent the states from abolishing (or anyhow amending) their own exceptions or waivers, as principles underlying the exceptions or waivers result from regulations having supreme legal power.

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?

We prefer the AIPPI Proposal for its complexity.

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.

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.

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.
Questionnaire Q199

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

National Group: Denmark

Contributors: Ejvind Christiansen
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Date: 11 June 2010

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.

Introductory note

In this questionnaire, “lawyer” denotes a Danish "advokat", i.e. a member of the Danish Bar and Law Society. To become a member of the Danish Bar and Law Society, one generally needs to hold a Danish LL.M. (master of laws), to have passed the Danish Bar and Law Society’s theoretical as well as practical bar examinations and to have been authorised as lawyer trainee for 3 years.

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?

Within the context of IP related court proceedings, forcible disclosure may follow from (i) witness testimony, (ii) civil search orders, (iii) civil discovery orders and (iv) criminal search orders.

The rules pertaining to (i) witness testimony and (iv) criminal search orders are old. The rules pertaining to (ii) civil search orders and (iii) civil discovery orders have been implemented recently as a consequence of the TRIPS agreement and the EU enforcement directive.

As regards (i) witness testimony, the general principle under Danish law, for anyone who is not a party to the proceedings at hand, is that unless explicitly exempted by law there exists an obligation to give testimony in court. (None of the parties involved in legal proceedings are required to give testimony in court.)

In criminal proceedings, a lawyer, including his assistants, may not against the wish of his client give testimony about what has come to his knowledge in the course of his work.

In civil proceedings, a lawyer, including his assistants, may as the general rule not against the wish of his client give testimony about what has come to his knowledge in the course of his work. However, to the extent the testimony does not directly relate to the lawyer's advice in court proceedings, the court may exempt from the general rule if the lawyer's or his assistants' testimony (a) is likely to be of decisive importance and that the importance of the case (b1) for the relevant party or (b2) for the society at large so justify.

The above privilege rules only apply to lawyers and their assistants.

Other IP professionals, such as patent attorneys, are generally not covered by the same privilege as lawyers, but have documentary privilege provided by the Danish Marketing Practices Act and also by the EPC. (Art.134a and Rule 153 EPC) The general obligation to provide witness statements may be exempted by the court for any witness, including non-lawyer IP professionals, if the witness statement concerns information (i) which according to law is subject to secrecy, and (ii) where the maintenance of secrecy is of substantive importance. The Danish Marketing Practices act implies that IP professionals have an obligation to keep confidential their knowledge of their clients' business secrets. Also the Codes of Conduct of several professional member organisations for patent attorneys (e.g
EPI, (European Patent Institute), FICPI (Fédération Internationale pour la Protection de la Propriété Industrielle) and the Association of Danish Patent Attorneys) contain Rules of obligation for its members to keep confidential their knowledge of their clients’ business secrets. All IP professionals may therefore in principle be exempted from providing particular witness statements comprising their clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.

It is uncertain whether the lawyer’s privilege extends beyond the lawyer’s internal assistants, such as secretaries and legal trainees, so that the privilege also comprises external assistants, such as professional advisors, including IP professionals and in particular patent agents, e.g. European Patent Attorneys. The purpose of the privilege weights in favour of an interpretation under which external assistants are covered as far as their particular advice to a lawyer is concerned. However, the nature of the privilege being an exemption to a firm general rule weights in the opposite direction. In one particular case, an external accountant that had assisted a lawyer was held not to be covered by the lawyer’s privilege. The résumé of the particular judgment is very short and may only reflect a special situation that does not that as a general rule external assistants are not covered.

As regards (ii) civil search orders, the search may generally cover all documents available at the searched address. However, a search order may generally not be directed against client related documents placed at the lawyer’s or the lawyer’s assistants’ premises.

As regards (iii) civil discovery orders, the discovery order may cover all information in respect of which the person, against whom the order is directed, is obliged to give witness testimony in court. A civil discovery order directed against a lawyer can therefore generally not cover the client’s correspondence with his lawyer or his lawyer’s assistants.

As regards (iv) criminal search orders, the search may not comprise documents from the defendant’s lawyer or the lawyer’s assistants.

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?

When the external third party is a lawyer or can be considered as a lawyer’s assistant the lawyer’s privilege apply. Reference is made to paragraph 1.1 above for further details.

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?

When the external IP professional is a lawyer or can be considered as a lawyer’s assistant the lawyer’s privilege apply. Reference is made to paragraph 1.1 above for further details.

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?

According to the wording of the Danish Administration of Justice Act, only Danish lawyers and their assistants are conferred with legal privilege. Reported Danish case law does not shed light on whether the legal privilege extends to foreign lawyers.

The possible limitation to Danish lawyers can be seen as balanced by the fact that only persons within Danish jurisdiction can be forced to appear as witnesses or can be subject to forcible discovery or civil or criminal search orders.

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 (e.g., 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. 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?

General privilege probably applies only to external lawyers and external lawyers’ assistants, cf. paragraph 1.1 above. It is uncertain whether privilege apply to internal lawyers, cf. below.

Non-lawyer IP professionals can be conferred with legal privilege that covers clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.
(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?

*Non-lawyers, including technical experts, can be conferred with legal privilege that covers clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.*

(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?

*In respect of external lawyers, privilege may extend to such lawyers’ external assistants, cf. paragraph 1.1 above. It is uncertain whether privilege apply to internal lawyers, cf. below.*

*Non-lawyers, including non-lawyer IP professionals and technical experts, can be conferred with legal privilege that covers clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.*

(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?

(a) *In respect of external lawyers, privilege may extend to lawyers’ external assistants, including foreign assistants such as foreign IP professionals, cf. paragraph 1.1 above. It is uncertain whether privilege apply to internal lawyers, cf. below.*

(b) *As set out in paragraph 1.4 above, according to the wording of the Danish Administration of Justice Act, only Danish lawyers and their assistants are conferred with general legal privilege. No general privilege therefore exists in respect of overseas IP professionals.*
Answer to all questions: The general privilege only applies to lawyers (i.e. “advokater”, cf. above) and lawyers’ assistants. It is unsettled whether privilege applies to all lawyers, or only to external lawyer. Lawyer’s privilege does not extent to persons that are not members of the Danish Bar and Law Society, such as Danish trademark attorneys, Danish patent attorneys, European Patent Attorneys or foreign attorneys-at-law, but they can be conferred with legal privilege that covers clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.

Limitations and exceptions

1.6 What limitations (e.g. dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (e.g. 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?

As set out in paragraph 1.1 above, absolute protection exists in the following situations: (a) In criminal proceedings, the lawyer and his assistants may not against the wish of his client give testimony or provide documentary evidence about what has come to his knowledge in the course of his work. (b) In civil proceedings, the lawyer and his assistants may not against the wish of his client give testimony or provide documentary evidence about what has come to his knowledge regarding particular court proceedings in which he has advised. (c) In respect of criminal search orders against a client, the search may not comprise documents between the client and his lawyer or lawyer’s assistants.

In civil proceedings, the lawyer and the lawyer’s assistants may generally not against the wish of his client give testimony or provide documentary evidence about what has come to his knowledge in the course of his work. To the extent that the testimony or the documentary evidence does not directly relate to the lawyer’s advice in court proceedings, the court may exempt from the general rule if the lawyer’s or his assistants’ testimony or documentary evidence (a) is likely to be of decisive importance and that the importance of the case (b1) for the relevant party or (b2) for the society at large so justify.

IP professionals that are not lawyers, such as Danish trademark attorneys, Danish patent attorneys and European Patent Attorneys, can be conferred with legal privilege that covers clients’ business secrets to the extent the maintenance of secrecy is of substantive importance.
In respect of civil search orders and civil discovery orders, reference is made to the comments in paragraph 1.1 above.

(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?

Third parties, including technical experts, can be conferred with legal privilege that covers clients' business secrets to the extent the maintenance of secrecy is of substantive importance.

(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?

In respect of external lawyers, the rules may extend to lawyer's external assistants, cf. paragraph 1.1 above. If so, the principles set out above in (i) applies.

Non-lawyer IP professionals and third parties, including technical experts, can be conferred with legal privilege that covers clients' business secrets to the extent the maintenance of secrecy is of substantive importance.

(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?

(a) If external assistants are considered as "lawyer's assistants", cf. paragraph 1.1 above, the principles set out in (i) applies also to overseas IP professionals that are assisting the lawyer.
(b) It is undecided by reported Danish case-law whether legal privilege extends to foreign IP professionals. In the affirmative, the privilege will probably only extend to foreign attorneys-at-law, see also paragraph 1.4 above.

(a)+(b) Overseas IP professionals can be conferred with legal privilege that covers clients' business secrets to the extent the maintenance of secrecy is of substantive importance.

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?

Any client would arguably prefer that privilege would extend to any person that could give unfavourable testimony against him or her. The Danish Administration of Justice Act generally aims at enabling the courts to establish the true facts and therefore, such extreme privilege is obviously not feasible. In fact, the limited but absolute privilege regarding lawyer's advice in court proceedings probably enhances the courts' ability to establish the true facts as defendants, in particular in criminal proceedings, need a trustful and open dialogue with a lawyer to make themselves heard during the proceedings. Indeed, the privilege is "client's privilege", not "lawyer's privilege".

In Denmark, "client's privilege" is in particular balanced by the ethical rules that any lawyer needs to abide to. The Danish Bar and Law Society actively monitors the lawyers' compliance and an independent Disciplinary Board, which is headed by a Supreme Court judge, handles complaints and is ultimately able to expel lawyers from the Danish Bar and Law Society.

As explained in paragraph 1.1 above, in Denmark, a relative privilege extends beyond the absolute privilege regarding lawyer's advice pertaining to court proceedings. This relative privilege covers everything that pertains to lawyer's professional work.
In order for lawyers to competently advise his client, lawyers in practice often need to liaise with external advisors. In respect of patent related matters it is to be noted that as Danish lawyers have no higher technical training, it is necessary for most clients to be co-assisted by a patent attorney in order to make themselves heard in legal proceedings. Similarly, clients’ obtainment of advice in non-contentious patent related matters also often necessitates thorough co-operation between one or more lawyers and patent attorneys. For "client's privilege" to work, "client's privilege" should therefore extend to at least such external advisors that assist a lawyer in particular matters. Against this background, it is in the view of the Danish Group obvious that legal privilege, as discussed above, should extend to at least IP professionals, including in particular patent attorneys, that have been assisting a lawyer in the lawyer's work.

The Danish Group recognises that legal privilege should remain an exemption to the general rule that courts, in order to establish the true facts, should have access to all relevant information, and that the legal privilege pertaining to lawyers is balanced i.a. by strict ethical rules that are proactively enforced by the Danish Bar and Law Society. If privilege is to be extended to IP professionals that are not lawyers, such ethical rules and proactive enforcement need to follow. The Danish Group recognises in particular that clients in both contentious and non-contentious patent matters need access to obtain legal advice from patent attorneys. As such, the justification for providing lawyers with privilege also exists for patent attorneys, but probably not for other IP professionals who most often hold a full LL.M. and has therefore relatively free access to become lawyer. Against this background, the Danish Group would support that European Patent Attorneys are given access to join a body similar to The Danish Bar and Law Society and that EPAs and their assistants in turn are conferred with the same relative, but not absolute, privilege as Danish lawyers. In this respect it is noted that EPA’s are subject to the Codes of conduct and Rules of discipline of the EPI and that breach of any of these are sanctionable ultimately by the Disciplinary Board of Appeals of the EPO

The Danish Group further supports that the scope of legal privilege is broadened in the context of Danish civil search orders and Danish civil discovery orders so that it is explicitly stressed that correspondence between the client and the client’s lawyers is exempted from forcible disclosure.

(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?
In the view of the Danish Group, legal privilege should not be generally provided to all third parties that are assisting the clients, cf. (i) above.

(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?

In the view of the Danish Group, legal privilege should extend to the both internal and external assistants of professionals that are themselves covered by legal privilege.

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?

In the view of the Danish Group, Danish law on privilege should entail that the legal principles could by analogy be applied to foreign individuals.

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?

No.
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?

The general rules should be easy to apply. Absolute privilege should apply to any advice given in the context of court proceedings. The court should in other contexts but only in exceptional circumstances be competent to exempt from 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?

Yes, see above paragraphs 1 and 2.2.

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?

See above paragraphs 1 and 2.2.

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?

The Danish Group suggests that exemption should be possible if the privileged information is likely to be of decisive importance and that the importance of the case (b1) for the relevant party or (b2) for the society at large so justify.

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'?

The Danish Group does not agree. Only highly trained and educated IP advisors that are subject to strict and proactively enforced ethical rules should be covered, such as European Patent Attorneys.

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?

See paragraph 2.6.
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?

N/A

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

N/A

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?

None.

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?

No.

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?

_The Danish Group believes that the AIPPI proposal should to modified so as in particular (i) to distinguish between absolute "litigation privilege" and only relative "lawyer-client privilege", (ii) to encompass quasi IPR, such as trade secrets, under the defined term "intellectual property rights"; and (iii) to limit privilege to particular highly trained and educated IP advisors that are subject to strict and proactively enforced ethical rules._

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.

N/A
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.

N/A

2.20 With the introduction of protection against forcible disclosure of IP professional advice or any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

No.
Questionnaire Q199

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

January 19, 2010

National Group: The Egyptian National Group (AEPPI)

Contributors: Ahmed G. Abou Ali and Gamal A. Abou Ali

Representative within Working Committee: Ahmed G. Abou Ali

Date: May 23, 2010

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?


However, Article 79 of Attorneys Law No. 17 of 1983 ("Attorneys Law") states that: "the attorney must keep [confidential] information revealed to him by his client ...". 
Attorneys, therefore, may not disclose information revealed to them by their clients whether in court, in legal proceedings or otherwise.

Further, Article 66 of Evidence Law No. 25 of 1968 states that: "attorneys, agents, doctors or others may not reveal incidents or information obtained through their profession …". This provision applies only with respect to court testimony.

Failure to keep confidential information as such, unless obligated by law, may result in the application of Article 310 of the Penal Code No. 58 of 1937 ("Penal Code") which provides for a sanction of imprisonment of not more than six months or a fine of not more than five hundred Egyptian Pounds.

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?

Article 66 of Evidence Law (see 1.1) imposes the obligation of non-disclosure on any professional who receives confidential information because of his/her profession. It seems that this rule extends to apply to communications between clients and third parties (such as technical experts) if such third parties' advice is required. However, and as stated in 1.1, Article 66 only applies with respect to court testimony.

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?

The language of Article 66 of Evidence Law is general. It imposes the obligation of confidentiality with respect to information " ... obtained through their profession ..." regardless of the source of information. Therefore, such third parties (for example technical experts) are obligated to keep confidential information that is revealed to them for the purpose of providing their advice in any court testimony.

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?

There are no specific rules available for overseas IP professionals. The provisions discussed above are general and do not limit themselves to communications with local IP professionals. It seems, therefore, that the provisions on protection against forcible disclosure (1.1 and 1.2 above) apply to local as well as overseas IP professionals.
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 (e.g., 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, 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?

The protection available is that relating to disclosure by lawyers and patent and trademark attorneys (whether lawyers or non-lawyers). The obligation of non-disclosure applies to non-lawyers only with respect to court testimony whereas that of lawyers is absolute (subject to limited exceptions). The foregoing applies to both external advisers and in-house advisers.

(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?

Given that the third parties will not be lawyers/legal advisers, only Article 66 of Evidence law will apply. The obligation of non-disclosure applies to non-lawyers with respect to court testimony only. The foregoing applies to both external and in-house advisers.

(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?

See (ii) 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 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?

See (i) and (ii) above.

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?

Both Articles 79 of Attorneys Law and Article 66 of Evidence Law provide an exception to the rule of non-disclosure/confidentiality. If the client discloses information relating to committing a felony or a misdemeanour, the attorney or other IP professional may reveal this information but only to the competent judicial authority.

(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?

See (i) above.

(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?

See (i) above.

(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?

See (i) 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 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?

The provisions providing protection against disclosure are general and somewhat vague. They do not expressly list the professions with which clients are entitled to protection against forcible disclosure. For example, no express mention is made in neither the Patents Agents Law nor in the Evidence Law. Consequently, courts' approach to and application of the provisions discussed above may differ and clients will not have the desired predictability of confidentiality.

(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?

See (i) above.

(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?

See (i) above.

(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?

See (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?

Applicable laws do not distinguish between local and overseas communications with IP professionals/advisers. Comments provided in 1.7 above are intended to apply to both local and overseas communications.

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?

No. Any communication between the client and his/her attorney/IP professional should be strictly confidential, except if an express exception applies.

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?

Normally, most of the communications between the client and his/her attorney/IP professional is of a confidential nature and will relate to the IP rights of the client. The "dominant purpose" criteria or other similar approach is subject to abuse.

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?
No. The limitations on protection (exceptions to confidentiality obligation) should be expressly stated and narrowly interpreted. The courts should not have discretion regarding what information may be disclosed.

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?

It is essential that the relationship of the client with his/her attorney/IP professional be confidential. This will provide more confidence to reveal further information, and therefore better understanding, to the attorneys/IP professionals. In addition, granting the court the discretion to request the revelation of confidential information may be subject to misuse by the courts and/or other parties involved. The criteria should be strictly objective.

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?

Not applicable.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes. In most cases, the professions of the persons "qualified to give IP advice" will be regulated by law (such as attorneys and patent and trademark attorneys/agents). That qualification should be enough to trigger the protection against forcible disclosure.

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?

Not applicable.

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

(i) What category is that?

Except for attorneys and patent and trademark attorneys and agents, no other professionals who may provide IP advice are required to be qualified (such as technical experts).
(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. IP professional advice should be protected from forcible disclosure regardless of whether the communications are with a person from a qualified category or not.

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

Whether or not the person providing the IP professional advice is or must be qualified is a regulatory matter of law. However often advice may be sought by non-regulated advisors but that should not affect the confidentiality between the client and such non-regulated IP professional adviser.

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. The standard and scope of protection should be the same in both lawyer-client privilege and litigation privilege.

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?

There is no good reason behind the differences between lawyer-client privilege and litigation privilege. Information disclosed in non-litigation context will be usually used in litigation context.

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. Countries applying the standard referred to in paragraph 2.9 above should be at liberty to vary or abolish a presently applied limitation. However, the variation to be allowed is that aimed at narrowing/limiting the standard rather than increasing/broadening it.
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?

None.

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.

Countries should be allowed to maintain certain exceptions, if they so wish. The crime-fraud exception In particular, crime-fraud exception

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. Countries should be at liberty to vary or abolish a presently applied exception or waiver. However, the variation to be allowed is that aimed at narrowing/limiting the exception rather than increasing/broadening it.

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?

None.

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?

The Egyptian Group is in favour of the AIPPI proposal.

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.
The AIPPI proposal refers to "A communication to or from an intellectual property advisor..", where the IP Advisor may obtain confidential information from other sources and not necessarily from the client. Hence, it may be a good idea to expand the protection so that it covers also confidential information received by the IP Advisor through his practice of the profession, and which is not necessarily known to the public.

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.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Estonian National Group

Contributors: Mr. Raul KARTUS

Date: March 30, 2010

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?

§ 6. Guarantees to professional activities of patent agents *

…

(2) Information disclosed to a patent agent shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses with regard to information which became known to them in the provision of legal services nor shall explanations be requested from them with regard to such information.
Media received in the course of provision of legal services shall not be confiscated from patent agents or the employees of a company of patent agents, or from a company of patent agents. (Patent Agents Act, entered into force on 20 April 2001.)

Most of the Estonian patent/trade mark attorneys are non lawyer patent agents.

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?

Taking into account the above mentioned case, protection of clients against forcible disclosure of communications is missing in the Estonian Act.

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?

See paragraph 1.1.

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?

(a) Communications between local patent agents in Estonia and overseas IP professionals shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses and media received in the course of their services shall not be confiscated.

(b) Communications between clients and overseas IP professionals are not protected against forcible disclosure.

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?
The guarantees against forcible disclosure of communications apply to the registered Estonian patent attorneys and registered Estonian trade mark attorneys.

(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?

The guarantees against forcible disclosure of communications do not apply to the communications between IP professionals’ clients and third parties.

(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?

The guarantees against forcible disclosure of communications between IP professionals and third parties apply only to the registered Estonian patent attorneys and registered Estonian trade mark attorneys. Protection of third parties against forcible disclosure of the communications is not guaranteed by a specific point of law.

(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?

(a) Protection against forcible disclosure of communications between registered Estonian patent attorneys or registered Estonian trade mark attorneys and overseas IP professionals is guaranteed.

(b) Forcible disclosure of communications between local clients and overseas IP professionals is not guaranteed by a specific point of law.

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?

No limitations apply.

(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?

*Protection against forcible disclosure of communications is not guaranteed.*

(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?

*Dominant purpose test applies.*

(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?

(a) *Dominant purpose test applies.*

(b) *Protection against forcible disclosure of communications is not guaranteed.*

**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?

*Estonian patent attorneys have not had any forcible disclosure problems at the State level.*

(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?

*Extensive patent litigation experience for conclusions is missing.*

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?

*Extensive patent litigation experience for conclusions is missing.*

**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?
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?

No provision should be made to limit the documents to which protection applies.

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?

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?

Our group considers that the limitation in relation to judicial discretion of the documents to which protection applies would not be acceptable.

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?

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?

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?
Yes. Quality of advice should be improved.

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?

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

   (i) What category is that?

   (ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category? No.

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

      In the interests of quality and legal certainty of the Court decisions.

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?

      Limitations do not facilitate open and frank communications between IP adviser and client.

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?

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?

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?

_The “3-point exception” provision, which would be similar to Article 30 of TRIPS is too general. In order to achieve consensus it would be acceptable if there is no other solution._

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?

_Extensive patent litigation experience for conclusions is missing._

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?

_Alternative proposal may be taken as a basis of the discussions._

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.

_Our group supports alternative in Section 5 in general, but does not support nomination of the in-house IP advisers (incl. lawyers and EPA’s) equally with the private practice legal advisers to the category of IP advisers who should have a privilege._

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.

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?

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._
Summary
In Estonia, information disclosed to a patent agent (registered Estonian patent/trade mark attorney) shall be confidential. Patent agents and the employees of a company of patent agents shall not be heard as witnesses with regard to their professional advice and media received in the course of their legal services shall not be confiscated. Limitation in relation to judicial discretion of the documents to which protection applies would not be acceptable. IP advisers (local and overseas) to whom lawyer-client privilege and litigation privilege applies, should have approved qualification in the field of IP protection. An alternative proposal made under Section 5 of the Working Guidelines is favored in general, however nomination of the in-house IP advisers (incl. lawyers and EPA’s) equally with the privileged private practice IP advisers is not supported.
Questionnaire Q199

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

January 19, 2010

National Group: The Finnish Group of AIPPI

Contributors: Rainer Hilli, Marja-Leena Mansala, Tapio Äkräs

Date: June 23, 2010

1. Q.199 - Questionnaire

The answers and opinions of the Finnish Group of AIPPI are presented in italic after the questions.

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?

Provisions concerning the legal position and situation of IP professionals in Finland are found in two acts. The Act on Advocates (496/1958) regulates the Finnish Bar Association and its members and the Code of Judicial Procedure (4/1734) governs the representation of clients before the court, pertaining both to procedural questions and qualification of the representatives in question. Furthermore, also the Act on Patent Agents (552/1967) and the Decree on patent agents (636/1969) and the Decree amending said decree (52/1996) concern the registration of patent agents. However, said act and decrees do not contain any regulations as regards the privilege of communications between clients and IP professionals in matters concerning IP advice. The Finnish Bar Association is an organization pertaining to public law, which is regulated by the Act on Advocates. The organization was preceded by a
registered association with the same name. All members of both organizations are and always have been lawyers.

Anyone applying for membership in the Bar Association must have completed a Master of Laws degree (LL.M.), entitling him/her to hold a judicial office, and he/she must be known to be a person of integrity. Furthermore, he/she must have several years of experience in the legal profession and other judicial duties. He/she must also pass an examination covering the basic elements of the legal profession and professional ethics. An advocate must be independent and autonomous in relation to the government and all other parties except for his client.

Only members of the Bar Association are entitled to use the professional titles "asianajaja" or "advokat".

Section 5c of the Act on Advocates states that an advocate or his assistant shall not, without due permission, disclose the secrets of an individual or family; or business or professional secrets which have come to his knowledge in the course of his professional activity. Breach of this obligation of confidentiality shall be punishable in accordance with Chapter 38 Section 1 or 2 of the Criminal Code (39/1889), unless a more severe punishment is stipulated elsewhere in the law. Said section in the Act on Advocates was given on 21 April 1995 and came into force on 1 September 1995 as Section 5b and was afterwards changed to Section 5c in 1999; initially, however, the obligation of an advocate or an agent not to disclose his or her client's confidential information was incorporated and stipulated in the Criminal Code in the 19th century following Central European tradition.

Pursuant to Chapter 15 Section 2 of the Code of Judicial Procedure, only an advocate or a counsel who has a Master of Laws degree is entitled to serve as an attorney or counsel and represent person / companies before the court; the degree is not required if said attorney or counsel is a direct ascendant or descendant, a sibling or a spouse of the party. According to Section 17 in the same Chapter, a representant and his/hers assistant are under the same obligation to confidentiality as an advocate as described above and as stipulated under Section 5c of the Act on Advocates. This privilege of confidential communication by the client includes issues and documentation related to court proceedings during the course of which the patent attorney / agent can assist an advocate. Section 17 in the Chapter 15 was given on 21 April 1995 and it entered into force on 1 September 1995.

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?

There is no explicit protection concerning communication between clients and third parties under statutory law in the absence of an advocate or attorney at law. If the communication is mediated or transmitted through an advocate or attorney at law, the statement from a third party is protected under the laws and provisions as stated in 1.1.
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?

*See the answers to 1.1 and 1.2.*

**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?

*See the answer to 1.1.*

**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?

*As demonstrated in the answer to 1.1, the Finnish legislation concerning the privilege of the client’s confidential information is scarce and limited in its scope. Only advocates have their attorney-client privilege explicitly stipulated and regulated in a separate act. The other groups of IP specialists and their communication (i.e. patent agent/attorney, trademark agent/attorney, ...*
design agent/attorney) may be granted privilege in situations related to certain court proceedings where the privilege concerns issues relating to said proceedings.

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?

Under de lege lata, to our knowledge, there are no limitations or exceptions to the rules stated in our answer to 1.1.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

Based on knowledge and understanding on said matters, we have no material or empirical experience that the quality of protection provided by the Finnish legislation would not be sufficient.

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?

With reference to our answer to 1.4, we have no experience of such problems in practice.

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?

Finland is a civil law country and as such, like in other civil law countries, the most important question is that the privilege granted to the confidential information and documentation of the client is accepted and acknowledged internationally. Said privilege serves the purpose to reject any demand of discovery. According to the Finnish legislation, the Court may order in a matter, upon the request of any one party, that the other party in said proceeding shall submit and provide certain document(s) which otherwise would be kept secret for the pursuit of study by the other party.
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?

*We are not convinced that limiting the documents to which protection applies would be the right answer to the international acceptance of client privilege. This could lead to a variety of limitations that would not improve harmonization.*

**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?

*See the answer to 2.2.*

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?

See answer to 2.2.

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?

**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"?

*In our opinion, in its current form and scope the qualification in question is somewhat too extensive and overly wide and a more limited scope would be better aligned with the purpose of the qualification.*

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?

*With reference to our answer to 2.6, we suggest that the wording and definition of the qualification would be amended as follows: "the qualification of an IP expert should be based on an examination or registration that shows his/her experience in the IP field".*

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

(i) What category is that?

*Trademark attorneys*
(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

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

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?

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?

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?

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?

Out of said two options, in their current form, we favor the AIPPI proposal.

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.

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.

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?

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.
15 January 2010  
(extended 2 February 2010)  

Question Q199  
Privilege Task Force  

National Group: The French Group of AIPPI  

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**

**Preliminary remark:**

French group would like to emphasize the main conceptual differences between “professional secrecy” and “legal privilege”. Professional secrecy is not in France equivalent to the legal advice privilege benefiting the client. The French criminal code prohibits professionals who are under an obligation of professional secrecy, such as “Avocats” from revealing secrets entrusted to them because of their profession. Therefore this is not so much a privilege for the client as an obligation for the professional to keep secret all the information received from his client. The client is free to decide whether or not to disclose the advice provided by the professional, but he cannot order the professional to provide information to a court; So, professional secrecy is an obligation on the adviser, contrary to privilege which is a right of the client in a common law country to withhold details of confidential communications with a legal adviser without losing his case as a result.
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?

For IP professional advice prepared by in-house IP advisers: protection under rule 153 of the Munich Convention (European patent convention), no other specific protection beyond the corporation trade secret protection

For IP professional advice prepared by IP advisers (“Conseils en propriété industrielle”) working in private practice: similar protection as the protection recognised to lawyers admitted to a bar, since the Law of February 11, 2004.

For lawyers admitted to a bar ("avocats"): broad scope of professional secrecy, last law change in April 1997 to extend the protection “in all matters; whether contentious or non-contentious”

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

No specific protection

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?

The protection existing under professional secrecy extends to all documents relating to a given matter (see 2.9 of AIPPI Submission to WIPO dated 28/08/2009)

Consequently, such documentation

- Is protected if the IP professional is a lawyer admitted to a bar (avocat) or a “Conseil en propriété industrielle”,

- if the IP professional is an in-house IP adviser no specific protection beyond the corporation trade secret protection and the rights granted under the Munich convention

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?

The protection existing under professional secrecy extends to all documents relating to a given matter (see 2.9 of AIPPI Submission to WIPO dated 28/08/2009).

a) between local IP professionals and overseas IP professionals

a-1 Local professional is an "avocat"

(i) in Europe
   cf art 19-5-3 Réglement interieur
(ii) with non EU Member States
   cf art 3-4 RI

a-2 Local professional is a “Conseil en propriété industrielle"

same rules

b) between clients and overseas IP professionals

- can be protected if the local IP professional is an in-house IP adviser and the overseas IP professional can claim privilege and supervises said the local IP professional,
- is not protected if the local IP professional is an in-house IP adviser and the overseas IP professional can not claim privilege or similar protection. Practice indicates that even in the certain countries (US for example) some courts or authorities recognize protection and some don't.

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?
   Apply to "avocats", "conseils en propriété industrielle" iworking in private practice;
Does not apply to non lawyer patent attorney, non lawyer trade marks attorney For in-house qualified IP advisers see 1 4) b above.

NB. Non-lawyer patent or trademark attorney is unknown in France

(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?

See 1 3) and 1 4) b above

(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?

Apply to “avocats”, “conseils en propriété industrielle”. For IP attorneys working in private practice see 1 3) and 1 4) b above.

NB. Non-lawyer patent or trademark attorney is unknown in France

(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?

Apply to the different IP professionals under the conditions described in 1.4;

See 1 4) b above.

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?
Where protection exists, no limitation, no exception, no waiver except within the provisions against money laundering, and criminal offences made by the IP professionals themselves

(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?

See 1 3) and 1) b above

(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?

Where protection exists, no limitation, no exception, no waiver except as in (i) above

(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?

Where protection exists, no limitation, no exception, no waiver except as in (i) 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 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?

Our group considers that the protection is not appropriate because unclear.

(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?
Our group considers that the protection is not appropriate because unclear

(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?

Our group considers that the protection is not appropriate because unclear

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?

Our group considers that the protection is not appropriate because unclear

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?

Our group does not agree that countries may limit the documents to which protection applies.

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?
Our group considers that it is dangerous to establish a standard based on the relationship between documents and the IP legal advice because some documents in relation with the IP legal advice could be disclosed; it includes those which may contradict the IP advice.

**Judicial discretion to deny protection**

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

See 2.2

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?

**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'?

This open standard may lead some common law countries to oppose the international ‘device’.

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?

Our group considers that a specific reference to a qualification, such as admission to practise before his/her national patent/design/trademark office, may be desirable.

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?
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?

   Our group considers that the treaty should not allow countries to adopt or maintain a difference between lawyer-client privilege and litigation privilege.

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?

   Because most if not all of the work of IP adviser is at least indirectly related to litigation; any opinion is about the freedom to act and its limits and would covers very often different options or take different views on specific matters and when litigation arises, the client and the IP adviser have to work under the new circumstances without running the risk of being jeopardised by earlier advices.

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?

   There should be a liberty to lower or abolish the limitation.

Exceptions and waivers

2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

   Yes.

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?

2.14 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?

Our group does not understand the link of this question with the content of article 30 of the TRIPS.

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

NO

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

2.17 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?

Our group prefers the alternative of Section 5, as it enhances the likelihood to be adopted by the most sophisticated countries while solving the most detrimental issues existing in most of the civil law countries, including ours.

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.

N/A.

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.

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?

We do not expect any adverse effect on our national law, on the IP systems or on any IP practitioner already enjoying protection.

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.
1.1 Under Section 39a (2) of the German Patent Attorneys Act a German patent attorney has to keep all information he/she gets secret. Under Section 203 of the German Criminal Act breach of clients secrecy is a criminal offence. To guarantee the clients’ secrets a patent attorney has the right to refuse testimony under Section 53 of the German Code of Criminal Procedure and under Section 383 of the German Code of Civil Procedure. This applies to the employees of a patent attorney as well. We do not know when the privileges for patent attorneys were introduced in the German law but it has been introduced in 1968 at the latest.

However, in Germany sole European patent attorneys (if they are not German patent attorneys at the same time) are not qualified to give legal advice in infringement matters or licensing. They are allowed to draft and prosecute European patent applications and oppositions. As a result they do not enjoy privilege in Germany for the time being. There is only a very limited privilege in respect to the European Patent Office under Rule 153 EPC.

1.2 There is now protection against forcible disclosure of communications with third parties unless the third party acts as an assistant to a patent attorney or lawyer.

1.3 The communication between patent attorneys and third parties such as technical experts are privileged if the technical expert acts under the supervision of the patent attorney.

1.4 The communication between German patent attorneys and foreign attorneys is privileged as well if the foreign attorney acts in behalf of the client. That applies to communication between foreign attorneys and the clients as well. However, there must be a chain of communication between German attorney, foreign attorney (if any) and the foreign client to enjoy privilege.

1.5 The answers are included above.

1.6 Generally there are no limitations or exceptions. However, a German attorney must not act or argue contrary to his own knowledge. Otherwise the attorney might be considered as an accessory.

1.7 As far as communication between clients and their attorneys is concerned the protection is fully sufficient (i). It is the opinion of the German Chamber of Patent Attorneys that the protection of communications between clients and third parties (ii) should not be granted unless the third party acts as an assistant under the supervision of an attorney (iii). Otherwise the enforcement of IPRs could be impeded disproportionately. There must be a limit.

1.8 So far we have not yet faced any problems. As far as we know German courts have granted full privilege to foreign attorneys as well, as long as they had acted on behalf of the client.
2.1 to 2.5 Any principle or standard should guarantee full and frank communication between clients and their attorneys. Therefore there should be no limitation unless the advisor (attorney) contributes to a criminal act or a fraud himself. This limitation is German standard.

2.6 and 2.7 The privileged should be limited to those persons (IP advisers) which are qualified to give legal advice under their national law. Otherwise a client could probably claim privilege for any witness alleging he/she has given legal advice. Therefore any country had to define who is a qualified legal advisor.

2.8 In Germany exclusively patent attorneys and attorneys at law are qualified to give legal advice in IP matters. Sole European Patent Attorneys are allowed to represent clients and to give legal advice only in persecution before the EPO (see above 1.1).

2.9 to 2.15 see above 2.1 to 2.5

2.16 No

2.17 We would support the standard as under 5.1. It looks like this is very equivalent to German standard. However, the privilege shall apply only as far as the IP advisor gives advice within the legal area covered his/her qualification, e.g. trademark attorneys for trademark matters only, European patent attorneys in patent prosecution and opposition before the EPO only.

Detlef von Ahsen

May 2010
Questionnaire Q199

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

January 19, 2010

National Group: Greek Group

Contributors: Dr. Helen G. Papaconstantinou, Mr. Lymberis, Mr. Kilimiris

Date: 19 March 2010

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?

Greek jurisdiction recognises the Attorney at Law –client privilege. It is protected by statute (article 49 of the Lawyers Code of Conduct). Such privilege has been confirmed in various cases by respective Court decisions.

In the Greek jurisdiction there are no provisions establishing Patent Attorney agents. Only Attorneys at Law are authorised to act as patent agents. Consequently, there is full protection of clients against forcible disclosure of communications relating to IP professional advice.
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?

With regard to communications between clients and third parties, there is no protection against forcible disclosure of communications, even when the advice of the third party is required to enable legal advice related to IP to be obtained or given.

We consider that such a protection should apply also when the advice of the third party is required to enable legal advice related to IP to be obtained and given.

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?

There is no case law on this topic. In our opinion, it is of paramount importance that protection should also be extended in these instances.

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?

a) We believe that, if the foreign IP adviser is bound in his country by an obligation of confidentiality, which creates privilege, the foreign IP professional will enjoy privilege to the same extend as the local IP professionals.

b) We believe that the same applies with respect to clients and overseas IP professionals.

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?

With regard to the sub-paragraphs (I) to (IV), the client protection applies only if lawyers, lawyers/patent attorneys, lawyers/trademark attorneys are involved. The client protection is not applicable if non lawyers, patent attorneys and non lawyers/trademark attorneys are involved.

With regard to in-house advisers (lawyers), the employer of any in-house lawyer is considered to be the lawyers’ client. If the lawyer is acting as a legal adviser in participating in the communications, the client privilege protection applies.

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?
In relation to all of the above instances (I-IV), there is only one exception to the application of privilege by statute in Greece, namely the legislation against terrorism and organized crime.

With regard to waivers, as it is the clients’ right to privilege and not the lawyers’, the client has the right to waive the privilege and permit disclosure.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

Our group considers that the existing protection, as described in our answer to question 1.1., is satisfactory only when considering the Greek jurisdiction.

As only Attorneys at Law are authorised in Greece to deal with the matters raised in the questionnaire, thus the rules on privilege applies exclusively to them.

Our concerns, however, are that, under the existing regime, European Patent Attorneys in Greece who only have technical background are not allowed to file patent applications and to deal with contentious cases. As a result, they are also not covered by the above-mentioned privilege.

In view of the above, we do wish that the Client – Attorney Privilege to be extended to cover communications also with non legal advisers or professionals.

We would also welcome the extension of the protection so as to also cover the questions raised in the sub-paragraphs (II), (III), (IV) of paragraph 1.5.

The EPC 2000 adopted on December 13, 2007 contains an article and a related rule intending to provide European Patent Attorneys with a Client – Attorney Privilege “from
disclosure in proceedings before the EPO in respect of communications between a professional representative and his client or any other person”. The new EPC privilege, however, is covering only communications relating to handling and giving opinion in proceedings before the European Patent Office.

It would be beneficial if the law relating to Client – Attorney Privilege on an international level is harmonized by way of a treaty, which should cover European Patent Attorneys, both in private practice and in industry, in relation to their clients or any other person.

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?

Our Group considers that the protection described in our answer to question 1.4 above is of appropriate quality.

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?

Our Group agrees that it is reasonable to focus on the device of “The Dominant Purpose Test” to define the relationship of the documents protected with the IP advice, which is to be protected from disclosure and to limit the documents accordingly.

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?

We deem that the suggestions proposed in 2.1 above would provide the most applicable solutions.
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?

We are concerned that allowing such discretions based on findings “of reasonable grounds” might lead to misuse of the system.

In any case, the basis “reasonable grounds” is very vague

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?

Although we understand the necessity of allowing a certain degree of judicial discretion, our concern is that basing this on the existence of “reasonable grounds” it would be too difficult to define the same.

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?

We do not believe that different expression would lead to a different opinion, because we believe that such a limitation, which establishes judicial discretion on the basis of grounds which are not clearly defined, might open the “Aeolus’ Bag”.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

YES.

2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

N/A

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

(i) What category is that?

Legal qualifications are required for all kinds of IP advisers in Greece.

(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?

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

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?

We do deem it necessary to require, as a part of any remedy, that the two forms of privilege be distinguished accordingly to categories of privilege, which are currently part of our law.

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?

N/A

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?

We cannot think of any further limitations that could be applied to the liberty to vary or abolish a previously applied limitation.

Exceptions and waivers

2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

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?
We agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such exception or waiver should it wish to do so in the future.

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?

A certain limitation should apply to the liberty to vary or abolish a previously applied exception or waiver.

It is difficult to indicate what limitations could be added.

In any case, any variations should be within the scope of the standard or principle agreed.

In case of abolishment, it would be advisable that the country involved would give some kind of explanations as to the reasons of abolishment of the exceptions.

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?

Our Group prefers the AIPPI proposal. The AIPPI proposal aims to the establishment of a particular standard, which is drafted in such a way as to apply to all countries.

Under the WIPO proposal regime, the current uncertainty among countries as to the application of privilege to clients would continue to persist.

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.

Our Group does not have any further suggestions that those put forward by AIPPI.

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.

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.
Zusammenfassung

Frage 204


- Die griechische Gruppe ist der Ansicht, dass es vorteilhaft wäre, wenn ein internationaler Vertrag das Instrument des Beratungsprivilegs regeln würde, so dass dieses Privileg zwischen dem Berater und dem Mandanten eine internationale Harmonisierung erfährt.

RÉSUMÉ

QUESTION Q199

La juridiction grecque, qui a un système de droit civil, ne reconnaît pas la divulgation. La loi grecque reconnaît le privilège professionnel des communications entre avocats et clients. Comme seuls les avocats en droit sont autorisés à agir comme agents de brevets, il existe une protection complète des clients contre la divulgation forcée de communications concernant les conseils professionnels par rapport à la propriété intellectuelle. Nous croyons, quant même, que le système est insuffisant, car il ne concerne que les avocats en droit et pas les conseillers en général, et il ignore d‘autres questions, comme la question de la territorialité etc.

Le groupe grec croit qu‘il serait nécessaire qu‘un instrument international soit adopté par voie de traité, de sorte que le privilège professionnel entre conseillers et clients soit harmonisé au niveau international.

ABSTRACT

QUESTION Q199

- In the Greek jurisdiction, which has a civil law system, we do not have discovery. Greek jurisdiction recognizes the Attorney at Law client privilege. As only Attorneys at Law are authorized to act as patent agents, there is full protection of clients against forcible disclosure of communications relating to IP professional advice. We, nevertheless, believe that the system is insufficient, because it deals only with Attorneys at Law and not generally with “advisers” and ignores other questions, such as territoriality, etc.

- The Greek Group believes that it would be beneficial if an international instrument on privilege is adopted by way of a treaty, so that client’s-adviser privilege is harmonized on an international level.
Questionnaire Q199

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

May 17, 2010

National Group: Hungary

Contributors: Dr. József K. Tálas, Attorney at Law
Dr. Eszter Szakács, Attorney at Law

Date: 17 May 2010

1. **Q199 - 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.
Preliminary Remarks:

The questionnaire seems to require answers on mandatory disclosure or privilege from disclosure of IP advice from the point of view of the client who received it and also from the point of view of the IP adviser who provided it. However, in Hungary the law generally provides professional confidentiality rules only from the point of view of the IP adviser, therefore, we are able to provide answers only from the point of view of the attorney at law and patent attorney as IP professional, since the questions could not be interpreted with respect to the client.

In the Hungarian law there is no attorney-client privilege as such, except in the following two specific proceedings.

The Unfair Competition Act (Act No. LVII of 1996 on the Prohibition of Unfair Market Practices and of Restrictions of Competition, Art. 65/B) stipulates that in proceedings initiated by the competition authority there is a privilege for communications between the client and his/her attorney at law.

In the course of the investigation by the competition authority (Hungarian Competition Authority), the authority may have access to any document containing business secrets. However, the authority shall not have access to, seize, or use as evidence any document containing communication between the client and his/her attorney at law, as long as the qualification for attorney-client privilege is apparent from the document itself, unless the privilege is waived by the client. However, the officer of the competition authority may inspect such document that is claimed to be attorney-client privileged in order to determine whether it is indeed a privileged communication. If there is a dispute concerning the privileged nature of the documents, the documents shall be deposited in a container that is capable to prevent access to the document. As to whether a document should enjoy the aforementioned protection, the Metropolitan Court of Budapest is entitled to decide within 8 days upon the request of the Hungarian Competition Authority. Against this decision an appeal can be filed with the Court of Appeal of Budapest.

If the Court rules that the aforementioned protection does not apply to the document, it shall be released to the Hungarian Competition Authority; henceforward the general
provisions applicable to documents shall apply to the released document. If the Court's decision is in the client's favour, the document shall be released to the client.

In a decision of the Hungarian Supreme Court published under BH2009.364 on the applicability of the privilege, the narrow interpretation of the Hungarian Competition Authority was rejected and the documents seized by the Authority which all contained communications between the client (Hungarian Chamber of Pharmacists) and its attorney at law were ordered to be released to the client.

The other proceedings in which there is a privilege are those before the European Patent Office (EPO). According to the European Patent Convention 2000 (promulgated by Act No. CXXX of 2007) and pursuant to Rule 153 of its Implementing Regulations (promulgated by Government Decree No. 319/2007 (XII. 5.) Korm.) there is a privilege for all communications concerning the case between the professional representative and his client or any other person, which communications are permanently privileged from disclosure in proceedings before the EPO, unless such privilege is expressly waived by the client.

This privilege relates to all professional representatives before the EPO irrespective of their nationalities. At present there are about 100 Hungarian patent attorneys who are on the list of professional representatives.

In all other proceedings the client and the IP adviser can only refer to the provisions of the law on business secrets and professional confidentiality, respectively, as explained below.

The Hungarian Constitution establishes that private secrets and personal data are protected by the law [Act No. XX of 1949 on the Constitution of the Republic of Hungary, Art. 59(1)].

Furthermore, the Hungarian Civil Code (Act No. IV of 1959, Art. 81) stipulates that private secrets and business secrets are protected as personal rights. The Civil Code contains a definition of the business secret: all facts, information, solutions or data pertaining to economic activities that, if published, or released to or used by unauthorized persons, are likely to imperil the rightful financial, economic or market interests of the owner of such secret - other than the State of Hungary or local authorities within Hungary -, provided the owner has taken the necessary steps to keep them confidential.

The Act on Attorneys at Law (Act No. XI of 1998, Art. 8) stipulates that an attorney at law is bound by confidentiality with regard to every fact and data about which he gains knowledge in the course of carrying out his professional duties. This obligation is independent of the existence of the agency relation and continues to exist after he has ceased to function as an attorney at law in the given matter. Confidentiality
pertains to all documents prepared by an attorney at law and all other documents in his possession that contain any fact or data subject to confidentiality. An attorney at law may not disclose any document or fact pertaining to his client in the course of an official inquiry conducted at the attorney's office, but he may not obstruct the proceedings of the authority. A client, his legal successor or his legal representative may release an attorney at law from the obligation to maintain confidentiality. An attorney at law even if so released may not be questioned as a witness about any facts or data about which he gained knowledge as a defence counsel. Confidentiality shall apply mutatis mutandis to law firms and their employees as well as lawyers’ bodies and their officers and employees. This confidentiality stipulated in the Act on Attorneys at Law does not extend to in-house lawyers who are employees and only bound by the confidentiality terms of the employment relationship. It means that facts and data about which an in-house lawyer gains knowledge shall be deemed as business secrets defined in the aforementioned Hungarian Civil Code. The Act on Patent Attorneys [Act No. XXXII of 1995, Art. 15(1)-(3)] establishes that a patent attorney is bound by confidentiality with regard to every fact and data about which he gains knowledge in the course of carrying out his duties as a patent attorney. This obligation continues to exist after the termination of his engagement as a patent attorney. The aforesaid confidentiality pertains to all documents of bodies of patent attorneys that contain any fact or data subject to the confidentiality requirement of a patent attorney. The client or his legal successor may release a patent attorney from the obligation to maintain confidentiality. In Hungary discovery in civil proceedings in the sense it is known in Anglo-Saxon legal systems does not exist, and a party is generally not obliged to reveal an IP professional advice in and out of court proceedings. In civil court proceedings the client (or his/her employee) may be obliged to disclose IP advice in the course of witness testimony unless either of the cases determined by the Code of Civil Procedure allows him/her to refuse testimony.

According to the Hungarian Code of Civil Procedure [Act No. III of 1952, Articles 169 and 170] witness testimony may be refused in the following cases: if the witness is a relative of either party; if by the testimony the witness would accuse himself/herself or any of his/her relatives with a criminal offence; if the witness is an attorney at law, doctor or other person professionally bound by confidentiality, unless he/she has been released from the obligation to maintain confidentiality; if the witness was involved in previous mediation proceedings in the same matter; if a witness is bound by state, service or business secret confidentiality and would violate such confidentiality by providing testimony, unless he/she has been released.

In litigation for infringement of intellectual property rights the client as a party may be obliged to provide communications with his/her IP adviser if the judge – based on the motion of the adverse party – deems it necessary and justified to be obtained as evidence related to the subject court claim. It is also up to the judge to evaluate if the client as a litigating party denies submission of such document. However, up to now we are not aware of any case where a client was ordered to file a copy of any communication with his/her IP adviser.

As for the disclosure

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?

Attorneys at law, law firms, individual patent attorneys and firms of patent attorneys are obliged to keep confidential all information, facts, data about which they gain knowledge in the course of carrying out professional duties. In the case of law firms and attorneys at law, the confidentiality pertains to all documents prepared by an attorney and all other documents in his possession that contain any fact or data subject to confidentiality. An attorney at law may not disclose any document or fact pertaining to his client in the course of an official inquiry conducted at the attorney's office, but he may not obstruct the proceedings of the authority. In the case of patent attorneys and firms of patent attorneys confidentiality relates to any fact or data subject to the confidentiality requirement of a patent attorney.

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?

Communications directly between clients and third parties are protected by the provisions concerning the business secrets stipulated in the Hungarian Civil Code. However, if it is not about information that constitutes business secret, it is advisable to communicate through professionals who are legally obliged to secrecy (lawyers or patent attorneys).

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?

IP professionals bound by confidentiality may only disclose information to third parties (e.g. technical experts) to the extent they are allowed by their client. The information received from third parties for the case of the client belongs to the scope of the secrecy obligation of the IP professionals.

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?
There is no distinction under the Hungarian law between communications performed within Hungary or the European Union and those with IP professionals of other countries as far as protection of business secret and professional secrecy obligation are concerned.

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?

Only in relation to IP professionals who are attorneys at law or patent attorneys. As regards of secrecy of other persons (technical experts, employees of a company) only secrecy related to business secrets may apply.

(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?

Only the protection of business secrets can be referred to.

(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?

The protection pursuant to professional secrecy can be referred to only by those IP professionals who are attorneys at law or patent attorneys.

(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?

As in the relevant Hungarian law on secrecy there is no distinction between Hungarian and foreign subjects or entities, it can be assumed that a foreign IP professional, who is under obligation of professional confidentiality according to his/her personal law, would be regarded by a Hungarian court to be entitled to refuse testimony for reason of his/her obligation to keep professional confidentiality. Other foreign entities may refer to the protection of business secrets, only.

**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?

In line with the respective European Community provisions, cases of terrorism, money laundering and crimes threatening or endangering people’s life, integrity, freedom or security are always excepted.

In the course of criminal investigations the documents exchanged between the client and the attorney at law or patent attorney or a third person bound by business secret confidentiality shall not be seized but only as long as they are in possession of the mentioned persons. If the same documents are in the possession of the client they are no longer protected and may be seized. Furthermore, the mentioned limitation only applies to communication between the attorney-at-law and the Client and does not apply to instruments elaborated by the attorney-at-law (such as contracts, court submissions) which can be seized without any obstacle.

With respect to proceedings before the competition authority, we refer to the corresponding paragraph in the Preliminary Remarks.
(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?

Only business secret confidentiality may be referred to.

In the course of the investigation by the competition authority, the public prosecutor (attorney general) and the competition authority by permission of the public prosecutor, and experts shall have access at any time to the necessary documents for discharging their respective duties, including documents containing business secrets, bank secrets, payment secrets and insurance secrets, and securities and fund secrets specified in specific other legislation, and shall be able to make copies and notes thereof.

The client and other parties to the proceedings may request – referring to safeguarding of business secrets - that free access to the documents for inspection or for making copies or notes be limited. Simultaneously with rendering a decision concerning the request, the investigator or the competent Competition Council may order the client or other parties to the proceedings to supply the same documents with business secrets removed.

(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?

The reply is the same as under point (i).

(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?

The same limitations as under point (i).

**Quality of protection**

**Local communications**
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?

(v) 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?

Appropriate, since it is extended to patent attorneys as well.

(vi) 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?

Appropriate, since these communications may be protected by business secret protection.

(vii) 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?

Appropriate quality when the IP adviser is a lawyer because his communications with a third party will be completely protected in those cases related to the legal advice given to his clients.

Communications with overseas IP advisers

1.7 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?

Appropriate quality, since these communications may be protected by business secret protection.

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?

Providing protection for communications of attorneys at law and patent attorneys as well as communications containing business secrets, the Hungarian legal system currently ensures a higher level of protection that the dominant purpose test, which current level is to be maintained.

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?**

The Hungarian legal rules exactly specify when and what type of documents should be disclosed which ensures maximum protection from the side of the attorneys/patent attorneys and business secrets holders.

**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?

Yes, in civil law litigations and only concerning documents in the possession of the party (client). As for documents in possession of a lawyer/patent attorneys or a person bound by business secret confidentiality, judicial discretion should not be allowed, only exemption set by the law may apply.

2.4 **As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?**

The Hungarian legal rules exactly specify when and what type of documents should be disclosed which ensures maximum protection from the side of the attorneys/patent attorneys and business secrets holders.
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?

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Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes.

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?

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

In Hungary, there is no category of industrial property agent or IP adviser which does not require a qualification.

(i) What category is that?

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(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?

Not applicable.

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

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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?

Being a “civil law country”, the Hungarian legal rules provide protection for all communications of lawyers and patent attorneys related to a commission (case) they undertook from a client, including advice. We are of the opinion that such high level of protection should be ensured in other countries too in order to reach uniform level of protection of clients worldwide.
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?

Such uniform protection would provide a sufficiently transparent system for commercial
entities and clients being involved in IP matters on an international level.

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?

We agree provided it does not reduce its scope.

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?

That it does not reduce the content of the standard, further restricting prosecution.

**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 dor the “3-point- exception” as discussed in for
4.28 above also set limits in this case?

That it not be an indirect means of introducing further restrictions.

2.16  Since the introduction of the 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 details?
No.

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?

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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.

Not applicable.

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.

No new proposals by the Group.

2.20 With the introduction if protection against forcible disclosure of IP professional advice or any other remedy as discussed above into the 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?

We do not expect that the introduction of the measures discussed above would have any adverse effects on Hungarian law; rather, the contrary would be the case.

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Note:
It will be helpful and appreciated if Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.
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
Professional within your country?

**RESPONSE**

- As per Indian law, Section 126 of the Indian Evidence Act precludes barrister, attorney, pleader, or vakil (hereinafter referred to as “professionals”) from disclosing, without the express consent of their clients:
  - Any communication made to such professionals;
  - The contents or condition of any document to which they have become acquainted;
  - From disclosing any advices given by them to clients.

For the purpose of this Section, 'Pleaders', as defined in the Code of Civil Procedure, 1908 means any person entitled to appear and plead for another in Court and includes an advocate, a vakil and an attorney of a High Court. But the Advocates Act, 1961 does not included the terms 'barrister' and 'attorney' in its definition of 'legal practitioners'. According to the Advocates Act, 1961, "legal practitioner" means an advocate [or vakil] of any High Court, a pleader, mukhtar or revenue agent.

However, this Section does not protect from disclosure -

- Any communications made in furtherance of any illegal activity or purpose;
- Facts observed by such professionals in the course of their employment, showing any crime/fraud has taken place since the commencement of their employment.

- **Section 127** of The Evidence Act further extends the privilege granted under section 126 to interpreters, clerks or servants.
- **Section 128** further states that if a party calls an attorney to stand as witness, the disclosure must be within the scope of the questions asked. Further, this Section
- **Section 129** of the Evidence Act states that no one can be compelled to disclose to the Court confidential communications between him and his legal professional adviser unless such a person offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the Court necessary to be known in order to explain any evidence which he has given, but no others.
- The Bar Council of India Rules: Part VI, Chapter II, Section 2, Rule 17 states that an advocate shall not breach section 126 of the Indian Evidence Act of 1872.

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?

**RESPONSE**

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2
There are two types of privileges under common Law: Legal Advice privilege and Litigation privilege.

- The Legal Advice privilege covers all those communications made between client and attorneys whether or not it is for the purpose of litigation. However, this privilege does not cover communication between the lawyer and third parties made for the purpose of enabling the lawyer to advice the client. Similarly, it does not cover communications between the client and third party for the purpose of laying the document in front of the lawyer to seek his advice.

- The Litigation Privilege covers all those communications made after the decision to proceed to litigation has been made. This privilege may extend to even those documents prepared between a client and a third party and which are to be submitted to the lawyer for the purposes of litigation. Of course this privilege can be claimed only when the decision to commence litigation has been taken.

- As there is no particular provision in the Evidence Act, such as S. 126, to privilege communications between clients and third parties (such as technical experts), it is likely that Indian Courts will follow the above mentioned common law distinction. Therefore, no protection is available for such communications between clients and third parties (such as technical experts) if it comes under legal advice privilege. But it is likely to be protected if it comes under Litigation privilege.

- It is advisable for the client to sign a contract with IP professionals who are not lawyers containing a provision requiring non-disclosure of confidential information.

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?

**RESPONSE**

No protection is available for such communications between non-legal IP professional and third parties (such as technical experts) if it comes under legal advice privilege. But it is likely to be protected if it comes under Litigation privilege (See answer to 1.1 and 1.2 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?

**RESPONSE**

India does not seem to have any clear position when dealing with the scope of privileges in respect to transnationals communications of lawyers and clients. Normally, Indian Courts are
likely to hold only ‘professionals’ as falling under the S. 126 protection. Such ‘professionals’ are those enrolled with either the State Bar Councils or High Courts but foreign lawyers will not be covered by S. 126 because they will not be enrolled with any of the local bodies. This is, however, a very strict interpretation and it is more likely that Indian Courts will follow the common law position as laid down in the English case law of Re Duncan Decd [1968] P. 306 where the Court held that the privilege extended even to communications with foreign legal advisers.

With respect to communications between clients and overseas IP professionals, the disclosure of communications will be protected in accordance with the laws of the country of such IP professionals.

Scope of protection – qualifications of IP professional advisers

1.5 With regard 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 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?

(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?

(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?

(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 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?

RESPONSE

The protections above apply as follows to different classes of advisors:
• As per the Indian law, legal practitioners are protected by privilege. As of date only the Advocates Act, 1961, defines legal practitioners. It is therefore presumed that S. 126 will follow the definitions laid down in the Advocate’s Act, 1961, is in pari material with the Legal Practitioner’s Act, 1879, which was also a predecessor of the Advocate’s Act.

• In India, trademark attorneys/agents are required by to have a law degree which brings them under the definition of legal practitioners as per the Advocates Act, 1961. Hence, they can claim a common law right of privilege.

• Patent agents as such are not required by statute to have a law degree which does not allow them to claim a common law right of privilege.

• The same provisions will apply to external advisers in the above mentioned categories.

• Part VI, Chapter II, Section VII, Rule 49 of the Bar Council of India Rules states that an Advocate cannot be a full salaried employee. So, an In-House advocate, who may be a full salaried employee, will not be considered as an Advocate. However, in the case Municipal Corporation v. Vijay Metal Works AIR 1982 Bom 6, it was adjudged that a salaried employee who advises his employer on the legal matters would get the same protection as other barrister or attorney under Sections 126 and 129 of the Evidence Act, 1872 provided that the communication between them should not be made in furtherance of any illegal purpose. But the Akzo Nobel Chemicals Ltd & Ors v European Commission, judgment by the European Court of Justice refused to grant attorney-client privileges to in-house counsel. Therefore, it is likely that an in-house lawyer should be in his independent capacity if his advice to the client has to fall within the parameters of Privileged communication.

• However, in practice the employment contract of an in-house counsel usually contains a confidentiality clause protecting any information disclosed to such counsel during the course of his employment. Though this confidentiality clause is not similar in nature to a ‘privileged communication’, subject to certain contractual exceptions, a client will be entitled to claim damages from the in-house counsel in the event of breach of such a confidentiality clause.

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?
(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?

(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?

(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?

**RESPONSE**

The protections above are limited in the following respects:

(a) **Crime/fraud**- Any such communication made in furtherance of any illegal purpose is not protected.

(b) The privilege extends to only such communications made between a client and a legal adviser which are in the course and for the purpose of his **professional employment**.

(c) **Waiver**- The privilege is that of a client; he may expressly waive the privilege as and when he likes.

(d) **Capacity-as-such**: Only advice sought from a professional acting as an independent legal advisor is protected.

**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?

**RESPONSE**

The present protection is not satisfactory as it is not extended to non-legal IP professionals when the communication comes under legal advice privilege.
(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?

**RESPONSE**
No, the reason is that the Indian law does not provide protection to any communications between third parties and clients when the matter comes under Legal advice privilege.

(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?

**RESPONSE**
No, the reason is that the Indian law does not provide protection to any communications between non-legal IP professionals and third parties when the matter comes under Legal advice privilege.

(iv) As to 1.4 i.e. 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?

**RESPONSE**
No. An extension or clarification in this respect would be desirable to deal with the case where the foreign IP professional is not a lawyer. Lawyers generally experience international comity; however, other IP professionals do not.

**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?

**RESPONSE**
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).

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 a 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?

RESPONSE

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?

RESPONSE

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?

RESPONSE
Yes

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?

RESPONSE
Such uniform guidelines would avoid conflicts in the application of different standards. Furthermore, the purpose is to attain the ends of justice which is the primary goal.

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?

RESPONSE
The judicial discretion is not required at all if the disclosure is for any other purpose other than the crime/fraud exception (see answer 1.6).

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’?

RESPONSE
Yes.

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?

RESPONSE
Not applicable.

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?

RESPONSE
No answer required, since all categories of IP advisers require qualification.
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?

RESPONSE
Yes.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

RESPONSE
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?

RESPONSE
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?

RESPONSE
We believe that any Treaty should allow a country to vary or abolish a limitation. Such variation should be only to widen the privilege protection it affords and not narrow it down. This will help in enhancement of standards set rather than reduction of its contents, which will keep the good faith expectations of parties seeking advice intact.

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.

RESPONSE
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?

RESPONSE
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?

RESPONSE
we believe that any Treaty should allow a country to vary or abolish a limitation. Such variation should be only to widen the privilege protection it affords and not narrow it down. This will help in enhancement of standards set rather than reduction of its contents, which will keep the good faith expectations of parties seeking advice intact.

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?

RESPONSE
The protection in India is restricted to IP professionals who are lawyers and not to non-legal IP professionals. Therefore, the potential abuse of this protection in so far as attempting to withhold the production of documents or other evidence is very less. But the Courts are always there to force the inspection of the documents and in deciding whether they are subject to the protection.

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?

RESPONSE
We prefer the AIPPI proposal as the terms are clear and well defined.
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.

**RESPONSE**
Not Applicable

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.

**RESPONSE**
No new proposals

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?

**RESPONSE**
There will be no adverse effect instead the introduction of such protection would likely to have a positive effect as the clients will be willing to discuss their legal problems and seek legal advice with non-legal IP professionals.
Question Q199

National Group : AIPPI Indonesia
Title : Remedies to protect the right of client against forcible disclosure of their IP professional advice
Contributors : Cita Citrawinda Noerhadi & Bambang Priyono
Representative within Working Committee : Cita Citrawinda Noerhadi
Date : June 4, 2010

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?

The protection of clients against forcible disclosure of communications relating to IP professional advice as to such communications between clients and IP professionals is protected under article 19 paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate, and article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant.

Article 19 paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate stipulates:

(1) advocate shall not disclose any thing that is known or obtained from the client because the professional relationship, unless stipulated otherwise by the Act.

(2) lawyers are entitled to maintain confidentiality with clients, including the protection of files and documents against wiretapping on electronic advocate’s communications.
This protection introduced into our law and became effective on April 5, 2003.

and,

Article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant stipulates:

“(4) Consultant of Intellectual Property Rights are obliged:
   a. To obey the laws in the field of Intellectual Property Rights and other legal provisions;
   b. To protect the client's interests, by maintaining the confidentiality of information relating to the application of Intellectual Property Rights foreclosed to him; and
   c. To provide consulting services and socialization in the field of Intellectual Property Rights, including procedures for filing applications in the field of Intellectual Property Rights.”

This protection introduced into our law and became effective on January 4, 2005.

Further, protection of clients against forcible disclosure is also provided by Patent Law No.: 14/2001 in Art. 4, par (2):

Article 4

(2) An Invention shall also not be deemed to have been published, if, within a period of 12 (twelve) months before the Filing Date, it was announced by any other person by way of breaching an obligation to preserve the confidentiality of the relevant Invention.

Thus, the client is still protected and has the right to file a patent application in case there is leak of the genuine information pertaining the invention itself and the novelty requirement of this invention would still be fulfilled.

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?

Not Applicable, but it could be covered from agreements (contract) between clients and third parties (such as technical experts).

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?

The clients could be protected against forcible disclosure of communications relating to IP professional advice between IP Professionals and third parties (such as technical experts) through agreement (contract). And the contract itself is necessary for evidentiary purpose, in case there is a breach and lead to the leak of confidential information to public.
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?

(a) Local IP professionals are protected by Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant. Hence, there are no specific regulation concerning protection to IP professional advice between local IP professionals in our country and overseas IP professionals.

(b) There are no specific Indonesian Law and Provisions regarding to Protection of clients applies in our country against forcible disclosure of communications relating to IP professional advice. However, it could be covered through agreement (contract) which made by clients and overseas IP professionals.

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 (e.g. 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. 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?

The protection of clients against forcible disclosure of communications relating to IP professional advice is applied between clients and IP Consultants.

(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?

Should the third parties are not IP consultants, therefore, the protection of clients against forcible disclosure of communications relating to IP professional advice will take into effect based on agreement (contract).

(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?
The protection of clients against forcible disclosure of communications between IP professional and third party will take into effect based on agreement (contract).

(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 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?

The only protection for communications provided to local IP consultants, however, the protection for communications (a) between local IP professionals and overseas IP professionals, and (b) between the clients and overseas IP professionals, will take into effect based on agreement (contract).

Limitations and exceptions

1.6 What limitations (e.g. dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (e.g. 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?

The limitations and/or exceptions and/or waivers apply to the protection of clients against forcible disclosure of communications namely interest for the security and defence, health, or safety of the public Criminal and/or Civil Court Proceedings and also by judges’ discretion to do justice.

(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?

See (i) 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?

See (i) 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?

See (i) 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?

Yes, the protection of clients against forcible disclosure of communications relating to IP professional advice is appropriate according article 19 Paragraph 1, 2 of Law No. 18 Year of 2003 regarding Advocate and article 8 paragraph 4 of Government Regulation No. 2 Year of 2005 regarding Intellectual Property Right Consultant.

(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?

No it is not appropriate quality. There should have provisions that regulate third party to disclose clients’ information, and maintain the secrecy. The third party might be applied to Article 1365 of Indonesian Civil Code concerning Tort.

(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?

See (ii)

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?
No, it is not appropriate quality, because there are no applicable Law and Provisions in Indonesia regarding to Protection of clients against forcible disclosure of communications relating to IP professional advice where those communications are between clients and overseas IP professional

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations
Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes, we agree that new provision should be made in the agreed principle or standard that countries may limit the documents such as clinical test.

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 mandatory to have such a limitation.

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No, we do not agree that countries should be bounded in judicial discretion.

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?

No, it is mandatory.

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

N/A.
Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes, there’s should be standard requirements for IP adviser 'to be qualified to give the IP advice.

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?

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

(i) What category is that?

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

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

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Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes, we do agree the protection is provided in IP Law (such as: Trade Secret Law, Industrial Design Law, Layout Design of Integrated Circuit Law, Patent Law, Mark Law, Copyright Law) and also Advocate Law.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

The main idea from lawyer-client privilege and litigation privilege are similar whereas both privileges (lawyer-client privilege and litigation privilege) are to protect client’s information.

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?
We, do not agree.

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?

N/A.

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, we agree.

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, we agree.

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?

N/A.

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?

N/A.

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?

The Indonesian Group is in favour of the AIPPI Proposal.

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.

N/A.
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.
N/A.

2.20 With the introduction of protection against forcible disclosure of IP professional advice or any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

We expect the development on national law regarding the protection of clients.

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.
Question Q199  
Privilege Task Force  

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

by Michael Dowling, Steven Garland, Wouter Pors and Jochen Buehling  

1. The context of these Guidelines  

1.1 The National and Regional Groups (the Groups) are requested to consider the following Guidelines on the topic of 'privilege' and similar protection. The main issue is what remedy or remedies should apply to the problem of the lack and loss of protection against forcible disclosure of IP professional advice.  

1.2 These Guidelines describe issues relating to remedies which the Groups need to consider along with their own thoughts as to what remedies it may be appropriate to adopt. The description refers mainly to patents IP advisers but the outcome is intended to be used as to client rights with advisers on IP generally. To obtain the views of the Groups so that a Resolution can be proposed for adoption at the AIPPI Congress in Paris in October 2010, there is a Questionnaire in this paper. The Groups' answers and views are requested in accordance with the Questionnaire, please.  

2. Introduction to remedies – the problem to be overcome  

2.1 The problem underlying the need for 'Remedies' has two parts – first the lack of adequate protection of clients in some countries against being forced to disclose their IP professional advice and secondly, where such protection does apply, the loss of that protection when that advice is communicated between countries.  

2.2 Obviously enough, individual countries can legislate to provide adequate protection from forcible disclosure within their own borders. However, they cannot legislate to avoid the adverse effect of the loss of the protection which applies within their own borders when advice is communicated to other countries in which the protection is lost.
2.3 The threat of forced disclosure most often arises during litigation involving an IP right and typically in countries having some level of documentary or oral discovery.

**Loss of protection – an acute problem for IP**

2.4 There are particular effects subjective to IP which make the application of protection against forcible disclosure of advice in relation to IP matters, an acute problem. Those effects arise from the following.

(i) IP tends to be owned in a number of countries by the same owner or legally related owners.

(ii) IP owners and third parties who assess the ownership or validity of IP, need to obtain professional services and advice in relation to IP, from country to country.

(iii) The professionals consulted by IP owners and third parties who assess IP rights are broadly speaking in two categories – lawyers and non-lawyers. Persons from both categories may need to be consulted in many countries where IP rights are in issue. This relates in particular to external professionals.

(iv) For both IP owners and third parties who assess IP rights, there are frequently differences of substance between the advice so obtained in the one country and another, and the respective persons involved have to resolve those differences. To do that the advice obtained may need to be transmitted from one country to another.

(v) Protection from disclosure applies most frequently in relation to their communications with lawyers but less so in relation to non-lawyer advisers.

(vi) Lawyer and non-lawyer advisers frequently need to obtain advice from third parties (like independent technical experts). The communications between such advisers and such third parties are frequently not subject to protection from forcible disclosure in a particular country. Further if they are protected in one country, frequently they are not in another country which they may need to involve in the communications.

(vii) There are differences in the provision and application of protection from disclosure of communications relating to IP professional advice as to common law countries on the one hand and civil law countries on the other.

(viii) No country is immune from the potential that IP advice (including technical advice on which the legal advice may be based) which is protected from disclosure within its own borders, can be required to be disclosed in another country or countries. The reasons can be various but frequently the reasons include that the one country does not recognise the IP advisers in another country as having a relationship with the client which involves privilege.

(ix) A client in a common law country can be forced to disclose its IP professional advice obtained in a civil law country because the civil law country does not provide privilege from disclosure. The disclosure in the common law country is required even though in the civil law country, disclosure will not occur. It will not
occur in the civil law country if there is no discovery there and professional secrecy applies.

The rationale for having protection from forcible disclosure

2.5 The rationale is that both for the benefit of the administration and enforcement of the law on the one hand and providing correct advice to the persons who seek advice on the other, circumstances must be created in which there can be full and frank sharing of all relevant information between clients and their respective IP professional advisers.

2.6 For the right 'circumstances' for sharing of information to apply, there must be reasonable certainty that protection from forcible disclosure will apply to the relevant communications. A judicial comment supporting the need for certainty was made by Rehnquist J. in *Upjohn Co v United States*, 449 US 383 (1981).

> 'If the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.'

2.7 Such certainty may seem difficult to achieve because protection against forcible disclosure may not apply absolutely. In common law countries, there are established limitations and exceptions on the application of protection from disclosure, such as where an allegation of crime or fraud is involved. Further, in some common law countries there may be a discretion as to whether privilege should apply if it would prevent the court from doing justice between the parties. However, such a discretion would in its exercise in some common law countries, normally be limited to the established exceptions to the application of privilege. Thus, it is unreasonable to expect that a minimum standard or agreed principle of protection against forcible disclosure will be acceptable to as many countries as possible if it does not allow in a country which already provides privilege locally, for such limitations and reasonable exceptions as are already established there.

2.8 The difference between civil law and common law in relation to protection against forcible disclosure for the 'clients' of internal legal counsel also needs to be remedied. Such protection applies in common law but generally not in civil law countries. Both common law and most civil law systems would not apply protection from disclosure to communications between a lawyer and client of any category (be that an employer of the lawyer or not) unless the lawyer was independent of the client. But in most civil law countries, employment of a lawyer is generally regarded as in itself denying independence whereas common law does not. This difference adversely affects numerous multi-national and other companies which employ lawyers and whose businesses are conducted in both civil and common law countries, both as to the legal and related third party technical advices they obtain from or through internal (in-house employee) lawyers there.
3. Previous work of AIPPI – Q163

3.1 Special Committee Q163 was set up in about 2000 to investigate whether lawyer-client privilege applied to communications between patent and trade mark attorneys and their clients. As a result of the work of Q163, AIPPI passed a Resolution at the EXCO meeting in Lucerne in 2003 the centrepiece of which was as follows.

AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognise that the protections and obligations of the attorney client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.

3.2 Thus the crux of the AIPPI Resolution was that the clients of patent and trademark attorneys should be afforded the same protection as communications between lawyers and their clients.

4. Remedies

4.1 The nature of the remedy required to meet the needs of clients using the IP systems is easy enough to state. There needs to be the one "device" agreed and applied within and between countries to achieve reasonable certainty of the application of protection against forcible disclosure of communications between clients and their IP advisers in relation to IP professional advice.

4.2 It seems to be generally accepted that the "reasonable certainty" factor is critical if protection against forcible disclosure is to be effective. That acceptance occurs because absent "reasonable certainty" the persons between whom full and frank disclosures should be made to achieve the public interests of enforcement of the law and correct advice, are not relieved of their inhibition against making full disclosure, particularly as to facts that may be negative to their positions.

4.3 At one end of the scale, potentially the "device" could involve each country applying a particular standard which deals with national and overseas issues irrespective of what any other country does in relation to the required protection. This is a unilateral approach. That is the direction in which Australia is now going and which for New Zealand is now a fait accompli. This 'solution' achieves recognition locally of privilege that applies to communications between overseas IP advisers and clients but not recognition overseas of
the protection against disclosure that applies in New Zealand and will apply in Australia. For that some form of international agreement is required.

4.4 At the other end of the scale, the particular 'device' could be a treaty by which the signatories would agree to recognise each others’ protection against forcible disclosure in particular circumstances, whether it is actually 'privilege' as such or not.

4.5 In between the unilateral approach and a treaty, there could be a recommendation by WIPO of a standard or standards to be adopted by Member States. Further, there could be bilateral, multi or even pluri-lateral agreements on standards to be applied between the signatories to those agreements.

4.6 The main issue to be resolved in reaching a consensus on remedies is the standard or principle which will govern what is required to be achieved by national law and international agreements in order to remedy the problems both at the national and international levels. The AIPPI proposal to WIPO of July 2005 provides a convenient starting point. Whilst that proposal was suggested to WIPO as a working paper for study of a treaty, the proposal can as well serve the purpose of study of a potential WIPO recommendation or of any other instrument, such as an agreement between countries. The Groups are invited by the Questionnaire in this paper to comment on the application of the AIPPI 2005 proposal including in modified forms, or to propose potential alternative solutions.

**AIPPI proposal to WIPO of 2005 (the AIPPI 2005 proposal)**

4.7 The standard or principle which AIPPI proposed was as follows.

A communication to or from an intellectual property adviser which is made in relation to intellectual property advice, and any document or other record made in relation to intellectual property advice, shall be confidential to the person for whom the communication is made and shall be protected from disclosure to third parties, unless it has been disclosed with the authority of that person.

*'Intellectual property advice’* is information provided by an intellectual property adviser in relation to intellectual property rights.

*'Intellectual property adviser’* means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person qualified under the law of the country where the advice is given, to give that advice.

*‘Intellectual property rights’* includes any matters relating to such rights.
4.8 Three of the main issues considered in the AIPPI proposal, were as follows.

- The nature and meaning of the protection.
- The scope of the protection.
- The qualifications of 'IP advisers' in relation to whom the protection of the client from forcible disclosure would arise.

4.9 The AIPPI proposal avoided using the word 'privilege'. Instead the proposal refers to the elements of the remedy ie confidentiality of the communications related to the obtaining of IP advice and protection from disclosure of that advice to third parties. Communications to or from an IP adviser made in relation to IP advice, are in effect deemed to be confidential and not to be subject to disclosure to third parties.

**Scope of protection – the 'dominant purpose' limitation**

4.10 The scope of the protection so proposed is wider than would be accepted in many common law countries where privilege now applies. In such countries, for example, a communication between an IP adviser and the relevant client would be discoverable if it was material in the litigation (ie relates to a matter in issue) and relevant (ie affects the meaning of a material matter). However, if it was made for the 'dominant purpose' of obtaining or giving legal advice, it would not normally have to be produced to the court or the other party. The 'dominant purpose' test is narrower than the words used in the proposal ie "in relation to intellectual property advice". So an issue arises for the Groups whether the protection against disclosure of documents should be limited to those which answer the 'dominant purpose test'. On one view this does not make sense in relation to a country which does not now apply the dominant purpose test. For all countries the preferred approach may be to provide that they may limit the documents to which protection applies by the dominant purpose test or such other test as reasonably defines the relationship of the documents protected with the IP advice which is to be protected from disclosure.

**Qualifications**

4.11 The main issue here is caused by clients needing IP legal advice from lawyers and non-lawyer patent attorneys and patent agents, or non-lawyer trade marks attorneys and agents. Some countries have embraced the concept that such non-lawyer IP advisers have in their own field, similar learning, and duties and liabilities to their clients, as do the relevant lawyers. In the relationship between non-lawyer IP advisers and their clients, similar imbalances exist which are a principal factor in creating the relationship of trust that the client and the lawyer have between them. For example, the patent attorney knows the law within the scope of the patent attorney's training and can apply it to the client's situation. The client is relying on that. The imbalance on the client's side is that the client knows the facts. The patent attorney has to rely on the client to disclose all of the relevant facts known by the client to enable the patent attorney to give the best advice. It is similar for trade mark attorneys and agents and their clients, and other IP advisers and clients.
4.12 Lawyers may have duties to the law and duties to the court which the patent attorney does not have. Such duties are important in common law countries. But should they or their absence be vital to the existence of protection of the client from forcible disclosure? They do not apply, at least not in any relevant way, in most civil law countries. To be practical, should not the issue of protection from forcible disclosure be looked at from the point of view of the client? The client has to and does rely upon the advice which is obtained from a non-lawyer patent attorney in the country in which the client happens to be doing business. That patent attorney has to rely upon the client for instructions. It is this relationship that creates the needs for full and frank sharing of information on both sides, and the reliance there has to be of the one upon the other for what they contribute to the outcome required. The relationship demands the need for confidentiality because of the needs, dependencies, and trust which apply as between the persons involved.

4.13 The content and even the existence of non-lawyer IP adviser qualifications are matters for the particular country where the client and the IP adviser happen to be. What can the client do about the IP adviser's qualifications including whether or not that IP adviser has the same layers of obligations to the law and the courts as does a lawyer?

4.14 Accordingly, the AIPPI proposal defines the 'intellectual property adviser' to whom the proposed standard would apply as requiring no more than to be qualified locally to give the advice in relation to which the question of disclosure arises (see the definition in paragraph 4.7 above). Other descriptions are possible. For example, the Australian IP authority has proposed – 'permitted to engage in intellectual property practice before the Intellectual Property Office in Australia or another jurisdiction'. The Groups may consider that a more specific reference to a qualification of some kind should be required. In the Australian proposal, "permitted" could be substituted by the word "qualified" to achieve that effect. A further and more fundamental reason for requiring a qualification would be that for privilege to be justified, the elements of mutual reliance between client and adviser, trust and the expectation of confidentiality must apply in the relationship. Thus the Groups may consider that merely being 'permitted to engage in intellectual property practice etc' (without any formal qualification) would not have each of these elements and thus would not give rise to 'advice' worthy of protection from disclosure. As well, AIPPI may need to be practical here. What prospect can there reasonably be of persuading the lawyers of Member States to accept the clients of unqualified agents as needing or being deserving of privilege?

4.15 The definition of 'intellectual property adviser' avoids the need for anyone to determine whether an IP adviser in a particular country has qualifications equivalent to those of an IP adviser in another country. That is irrelevant to the client.

4.16 Nonetheless, there are many potential issues in defining 'intellectual property adviser' such as the following. What if there are no qualifications that apply to a person who gives intellectual property advice in a particular country? What if the IP advisers are in no way regulated? What if by the local law, the IP adviser has no duty of care to the client? An
advantage of a duty of care in this context would be that the IP adviser would be bound by
duty owed to the client to advise how the law will apply to the client's circumstances.

4.17 In a helpful critique of the AIPPI proposal, one commentator (Prof. John Cross of the
University of Louisville Law School) included points in favour of the proposal in his paper
delivered at the main INTA meeting in 2009 entitled '"Evidentiary Privileges in International
Intellectual Property Practice', along the following lines.

(i) By making the governing standard established by the law of the forum, the local
courts (and one might add, the parties) are relieved of having to ascertain the
particulars of other nations' laws in working out whether protection from disclosure
applies to overseas documents, locally.

(ii) The proposal provides predictability of the protection applying to clients and their
representatives. If the standard is widely adopted, the predictability of the
application of the standard would encourage full candour between clients and their
representatives.

(iii) The broad scope of the proposal which covers all communications in relation to IP
advice and third parties so consulted (including overseas representatives), is highly
attractive to IP clients and their representatives.

(iv) The protection of communications between IP professional advisers and their
counterparts elsewhere thus provided reflects the realities of international IP
practice involving in effect a team or teams of legal representatives in different
countries.

4.18 However, Prof. Cross also raised two problems with the AIPPI proposal. First, the
protection proposed is broader than that currently available in common law countries. In
those countries, the protection currently available is privilege, but such privilege is in two
forms which have different scope. One of those forms has various names like "attorney-
client privilege" or "legal advice privilege". In these Guidelines, that category of privilege is
called "lawyer-client privilege". The other form of privilege is reasonably universally known
as "litigation privilege". Prof. Cross anticipates resistance to the AIPPI proposal because it
does not preserve the differences and limitations of those two forms of privilege.

4.19 Secondly, Prof. Cross points out that the AIPPI proposal does not provide for any
exceptions. These Guidelines have in effect raised the need for the Groups to consider
and decide what provision should be made for existing law and practice which limit claims
for protection from disclosure – the crime-fraud exception (para 2.7), judicial discretion to
disallow claims for protection (para 2.7), and limitations on the scope of protection by
requiring a particular relationship of the documents which are protected (the 'dominant
purpose' test – para 4.10) with the IP advice sought to be protected. The foregoing does
not purport to define what exclusions and limitations exist now. The 'solution' will have to
take all existing limitations, exclusions and waivers into account.
4.20 The Groups are invited to consider and answer the questions in the Questionnaire on the topics of “Scope of protection” and “Exceptions” taking into account the further background on those subjects stated below.

**Scope of protection against forcible disclosure – are the differences between lawyer-client privilege and litigation privilege relevant?**

**Lawyer-client privilege**

4.21 Lawyer-client privilege applies to communications between a client and lawyer for the purposes of the latter advising the former. Subject to the client waiving the right to privilege, the term of privilege is forever, ie it applies following termination of the lawyer/client relationship and the death of the client. In most common law countries, lawyer-client privilege does not apply to communications between the lawyer and third parties (such as technical experts the lawyer may engage) even if such communications are required to enable the lawyer to advise the client. Australia and the United Kingdom are exceptions – privilege does apply to such communications subject of course to the ‘dominant purpose’ test.

**Litigation privilege**

4.22 Litigation privilege applies to communications between a client and lawyer for the purposes of the latter advising the former where litigation exists or is contemplated. It also applies to communications with third parties in relation to litigation where the lawyer needs information from a third party (for example, an independent technical expert) to enable the lawyer to advise the client.

4.23 In litigation, both forms of privilege (lawyer-client and litigation) can apply to particular communications.

4.24 These ‘privileges’ ie, against disclosure including to the court, the opponent in litigation or third parties, are subject in common law countries to the court denying protection from disclosure if the person seeking discovery can show the application of any of the matters described in para. 2.7 above. In civil law countries, this is not generally an issue because they do not have forcible disclosure or discovery. The word ‘generally’ in the previous sentence is deliberately cautious. In France for example, a Civil or Criminal judge may enjoin a party (or a third party) to disclose a specific document in any case including an IP case.

4.25 The Groups should consider, particularly those in civil law countries, whether there is for them any good purpose in requiring as a part of any remedy that the two forms of privilege be distinguished – is there any good reason for them to take on a standard of protection from forcible disclosure which requires the differences between lawyer-client privilege and litigation privilege to become part of their law? What would be achieved by that?
4.26 The Groups should weigh the following other factors in deciding what scope of protection should apply under the standard which is to be adopted.

(i) The AIPPI proposal qualifies as good law under the Rehnquist J requirement of 'certainty'.

(ii) The AIPPI proposal has the other virtues specified by Prof. Cross as stated in paragraph 4.17 above.

(iii) The historic reasons for having differences between lawyer-client privilege and litigation privilege as to third parties do not seem justifiable where the lawyer needs third party advice to enable correct advice to be given to the client.

(iv) No common law country has written the differences between lawyer-client privilege and litigation privilege out of its law as yet.

(v) For both civil and common law countries, there is no point in AIPPI putting forward any proposal for reform where the reform is too far ahead of existing law.

The Groups may conclude that the existence of differences between lawyer-client privilege and litigation privilege will be provided for in any event by modifying the AIPPI proposal to allow for limitations and exceptions (see below).

Limitations on and exceptions to protection from forcible disclosure

4.27 As previously indicated in these Guidelines, many common law countries apply limitations on, exceptions to, and waiver of privilege from disclosure of IP legal advice. The Groups need to consider how to import into the AIPPI proposal allowance for those countries which require to have them, of appropriate limitations and exceptions. Prof. Cross suggests that AIPPI should look to current IP treaties for guidance, for example, the '3-point' exceptions in TRIPS.

4.28 The '3-point' exception provision in Article 30 of TRIPS states as follows.

"Exceptions to Rights Conferred

Members may provide limited exceptions to the exclusive rights conferred by a patent provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties"

4.29 The following wording is not intended to be anything but an indication of how AIPPI's proposal can allow for limitations, exceptions and waiver if the Groups answer the Questionnaire positively on the principle of allowing for them. Generally speaking, the Questionnaire aims to obtain views on the acceptability of principles. Debate on the suitability of particular wording will come later. The exception provisions in the AIPPI proposal might, for example, state as follows.
Any country may except from such protection in relation to legal advice or proceedings, any communication, document or other record on the basis of a limitation on, or exception to, or waiver of the application of protection from forcible disclosure of IP legal advice (including any technical advice on which it is based) which applied in its law as at the signing of this instrument.

Any country which did not apply in its law any such limitation on, exception, or waiver referred to in the previous paragraph, may hereafter adopt and apply in its law at any time any of the limitations or exceptions, or waivers to which the previous paragraph applies.

However, the Groups may decide that a broader formulation which allows not only for existing limitations, exceptions and waivers to continue in force but as well for the possibility of including new ones in the future provided that they do not erode the fundamental undertaking to provide the protection from forcible disclosure except as may be required by the particular circumstances of a particular case. It is important to create protection which if it is applicable will be accepted by other countries as a protection they must themselves recognise and support. Such recognition and support cannot reasonably be expected to apply if in the particular circumstances of the case, non disclosure could effect a substantial harm to doing justice. The Groups may sense that in the great majority of cases, the benefit of the protection against disclosure required by the standard will be clearly greater than that of the disclosure of otherwise protected communications. That would be the case where the subjects of the particular documents in dispute could be proven from another source. That is often the case because the protection from disclosure is essentially confined to communications relating to IP professional advice, not the facts of the case.

4.30 Other limitations and exceptions for which provision may need to be made should be considered in due course on the basis of the answers given to the Questionnaire in this paper.

5. An alternative proposal focussing particularly on the issue of in-house counsel in civil law countries

5.1 These Guidelines have acknowledged this issue as a serious one (see para. 2.8). A proposal has been made to WIPO as stated in paras. 5.2 and 5.3 following.

(i) A WIPO Treaty should require each Contracting State to specify categories of adviser whose clients will have privilege before the State's Courts, intellectual property offices, tribunals, and investigators. These should be all such local general lawyers and local specialist IP advisers as the State considers to be
adequately regulated, plus (in the case of EPC members) locally-resident European Patent Attorneys (EPAs) (both in private practice and in-house).

(ii) Within each Contracting State, the following communications from or to the specified categories of adviser should be privileged (together with documents, material, and information preparatory to or otherwise related to such communications).

'Communications as to any matter relating to any invention, design, technical information, trade secret, trade mark, geographical indication, domain name, literary or artistic work, performance, software, plant variety, database, or semiconductor topography, or relating to passing off or unfair competition'.

(iii) Each Contracting State’s Courts, intellectual property offices, tribunals, and investigators should respect the privilege of communications as defined in (ii) (plus preparatory/related documents, material, and information) from or to advisers specified under (i) by other States (both private practice and in-house), and in any case from or to EPAs resident in EPC States (both private practice and in-house).

5.2 The proposal made to WIPO comments as follows.

**Special status is proposed for European Patent Attorneys (EPAs).** [The cross-references in the following wording are to the sub-paragraphs in the previous paragraph 5.1]. A high and increasing proportion of IP advisers in the EPC states are in practice EPAs as well as possibly having local national qualifications. Therefore, even if the governments of EPC member states are uneasy about the sufficiency of regulation of certain local IP advisers, and therefore do not want to specify them under (i), much of the existing problem will be solved by the specification of locally-resident EPAs under (i) together with the requirement relating to EPAs under (iii).

5.3 The proposed instrument would

(i)

(a) require each country to specify those legal advisers whose clients would benefit from the treaty

(it is expected for instance that USA would nominate, at least, all US attorneys; UK would nominate, at least, all UK solicitors, all UK barristers, all UK patent attorneys, all UK trade mark attorneys, and all UK-resident European Patent Attorneys; Japan would nominate, at least, all Japanese general lawyers and also all Japanese patent attorneys; and each EPC country other than UK would nominate, at least, all locally-resident European Patent Attorneys); and

(b) (so far as intellectual property disputes are concerned) require each country, to the extent it has a doctrine of discovery and privilege, to apply its existing doctrine of privilege equally to the clients of legal advisers
nominated by itself and to the clients of legal advisers nominated by any other country and in any case to European patent attorneys resident in EPC countries.

(The instrument would require all countries to treat equally under (a) or (b) all European Patent Attorneys, regardless of whether they work in-house or in private practice. Also if one country chooses not to discriminate under (a) between its locally-qualified in-house and private practice legal advisers, then that non-discrimination has to be respected by all other countries under (b), regardless of whether those countries choose to discriminate among their own locally-qualified legal advisers.)

(ii) The instrument summarised in the previous paragraph would have little or no effect on court actions in civil law countries where there is little or no discovery. However, it would have a major effect on court actions concerning intellectual property in common law countries, benefiting any party who has taken advice from a legal adviser nominated by a foreign country.

AIPPI commentary

5.4 The Groups will see that this proposal has particular features as follows. First, the proposal is in effect one which applies the doctrine of national treatment with additions. It does not (like the AIPPI proposal) require a particular standard to be applied by all countries. Thus the current imbalance within countries as to the application of privilege to clients of non-lawyer patent attorneys and as to communications with third parties to enable legal advice to be given, would continue. Therefore the risk of loss of protection when IP professional advice obtained in a particular country is transmitted internationally would continue.

5.5 Under this proposal, clients would still have the uncertainty of different standards applying country by country and the need to know what those different standards are in order to have the security needed to make full and frank disclosures to the IP professional advisers in any particular country.

5.6 The only non-lawyer patent attorneys for whom the instrument would require privilege are European Patent Attorneys. The Groups may consider that the clients of non-lawyer patent attorneys of a wider category should have privilege.

5.7 The proposal requires change in every country in relation to the requirements that privilege will apply equally to the clients of IP advisers nominated by any other country and in any case to European Patent Attorneys resident in EPC countries. The Groups may consider that if all countries are challenged by having to change their laws in this way, the opportunity should be taken to achieve a particular standard of protection from disclosure globally, and the benefits which that would achieve (see paras 5.4 and 5.5 above).
5.8 On the issue of in-house counsel, the AIPPI proposal includes in-house counsel. The definition of 'intellectual property adviser' is not limited to lawyers of any particular category. Of course, if the wording of the standard which is proposed allows for current limitations to be continued (as discussed in paras 4.27 to 4.31 above), the current European view that in-house lawyers are not independent, would continue to apply. That 'European' view referred to in the previous sentence does not necessarily reflect the law in particular European countries. In France, for example, when litigation is actual or contemplated, professional advice relating to that is protected against forcible disclosure under professional secrecy laws and that includes the client and those of its employees in charge of or involved in the litigation, including its in-house counsel. Such protection does not however have recognition overseas (where the local law for recognition of protection overseas requires reciprocity) as the equal of privilege.

5.9 The issue of in-house counsel is the subject of Q 206 and has not yet been studied by AIPPI. However, the problem of forcible disclosure which the current treatment of in-house counsel in most civil law countries (particularly in Europe) causes, is well known and seriously negative for the efficient operation of protection against forcible disclosure of IP professional advice. The Groups therefore may consider that if the AIPPI proposal makes provision for current limitations to be continued, it should specifically provide for the extension of the protection proposed as it relates to in-house counsel so that their 'clients' are treated in the same way as are those of external advisers. It could exclude any limitation on that extension which is to the effect that clients of in-house IP advisers do not have privilege from forcible disclosure of the advice of those advisers because they are employed by the client.

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?
Forcible disclosure of communications between clients and IP professionals is protected under the following Acts in Ireland:

1. The Trade Marks Act 1996 came into effect on July 1, 1996. Section 91(1) of the Act provides: This section applies to communications in respect of any matter relating to the protection of a trade mark or in respect of any matter involving passing off.

(2) Any communication to which this section applies—

(a) between a person and his registered agent, or

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

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his solicitor.

2. The Patents Act 1992 came into effect on August 1, 1992. Section 94 (1) of the Act provides: A communication to which this section applies shall be privileged from disclosure in any proceeding (including a proceeding before the Controller or competent authority under the European Patent Convention or the Treaty) to the same extent as a communication between client and solicitor is privileged in any proceeding before a court in the State.

(2) This section applies to a communication—

(a) between a person, or person acting on his behalf and a solicitor or patent agent, or person acting on his behalf, or

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

in relation to any matter concerning the protection of an invention, patent, design or technical information or any matter involving passing off.

3. The Industrial Designs Act 2001 came into effect on July 1, 2002. Section 87 of the Act provides: (1) This section applies to communications in respect of any matter relating to the protection of a design.

(2) Any communication to which this section applies—

(a) between a person and his or her registered agent, or

(b) for the purposes of obtaining or in response to a request for information which a person is seeking for the purpose of instructing his or her registered agent,

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his or her solicitor or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his or her solicitor.

(3) In subsection (2), “registered agent” means:
(a) a registered trade mark agent;
(b) a registered patent agent.

(4) Section 94(2) of the *Patents Act, 1992*, is hereby amended by the deletion of “design” and the said subsection shall be construed and have effect accordingly.

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?

The provisions in 1.1 cover where the client is seeking information in order to instruct his registered agent, otherwise there are no specific provisions, however the general law relating to privilege may apply in appropriate circumstances.

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?

The provisions in 1.1 cover where the IP professional is seeking information in order to allow the client to instruct his registered agent, otherwise there are no specific provisions, however the general law relating to privilege may apply in appropriate circumstances.

**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?

There is no specific legislation on this issue, however the same provisions identified at 1.1, 1.2 and 1.3 are likely to apply in Ireland. In relation to overseas, it is likely to be a matter of local law in each jurisdiction.

**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?

Lawyer: In so far as a lawyer is a solicitor, the normal rules of legal professional privilege apply and depending on the nature and circumstances of the communication they may in appropriate circumstances be protected against forcible disclosure of communications relating to IP professional advice given to clients. In addition, solicitors are specifically mentioned in the provisions relating to patents (see 1.1 above).

Lawyer/patent attorney, non-lawyer patent attorney, lawyer/trade mark attorney, non-lawyer trade mark attorney: communications between these individuals and their clients may be protected against forcible disclosure as set out in 1.1 above.

There is no distinction in Ireland law between external and in-house IP Professional advisers other than where there is a noting on the Register of Trade Marks and Patent Agents that specifically states that the agent may only represent their organisation.

(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?

See 1.5(i) above

(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?

See 1.5(i) above

(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?

See 1.5(i) above. In relation to communications with overseas IP Professionals, it is likely to be a matter of local law in each jurisdiction.
Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The same exceptions, limitations and waivers apply to these communications as under the general law relating to privilege, for example:

Limitations:

The dominant purpose test

If the communication is deemed to be legal assistance rather than legal advice it is not privileged.

Exceptions:

The crime/fraud exception

Privilege will not be permitted if it would injure the interests of justice where persons were guilty of moral turpitude or wrong-doing even where it does not amount to fraud.

Waiver:

A client can waive the privilege.

In relation to advice given to corporate clients, if the client shares the advice outside the corporation the privilege will be waived.

Privilege may also be lost if mistakes are made and privileged items are disclosed in error to the other side.

(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?

See 1.6(i) above.

(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?

See 1.6(i) above.
(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?

See 1.6(i) above. In relation to communications with overseas IP Professionals, it is likely to be a matter of local law in each jurisdiction.

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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.

(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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.

(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?

It is quite wide ranging as the same protection that applies to communications with Solicitors applies to communications with IP professionals.
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?

There are no specific provisions dealing with overseas communications and therefore clarification may be advisable.

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Privilege has never been a blanket protection. Similar limits apply with regard to the legal professional privilege in relation to communications with solicitors.

Judicial discretion to deny protection
2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

This would be very vague and subjective. Clients should be able to communicate with IP professionals without fear that this communication will be forcibly disclosed on some unclear and arbitrary basis.

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?

We do not foresee any wording which would address our concerns.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes.

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?

Not Applicable

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

(i) What category is that?

There is no specific recognised copyright qualification.

(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?

No

(iii) As to your answer to sub-para (ii), why?
As there is no specific recognised copyright qualification, any communication would likely fall under general legal principles.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes. There is no reason why countries should not be allowed to limit the scope of protection to the categories of privilege which are currently part of their law.

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?

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?

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?

It would be appropriate if limitations were varied in accordance with how the limitations under general legal principles develop.

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 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?

It would be appropriate if limitations were varied in accordance with how the limitations under general legal principles develop.

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?

Litigation is quite rare in Ireland and there have been no major cases that have dealt with this issue that we are aware of.

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?

The alternative proposal in Section 5 does not provide more protection than we already have in Ireland. The AIPPI proposal is preferable, however it would need to be modified to take account of Professor Cross’ recommendations set out above.

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.
There are two ways to deal with this, namely to introduce specific provisions for all IP professionals or to apply the same provisions as apply to legal professional privilege. As the same document or communication can contain IP advice and general legal advice, it would be difficult to operate two different systems of privilege so it would be more practical to implement similar provisions to the existing legal professional privilege system.

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.

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?

If the situation remains the same or the scope of privilege is broadened, it is unlikely that there will be any serious adverse effects. However if the scope is narrowed there are likely to be extremely prejudicial adverse effects.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Israel

Contributors: Tal Band

Date: May 20, 2010

Please note that in answering the questionnaire, no deliberations or discussions were held with the various members of the Israeli group. Therefore, the reply below reflects S. Horowitz & Co.'s opinion only.

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.
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?

According to the applicable Israeli law dealing with privilege, a distinction should be made between two main categories of "IP professionals". While attorney-client privilege is governed by statutory law, namely by the Evidence Ordinance [New Version], 5731-1971 ("the Evidence Ordinance"), and the Bar Association Law, 5721-1961, patent agent-client ("non-attorney") privilege is neither mentioned in the Ordinance nor in the Patents Law, 5727-1967 ("the Patents Law"), but has rather evolved through the court's case law. Pursuant to the Evidence Ordinance, communications between an attorney and his client are considered to be privileged (which privilege is absolute), provided that the client has not waive the privilege, as will be clarified in more details below.

As far as client - patent agent privilege concerns, according to a decision rendered by the Israeli District Court, communications between an Israeli patent agent and his client, on patent related issues, are privileged. This concept was raised for the first time in a decision rendered by the Tel-Aviv District Court in 1984 (C.F. 2284/83; M.F. 9187/83 Naan Metal Works v. Hydroplan Engineering, P.M. 1984 (b) 397 ("the Naan case")). It should be mentioned that such decision has not yet been affirmed by the Israeli Supreme Court. However, it has been cited, and supported, by the honourable J. Kedmi, a former Supreme Court Justice, in his leading treatise on evidence law in Israel.

In the Naan case, the Court held that, in certain circumstances, documents prepared by a patent agent in the course of the prosecution of a patent may be deemed privileged under the privilege rule applicable to documents prepared in anticipation of litigation ("the litigation privilege). However, the Court did not explain under what specific circumstances that rule would apply. Nonetheless, the Court held that, in the case at hand, in view of the numerous legal disputes which existed in connection with the relevant patents, it would be fair to state that the work performed by the patent agent relating to the registration of those patents, had been performed in anticipation of litigation.

It should be also noted that in the framework of the litigation privilege, the "dominant purpose” doctrine should apply. According to said rule the anticipation of litigation privilege would apply only if the dominant purpose for preparing the document was in preparation for litigation. Therefore it should be questioned whether such doctrine could be applied broadly so as to cover communications relating to the registration of patents as well. In view of the above, we are of the opinion that it would apply where the subject-matter of the communications concerns potential infringement, or even the validity of patents.

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?

Communications between clients and third parties (such as technical experts) could be regarded as privileged under the "anticipation of litigation privilege", provided such communication met the case criteria. The privilege on documents prepared in anticipation of a trial is not statutory but evolved by the Supreme Court.
According to the current Supreme Court case law “anticipation of litigation privilege”, would apply provided that dominant purpose for preparing the document was in preparation for litigation. If an anticipated trial was merely one of the reasons, or purposes, for preparing the document, it would not be considered 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?

As to correspondence exchanged between an attorney and such third party concerns the statutory privilege will apply. With respect to communication between patent agents and third parties, we believe that our answer to question 1.2 above will equally apply, provided that the dominant purpose doctrine is proven. This rule may apply to both attorneys and patent agents since, as stated above; the "anticipation of litigation privilege" was developed through case law and is not rooted in the particular attorney-client privilege as specified in Section 48 of the Evidence Ordinance.

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?

We believe that both types of communications (namely, between Israeli IP professionals and foreign IP professionals, as well as between Israeli clients and overseas IP professionals) may be regarded as privileged under the client–attorney privilege or “anticipation of litigation privilege”, as applicable. However, with respect to patent agent it should be noted that since to the best of our knowledge, such issues have not yet been dealt with by the Israeli courts, no clear-cut answer may be given.

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?

As mentioned in our answer to question 1.1. Above:
• Communications between an attorney and his client are deemed privileged pursuant to Section 48 of the Evidence Ordinance.

• Communications between a patent agent and his client are deemed privileged according to the decision rendered in the Naan case. However, this form of privilege will not be as strong as that accorded to attorney-client privilege, due to the privilege being relative (and not absolute) for elaboration see 1.6 (i) below. We are of the opinion that such rules will apply also to trademark agent, although we are not aware of any case law on this specific issue.

• According to Israeli case law, communications between in-house legal counsel and his client will be deemed privileged, in the same manner as attorney-client communications are deemed privileged.

• We are not aware of any reference in Israeli case law as to whether patent agent-client privilege would extend also to communications between in-house patent agents and other employees of the company. However, we believe that the Israeli courts should treat the privilege of communications of in-house patent agents in similar manner to that accorded to communications of in-house legal counsel.

(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?

As mentioned in our answer to 1.2 above, communications between clients and third parties (such as technical experts) might be regarded as privileged under the “anticipation of litigation privilege”. However, such documents will be considered privileged for so long as the dominant purpose doctrine is proven. There does not appear to be any difference if an attorney or a patent agent litigates the issue.

(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?

As mentioned in our answer to question 1.3 above, communications between IP professionals and third parties (such as technical experts) may be regarded as privileged under the “anticipation of litigation privilege”. Here, too, we believe that there does not appear to be any difference if the "IP professional" is an attorney or a patent agent.

(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?

Subject to the above mentioned differences between client – attorney privilege and client patent agent privilege, we are of the opinion that there is no reason for any distinction to be made between lawyer and patent agent, in the context of section 1.4.
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?

As mentioned above, there is no clear statutory law or decision regarding the limitations on, and exceptions to, patent agent-client privilege. Though, it could be expected that the privilege on communications between a client and a patent agent would be regarded as relative, rather than absolute, privilege. Accordingly, when dealing with a particular case, the court would have the discretion to decide whether there are any overwhelming reasons to justify denying the privilege, if disclosure is necessary in order to reveal an important fact in the trial, or in view of public policy reasons. In almost all patent litigation, such public policy reasons could take the form of the public interest to remove invalid patents from the register, in order to promote commercial competition, reduce prices, and foster the development of technology.

Thus, for example, if the disclosure of the communications is required in order to reveal an important fact concerning prior art, and such fact could not be revealed in any other reasonable way, the communications may not be privileged (if, of course, the patent agent’s privilege is considered relative, rather than absolute, as stated above). On the other hand, if the disclosure is sought merely in order to present the opinion of the patent agent on questions concerning the patent, or if it is intended merely as a “fishing expedition”, the communications may be protected. (Of course, this is only an example of the distinction to be made by a court.)

(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?

Our answer to 1.6 (i) above would equally apply to communication (documents) between clients and third parties.

(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?

Our answer to 1.6 (i) above would equally apply to communication (documents) between IP professionals and third parties.

(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?

See our answer to 1.6 (i) 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 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?

As mentioned above, patent agent-client privilege is not a statutory privilege; it is governed by a District Court decision (namely, that rendered in the Naan case) and, thus, does not constitute a binding precedent and may be overruled by Israel supreme court. As mentioned in the said decision, the rationale for privilege is to allow for circumstances that facilitate full and open disclosure of all relevant information between clients and their IP professional advisers. The lack of either statutory legislation or Supreme Court precedent, as well as the relativity of the patent agent-client privilege could create legal uncertainty.

(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?

We consider the protection to be of appropriate quality

(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?

We consider the protection to be of appropriate quality

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?
See our answer to question 1.7 above.

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes. We believe that patent agent-client privilege should be afforded the equivalent status of attorney-client privilege. Pursuant to the Evidence Ordinance, only communications relevant to the legal services/litigation will be deemed to be privileged. We are therefore of the view that communications between a patent agent and his client should similarly be deemed privileged, but only to the extent relevant to the IP legal advice. The "dominant purpose test" is an appropriate mean for this context.

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?

The rationale to recognize the privilege on communications between a client and his patent agent, based on the nature of the patent agent's profession under the Patents Law, is to enable circumstances that will facilitate full and open disclosure of all relevant information between the client and his patent agent. Accordingly, only matters relevant to the IP legal advice should be deemed privileged.

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?

As mentioned above, we believe that attorney-client privilege should equally apply to patent agent-client privilege and should be regarded as absolute, rather than, relative, privilege, so as not to allow the courts any judicial discretion (subject to the discretion mentioned in sec. 2.1 above). As mentioned above, the current status accorded to patent agent-client privilege is that the privilege...
is relative. Thus, when dealing with a particular case, the court has the discretion to decide whether there are any overwhelming reasons to justify denying the privilege, if disclosure is necessary in order to reveal an important fact in the trial, or in view of public policy reasons.

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?

See reasons above.

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?

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’?

No. We believe that this standard is too broad, and that the IP adviser should be “certified” (rather than ‘qualified’) to give the relevant IP advice. Further, according to Section 143 of the Patents Law, in order for a person to act as a patent attorney (of course, after passing the appropriate patent attorney examinations) he must obtain the relevant certification as required by the Ministry of Justice.

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?

In our view, the limitation would be acceptable if worded: "to be certified to give the IP advice …”.

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?

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes.
2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

*We are of the opinion that any country should have the liberty to broader the protection of the communication between a client and patent agent, but not to restrict the agreed standard.*

**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, as mentioned above, we believe that attorney-client privilege should be accorded the same status as patent agent-client privilege and be subject to the similar exceptions as applicable under law in respect of the former privilege. According to Israeli case law, when a client reveals to his attorney that he is about to commit a crime, such communication would not be regarded as privileged. It has further been determined in Israeli case laws that the client is deemed the owner of the privilege and, thus, is in a position to waive his rights in this regard.

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?

*See our response to sec 2.12 above.*

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?

*See our response to sec 2.12 above.*
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?

As mentioned above, the only case on point that expressly dealt with the subject of patent agent-client privilege is the Naan case.

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?

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.

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.

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?
Questionnaire Q199

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

January 19, 2010

National Group: AIPPI ITALY

Contributors: Renato Sgarbi, Carlo Maria Faggioni, Daniele De Angelis, Olga Capasso

Date: April 27, 2010

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?

Though Italian Civil Code and IP law do not provide any specific protection against forcible disclosure of communications relating to IP advice, between clients and professionals within our country, art. 206 of the Italian Industrial Property Code recites that the IP attorney is bound to professional secret and art. 200 of Penal Procedure Code applies. Such provision states that a “technical consultant” can not be forced to disclose what he/she knows pursuant his/her professional activity. Same provision applies also to Italian Lawyers.
Moreover, according to Italian legal system Parties are not obliged to provide information to the counterparty about advices or communications between them and professionals in Italy, unless required to do so by a judge in some particular cases.

Furthermore, where advice is sought from European patent professional representatives acting in their capacity, all communications between the professional representative and his client or other person relating to that purpose and bound not to disclose information accepted in confidence in the exercise of his duties, are permanently privileged from disclosure in proceedings before the European Patent Office (unless such privilege is expressly waived by the client (art. 134a(1)d EPC; r.153 epi institute by-laws).

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?

The same principles above apply also in respect of communications between clients and third parties (i.e. technical experts) or between professionals and third parties within Italy.

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?

The same principles above apply also in respect of communications between clients and third parties (i.e. technical experts) or between professionals and third parties.

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?

The same principles above apply

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?

all

(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?
yes
(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?

Possibly no
(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?

yes
(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?

Possibly no, in function of the Law appliable to the overseas IP professional

Above provisions apply for all of (i) to (iv) as to lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney.

Moreover Italian Forensic Code of Conduct, related to Lawyers, foresees that the duty of confidentiality is also a right (art. 9).

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?

Art. 200 CPP refers to exception where obligation exists.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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 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?

A similar provision of Art. 9 of the Italian Forensic Code of Conduct (as above cited) should be inserted in the Code of Conduct of Italian IP Attorneys

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?

A similar provision of Art. 9 of the Italian Forensic Code of Conduct (as above cited) should be inserted in the Code of Conduct of Italian IP Attorneys

However the Group is not aware of problems arisen in practice

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).
Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

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?

Yes

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?

In fact under the existing IP system, in Italy there is already a judicial discretion to deny protection from disclosure only in limited cases: the latter might be broadened.

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?

In the Italian IP code the judge has to decide upon an explicit request of the parties for ordering exhibition of documents; he does not have the power to deny protection of documents, but the power of obliging a party to disclose them.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

Yes

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

(i) What category is that?

Unqualified employees of industry

(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?

No

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

They should be considered as Party.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

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?

No

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?

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?

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?

AIPPI

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.

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.

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?

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.
Questionnaire Q199

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

January 19, 2010

National Group: Japan

Contributors: Yuzuru OKABE, Yoshikazu IWASE, Hiromi TANAKA, Tomohiko MAKINO, Shinichi MURATA, Kazuhiko YOSHIDA, Mami HINO

Date: March 31, 2010

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?

First of all, unlike in common law countries, there is no discovery in Japanese litigation proceeding; namely a party to litigation is never required to produce “all documents related to a certain subject matter.” A Japanese court may order document production under the Civil Procedure Code, article 223 (1) and the Patent Law, article 105, which also applies mutatis mutandis to trademark and design patent under the Trademark Law, article 39 and the Design Patent Law, article 41, and the Copyright Law, Article 114-3, only when the court finds necessity to examine the document upon a party’s motion, wherein the document to be produced and its holder are identified, and the fact to be proved by the document is described
Therefore, in reality, it is extremely unlikely that Japanese court would order a party to produce documents reflecting confidential communications between him and a Japanese lawyer or patent attorney in patent litigation because it is extremely unlikely, if not impossible, that one could convince Japanese court that the documents are necessary to find a fact relevant to the patent dispute. In Japan, intent of an accused infringer generally would not change the extent of patent infringement or the extent of damages except it may affect finding of indirect infringement (the Patent Law, article 101 (ii) and (v)).

In addition, the Civil Procedure Code of Japan, amended effective January 1, 1998, expressly confirmed the existence of a litigation privilege with respect to confidential communications between a lawyer or a patent attorney and their clients. Under the Japanese Civil Procedural Code, such communications are shielded from disclosure or production in Japanese court proceeding. Paragraph 1 item (2) of Article 197 provides that “[w]here a witness who is or was a ... lawyer, patent attorney ... is questioned with regard to [a] fact which he has obtained knowledge in the exercise of his professional duties and he should keep secret,” that witness has a testimonial privilege. Article 220 (4)(c) of the Japanese Civil Procedure Code specifically exempts from production in court proceedings documents reflecting the communications between a lawyer or a patent attorney and their clients described in paragraph 1 item (2) of Article 197. Also, Article 220 (4)(c) protects “the holder” of documents relating to confidential communications between a lawyer or patent attorney and their clients, and does not state that it is limited to the situation where the holder is the lawyer or patent attorney or the client.

Also, in addition to the privilege mentioned above, if the document at issue is found to be a document only for the client’s own use, the Civil Procedure Code of Japan, Article 220(4)(d) confirms that the existence of a litigation privilege with regard to the document.

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?

As our answer to question 1.1, documents reflecting communications between a client and a third party in connection with the third party’s advice would not be a subject of forcible disclosure unless the court finds necessity to examine the document upon a party’s motion (the Japanese Civil Procedural Code, article 221 (1), article 223 (1) and the Patent Law, article 105, which also applies mutatis mutandis to trademark and design patent under the Trademark Law, article 39 and the Design Patent Law, article 41, and the Copyright Law, Article 114-3 ). Therefore, in reality, it is extremely unlikely that Japanese court would order a party to produce such documents in patent litigation because it is extremely unlikely, if not impossible, that one could convince Japanese court that the documents reflecting communication between a client and a third party relating to the third party’s advice enabling legal advice related to IP are necessary to find a fact relevant to the patent dispute.
In case of forcible disclosure, it might be difficult that the client is shielded from production of such documents reflecting communication between him and the third party only because the communication is required to enable legal advice related to IP obtained from a Japanese lawyer or patent attorney.

If, however, the documents reflecting communications between clients and third parties contain technological or professional secret, such communications are shielded from disclosure or production in Japanese court proceeding under the Japanese Civil Procedural Code as well. Paragraph 1 item (3) of Article 197 provides that "[w]here a witness is questioned with regard to the matters on technological or professional secret," that witness has a testimonial privilege. Article 220 (4)(c) of the Japanese Civil Procedure Code specifically exempts from production in court proceedings documents reflecting the communications between clients and third parties relate to technological or professional secret described in paragraph 1 item (3) of Article 197. It is the same if the document at issue is found to be a document only for the client's own use (Civil Procedure Code of Japan, Article 220(4)(d)).

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?

As our answer to question 1.1, from the beginning, documents reflecting communications between a Japanese lawyer or patent attorney and a third party in connection with the third party's advice would not be a subject of forcible disclosure unless the court finds necessity to examine the document upon a party's motion (the Japanese Civil Procedural Code, article 221 (1), article 223 (1) and the Patent Law, article 105, which also applies mutatis mutandis to trademark and design patent under the Trademark Law, article 39 and the Design Patent Law, article 41, and the Copyright Law, Article 114-3 ). Therefore, in reality, it is extremely unlikely that Japanese court would order a party to produce such documents in patent litigation because it is extremely unlikely, if not impossible, that one could convince Japanese court that the documents reflecting communication between a Japanese lawyer or patent attorney and a third party in connection with the third party's advice enabling legal advice related to IP are necessary to find a fact relevant to the patent dispute.

In addition, since communications between a Japanese lawyer or patent attorney and a third party correspond to "[a] fact which he has obtained knowledge in the exercise of his professional duties and he should keep secret" provided in Paragraph 1 item (2) of Article 197, an holder of documents reflecting such communications is shielded from disclosure or production in a Japanese court proceeding under the Japanese Civil Procedure Code, Article 220 (4)(c), as answered to Question 1.1

**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?

As our answer to question 1.1, from the beginning, documents reflecting either of (a) or (b) communications would not be a subject of forcible disclosure unless the court finds necessity to examine the document upon a party's motion (the Japanese Civil Procedural Code, article 221 (1), article 223 (1) and the Patent Law, article 105, which also applies mutatis mutandis to trademark and design patent under the Trademark Law, article 39 and the Design Patent Law, article 41, and the Copyright Law, Article 114-3; and in reality, it is extremely unlikely that Japanese court would order a party to produce such documents in patent litigation because it is extremely unlikely, if not impossible, that one could convince Japanese court that the documents are necessary to find a fact relevant to the patent dispute.

In addition, since communications (a) between a Japanese lawyer or patent attorney and an overseas IP professional correspond to “[a] fact which he has obtained knowledge in the exercise of his professional duties and he should keep secret” provided in Paragraph 1 item (2) of Article 197, a holder of documents reflecting such communications is shielded from disclosure or production in a Japanese court proceeding under the Japanese Civil Procedure Code, Article 220 (4)(c), as answered to Question 1.1

However, with regard to (b), since overseas IP professionals are not listed in paragraph 1 item (2) of article 197, it is not clear whether or not this provision applies to the communication between clients and overseas IP professionals. If the documents reflecting communications between clients and overseas IP professionals contain technological or professional secret, such communications are shielded from disclosure or production in Japanese court proceeding under the Japanese Civil Procedural Code as well. Paragraph 1 item (3) of Article 197 provides that “[w]here a witness is questioned with regard to the matters on technological or professional secret,” that witness has a testimonial privilege. Article 220 (4)(c) of the Japanese Civil Procedure Code specifically exempts from production in court proceedings documents reflecting the communications between clients and third parties relate to technological or professional secret described in paragraph 1 item (3) of Article 197. It is the same if the document at issue is found to be a document only for the client's own use (Civil Procedure Code of Japan, Article 220(4)(d)).

At any rate, this would not be a problem since it is extremely unlikely that Japanese courts would order production of documents reflecting confidential communications between a client and an overseas IP professional as stated earlier.

**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?

Our answers to questions 1.1 through 1.4 apply to registered Japanese lawyers and Japanese patent attorneys. In Japan, lawyers and patent attorneys may handle both patents and trademarks, and there is no such category as trademark attorneys.
(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?

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?

Japanese Civil Procedure Code, Paragraph 2 of Article 197 provides “Paragraph 1 does not apply in case the witness is exempted from his obligation to keep secret.” Therefore, an holder of documents reflecting communication between a client and a lawyer or patent attorney is no longer shielded from forcible disclosure under the Article 220 (4)(c), after the Japanese lawyer or patent attorney is exempted from his obligation to keep the communication between him and his client.

(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?

Same as the answer to (i).
(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?

Same as the answer to (i).

(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?

With regard to (a), the answer is the same as the answer to (i).

With regard to (b), if there is such protection, the answer is the same as the answer to (i).

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?

Our Group considers that the protection described in answer to questions does not have a problem in Japanese court proceeding. As explained, courts’ production order is limited to a case wherein examination of the document is necessary; and the documents described in questions would not be a subject of courts’ production order in patent litigations.

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

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?
Our Group considers that the protection described in answer to questions does not have a problem in Japanese court proceeding. As explained, courts’ production order is limited to a case wherein examination of the document is necessary; and the documents described in questions would not be a subject of courts’ production order in patent litigations.

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes, we do.

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?

Although the protection in Japanese court proceeding is of appropriate quality, there is always a risk that such appropriately protected documents may be required to be disclosed in another country or countries. It is also a problem that such risk is not predictable.

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?

Regardless of whether it is explicitly provided or not, we do not object such exception.

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?
As far as it is reasonable, we understand that there are occasions where courts have to give preference to something else over such protection.

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

N/A

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

We believe that the standard required by the principle agreed should require the IP adviser not only to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given and also to have a duty of confidentiality to clients subject to penalty prescribed by a professional moral code.

2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

N/A

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

(i) What category is that?

An employee member of a legal division or an intellectual property division of a client company may give IP advice to other employee of the client company.

(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?

We do not think that additional protection for such advice is necessary.

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

In Japanese IP litigations, it is very unlikely that a court orders the document reflecting IP professional advice is to be disclosed; and in addition, if the document reflecting such advice is found to be a document only for the client’s own use, the Civil Procedure Code of Japan, Article 220(4)(d) confirms the existence of a litigation privilege with regard to the document.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege
2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes, we do.

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?

N/A

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?

N/A

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?

N/A

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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

Yes, we do.

2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPI, 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, we do.

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?

Our Group agrees to the “3-point-exception.”
Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No, we have not experienced any.

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

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?

Our Group prefers AIPPI proposal since it would reduce the uncertainty or unpredictability as to how documents reflecting communications relating to IP advisors are protected in other jurisdictions.

Proposals from your Group

Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

N/A

The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

N/A

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?

No we do not.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Lithuanian group

Contributors: Reda Zaboliene
Kristina Vilkiene

Date: 21/05/2010

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? No protection provided under national law regarding the disclosure of communications between clients and IP professional (exception is applied only for attorneys at law who also might have the qualification as patent attorneys).

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given? No protection provided under national law.
1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given? No protection provided under national law (protection of communication is foreseen only for attorneys at law thus the protection might be applied for those patent attorneys who also have the qualification as attorney at law).

Overseas communications

1.4 What protection of clients applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals? No protection provided under national 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? There is only protection of communication between attorney at law and attorney at law/patent attorney and the client provided under national law.

(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? No regulation under national law.

(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? Protection of communication is provided only for attorneys at law and thus for attorneys at law/patent attorneys.

(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? Protection of communication is provided only for attorneys at law and thus for attorneys at law/patent attorneys.
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? As concerns the attorneys at law (attorneys at law/patent attorneys) it is prohibited to examine, inspect or take the attorneys at law practice documents or files containing information related to his professional activities, examine postal items, wiretap telephone conversations, control any other information transmitted over telecommunications networks and other communications or actions, except for the cases when the attorney at law is suspected or accused of a criminal act. Such permission should cover only the documents related to the allegations or charges made against the attorney at law.

(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? As concerns attorneys at law/patent attorneys the same protection and exceptions should be applied as indicated in 1.6 (i).

(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? As concerns attorneys at law/patent attorneys the same protection and exceptions should be applied as indicated in 1.6 (i).

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? Such a protection should be provided by the national law.
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?

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed? Yes.

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

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? Yes.
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?

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?

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"? No alternative proposals.

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?

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

(i) What category is that? Not applied in our country.

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law? Yes.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation? Yes.

2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it? No proposals from the Group.

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? No proposals from the Group.

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details? No experience with any adverse effects.

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? No proposals from the Group.

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. No alternative proposals from the Group.

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. No additional comments.

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? No adverse effects expected.

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.
Questionnaire Q199

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

January 19, 2010

National Group: Malaysia Group

Contributors: Chew Phye Keat

Date: 20th May 2010

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

Note: Please see attached paper – Malaysian Position on IP Adviser – Client Privilege which summarises the current legal position and answers to the questions below.

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?

There is client privilege between clients and IP professionals who are lawyers. This protection arose as part of the inception of the legal profession in Malaysia. Please see attached paper on actual wording of privilege.
1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

No privilege is granted in this situation.

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?

Privilege is granted for this situation as part of the client-lawyer privilege.

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?

There will be privilege in (a) and (b) provided the IP professionals (local and overseas) are lawyers.

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?

The privilege would apply to external and in-house legal advisors but not non-lawyer IP Professionals.

(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?

No privilege in this situation

(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?

The privilege would apply to external and in-house legal advisors but not non-lawyer IP Professionals.

(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?

The privilege would apply in (a) and (b) to external and in-house legal advisors but not non-lawyer IP Professionals.

Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The communication must not be for an illegal purpose.

(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?

No privilege in this situation.

(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?

Same as (i) above

(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?

Same as (i) 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 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

**Answer to all the above:** the quality is sufficient but should also be granted to IP Professionals who are not lawyers but who have been registered with the appropriate IP Office of the relevant country (whether local or overseas).

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:** the quality is sufficient but should also be granted to IP Professionals who are not lawyers but who have been registered with the appropriate IP Office of the relevant country (whether local or 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?
To achieve consistency and uniformity within the jurisdiction of Malaysia – the extent and quality of privilege should be the same as that granted to lawyers generally.

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?

Same answer as in 2.1 above

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?

For lawyers' privilege, there is no judicial discretion and this principle should be retained for IP Professionals for consistency within the jurisdiction

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 as in 2.3 above.

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?

Not applicable.

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'?

Do not 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?

Privilege should only be granted to IP Professionals who are registered with the IP Office as such - please see attached paper for more clarification.

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?

Answered in 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?

Yes

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

No

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?

Not applicable

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 exceptions (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?

No

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?

Not applicable

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?
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 would prefer the alternative in Section 5 as it leaves the individual jurisdictions’ standard and extent of privilege intact (with some additions) while extending it to IP Professionals including who are non-lawyers. To push for a uniform international standard may require more extensive local legislative changes impacting the lawyers’ general privilege as you can’t have 2 standards - one for lawyers generally and one for IP Professionals. This will be a much harder exercise and perhaps practically unattainable.

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

none.

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.
1. Status of IP Advisers in Malaysia

- Following IP advisers are recognized by legislation:
  - Registered Patent Agent    Patents Act 1983
  - Registered Trade Mark Agent   Trade Marks Act 1976
  - Registered Industrial Design Agent   Industrial Designs Act 1996
  - Registered Geographical Indications (GI) Agent Geographical Indications Act 2000

- The above legislation provide that such registered IP Agents have the “exclusive” right to file for the Intellectual Property Rights (IPR) in the respective fields of IP on behalf of clients.

- The exclusivity granted to such IP agents pertains to prosecution of IPR to obtain registrations – other areas of IP practice such as rendering of advice and administrative enforcement are not the exclusive domain of registered IP Agents.

- Also, such registered IP Agents do not ipso facto have locus standi to litigate IP cases in the civil courts. Only practising lawyers have such standing in Malaysia.

- One can become a registered IP Agent by meeting the minimum qualifications and where necessary undergoing the relevant examinations set by the Malaysian IP office. Many lawyers who practice IP law are also registered IP Agents.

- There is also a category of IP Advisers who are not practising lawyers and also not registered IP Agents. This is because the practice of some IP matters such as rendering advice on IP issues or the administrative (ie non-court) enforcement of IP rights are not by law prescribed to be the exclusive domain of practicing lawyers or registered IP Agents.

2. Privilege Position of IP Advisers

- In Malaysia, the law on privilege is generally a subject matter of legislation supplemented with common law principles where applicable. Generally the law of privilege in Malaysia only covers communication between a lawyer and his client.

- The above legislation which establish the registration of IP Agents do not provide privilege for registered IP Agents.

- The Malaysian law on privilege currently does not protect communication between registered IP Agents (who are not lawyers) with their clients.

- Similarly IP Advisers who are not registered IP Agents and who are not lawyers also do not enjoy privilege.
However, lawyers are under relevant legislation and common law entitled to lawyer client privilege in respect of communication between the lawyer and his client. This privilege would also apply to all IP legal matters acted upon by the lawyer for his client, whether or not the lawyer is also a registered IP Agent.

Summary of Privilege Position

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<thead>
<tr>
<th>IP ADVISERS</th>
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<th>Lawyers</th>
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<tr>
<td>Registered IP Agent</td>
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<tr>
<td>Non-Registered IP Agent</td>
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<td>(No Privilege)</td>
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3. **Scope of Privilege**

- As stated earlier, only IP Advisers who are practicing lawyers enjoy privilege due to the law governing lawyer-client privilege.

- The privilege is principally established by Section 126 of Evidence Act, 1950 which states as follows:

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

  Provided that nothing in this section shall protect from disclosure –

  (a) any such communication made in furtherance of any illegal purpose;

  (b) any fact observed by any [advocate] in the course of his employment as such showing that any crime or fraud has been committed since the commencement of his employment.

(2) It is immaterial whether the attention of the [advocate] was or was not directed to the fact by or on behalf of his client.”
The term “advocate” is defined under the Interpretation Act to mean a lawyer qualified to practice law in any part of Malaysia ie a practicing Malaysian lawyer.

The scope of privilege is wide and covers all communication in the course and for the purpose of his services as lawyer and continues even after cessation of his employment as lawyer of the client. The communication protected by privilege would also include communication between the lawyer and third parties (such as independent expert witnesses) during the course of his engagement as a lawyer.

In addition to the above the client is also protected by privilege under the Evidence Act as provided in Section 129 which states as follows:

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

It should be noted that the privilege under Section 129 uses the wider term “legal professional adviser” and not “advocate” as provided in Section 126. This term it appears is wide enough to include in house lawyers and foreign lawyers but is unlikely to include registered IP Agents or other IP Advisers (who are not lawyers) whether local or foreign.

4. “Indirect” Privilege

In view of the above to ensure privilege of advice given by local/foreign IP Advisers who are not Malaysian lawyers it will be necessary for the Malaysian client to instruct his Malaysian lawyer to procure the relevant advice. Since such advice would be part of communication between the client and his lawyer, it will be protected by lawyer-client privilege.

Also it should be noted that advice previously obtained by a client from a non-lawyer foreign IP Adviser would ordinarily not be protected by privilege as it was obtained without the involvement of the client’s legal professional adviser or lawyer.

5. Assessing the Current Extent and Scope of Privilege

Issue: Should privilege be extended to communication between client and:
(a) local IP advisers who are non-lawyers
(b) foreign IP advisers whether lawyers or non-lawyers?

From a client’s perspective it is obvious that the extension of privilege to communication with
(i) Malaysian non-lawyer IP Advisers
(ii) Foreign IP Advisers
would be advantageous to the client. Such extension of privilege would enable the client to obtain advice from parties which the client thinks is best able to provide such advice and such advice can be solicited free of concerns of discovery and confidentiality.
- On the issue of which type of IP Adviser should enjoy the client privilege it is arguable that such privilege should only extend to IP advisers who are “legally qualified” and recognized as such to provide such advice. Accordingly, a case could be made to say that such privilege if it is to be extended beyond lawyers to non-lawyers should only cover IP advisers who are registered IP agents since such persons are recognized as legally qualified under the respective IP legislation. The flow chart could therefore look like this:

![Flow Chart]

- In respect of foreign IP Advisers the issue may be more complex
  - foreign lawyers advising on any legal subject matter in general already have the privilege accorded to communication between them and the Malaysian client as explained above.
  - one then has to argue from a policy perspective why foreign IP advisers (who are not lawyers) should also be granted privilege.

- The policy arguments here could be as follows:
  - multi-jurisdictional nature of IP
  - need for foreign expertise
  - cost factor

- **Multi-Jurisdictional Nature of IP**

Very often the client may wish to file for IPR in more than one jurisdiction and this will naturally entail the use of foreign IP advisers with direct communication between the client and the foreign IP adviser. The logic is that such communication should be protected by privilege.

- **Need for Foreign Expertise**
Particularly in the field of patents where the subject matter may require a high degree of technical skill and knowledge, it is to be expected that foreign expertise such as from specialized patent attorneys may be sought. Again the direct communication between client and foreign IP Adviser should be protected by privilege. Furthermore there is also a need to protect in the home country (Malaysia) the advice given by a Malaysian IP Adviser which is being considered by the same client’s overseas IP Adviser.

- **Cost Factor**

From a cost perspective the local client would be put to greater expense if it has to pay 2 sets of fees (local lawyer and foreign IP Adviser) in order to ensure privilege for the IP advice from foreign IP Adviser.

In view of the above it is also submitted that communication between foreign IP Advisers and a local client should also be protected by privilege. However, the issue of the legal qualification of the foreign IP Adviser should also be taken into consideration. Accordingly privilege should only apply in respect of clients in their relationship with foreign IP Advisers where such privilege is recognized in their respective jurisdictions.

6. **Scope of Privilege**

It is submitted that the scope of lawyer-client privilege appear to be adequate and therefore it would suffice for amending legislation to merely state that the privilege to be extended to qualified IP Advisers should be of the same scope applicable to lawyers. This will also help streamline privilege laws and ensure the same standard for both lawyers and qualified IP Advisers.

7. **Support for Proposed Treaty**

Insofar as the proposed treaty would encompass (or is not inconsistent) with the above points, based on the arguments and issues raised it will be beneficial for Malaysia to enter into the proposed treaty which would allow for minimum standards for the recognition and application of privilege and the protection of clients’ privilege in Malaysian legal advice when that advice is considered by the clients' IP Advisers overseas.
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?

In our legislation there is nothing that regulates the case in particular; however what most resembles in this case is the following:

The Federal Civil Code establishes that the lawyer that reveals a secret or confidential information to the opposing party of the one who gave him power, shall be liable for damages and will be subject to cases referred in the Criminal Code.

We also have the Criminal Code which states that the persons that reveal a secret or confidential information related with their employment, job, work shall be imposed by
community work. And even get a suspension of profession in case when this disclosure is made by a persona providing professional services.

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?

There is no specific provision applicable

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?

As in the previous answers there is no provisions that specifically prevents the forcible disclosure.

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?

As indicated, this is an issue not specifically regulated under Mexican law. The IP attorney should keep the confidentiality, as consequence of his duty as an attorney.

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? Not applicable

(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? Not applicable.

(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? Not applicable

(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? Not applicable

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? Not applicable

(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? Not applicable

(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? Not applicable

(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? Not applicable

(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? Not applicable

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?
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?

Not applicable

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?
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?

Yes

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?

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?

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

Yes

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?

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

There is no category of IP Agent in our country. It is not required a qualification to prosecute an IP right. To bring a case into court, the attorney should be previously obtained a law degree, but it does not require a certification as a patent attorney.

(i) What category is that?

Does not exist

(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?

Not applicable

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes
2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

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?

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?

Not applicable

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?

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 don't have a specific proposal.

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.

No new proposals

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?

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.
Questionnaire Q199

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

January 19, 2010

National Group: The Netherlands

Contributors: Wouter Pors

Date: 15 June 2010

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?

Communications with lawyers who are admitted to the bar is protected. This includes communications with in-house counsel who are also lawyers admitted to the bar. Communications with patent attorneys are protected.

Privilege may also be awarded to IP professionals who are under a obligation of confidentiality imposed by law, but in addition it should be established that the legislator in imposing that obligation had taken into account that this would result in a privilege (Dutch Supreme Court 22-12-1989, NJ 1990/779, International Tin Council), whereas an important factor also is
whether the person invoking the privilege had a legal position that required people who wanted such legal interests represented to hire his services, like with the mandatory representation by a lawyer admitted to the bar in most civil proceedings (Dutch Supreme Court 6-5-1986, NJ 1986/8814, *Tax Adviser*).

Trademark attorneys, design right attorneys and other IP professionals are not regulated by law at all, so there is no obligation of confidentiality imposed by law that could form the basis of a legal privilege.

In as far as tax advisers and accountants are involved in IP matters, it is clear that they do not enjoy privilege, as this has been denied to them in general by the Dutch Supreme Court.

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?

None.

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?

If the third party is hired by an IP professional who enjoys privilege, the communications between the third party and the IP professional are covered, as well as the communications between the IP professional and the client resulting there from. Thus, if protection is required, the communication with the third party should go through the IP professional who enjoys protection.

**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?

In case (a) the overseas professional is hired by the local professional and thus these communications are covered by the same protection as the communications between the client and the local IP professional. In case (b) protection would be awarded if the overseas IP professional would enjoy protection in his home jurisdiction.

**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?

As mentioned above: to external lawyers admitted to the bar, to in-house lawyers admitted to the bar and to patent attorneys, but not to other IP professionals who are not regulated by statutory law or whose obligation of confidentiality is not regulated by statutory law.

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?

If privilege exists, it only covers information acquired or developed within the course of the activities for which the privilege was granted. It for instance does not relate to friendly non-business related conversations and other non-professional contacts. It may even not relate to certain business information. For instance, an in-house lawyer admitted to the bar may invoke privilege with regard to litigation that he is involved in on behalf of the company and with regard to legal advice given to the board of his company and preparatory materials used in the course of developing such advice or litigation, but not to information which has been placed in his possession for the mere purpose of keeping it confidential, but which otherwise is outside the scope of legal advice or litigation.

With regard to lawyers admitted to the bar, the courts are not allowed to fully test whether privilege is invoked correctly. The court may probe whether the privilege has really been invoked with regard to information that is covered by such privilege, but if the lawyer insists that it is, the court has to accept that. If this was a misrepresentation, disciplinary action might follow, but that will not influence the outcome of the litigation in court.

There is no case law on the scope of an eventual privilege for other IP professionals, as there is no case law in which such privilege was accepted anyway.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

For lawyers admitted to the bar and for patent attorneys the protection is of appropriate quality.

There is no unanimity whether such protection should also apply to trademark and design right attorneys. According to one view there would be an essential difference between advising on developing technology and advising on branding and design. According to another view, such advice could be equally essential to the client and decisions on such strategies would constitute trade secrets worthy of protection.

Although a statutory regulation of their profession was proposed in the Benelux Treaty on Intellectual Property, the Benelux Office for Intellectual Property, which is responsible for trademark law and design right law in the Benelux countries, has taken the position that this would constitute too much of a burden. Thus, there is no statutory obligation of confidentiality so far.

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?

Currently there is no guarantee that protection granted to Dutch IP advisers is sufficiently recognized overseas. Thus, the protection is not of appropriate quality.

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?
There may indeed be a limitation that would exclude communications which are not really related to advice on an IP matter from protection.

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?

Protection should not be abused to protect other communications.

**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?

In order for the protection to be effective, the IP professional should be allowed to refuse to disclose such communications to the court, even for the purpose of exercising judicial discretion. Under Dutch law, the court may probe whether the privilege has really been invoked with regard to information that is covered by such privilege, but if the lawyer insists that it is, the court has to accept that. We think that is a good system.

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?

See 2.3

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?

Perhaps a solution could be found if the court exercising judicial discretion with regard to an overseas IP professional should apply the rules for judicial discretion that would apply in that professional’s home jurisdiction, in as far as these offer further protection than the rules of the court’s jurisdiction.

**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’?

As mentioned above, there is no unanimous view on this.

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?
There would be unanimity that IP advisers who are qualified to give IP advice under statutory law, where the statutory law includes an obligation of confidentiality aimed at granting legal privilege, should be protected.

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

(i) What category is that?
   
   Trademark attorneys, design right attorneys and anyone except lawyers admitted to the bar and patent attorneys.

(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?
   
   As mentioned above, opinions on this vary.

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

   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?

   This would mean that certain communications that are protected in The Netherlands would not be protected abroad.

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?

   The Netherlands do not apply such a limitation.
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?

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.

Not if this means that a level of protection which is respected in The Netherlands is not respected abroad. Besides, this means that protection granted on an international level can be undermined by national legislation, without any test of acceptability.

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?

There is no objection against abolishing an exception or waiver, but there should be no variations that undermine the desired level of protection.

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?

It should at least not undermine the level of protection.

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?

The AIPPI proposal, because it requires a particular standard to be applied by all countries.

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.
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.

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.
Questionnaire Q199

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

January 19, 2010

National Group: New Zealand
Contributors: Rosemary Wallis
Date: 21 April 2010

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?

Under section 54 of the New Zealand Evidence Act 2006, a person who obtains professional legal services from a legal adviser (which includes in the case of a registered patent attorney, the obtaining or giving information or advice concerning intellectual property) has privilege in respect of any communication between the person and the legal adviser. This section updates the patent attorney privilege contained in section 34 of the Evidence Amendment Act (No 2) 1980.
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?

*Under sections 56(2)(a) and (d) of the Evidence Act 2006, only a person who is, or on reasonable grounds contemplates becoming, a party to a legal proceeding has a privilege in respect of (among others):*

- a communication between the client and any other person or information compiled or prepared by any other person, at the request of the client and
- *only if the communication or information is made, received, compiled, or prepared for the dominant purpose of preparing for a proceeding or an apprehended proceeding.*

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?

*Under Sections 56(2)(b) and (d) of the Evidence Act 2006, only a person who is, or on reasonable grounds contemplates becoming, a party to a proceeding has a privilege in respect of (among others):*

- a communication between the client’s legal adviser and any other person and information compiled or prepared by any other person, at the request of the client’s legal adviser and
- *only if the communication or information is made, received, compiled, or prepared for the dominant purpose of preparing for a proceeding or an apprehended proceeding.*

**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?

*(a) Under Section 56 of the Evidence Act 2006, only a person who is, or on reasonable grounds contemplates becoming, a party to a proceeding has a privilege in respect of (among others) a communication between the client's legal adviser and any other person and information compiled or prepared by any other person, at the request of the client's legal adviser and only if the communication or information is made, received, compiled, or prepared for the dominant purpose of preparing for a proceeding or an apprehended proceeding.*

*(b) The Evidence (Recognition of Overseas Practitioners) Order 2008 entitles a client of an overseas practitioner (which is defined in section 51(1)(c) of the Evidence Act 2006 to include a person which is entitled to undertake work normally undertaken by a lawyer or a patent attorney) to claim legal privilege in respect of certain communications. The Order lists the*
countries to which this applies. The countries include the United States of America, the United Kingdom, Australia, states of the European Union, Canada, China and Korea (among others).

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?

In New Zealand, there are only “patent attorneys”, there are no separate “trade marks attorneys”. Under section 51 of the Evidence Act 2006 (which deals with the interpretation of terms used in Subpart 8 of the Act “Privilege and confidentiality”), a “legal adviser” is defined as a lawyer, a registered patent attorney (i.e. a person who is registered under section 100 of the Patents Act 1953) and an overseas practitioner. An “overseas practitioner” is further defined (section 51, Evidence Act 2006) as a person who is, under the laws of a country specified by an Order in Council (which includes the Evidence (Recognition of Overseas Practitioners) Order 2008), entitled to undertake work that, in New Zealand, is normally undertaken by a lawyer or a patent attorney.

Thus, protection extends to lawyer, lawyer/registered patent attorney, non lawyer registered patent attorney and ‘overseas practitioners’ as defined in section 51 of the Evidence Act 2006.

In-house counsel must maintain a current practising certificate if they wish to claim legal privilege in respect of communications with their client/employer, and these must be in the nature of legal advice.

There is also precedent for the position that for privilege to apply to communications by a third party (which may cover non lawyer, unregistered patent/trademark executives), that third party
must be, not merely an agent of the solicitor or the client in a general sense, but an agent for
the purpose of communication with the other party to give or obtain legal advice. This point
has not been determined under the new Act. However, previously privilege extended to
communications between local and overseas patent attorneys for purposes of obtaining legal
advice only.

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?

Section 67 of the Evidence Act 2006 grants judges the power to disallow privilege where they
are satisfied that the communication was made/received, or the information was
compiled/prepared for a dishonest purpose, or to aid in the commission of an offence.

Where a party challenges a claim to privilege, Rule 8.31 of the High Court Rules states a
judge may, in assessing that claim, require the document to be produced to the judge and
inspected for the purpose of deciding the validity of the claim.

Further, section 65 of the Evidence Act 2006 allows a person who has privilege to expressly or
impliedly waive that privilege where s/he voluntarily produces or discloses, or consents to the
production or disclosure of, any significant part of the privileged communication or information.
Privilege is not waived where the disclosure occurred involuntarily or mistakenly or otherwise
without the consent of the person who has the privilege.

A further instance where privilege may not be sustained is where a client takes action against
his/her legal adviser in respect of advice given.
Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

While section 56 of the Evidence Act 2006 grants privilege for preparatory materials for proceedings, the definition of ‘proceeding’ as set out in section 4 of that Act does not cover proceedings before the Commissioner of Patents or Trade Marks (for example, trade mark / patent opposition / revocation proceedings). The gap here suggests that advice obtained in respect of these proceedings is not privileged unless provided by a lawyer or registered patent attorney. Therefore, communications with third parties in relation to evidence (for example, technical experts) in proceedings before the Commissioner, are most likely not privileged. However, there is no discovery regime in relation to proceedings before the Commissioner, so the risk of the communication being discovered during proceedings before the Commissioner is low but such communications could be produced during legal proceedings at a later stage.

Furthermore, in New Zealand, the Lawyers and Conveyancers Act 2006 established certain “reserved areas of work” within which only lawyers may act. This includes giving legal advice in relation to the direction or management of any proceedings before a New Zealand court or tribunal. Therefore, patent attorneys who are not lawyers may not have privilege in respect of advice in relation to legal proceedings.

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?

While the Evidence (Recognition of Overseas Practitioners) Order 2008 extends privilege to clients of overseas practitioners (including registered patent attorneys), this privilege is not reciprocated by the law of other countries. A large number of New Zealand businesses wanting to venture into overseas markets will no doubt seek advice from their New Zealand patent attorneys, with respect to protecting and commercialising their IP, prior to actually entering those markets. For such a business to have confidence in those ventures, there must be a reasonable certainty that it will be protected from being forced to disclose the relevant communications between it and its New Zealand patent attorney. However, while such advice
may be privileged in New Zealand, should a dispute arise in another country, this advice will be open to scrutiny by not only the courts, but other parties and counsel, i.e. where IP litigation arises, clients will be forced to disclose advice provided by their New Zealand patent attorneys in relation to the protection and commercialisation of that IP. It could also have ramifications for their activities in other countries, as attorney/client information publicly disclosed in one country may find its way into other countries, and damage commercialisation prospects there.

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes; those documents that relate to legal advice only.

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?

To ensure that privilege is not extended to a broader category than that which it was introduced to protect.

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?

Yes.

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?

To avoid the abuse of privilege where clients may seek to claim privilege for improper or fraudulent purposes. The nature of the advice must be given due weight.
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?

*Countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be improper or fraudulent purpose underlying the obtaining / provision of legal advice.*

**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'?

_**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?

*Rather than use the word ‘qualified’, perhaps a better position would be to require the IP adviser to be ‘entitled by / at law to give IP advice’.*

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

(i) What category is that? *IP advice may be given by non-lawyer non-registered patent executives, however only lawyers can ‘direct proceedings’. Privilege does not attach to communications by non-qualified persons unless they are supervised by qualified persons.*

(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? _**No.**_

(iii) As to your answer to sub-para (ii), why? *They are not subject to the discipline of the regulatory body for the profession or the courts or the Commissioner of Patents; it is an issue of accountability.*

**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, a minimum standard should apply, above which there will be limitations.**_

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 work is international. A minimum standard applicable globally would ensure that protection is matched in each country.*
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, provided the country till adheres to the minimum standard proposed.

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?

A country should have the liberty to vary or abolish a previously applied limitation so as to bring its laws into line with the minimum standard prescribed.

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, provided the country maintains the minimum standard.

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?

Yes

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No

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

2.17 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?
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.

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.

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?

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.
Questionnaire Q199

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

January 19, 2010

National Group: Norway

Contributors: Amund Brede Svendsen

Date: May 19, 2010

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?

Answer: No protection applies to IP professional advice as such. Protection applies to communications between clients and lawyers in private practice. There is no distinct litigation privilege. As to communications between client and in-house lawyers, there is some case law from the last decade or so supporting the view that they can be protected if the in-house lawyer has a role that, were it not for the fact that he is an employee of the client, would equal that of an independent lawyer.

The general rules on privilege were introduced at least as early as 1927.
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:** None, unless such technical experts are employed or retained by a lawyer the communications with whom would be covered by protection, see answer to Question 1.1

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:** None, unless such technical experts are employed or retained by a lawyer the communications with whom would be covered by protection, see answer to Question 1.1

**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?

**Answer:**
(a) Communications relating to advice sought by a client from a foreign IP professional via a local IP professional would be protected by if:
(i) the foreign IP professional is a lawyer in private practice, and
(ii) the local IP professional is a lawyer or is employed or retained by a lawyer

(b) Communications relating to advice sought by a client from a foreign IP professional directly would likewise be protected if the foreign IP professional is a lawyer

Generally, it is thought that a Norwegian court would avoid ordering a foreign IP professional to disclose communications which he or she would be prevented from disclosing under the laws governing their professional activities in the jurisdiction where they conduct them. However, there is no case law dealing with this.

**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?

Answer: Client protection applies to lawyers, lawyer/patent attorneys, lawyer/trade marks attorneys, provided they are practicing lawyers, i.e. are registered with the Control authority for legal practices. Client protection does not apply to communications between the client and his in-house advisers, with the exception of in-house lawyers on certain conditions, see the answer to 1.1 above.

Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?
Answer: The protections mentioned have the following exceptions/limitations

a) Money laundering legislation (EU/EEA based legislation)

b) Communications for which the client has waived protection or the contents of which he has disclosed.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

Answer: The general level of protection is thought to be adequate in quality. There have not been many problems in practice from the point of view of the clients. However, it would appear that protection should be available to communications between clients and IP professionals that are not practicing lawyers or employed or retained by a practicing lawyer. There would no longer be a need to ensure that non-lawyer IP professionals and technical experts are employed or retained by lawyers for protection to apply to communications between them and clients. Competition between lawyer and non-lawyer IP professionals would be fairer.

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 there are no recorded cases of loss of protection in Norway for communications relating to advice sought by a client from a foreign IP professional, there is clearly a risk of this occurring, and the general uncertainty and unpredictability of the present situation in not satisfactory.
2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations
Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Answer: Probably they should.

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: Some minimum relationship with the seeking of advice should probably apply for protection to be available.

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: It is in the best interest of all parties and of society at large that IP advice, similarly to legal advice, should be sought and given under full disclosure of all relevant facts and that opinions and advice should be candid and frank. For this to happen, the communications between client and adviser need to be protected, so that they can be made in confidence that they will be confidential, and that such protection will apply globally and at all times.

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?
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: A license by the patent or trademark office, or a form of registration that confirms the adviser is qualified to give the IP advice, combined with a control authority supervising the conduct of IP advisers practices should be required.

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

(i) What category is that?
(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?
(iii) As to your answer to sub-para (ii), why?

Answer: (i) None applies
(ii) and (iii) N/A

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: Probably 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?

Answer: Norway has no discovery. A court may order a party (or a third party) to disclose a specific document, but not if that means setting the principle of lawyer-client privilege aside. There appears to be little need to introduce a specific litigation privilege in Norway.

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:** There should be liberty to abolish a limitation.

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:** It should not be possible for any country to introduce any limitations or to expand the scope of any existing limitations to privilege. It is especially important that no country should have the liberty to introduce or expand the scope of any limitations to privilege with retroactive effect, i.e. with effect on communications that have already been exchanged between client and adviser or third party when the limitations in questions are enacted and made public.

### 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, as long as its scope is not expanded or the conditions for applying the exception are not eased.

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?

**Answer:** The “3-point-exception” may be a useful approach.

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?

**Answer:** N/A

### 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?
**Answer:** The AIPPI proposal, because it is the only one of the two that deals with the problem of different standards in different countries. Also, it widens the scope of application of the protection to other categories of IP advisers than European Patent Attorneys.

**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.

**Answer:** The Norwegian group generally favours the AIPPI proposal. However, within the group, there are different opinions as to whether communications between client and in-house counsel and in-house IP advisers should be protected.

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.

**Answer:** One should try to achieve a general recognition and enactment where necessary of the principle in each jurisdiction that, if communications between a client and its IP adviser belonging to an identified group or category are protected from forcible disclosure, then it shall not matter if that IP adviser is foreign or operates or is qualified to give advice in a different jurisdiction than that of the client: the communications shall be privileged.

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?

**Answer:** We do not anticipate such adverse effect.
Questionnaire Q199

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

January 19, 2010

National Group: [ASOCIACION PANAMEÑA DE PROPIEDAD INTELECTUAL (APADEPI), The Panamanian Intellectual Property Association]

Contributors: Maria Eugenia Brenes

Date: [May 20th, 2010]

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?

[PANAMA]

There are two different kinds of protection of clients against forcible disclosure of communications.

1. Regarding to any kind of professional advice given by lawyers to clients (including IP matters), with regards to the process at hand, the lawyer is not obliged to declare with regards to the confidences received from his clients. And the advises given with regards to a process
handled by the lawyer. The said protection is general, it is included in the Article 912 of the judicial code, and refers to testimonies.

2. Additionally the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

In Panama there are no exclusive regulations to the matter of “forcible disclosure of communications” relating to attorney client communication, our rules for discovery are of general application.

A Pre-trial discovery is possible (it can be granted upon a court decision based in the fact that without it, evidence might be lost), but it is seldom granted in Panama, and it cannot be targeted to a client attorney communication.

Courts do not grant pre trial discovery disclosure to “fishing expeditions” as they are called in the country and refer to those where the applicant request all kind of documents without any rationale behind the search of a specific document.

Additionally Panama does not have privilege or protection for communications related to clients and any other non lawyer IP adviser. Therefore the risk of disclosure either forcible or caused by lack of sufficient measures to protect the information is imminent.

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?

[PANAMA]

The Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Unless the lawyer participates in the communication the same is not deemed protected.

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?

[PANAMA]

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Unless the lawyer participates in the communication the same is not deemed protected.
**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?

**[PANAMA]**

There are two different kind of protection of clients against forcible disclosure of communications relating to any kind of professional advice given by lawyers to clients (including IP matters), with regards to the process handled. Said protection is general, it is included in the Article 912 of the judicial code, it regards to testimonies.

Additionally the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Any disclosure made by a Panamanian Lawyer, in other country, as long as evidenced here in Panama, can be subject to the application of the Ethics Code of the National Bar Association.

**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 (e.g. 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?

**[PANAMA]**

To Lawyers, there is no distinction whether outside or in house counsel, of any kind of Law Practice (including IP Law).

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

(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?
Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client’s lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.

(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?

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client’s lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.

(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?

Under the Ethics Code of the National Bar Association (equal to ABA) in article 13 states that the lawyer and his employees have the duty to keep the secrets and confidences of its clients, even after the termination of their relationship, and neither the lawyer, nor his employees can be forced to reveal such secrets, unless duly authorized by the client.

Communications shall be generated by the client’s lawyer to his employees or to third parties in the rendering of advice to extend the client-lawyer privilege to said communication.
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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”

Additionally the attorney or its employees, that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client’s authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

(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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”

Additionally the employee of the lawyer, keeping a confidence or secret that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client’s authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

(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?

[PANAMA]

In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”
Additionally the employee of the lawyer, keeping a confidence or secret that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client’s authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

(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?

[PANAMA]
In Panama, the party requesting the Pre Trial Discovery Measure “forcible disclosure”, according to the Judicial Code, article 816 and Doctrine of the application of said Code, shall evidence to the judge the “the interest or fear justifying the pre trial discovery”

Additionally the employee of the lawyer, keeping a confidence or secret that discloses information, communications of a client, does not incur in an Ethic fault if the disclosure was made with the client’s authorization or the disclosure was made as a result of its self-defence (lawyers self defence).

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?

[PANAMA]
The protection is not appropriate, it shall be more specific and related only to IP matters and relationships, where not only lawyer employees participate in advise giving, but other IP professional, such as engineers, doctors, agents, technicians, etc. shall be included.

(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?

[PANAMA]
There is not protection given to clients to this kind of disclosure, unless an attorney o lawyer has requested the advice from the third party, and in that case, the privilege set forth in answers below apply.
(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?

[PANAMA]

There is not protection given to clients to this kind of disclosure, unless an attorney or lawyer has requested the advice from the third party, and in that case, the privilege set forth in answers below apply.

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?

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?

[PANAMA]

No, we agree that a general provision should be made, and shall be kept as simple as possible to be applicable to all countries, no matter if common or civil law applies, a main rule shall be created and each country shall develop and define their own tests to apply to.

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?

[PANAMA]

In Panama the forcible disclosure seldom occurs in IP related matters, furthermore, our law does consider all communications between lawyer client to be privileged, why would we want...
to limit the same? Meaning that the dominant purpose test only will limit the scope of our protection.

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?

[PANAMA]

Courts do have that discretion here. As explained in 1.1 and 1.6; but we consider that judicial discretion in the IP subject matter although shall have limitation, should not rely solely on court's discretion.

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?

[PANAMA]

Courts in Civil Law countries do not have the same power as Common Law countries, and granting a power seldom given without proper training and control can generate a huge problem in IP related matters, where client secrets are at stake..

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?

Not applicable

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'?

[PANAMA]

Yes, we consider that all communications related to IP advice, given by qualified IP advisors shall be kept protected, without entering into the kind of communication given.

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?

[PANAMA]

Not applicable

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?

[PANAMA]
Not applicable

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?

[PANAMA]
No, all communications between lawyer client, and advisor client, related to IP matters shall be kept protected.

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?

[PANAMA]
It will definitely limit the scope of our protection.

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?

[PANAMA]
Yes, any country should have the right to apply the standard or not.

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?

[PANAMA]
The liberty to abolish the privilege distinction or any other limitation shall only be limited by the definitions set forth in the proposed and then approved treaty, in the sense that it would not limit the right of protection that a client has won with this agreed standard.

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.

[PANAMA]
At least self defence rule, the crime fraud rule too, the public domain theory (when applicable) or the client's consent.

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?

[PANAMA]
Yes any State shall have the right to vary the limitations or exceptions to any rule, as long as the principal right protected by the treaty lies unprotected.

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?

[PANAMA]
The liberty to abolish the privilege distinction or any other limitation shall only be limited to the definitions set forth in the proposed and then approved treaty, in the sense that it would not limit the right of protection that a client has won with this agreed standard.

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?

[PANAMA]
Not applicable.

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?

[PANAMA]
We find the WIPO proposal to be more in accordance with Panamanian Civil Law System, where a definition of the IP Adviser will be brought, where all communication pertaining any matters of IP (defining the matters) would be included, where no difference of in house or private practice attorneys are brought, where no standards to communications shall be applied and the client and solely the client shall decide whether a communication can and will be disclosed.
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.

[PANAMA]
We rather the WIPO approach; it poses fewer changes to the system, yet gets the same protection acquired by the AIPPI proposal.

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.

[PANAMA]
No further comments

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?

[PANAMA]
We do not foresee any adverse effects.

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.
Questionnaire Q199

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

January 19, 2010

National Group:    Philippine Group

Contributors:    Rogelio Nicandro

Date:    May 21, 2010

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: For IP professional advice given by lawyers in the Philippines, the client has for his protection Canon 21 of the Code of Professional Responsibility and Canon No. 37 of the Canons of Professional Ethics.

For IP professional advice given by IP professionals who are not lawyers (such as patent agents or technical advisers or consultants), there are no specific ethical rules in effect. However, if the disclosure can be considered as maliciously made and/or contrary to the traditional or common perception of what is fair and just, it is possible for the client to obtain some relief by way of damages under Chapter 2, Human Relations, of the Civil Code of the Philippines.

For IP professionals who are not lawyers, it is therefore advisable for the client to require the IP professional to sign a contract containing a provision requiring non-disclosure of confidential information.

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: The same answer to Question 1.1 (above) applies.

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: The same answer to Question 1.1 (above) applies.

Overseas communications

1.4 What protection of clients applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Answer: With respect to letter (a), local IP professionals in our country are bound by the same rules stated in 1.1. For overseas IP professionals, there may be a distinction between IP professionals who are lawyers and IP professionals who are non-lawyers. For IP professionals who are lawyers,
they are likely bound by the respective canons of legal ethics applicable in their countries. For IP professionals in other countries who are non-lawyers, we are not competent to answer. However, we advise that confidentiality clauses should be included in their employment contracts.

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?

Answer: Our answer is the same as our Answer to 1.1 above.

(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?

Answer: Our answer is the same as our Answer to 1.1 above where IP professionals who are non-lawyers are involved.

(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?

Answer: Our answer is the same as our Answer to 1.5 (ii) above

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?
Answer: With respect to letter (a), local IP professionals in our country are bound by the same rules stated in 1.1. For overseas IP professionals, there may be a distinction between IP professionals who are lawyers and IP professionals who are non-lawyers. For IP professionals who are lawyers, they are likely bound by the respective canons of legal ethics applicable in their countries. For IP professionals in other countries who are non-lawyers, we are not competent to answer. However, we advise that confidentiality clauses should be included in their employment contracts.

As to (iv) (b.), our answer is the same as our answer to (iv) a. (above)

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 waiv ers 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?

Answer: Generally, there are no limitations applicable to IP professional advice given by IP professionals who are lawyers. With respect to IP professionals who are not lawyers, since there is no professional code of ethics in effect in the Philippines with respect to them, the limitations stated may apply.

(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?

Answer: Our answer is the same as our answer in 1.1 (above) where IP professionals who are non-lawyers are involved.

(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?

Answer: Our answer is the same as our answer to 1.6 (i) (above).
(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

Answer: With respect to (a), local IP professionals in our country are governed by the rules stated in our answer in 1.1 above. With respect to overseas IP professional, our answer is the same as in 1.5 (iv). For letter (b), our answer is the same as our answer to 1.6 (iv) a.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

Answer: With respect to IP professionals who are lawyers, we believe that the protection stated in 1.1 is adequate. With respect to IP professionals who are non-lawyers, it may be better if they have their own code of professional ethics.

(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?

Answer: Our answer is the same as our answer to 1.7 (i) above.

(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?

Answer: Our answer is the same as our answer to 1.7 (i).

(iv) as to 1.4 ie the protection applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those
communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Answer: Since our local code of professional ethics and local standards are different from those applicable to overseas IP professionals, it will be better if there are uniform provisions governing both local and overseas IP professionals.

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: The differences in rules applicable to local IP professionals vis a vis overseas IP professionals may give rise to conflicting interpretations and applications of the respective rules. It would appear that uniform rules should be put in place.

One problem that may arise is the traceability of improper disclosures of confidential information, that is, who made the improper disclosure. Another problem is with respect to jurisdictional issues, namely, venue as well as service of writs and other court processes.

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Answer: We agree that uniformity in standards is desirable.
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: To avoid conflicts. The practical difficulties mentioned in our answer to Q. 2.8 may apply in this case.

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: We agree.

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: To avoid conflicts in the application of different standards. Furthermore, the purpose to attain the ends of justice is a worthy goal.

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

Answer: The limitation as expressed in 2.3, is acceptable to us.

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: Yes

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: N.A.

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

(i) What category is that?
Answer: This may apply to some persons who are not degree holders but who may have some knowledge or expertise in the specific field where the IP advice is given.

(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?

Answer: Yes

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

Answer: Because the advice given is generally confidential in nature if given by an IP professional.

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

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: N.A.

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: Considering the speed of globalization, when cases involving clients and professionals in 2 or more countries increase rapidly, each country concerned should consider a change in its existing rules to achieve uniformity in rulings.

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: The same as the limitation stated in our answer to 2.12.

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: We prefer the AIPPI proposal. The terms are clear and well defined.

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: N.A.

2.18 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

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.
1. Q.199 - Questionnaire

The Groups are asked to reply to the following questions in the context of what applies or what they may consider ought to apply in their own country or by agreement between their country and others, as may be appropriate to the particular question. The responses of each Group need to be endorsed by that Group. It will be helpful and appreciated if the Groups follow the order of the questions in their reports and use the questions and numbers for their responses.

Present position

Local position

1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and IP professionals within your country? When was this protection introduced into your law?

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

Polish law recognizes a protection of confidentiality of IP professional advisors working with clients on the protection of their IPR rights. The protection of IP advisors against forcible
disclosure of information received during providing advise to a client is set forth in various regulations with regards to different professional groups. In Poland there are several groups of professionals working on the protection of IPR rights:

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

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


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

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

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

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


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

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

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

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


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

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
**No Polish regulations.**

1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

*No Polish regulations.*

**Overseas communications**

1.4 What protection of clients applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

*No Polish regulations.*

**Scope of protection – qualifications of IP professional advisers**

1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to in-house advisers?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

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

(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

*N/A*

(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

*N/A*

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?
Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges' discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

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


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

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

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

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

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

(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts)
where their advice is required to enable legal advice related to IP to be obtained and given?
N/A

(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
N/A

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?
N/A

Quality of protection
Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

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

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

There is no legal basis of protection.

(iii) as to 1.3 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

There is no legal basis of protection.
Communications with overseas IP advisers

1.8 Does your Group consider that the protection described in answer to question 1.4 above is of appropriate quality or not, and if not, why not – what are the problems in practice?

N/A

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes.

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

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

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?
The attorney should not be obliged to testify against his client. The profession of an attorney is the profession of public confidence and the situations where the priority is given to the protection of client’s interests should be always taken into consideration. Client should feel safe confiding in his/her attorney.

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

n/a

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

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

2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

n/a

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

No

(i) What category is that?

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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

2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?
Yes.

2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it?

No limitation.

Exceptions and waivers

2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

No.

2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPPI, does your Group agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such an exception or waiver should it wish to do so in the future, in other words, that there should be liberty to vary or abolish a presently applied exception or waiver?

Yes.

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it, in particular should e.g. the limitation for the “3-point-exception” as discussed in para 4.28 above also set limits in this case?

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

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No

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

2.16 Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section 5 above), does your Group prefer and if so why?

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

Proposals from your Group

2.17 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

n/a
2.18 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

n/a

2.20 With the introduction of protection against forcible disclosure of IP professional advice or any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

n/a
1.1. Portuguese law does not provide for any duty of confidentiality in which refers to relations between IP professionals and clients. In the specific case of lawyers, there are rules which expressly govern the duty of confidentiality.

1.2. Communications between clients and third parties are not protected by any duty of confidentiality. Cases where third parties are bound by such duty by virtue of the rules applying to their profession are excepted.

1.3. Communications between IP professionals and third parties are not protected. Cases where the IP professional is a lawyer or the third parties are bound by the duty of confidentiality are excepted.

1.4. A) Communications between local professionals and other IP professionals throughout the world are not protected (except where the local professional is a lawyer).

   B) The duty of confidentiality binding foreign IP professionals depends on the rules applying to the profession in the country of origin.

1.5. i) Only in which refers to the IP professionals who are lawyers.

   ii) Only where the third parties are bound by the duty of confidentiality.

   iii) Communications are only protected with regard to the IP professionals who are lawyers.

   iv) a) Communications are only protected where the local IP professional is a lawyer.
b) Communications are only protected if the domestic law of the foreign IP advisers provides for the duty of confidentiality.

1.6. i) In force majeure cases and where ordered by the Courts or the Bar Association, lawyers may be exempted from the duty of confidentiality.
   ii) There is no protection.
   iii) The same reply as under i).
   iv) a) The same reply as under i).
      b) Communications are not protected.

1.7. i) Inappropriate quality. Privilege should be extended to IP professionals. In addition to improving the system in terms of guarantees for clients, this measure would constitute an important factor in avoiding “discrimination” against these professionals with reference to lawyers.
   ii) Appropriate quality. Although, in some cases, privilege would be justified (and, in some situations, communications are in fact covered by privilege) it would be extremely difficult, from a legal point of view, to specify in detail which situations deserved protection and which should not be subject to that regime.
   iii) Inappropriate quality. The same reply as under i).
   iv) a) Inappropriate quality.
      b) Appropriate quality.

1.8. Appropriate quality. Domestic law should not pronounce itself on duties concerning IP professionals from other countries.

2.
2.1. Domestic law should establish limits to the duty of confidentiality binding IP professionals, thereby adapting the scope and limits of the privilege to the regime already applying to other professionals, such as lawyers.

2.2. It would be justified to impose limits with the purpose of harmonising the concept of confidentiality with the professions already subject to that duty.

2.3. Judicial discretion is justified, not in an absolute sense, but only in harmony with the common practice of the Courts in which regards other professions subject to privilege.

2.4. ---------------
2.5. Further to the aspect mentioned in 2.3., limitation as a function of legal or constitutional imperatives may be justified.

2.6. Yes. The IP adviser should be seen as a qualified professional, duly authorised in accordance with domestic law, contrary to other professionals who, occasionally, practise the activity without the due qualifications.

2.7. ---------------

2.8. The category of Industrial Property Agent in Portugal is conditional on qualification. Only Industrial Property Agents and lawyers are qualified as IP advisers.
   
i) Non-existent.
   ii) In cases where the IP adviser is not an Industrial Property Agent or a lawyer, the confidentiality regime of communications is not justified.
   iii) The guarantees and safeguards derived from the duty of confidentiality should be inherent to qualified professionals and not extended to other professionals who practise IP advising acts in a sporadic and unqualified manner.

2.9. States should have the power to limit the protection granted to communications as a function of certain categories of privilege. This mechanism is justified with the aim of achieving uniformity at national level in which concerns confidentiality in the different professions bound by that duty.

2.10. Not applicable.

2.11. In practical terms, it shall be very difficult to implement a system which prevents States from varying or abolishing the limits of confidentiality. This is a reserved sovereignty which the States can hardly renounce to.

2.12. Not applicable.

2.13. Yes.

2.14. Yes. If there are variations to the regime of confidentiality applying to other professions, such variations should also affect the limits of privilege in the case of IP professionals.
2.15. It might be established that States may only vary the limits when the general regime applying to the duty of confidentiality is altered, thereby maintaining the consistency between the communications of the IP professionals and, for instance, the duties of confidentiality which bind lawyers.

2.16. No.

2.17. The Portuguese Group prefers the AIPPI proposal in the sense that each country should specify which legal advisers would benefit from the treaty.

2.18. Not applicable.

2.19. No new proposals.

2.20. No relevant negative effects derived from the introduction in our country of the measures discussed above are foreseeable.
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?

No discovery and no attorney-client privilege are established.

IP professionals including attorneys at law and patent attorneys have an obligation to keep secrecy of the information which was obtained in their work for the client. The obligation of attorney at was introduced in 1949, and the obligation of patent attorney was introduced in 1961 into law.

However, the information or advice which clients obtain from the attorneys at law or patent attorneys is not protected.
1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

No protection is given to disclosure of communication between clients and third parties.

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?

As same as in 1.1, the information which attorneys at law or patent attorneys obtain from third parties is protected to the extent which the obligation of secrecy is applied. However, the information which third party obtain from attorneys at law or patent attorneys is not protected.

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?

(a) The information which attorneys at law or patent attorneys obtain from overseas IP professional is protected to the extent which the obligation of secrecy is applied.

(b) However, the information which clients obtain from overseas IP professionals attorneys is not protected.

Scope of protection – qualifications of IP professional advisers

1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to in-house advisers?

(i) as to 1.1. ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

Applies to attorneys at law and non lawyer patent attorneys. No clear provision or case law regarding in-house adviser. However, it may be interpreted that it includes in-house advisers

(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?

**No protection 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?

**Applies to attorneys at law and non lawyer patent attorneys and be interpreted to include in-house advisers**

(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?

(a) **Applies to attorneys at law and non lawyer patent attorneys and be interpreted to include in-house advisers**

(b) **No protection is given**

### 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 waives apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

**The obligation to keep secrecy can be exempted upon client’s consent or for public interest.**

(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?

**No protection is 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?
The obligation to keep secrecy can be exempted upon client’s consent or for public interest.

(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?

(a) The obligation to keep secrecy is exempted upon client’s consent or for public interest.
(b) No protection is given

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?

Not appropriate quality for protecting client because the information or advice which clients obtain from the attorneys at law or patent attorneys is not protected.

(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?

No protection is 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?

Not appropriate quality for protecting client because the information or advice which third parties obtain from the attorneys at law or patent attorneys is not protected.

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?

Not appropriate quality for protecting client because the information or advice which clients obtain from overseas IP advisers is not protected.
2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed? Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

The provision should be made in an open manner which can be compatible with the currently existing laws in respective member states or countries.

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? Yes

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

The provision should be made in an open manner which can be compatible with the currently existing laws in respective member states or countries. Current law in Korea allows exception to the obligation of attorneys at law or patent attorneys for the public interest.

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?

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 or for the public interest.
Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’? Yes

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?

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

(i) What category is that? Not exist

(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? N/A

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

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law? Yes

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why? N/A

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?

It should not erode the fundamental standard for protection from the forcible disclosure except as may be required by the particular circumstances of a particular case.

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?

**Yes, the limitations should not indirectly undermine the standard of general principle.**

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**

2.16 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?

We prefer the AIPPI proposal since it would provide minimum standard or agreed principle of protection against forcible disclosure which will be acceptable to as many countries as possible.

**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.

**None**

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?

Currently we do not expect any major adverse effect.

**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.
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?

R. The general rule is that there are no specific provisions in respect the protection against forcible disclosure of communications relating to IP professional advice. The IP professional advisor has the obligation-according to the specific Law regarding the profession of IP attorney- no to divulge the information and documents received from his client or with regards to the client except for the limits given by the power and within the applicable framework.

There are two exceptions to the rule, cases in which there is a certain degree of protection having features defined by the Law:
i) In case the IP professional is equally a lawyer member to the Bar, the communication between him and his Client falls within law that is governing the profession of Lawyer. According to this Law, in order to ensure professional secrecy, both the acts and professional work of the lawyer in his premises are inviolable. The inspection at the workplace and home of the lawyer and the seizure of the documents can only be done by the prosecutor, under a warrant issued according to the Law. Also, in case when the IP professional is a lawyer, the Law clearly states that the contract between the lawyer and his client can not be embarrassed or controlled directly or indirectly by any State organ.

ii) In case the IP professional is a European Patent Attorney and the object of the communication is a European Patent or European Patent Application, there is a protection pursuant to, Art. 133, 134, 134a (1)//European Patent Convention and Rule 153 apply in respect to the communications that have as object a European Patent.

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?

R. No specific protection. The Rule 153 EPC refers to the communication between the professional representative and [...] any other person and not to the communication between the Client and...any other person.

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? –

R. The general rule is that there are no specific provisions in respect the protection against forcible disclosure of communications relating to IP professional advice. There are two exceptions to the rule, cases in which there is a certain degree of protection:

i) In case the IP professional is equally a lawyer member to the Bar, the communication between him and his Client falls within law that is governing the profession of Lawyer – In this Law, it is mentioned that the Lawyer can enter into cooperation agreements with third parties such as experts with no specific provisions about the protection against forcible disclosure other than the one illustrated at 1.1.i). Indirectly we may infer that there is a protection of the home and workplace of the lawyer, and that according to this protection the documents that are found in the premises of the lawyer (including those that refer to the contract with third parties) can not be disclosed without a warrant.

ii) In case the IP professional is a European Patent Attorney and the object of the communication is a European Patent or European Patent Application, there is a protection pursuant to, Art. 133, 134, 134a (1)//European Patent Convention and Rule 153 apply in respect to the communications that have as object a European Patent, because, according to art. 153 the object refers to “all communications between the professional representative and his client or any other person”, this any other person possibly an expert.
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?

R. – no specific provisions other than the ones already indicated at 1.1.

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 (e.g. 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. 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?

R. applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

(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?

R. N/A

(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?

R. applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

(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 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?

R. See (i) applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case
the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

Limitations and exceptions

1.6 What limitations (e.g. dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (e.g. 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?

R- The warrant issued by the prosecutor is a limitation. The waiver provided in the EUROPEAN PATENT CONVENTION (“unless such privilege is expressly waived by the Client”). In addition, the lawyer cannot be heard as a witness and can not provide any information in respect to the pending file to any authority or person without the express consent of all his clients who have an interest in said file.

(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 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?

R. Same as (i) 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?

R. Same as (i) 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?

R. Same as (i) 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?
R- Fairly appropriate, because in Romania's legal system, the judges usually do not ask for submitting as evidence the communication between the IP professional and his client. Warrants are issued in exceptional circumstances such as large fraud or crime.

(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?

R. Same as (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?

R- Same as (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?

R. If the lawyer has the domicile in Romania, then the applicable law in respect to the communication between lawyer and client is the Romanian one, irrespective of the place of business of the lawyer. The protection is fairly appropriate, because in Romania's legal system, the judges usually do not ask for submitting as evidence the communication between the IP professional and his client. Warrants are issued in exceptional circumstances such as large fraud or crime.

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?

R. NO
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?

R. In practice it very difficult to define such relationship with accuracy, creating an additional difficulty to the system.

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?

R. 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?

R. Judicial discretion is difficult to be put in practice in this matter where the forcible disclosure in IP matters does not constitute a rule, therefore it would complicate more the way the system works.

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?

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'?

R. YES

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?

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

(i) What category is that?

R. Copyright

(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?

R. YES

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

R. Because copyright is one of IP rights, and secondly because in some cases there is overlap of protection of more types of rights.
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?

R. 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?

R. Because in the course of providing advice to a client for practical it is very hard if not impossible to make a clear delimitation between the two forms of privilege and their corresponding objects. In many situations the areas could contain overlap or could evolve in time in such a way to contain overlap. For the Client it is difficult to understand with two different standards that may apply to what is for him one single matter where he expects guidance and action.

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?

R. YES, there should be liberty.

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?

R. The limitation should be in conformity with the other laws in force applicable to the matter.

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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

R. 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?

R. 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?

R. The limitation should be in conformity with the other laws in force applicable to the matter.

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?

R. No experience

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?

R. The Alternative described in Section 5 (the one that has been made to WIPO) is preferred because its implementation is more realistic having in view that there are many differences between the systems of law of different countries. Secondly the Alternative proposes a special status for the European Patent Attorneys. Having in view that a large portion of the potential litigation is in relationship with the validity and/or the infringement of European Patents, this clarification of the status of the European Patent Attorneys is more than welcome.

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.

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.

R. If at all possible, we would favour a harmonization of the provisions related to the protection of the communication between the IP professional and his client when said IP professional is a lawyer with the cases when said professional is not a lawyer.

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?

R. Cannot be anticipated at this time. Overall there should not be any other adverse effects than those arising from the misinterpretation of the law.

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.
SUMMARY

The current situation in Romania shows that there is a fairly appropriate protection of the Clients against forcible disclosure of their IP professional advice, mainly because the current practice of the Courts rarely asks such disclosure in matters of intellectual property. There are no specific provisions for the protection of the advice given by IP professionals at large, but there are some specific provisions for the cases when the IP professionals are at the same time either lawyers or European Patent Attorney. Romanian group is in favour of adopting the Alternative that has been made to WIPO and not the AIPPI proposal because its implementation is more realistic and because it proposes a special status for the European Patent Attorneys.

Résumé

La situation législative en Roumanie est suffisamment acceptable en ce qui concerne la protection des clients contre le dévoilement du conseil donné par un conseiller en propriété industrielle parce qu’en pratique, les Tribunaux ne le demandent que rarement dans les dossiers de propriété industrielle. Il n’y a pas de provisions spécifiques pour la profession de conseiller en général. Il y a seulement deux exceptions où la loi prévoit une protection spécifique : si le conseiller est à même temps avocat ou si le conseiller est en même temps conseiller de brevet européen.

Le group roumain serait en faveur de l’adoption de l’Alternative plutôt que la proposition AIPPI parce que son implémentation est plus faisable et parce qu’il prévoit un statut spécifique pour le conseiller de brevet européen.

Zusammenfassung

Die aktuelle Situation in Rumänien zeigt, dass es einen ziemlich angemessenen Schutz der Kunden gegenüber der erzwungenen Offenlegung des Inhalts der Beratung ihrer IP-Fachberater gibt. Vor allem, weil die derzeitige Gerichtspraxis nur selten in Angelegenheiten bezüglich geistigen Eigentums nach einer solchen Offenlegung verlangt. Es gibt zwar im allgemeinen keine konkreten Bestimmungen zum Schutz gegen eine solche erzwungene Offenlegung, jedoch gibt es einige spezielle Bestimmungen im Fall, dass der IP-Fachberater gleichzeitig Rechtsanwalt oder Anwalt des Europäischen Patentamtes ist.

Die rumänische Gruppe spricht sich für den alternativen Vorschlag der WIPO und gegen den Vorschlag der AIPPI aus, weil ihre Umsetzung realistischer ist und einen besonderen Status für die Anwälte des europäischen Patentamts vorschlägt.
Questionnaire Q199

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

January 19, 2010

National Group:   Russia

Contributors:   Aleksey Zalesov, Alexander Sobolev

Date:     06/06/2010

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?

There is NO special provisions regarding protection of clients against forcible disclosure of communications relating to IP professional advice applies in Russia. Patent attorney is obliged to keep information received from the client confidential but the law does not give any privileges to such information. The only exemption is when IP professional is registered as advocate (special status of lawyer who is entitled to handle criminal defence cases). In this case (article 8 on the Law on advocates) – the information received by advocate from the client is privileged and shall not be forcefully disclosed. Besides that exemption only general rule on protection of commercial secret (if IP legal advice is presented as commercial secret).
1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

No special provisions i.e. Only general rule on protection of commercial secret (if such communication is presented as commercial secret).

1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

No special provisions i.e. for IP professionals Only general rule on protection of commercial secret (if such communication is presented as commercial secret). The only exemption is when IP professional is registered as advocate (special status of lawyer who is entitled to handle criminal defence cases). In this case (article 8 on the Law on advocates) – the information received by advocate from the client is privileged and shall not be forcefully disclosed.

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?

No special provisions i.e. for IP professionals Only general rule on protection of commercial secret (if such communication is presented as commercial secret). The only exemption is when IP professional is registered as advocate (special status of lawyer who is entitled to handle criminal defence cases). In this case (article 8 on the Law on advocates) – the information received by advocate from the client is privileged and shall not be forcefully disclosed.

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?

Only for ADVOCATS
(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?

SAME

(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?

SAME

(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?

SAME

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?

If IP professional is advocate then only crime/fraud exception is applicable

(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?

SAME

(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?

SAME
(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?

SAME

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?

We believe that the most significant limitation is the fact that protection is available only for advocates and patent attorneys do not enjoy such protection at all (if not registered as advocates)

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

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?

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 agree, the standard provisions on such documents must be elaborated to avoid double meaning.*

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?

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?

*We believe that standard provisions counting limited possibility for such disclosure shall be elaborated.*

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?

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?

*We agree*

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?

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?

**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?

*We agree. The agreed limitations shall be possible as and exception from general rule of protection of information involved in IP professional's activity*

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?

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?

*We agree*

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?

*We do not see any legitimate possibility to deny the country such sovereign right*

**Exceptions and waivers**

2.12 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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

*We agree*

2.13 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?

*We agree*
2.14 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?

*At least fraud/crime exceptions*

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

2.15 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 agree with AIPPI proposal as more balanced.*

**Proposals from your Group**

2.16 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.

2.17 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.

______________________________

**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.*
Questionnaire Q199

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

January 19, 2010

National Group:   Singapore

Contributors:   Morris John

Date:     August 4, 2010

1. Q.199 - Questionnaire
The Groups are asked to reply to the following questions in the context of what applies or what they may consider ought to apply in their own country or by agreement between their country and others, as may be appropriate to the particular question. The responses of each Group need to be endorsed by that Group. It will be helpful and appreciated if the Groups follow the order of the questions in their reports and use the questions and numbers for their responses.

Present position
Local position
1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and IP professionals within your country?

Answer –
Professional communication between a lawyer and his client

Section 128 of the Singapore Evidence Act provides that:
No advocate and solicitor (Singapore lawyer) shall at any time be permitted, unless with his client's express consent, to disclose any communication made to him in the course and for the purpose of his employment as such advocate or solicitor by or behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment.

Confidential communications covering all IP related matters (i.e. patent, trademark, design copyright and passing off) are covered by the professional privilege between a lawyer and his
client. The privilege belongs to the client and not the lawyer and can be waived by the client but not the lawyer (unless consent is given by his client)

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

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

**Common Law**

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

**Privilege for communication with patent agents**

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

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

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

is privilege from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

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

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

**Answer**-

Communications between a client and 3rd parties (including technical experts) are not privileged. However, where the advice of 3rd party experts are sought to enable legal advice related to IP to be obtained then it would be prudent for the communications to be made between the 3rd party experts and the lawyer or patent agent (relating to any patent matters in the latter case) on behalf of his client so that the statutory privilege protection can apply to such communication. (Section 128 Evidence Act and Sections 94 & 95 Patents Act)
1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

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

(a) **Lawyers**

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

(b) **Patent Agents**

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

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

(d) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent, is privilege from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

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

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

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**Overseas communications**

1.4 What protection of clients applies in your country against forcible disclosure of communications applying to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

**Answer**

(a) Confidential communication between local IP professionals (lawyers and patent agents) and overseas IP professionals are privilege bearing in mind the more restricted privilege of patent agents and their clients.

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

**Section 131 of the Evidence Act states:** No one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional adviser unless he offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others.
Communication between the client and foreign professional lawyers would come within the scope of the section. There is no Singapore case law to clearly establish if a foreign patent agent who is not a lawyer would come within the ambit of the section. It would be prudent therefore for the client to take the view that communication between the Singapore client and the foreign patent agent may not be covered by privilege.

Scope of protection – qualifications of IP professional advisers

1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to inhouse advisers?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

Answer

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

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

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 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?
communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

Answer

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

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

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

Quality of protection

Local communications
1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

(iii) as to 1.3 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

(iv) as to 1.4 ie the protection applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Answer

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

1.8 Does your Group consider that the protection described in answer to question 1.4 above is of appropriate quality or not, and if not, why not – what are the problems in practice?

Answer

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

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Answer – Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

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

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

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

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

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

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

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

(i) What category is that?
(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?
(iii) As to your answer to sub-para (ii), why?
Answer - Only lawyers (who can render advice in all areas of IP) and patent agents (restricted to patent matters only) are recognized as IP professionals. Privilege from disclosure subsist as explained earlier herein.

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. The public interest and benefits to be obtained in harmonizing the law on privilege from disclosure should not detract from the other public interest and right of countries to legislate laws to suit local conditions and concepts.

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

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

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it?

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

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

2.16 Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section 5 above), does your Group prefer and if so why?

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

Proposals from your Group

2.17 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

Answer – Not applicable

2.18 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

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

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.
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?

Attorney-client privilege exists in South Africa and derives from the common law. It was adopted in South Africa from English law (General Accident, Fire and Life Assurance Corporation Ltd v Goldberg 1912 TPD 494). Privilege is a right which vests in the client and is, for example in the case of an attorney, viewed as part of the duties of the attorney towards his/her client. To understand legal professional privilege it is generally necessary to identify two different circumstances and the different rules that relate to them:
- The first is that all confidential communications passing between lawyer and client and between the client's lawyers in relation to seeking legal advice are privileged. This is known as the legal advice privilege.

- The second, known as the litigation privilege, protects from disclosure communications made between the client and lawyer and between the client or lawyer and third parties for the purposes of obtaining legal advice for actual or contemplated litigation. It protects from disclosure materials prepared for use in litigation.

The distinction is important. Litigation privilege may attach to communications with those categorised as third parties whereas legal advice privilege generally speaking does not.

The principle of legal advice privilege, has been (most notably) set out in the Appellate Division (as it then was) in the case of *The State v Safatsa* 1988 (1) SA 868(A). In *Safatsa* the privileged nature of all communications between an attorney and a client made for the purposes of giving or receiving legal advice between attorney and client was confirmed. In *Mohammed v President of the Republic of South Africa and Others* 2001 (2) SA 1145 (C) it was made clear that the scope of legal advice privilege extends to in-house legal advisors when acting in their capacity as such.

As far as the contributors are aware, almost (but not) all IP professionals (patent attorneys, patent agents and trade mark practitioners) practising in South Africa today are attorneys. There are a few practising patent agents who are not qualified as attorneys. In addition to the common law, section 24(8) of the South African Patents Act, 1978 provides that any person who practices as a patent attorney shall be deemed, for the purposes of any law relating to attorneys, to be practicing as an attorney. Section 24(8) was introduced into the Act at the date of promulgation of the Act (1 January 1979). Section 24(9) provides that any communication by or to a patent agent (the definition of agent includes an attorney) in his or her capacity as such shall be privileged from disclosure in legal proceedings in the same manner as is any communication by or to an attorney in his or her capacity as such. It is understood that the intended effect of section 24(9) was to protect clients by extending the normal rules of privilege that apply to attorneys to their communications with patent agents who are not qualified as attorneys. The section was introduced by way of amendment to the Patents Act in the Patents Amendment Act of 1997. There are no similar provisions in relation to Trade Mark attorneys in the South African Trade Marks Act, 1993. Therefore, in short, all of the principles that apply to lawyers generally apply to all IP professionals.

Thus, in South Africa, the law of privilege is reasonably well developed. Intellectual property rights holders are entitled to claim privilege in respect of all communications with their IP legal advisors (i.e. patent or trademark attorneys or patent agents), provided those communications are made for the purpose of giving or receiving legal advice. This would not only include the most commonly encountered relationship between a client and his legal advisor(s) in private practice but would also extend to in-house legal advisor(s) communicating with his or her client (employer). This may
extend to communications with third parties in circumstances in which litigation privilege applies.

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?

If the employee of the “client” who enters into the communication on behalf of the client is an attorney or an in-house legal advisor and the communications were made for the purposes of giving or receiving legal advice then the client would enjoy privilege. However, if the client is not so qualified then the only privilege which could, in principle, apply to these communications would be that of litigation privilege. Such communications are generally not privileged unless made (i) for the purposes of litigation existing or contemplated; (ii) in answer to enquiries made by the party as the agent for or at the request or suggestion of his or her legal advisor; and (iii) for the purposes of obtaining legal advice from the legal adviser or to enable him or her to conduct the action. Thus, if an “ordinary” client communicates with a third party outside of the ambit of the above (i.e. not in relation to particular litigation) such communications would usually 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?

This is not a communication between legal advisor and client. Thus, the legal advice privilege would ordinarily not extend to these communications and protection would, thus, usually be limited to situations in which litigation privilege applies. However, there may be certain factual situations in which such communications could arguably be held to be privileged to give proper effect to the principles underpinning the privilege rule i.e. in circumstances in which privileged information that passed between the client and the legal advisor was made available to a technical expert to enable the legal advisor to provide the client advice.

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?

In relation to (a), communications between a local IP professional, whether a trade mark attorney or a patent attorney or agent, and an overseas professional would be considered to be privileged if the communications were made for the purpose of giving or receiving legal advice to a particular client (i.e. the local attorney is acting as an
agent for obtaining the advice from the overseas attorney) for the reasons already given.

In relation to (b), if the employee of the client acting on the client's behalf is a legal advisor as discussed above and the communication was made for the purposes of obtaining legal advice from the overseas IP professional the communication would be considered to be privileged in South Africa.

If the representative of the client is not so qualified then the position is not entirely clear since as far as we are aware a clear principle has not emerged from judgments of our Courts as to the basis on which communications between local and foreign parties may enjoy privilege. Although it is undecided, in the context of intellectual property, in South Africa it has seemingly been accepted by the conduct of parties in SA litigation that the standard that should be applied is to consider whether or not such communications would have enjoyed privilege in the terms of the foreign law of the country concerned. In the case of Bioclones (Pty) Ltd v Kirin-Amgen Inc. 1993 BP 556, Eloff JP did not make a finding as to the extent to which it would be permissible to look at foreign legal systems to support the claim of privilege but accepted the submissions made that such communications were made for requesting or giving legal advice relating to patent applications and were privileged in the particular countries in finding that such documents were privileged in South Africa.

Thus, it may be possible to argue that these communications are privileged on the basis that they would enjoy privilege in the jurisdiction in which the overseas IP professional is situated, although this is not entirely clear.

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?

The position has been made clear above. IP advisors in South Africa are all attorneys or patent agents the latter enjoying the same (statutory) rights in respect of privilege that attorneys do. The status extends to in house lawyers. However, there is a distinction drawn between communications made in the capacity as legal advisor, which would enjoy the protection of privilege, and other communications not made in that capacity but in a commercial or managerial capacity, which would not be privileged *(Mahommed vs President of the Republic of South Africa and Others 2001 (2) SA 1145 (C))*.

**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?

There are no specific limitations, exceptions or waivers that we are aware of that are applied in relation to IP advisor privilege. More generally, in *S vs Safatsa* 1988 (1) SA 868, Botha JA said (without deciding whether the rule of
privilege in the circumstances applicable in that case could ever be relaxed):

“That any claim to a relaxation of the privilege …. must be approached with the greatest circumspection”. (page 886)

Thus, South African courts have generally upheld the right to claim privilege and there are very few examples of exceptions being made to it. There are a handful of pre-Constitution cases wherein it was held that privileged documents could be seized by police in terms of the Criminal Procedure Act. The courts have also considered the fundamental right of legal advice privilege against the right under the Constitution that every person has access to any information held by the State. This has involved a balancing exercise of the competing rights.

In Jeeva and Others vs Receiver of Revenue, Port Elizabeth, and Others 1995 (2) SA 433 (SE) the High Court held that a claim to privilege constituted a reasonable and justifiable limitation of the right of access to information. It therefore upheld the claim of privilege. The Court concluded:

“... the Courts should, in my judgment, be inclined to uphold a bona fide claim to legal professional privilege in answer to a claim for access to information”. (page 455)

However, in Van Niekerk vs Pretoria City Council 1997 (3) SA 839 (T) however the Court held that the conclusion, as expressed in Jeeva’s case “may be too generally stated”; that “claims to legal professional privilege differ greatly in their nature, and the ambit of the privilege may be very wide indeed”. The Court stated:

... recourse to legal professional privilege as a defence to a right under s23 should be carefully scrutinised”. (page 849)

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?

(i) the standard of privilege as set out in 1.1 is very comprehensive and considered to be adequate;

(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?

(ii) We consider the scope of the local privilege to be adequate. South African law only recognises privilege in relation to communications between a legal professional and a client. We see the practical benefits of allowing a non-qualified client to be in a position to communicate freely and openly with a third party such as a technical expert, before litigation is contemplated, without fear of later disclosure i.e. for patent prosecution purposes. However, it may be difficult to have such a principle incorporated into SA law which would amount to extending the principle of legal privilege generally to communications between non-professional persons. See also (iii) below.

(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?

(iii) We consider the position to be not entirely clear as indicated in 1.3 and consider that it would be advantageous to have certainty concerning communications between advisor and third parties (outside the litigation privilege protection that already exists) to allow a legal advisor to best promote clients interests by communicating with such third parties, i.e. for patent prosecution purposes, safe in the knowledge that such communications are privileged.

(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?
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?

No. The potential problems in practice are that a non-qualified client may chose to communicate with a foreign patent agent in relation to the prosecution of a patent application in that country only to find that the communication may not be privileged in SA since it did not pass between a legal advisor (as defined in SA) and the client and/or it does not enjoy privilege in the particular country concerned. However, the comments that privilege may still be claimed locally by applying the foreign standard set out in 1.4 should be kept in mind if such foreign privilege exists.

2. Remedies

The ‘device’ to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the ‘dominant purpose’ test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

These matters should be within each country’s discretion.

Judicial discretion to deny protection
2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

The purpose of privilege, which is to allow honest communications between attorney and client would be undermined by such a broad discretion.

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?

The only limitations allowed should be where the fundamental (Constitutional) rights of the other party would be undermined if access to the privileged documents was not granted to the other party or if it falls within a crime or fraud exception.

Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser “to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given”?

Yes.

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?

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?

All “IP advisers” in South Africa (at least those in respect of whom communications are privileged) are attorneys and have qualifications in law or patent agent qualifications.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege
2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

Yes.

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

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?

Countries should be allowed to develop their law and, in so doing, should be entitled to vary or abolish previous limitations on privilege but to allow further limitations to privilege would seem contrary to the principles intended standards.

**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 exceptions (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?

See the answer to 2.12 above.

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No.
The AIPPI proposal compared with the alternative described in Section 5 above

2.17 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?

The AIPPI proposal because it is generally consistent with the legal position in South Africa and would require only minor changes to be made to the position in South Africa already. In addition the section 5 proposal does not seem to address the fundamental issue of international harmony to the extent that this achievable.

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.

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.

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?

No.

__________________________________

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.
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.

Prior Remarks:

The Spanish Constitution establishes that professional secrecy must be regulated by “law” (article 24.2). As a result, Industrial Property Agents are not included given that there is no regulation with the status of a specific law covering this right, something which does exist for lawyers who are exempt from testifying about certain matters they may know of through professional secrecy pursuant to article 437.2 of the Organic Law on the Judiciary. Article 64 of Royal Decree 2245/1986 approving the Implementing Regulations of Law 11/1986 mentions professional secrecy as an obligation of Industrial Property Agents to clients but does not develop the content. The same is the case with articles 7 and 47 of Royal Decree 278/2000 approving the Statutes of the Official Association of Industrial Property Agents.

Article 134.1 d) of the Munich Convention must also be mentioned. Although its scope of application is limited to proceedings before the European Patent Office, it includes the right to refuse to disclose communications exchanged with clients or with
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?

The disclosure of secrets is protected only in cases in which there is a legal obligation to keep secret and not testify, such as in the case of lawyers. There is no “privilege” when there is only a simple obligation of confidentiality, as is the case with non-lawyer industrial property agents.

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?

Communications directly between clients and third parties are not protected. It is advisable to communicate with professionals who are legally obliged to secrecy (lawyers) acting as intermediaries, even knowing that the protection is not absolute.

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?

Communications with IP professionals who are lawyers are protected regardless of whether those communications are with a client or with a third party in matters regarding legal assistance, albeit with the possible exception mentioned above. The remaining communications of non-lawyer IP professionals are not protected.

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?
In the above terms,

A) Communications between local professionals legally obliged to secrecy (lawyers) and clients or other IP professionals throughout the world would be protected.

B) Foreign IP professionals (except lawyers) are not currently recognized as having “privilege” and neither are their communications with their Spanish clients privileged.

However, if the litigant requests the other party to exhibit correspondence exchanged with his lawyer or makes such a request of the lawyer himself, article 328 of the Law on Civil Proceedings allows the judge to order disclosure although we have no knowledge of this having occurred in any case.

**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?

Only in relation to IP professionals who are lawyers. As regards in-house lawyers and secrecy in relation to other people in the company, protection is more than doubtful in view of decisions by the Courts of the European Union.

(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?

There is no protection.

(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?

The only communications protected are those of IP professionals who are lawyers.
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?

A) Communications are protected when the Spanish IP professional is a lawyer.

B) Communications do not enjoy privilege if the IP adviser is not in Spain.

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?

Cases of terrorism, money laundering and crimes threatening or endangering people’s life, integrity, freedom or security are always excepted.

Additionally, as mentioned above, the Law on Civil Proceedings accords a certain discretion to judges.

(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?

There is no protection for direct communications between clients and third parties who are not legally obliged to secrecy.

(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?

The reply is the same as under (i).

(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?
A) The same limitations as under point (i).

B) Communications between clients and overseas IP advisers are not protected.

**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?

Inappropriate quality. Privilege should be extended by law to industrial property agents with degrees in fields other than law who provide services giving rise to confidentiality which must be protected so that advice may be given with guarantees.

(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?

Not of appropriate quality because they are understood as being communications with no special protection. Given that they are instrumental to giving proper advice, they should be protected.

(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?

Appropriate quality when the IP adviser is a lawyer because his communications with a third party will be completely protected in those cases related to the legal advice given to his clients, always under the general conditions mentioned 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?

Inappropriate quality. A foreign IP adviser, regardless of whether he has studied law, is recognized as a lawyer in Spain only if he is authorized to act before the Spanish courts.

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?

The “dominant purpose” test should be applied in an open manner with the exceptions the law currently contemplates such as terrorism, money laundering and damage to persons.

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?

Imposing strict measures on judges’ discretion in each country by limiting specific cases would not facilitate reaching an agreement on this point. It would seem easier for each country to recognize and apply the “dominant purpose” test as the main method. The interpretation of this test will always contain an element of discretion for judges.

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?
Yes. By means of reasoned decisions.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

The lack of scope for discretionary but reasoned decisions by judges, when reality is so rich in nuances, could be seen as an “exorbitant privilege” (a hateful word).

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?

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Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

Yes.

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?

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

There is no category of Industrial Property Agent or IP adviser which requires no qualification.

(i) What category is that?

Non-existent.

(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?

Not applicable.

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

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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?

As a “civil law country”, Spain protects communications of lawyers with third parties as well as with any technical advisers necessary for giving the advice regardless of whether its purpose is defense (litigation privilege) or for advising the client (lawyer-client privilege). The remaining countries should extend the current typical scope of protection, especially protection for
consulting necessary third parties other than the client when it is necessary for giving the advice or making the defense in “common law countries”.

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?

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?

We agree provided it did not reduce its scope.

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?

That it not reduce the content of the standard, further restricting prosecution.

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 exceptions (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 for 4.28 above also set limits in this case?

That it not be an indirect means of removing the content from the general principle.

2.16 Since the introduction of the 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 details?

No.
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 proposal to the extent that each country would clearly specify which legal advisers would benefit from the treaty. However, we do not have a clear position with respect to the matter of in-house counsel. The General Court of the European Union (decision dated 17 September 2007), cases T125/03 and T253/03 (Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd) and the AM&S decision (case 155/79) delimits protection to the extent that the lawyer must be independent, i.e. he must not be obliged to his client because of his relationship as employee.

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.

Not applicable.

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.

No new proposals by the Group.

2.20 With the introduction if protection against forcible disclosure of IP professional advice or any other remedy as discussed above into the 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?

We do not expect that the introduction of the measures discussed above would have any adverse effects on Spanish law; rather, the contrary would be the case.

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.
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?
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
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.
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.
I submit the following report.

1. **Q.199 - Questionnaire**

   **Present position**

   **Local position**

   1.1 **Protection of communication between clients and IP professionals**

   The Federal Law on Patent Attorneys of March 20, 2009 (BBl 2009, pages 2013 ff.) will enter into force on January 1, 2011 (PAG). According to Article 10 PAG patent attorneys and their assistants will be subject to the same protection of professional secrecy as lawyers as of January 1, 2011. Article 321 point 1 first sentence of the Federal Criminal Code (FCC) (SR 311.0) and Article 171 para 1 of the Law of Criminal Procedure (BBl 2007, pages 6977 ff.) are amended accordingly. The protection emanating from Article 321 FCC has not been applied to in-house lawyers by jurisprudence.

   The Swiss Law on Civil Procedure of December 19, 2008 (BBl 2009, pages 24 ff.) (LCP) will enter into force on January 1, 2011. It will replace the Law on Federal Civil Procedure of December 4, 1947 and the 26 existing Cantonal Laws on Civil Procedure. According to Article 156 LCP the courts are bound to protect business secrets. According to Article 160 para 1 lit. b LCP, documents related to correspondence with the attorney need not be produced. The provision has not been extended to patent attorneys. However, patent attorneys may refuse to produce documents based on Article 163 para 1 lit. b and Article 166 para 1 lit. b LCP.
because the breach of confidentiality would be punishable under the amended Article 321 Federal Criminal Code. The communication with in-house lawyers and patent attorneys is protected by Article 156 LCP.

1.2 Protection of communications between clients and third parties

The answer to this question is complex. If the technical expert is a lawyer or patent attorney, the communication is protected by the legal provisions stated under point 1.1 above. Otherwise the client would have to invoke Article 156 LCP concerning protection of business secrets (in general).

1.3 Protection of communications between lawyers/patent attorneys and third parties such as technical experts

These communications are protected under Article 321 point 1 first sentence Federal Criminal Code (as amended) and enjoy, therefore, the privilege of Article 163 para 1 lit. b and Article 166 para 1 lit. b LCP.

Overseas communications

1.4 Protection of communication with overseas professional

Communications between local IP professional and overseas IP professionals are protected under the legal provisions stated in section 1.3 above. The law on patent attorneys is only applicable to persons that give advice or represent clients in patent matters in Switzerland (Article 1 para 2 PAG). The communications between Swiss clients and foreign patent attorneys are presumably only protected as business secrets under Art. 156 LCP, and not under Article 10 PAG unless the advice is given in Switzerland.

1.5 Scope of protection

The full protection emanating from Article 321 FCC is applicable to independent lawyers and patent attorneys doing business in Switzerland. It is presumably also applicable if patent attorneys give advice in design or trademark matters. The activities of persons that instruct exclusively trademark and design matters would fall outside the scope of Article 1 para 2 PAG and Article 321 FCC. Since the new legislation is not yet in force and there is no jurisprudence, no reliable opinion can be expressed on issues not specifically regulated.

Limitations and exceptions

1.6 Limitations

For the protection based on Article 321 Federal Criminal Code there is basically no exception. It is, however, held to be inapplicable to in-house lawyers by jurisprudence. For trade and business secrets protected by Article 156 LCP and by substantive law provisions such as Federal Code of Obligations of March 30, 1911 (CO) (SR 22), Article 321a (employment), Article 418 lit. d (agency), Articles 697 and 730 (corporation), and Article 857 (cooperative) and Law against unfair Competition of December 19, 1986 (LUC) (SR 241), Article 6, there are exceptions in particular in connection with criminal investigation or overriding public or party interest. In connection with criminal law investigation the right to withhold information is
narrowly defined. According to Article 171 para 1 Law of Criminal Procedure professional secrets are only protected within the framework of Article 321 FCC. The exception for public or overriding third party interest is complex because there is no single provision of law that may be invoked. The practical importance is limited.

**Quality of protection**

**Local communications**

1.7 **Quality appraisal of protection**

(i) Communication between clients and IP professionals: With respect to independent lawyers and patent attorneys, the protection is excellent (Art. 321 FCC). With respect to pure trademark agents and in-house lawyers (and presumably patent attorneys as well), the protection is relatively weak (Article 6 Law against unfair Competition, Article 156 LCP).

(ii) Communication between clients and third party experts other than patent attorneys or lawyers: Relatively weak protection by substantive law (e.g. Article 6 Law against unfair Competition and Article 156 LCP).

(iii) Communication between independent lawyers or IP professionals and third parties, e.g. experts: Protection is excellent (Article 321 FCC).

**Communications with overseas IP advisers**

1.8 The protection of communication between independent local lawyers or IP professionals and overseas IP professionals is excellent based on Article 321 FCC. The protection of communication between clients as well as in-house lawyers (and presumably patent agents) and overseas IP professionals is weaker (Article 156 LCP and Article 6 of the Law against unfair Competition).

2. **Remedies**

**Limitations**

**Tests such as the 'dominant purpose' test.**

2.1 Switzerland has two standards of protection:

(i) The protection under Article 321 Federal Criminal Code (FCC) extends to all information to which the lawyer or patent attorney becomes privy in the exercise of his profession. There is no restriction that would exclude any kind of document (provided it is linked to the exercise of the profession).

(ii) The protection under Article 156 LCP looks exclusively at the document. If it contains a business secret, it is protected, otherwise not.

2.2 Based on the above, there is no need for a further standard and in particular not for a further limitation.
Judicial discretion to deny protection

2.3 There should be no discretion.

2.4 It is difficult to imagine a situation where the disclosure of secrets is necessary to render justice. What is conceivable is a rule that a judge may ask a party to disclose a secret protected by Article 156 LCP to the judge alone in order to facilitate the rendering of justice (in arbitration protected evidence is sometimes disclosed to the attorney of the opposite party – under agreement of confidentiality). An exception addressed to the lawyer or IP professional for secrets protected by criminal law under Article 321 FCC is not conceivable at all.

2.5 In civil procedure the judge may ask the parties (not the lawyers or IP professionals) to disclose documents deemed secret under assurance of preservation of secrecy to the court.

Qualifications required of IP advisers

2.6 There is no opposition against this standard. However, it should be pointed out that under Swiss law only patent attorneys enjoy the protection of professional secrets like lawyers. There is no corresponding protection for pure design or trademark agents.

2.7 Not applicable.

2.8 The new law concerning patent attorneys describes the heavy conditions to be met in order to be allowed to use the title "Patent attorney". It is somewhat extraordinary that lawyers specialized in IP may not call themselves "Patent Attorney" (Article 2 LPA). Only people with a title in engineering or natural science may qualify as "Patent Attorney". If registered with the European Patent Office, however, lawyers may call themselves "European Patent Attorney". The new law concerning patent attorneys (PAG) is applicable to all persons giving advice or acting as agent in patent matters who qualify to bear the title of "Patent Attorney" or "European Patent Attorney" (Article 1 LPA). There are thus no patent attorneys without qualification protected by the new legislation.

Scope of protection against forcible disclosure – difference between lawyer-client and litigation privilege

2.9 There should be no limitation to the protection of information with which lawyers or patent attorneys have been entrusted. Otherwise there is no opposition in principle to the proposed concept.

2.10 Not applicable.

2.11 Yes.

2.12 None

Exceptions and waivers

2.13 No. If the aim is to harmonize the protection, the exceptions have to be harmonized as well. That means that if in any given country the exceptions presently granted by the applicable law exceed the concept underlying the harmonisation, the law has to be changed within a period of grace.
2.14 Yes, of course.

2.15 We doubt whether Article 30 TRIPS is of any help. If it is agreed that harmonisation of protection by necessity requires a harmonisation of exceptions as well, it will be necessary to define the exceptions allowed (in as general terms as possible) for each category of protection.

2.16 Since the law enters into force on January 1, 2011, there is no case law yet.

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

2.17 The AIPPI proposal would be more effective and merits priority.

Proposals from the Swiss Group

2.18 In Switzerland the introduction of the Federal Law concerning Patent Attorneys is definitely a big step forward. The open questions in Switzerland are:

(i) the protection of trademark agents and trademark and design matters,
(ii) the protection of in-house lawyers and in-house patent attorneys by jurisprudence.

(The application of Article 321 Federal Criminal Code and the protection resulting from it to in-house lawyers and in-house patent attorneys is not excluded by the text of the law. The non-applicability results from its interpretation by jurisprudence.) On an international level matters are complicated enough without the confusion a further proposal is likely to create.

2.19 There are no further comments.

2.20 There may be a conflict with the present interpretation of the scope of Article 321 FCC in Switzerland according to which the protection does not apply to in-house lawyers. It would require a further in-depth analysis to determine if and in what respect the text of the national legislation would need to be amended. Whenever Switzerland adheres to a treaty, the implementation usually takes the form of an act of law in connection with which relevant provisions of national laws are amended, if necessary.

Final remark: The Swiss Group did not yet have an opportunity to formally approve the above report yet.
Questionnaire Q199

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

January 19, 2010

National Group: Thailand

Contributors: Chavalit Uttasart/ Kowit Somwaiya / Pattarakorn Tangkaravakun/ Panisa Suwanmatajarn

Date: March 2010

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?


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 (e.g., 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. 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?

(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?

(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?

(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 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 (e.g., dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (e.g., crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?
(i) as to 1.1 is 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.
Questionnaire Q199

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

January 19, 2010

National Group: [AIPPI TURKEY]

Contributors: [Kerim Yardimci, Aydin Deris, Onder Ozden]

Date: [May 19, 2010]

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?

Current situation of the profession must be explained before answering this question. There are three different titles, which can be cumulative in order to be IP professional in this country:

1. Trademark Attorney: Are authorized to use the title only those who have passed the exam in respect of trademark/geographical indication held by the Turkish Patent Institute (T.P.I.)
and who are recorded on the trademark attorneys’ registry subject to paying the yearly insurance and attorney fees.

2. Patent Attorney: Are authorized to use the title only those who have passed the exam in respect of patents/designs held by the Turkish Patent Institute (T.P.I.) and who are recorded on the patent attorneys’ registry subject to paying the yearly insurance and attorney fees.

3. Attorney-at-law: Are authorized to use the title only those who meet the requirements to be attorney-at-law according to the Code of Attorney-at-law and who are recorded on the bar registry subject to paying attorney fees.

<table>
<thead>
<tr>
<th></th>
<th>Capacity to act before T.P.I.</th>
<th>Capacity to act before Court of Justice</th>
</tr>
</thead>
<tbody>
<tr>
<td>Trademark Attorney</td>
<td>For trademark and geographical indications</td>
<td>None</td>
</tr>
<tr>
<td>Patent Attorney</td>
<td>For patents, utility models and industrial designs</td>
<td>None</td>
</tr>
<tr>
<td>Attorney-at-law</td>
<td>None</td>
<td>For all kind of legal matters including complete IP legislation</td>
</tr>
</tbody>
</table>

For the attorney-at-laws, according to the article 36 of the Code of Attorney-at-law entered into force on 19.03.1969, it is forbidden to disclose any information obtained within their capacity of attorney-at-law even when such disclosure is expressly permitted by the client.

As for the trademark/patent attorney however, no provision with respect to professional secrecy exists within the article 30 of the Law no. 5000 with respect to Institution of the T.P.I. mentioning the qualification to be a trademark and/or patent attorney.

Therefore, it is possible to ascertain that there is professional secrecy -thus protection against forcible disclosure- for attorney-at-law acting before the courts or for a contemplated litigation or for IP legal advice regarding the validity and scope of protection - independent of the question whether the legal advice is provided with respect to the office action involved in administrative level or judicial level. For ease of reference, we may call them “Category Z” of IP professional.

As to the (1) trademark attorney, (2) patent attorney, and (3) in house attorney-at-law working as employee (thus not independent), there seems to be no professional secrecy -thus no protection against forcible disclosure at first sight. That being said, according to the Article 239 of the Turkish Criminal Code, which can be relied upon as a general rule against forcible
Disclosure of communications relating to IP professional advice rendered by the professionals mentioned in the preceding sentence;

**Disclosure of Confidential Information or Documents as Trade Secret, Banking Secret or Client Secret**

Article 239 – (1) A person who delivers or discloses to unauthorized parties the confidential information or documents comprised of trade secret, banking secret or client secret, which are known to him because of his qualification or mission, profession or art, shall be imprisoned up to three years and sentenced to a monetary fine up to five thousand days upon complaint. In case of delivery or disclosure of such information or documents to the unauthorized persons by those who obtain them by illegal means, the penalty shall be enforced in accordance with this paragraph.

(2) The provisions of the first paragraph shall be enforced for the scientific discoveries and inventions or information susceptible to industrial application.

(3) In case of disclosure of such secrets to a foreigner not resident in Turkey or their officers, the penalty to be executed on the offender shall be increased in the rate of one thirds of the due penalty. No condition of complaint shall be sought in such case.

(4) A person, who forces another party to disclose the information and documents under the scope of this article using physical violence or threatening, shall be sentenced to imprisonment for three to seven years.

Considering that there is not a single court decision with regard to the application of the Article 239, it is not possible to ascertain that this provision constitute a sufficient protection against forcible disclosure (request from common law countries where discovery is available) for the second category of IP advisers. For ease of reference, we may call them “Category X” of IP professional.

In addition to the above; communications between the European Patent Attorneys acting in their capacity - i.e. with regard to preparation proceedings and validity/infringement/scope of protection of European Patent - and the client or any other person is privileged in accordance with article 134a(1) EPC and rules 153 EPI.

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?

Protection of communications between clients and third parties (such as technical experts) against forcible disclosure shall be provided by the implementation of Article 239 of the Criminal Code. Again there is no court decision with regard to this point.

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?

Communications between the “Category Z” and Technical Experts are protected.

For communications between the “Category X” and Technical Experts, please refer to question 1.1 and question 1.2.

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?

(a) answer of the question 1.1. would apply based on territoriality principle.
(b) no protection.

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?
   Please refer to the answer of the question 1.1.

(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?
   Please refer to the answer of the question 1.2.

(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?
   Please refer to the answer of the question 1.3.
(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? Please refer to the answer of the questions 1.4.

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?
No limitation/exceptions for “Category Z”. As for the “Category X”, since there is no specific provision for the protection against forcible disclosure, it is not possible to determine whether there is any the limitation/exception.

(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?

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?

Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure. Therefore, there is a need for specific article in the law at least for trademark and patent attorneys.

(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?

In the view of the absence of any established jurisprudence there is legal uncertainty whether the Article 239 provide sufficient protection against forcible disclosure.

(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?

Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure.

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?

Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure.

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?

The dominant purpose test is irrelevant for our country so much that the only communications that are surely privileged are with respect to “Category Z” i.e. in case of litigation or contemplated litigation.

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?

Please refer to the answer of the question 2.1.

Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

No.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

It may lead to the misuse of the protection unless judicial discretion can be exhaustively listed.

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?

Exhaustive list of judicial discretion must be enumerated, if possible, in order to avoid any abuse.
Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

Yes.

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?

-

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?

Not applicable.

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?

Such a distinction is not required in our country. However, for the sake of harmonization, the Turkish Group agrees that the standard should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law.

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?

-

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 to the right to abolish a limitation or the right to vary if it further restricts the limitation.

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?

Please see above.

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?

Only right to broaden the scope of the limitation should not be allowed.

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

No.
The AIPPI proposal compared with the alternative described in Section 5 above

2.17 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?

AIPPI proposal is preferable as the alternative in Section 5 would create a mitigated solution.

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.

Not applicable.

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.

- 

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?

- 

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.
ABSTRACT

The situation regarding the protection against forcible disclosure of communications with respect to IP professional advice depends on the title of the IP professional adviser. The professional secrecy exists for attorney-at-laws, however due to absence of any specific legislative act, the situation of trademark and patent attorneys with respect to the protection against forcible disclosure remain ambiguous. The only provision available that can protect the client from forcible disclosure is the general provision of the Turkish Criminal Code. However due to the absence of any decision regarding the application of the said provision, it is not possible to anticipate what would be the scope and the extent of protection and who would be covered from this provision. The Turkish Group believes that in order to create legal certainty, it would be appropriate to specifically legislate the professional secrecy for trademark and patent attorney at national level.

At international level, the Turkish Group believes that a single international instrument such as proposed by AIPPI would be preferable compared with non-binding recommendation or unilateral, bilateral or multilateral solution as the latter would hardly make the protection against forcible disclosure more predictable.

Die Türkische Gruppe glaubt, auf dem internationalen Niveau, ein einziges internationales Instrument wie dasjenige vorgeschlagen von AIPPI könnte einer nicht bindenden Empfehlung oder einer einseitigen, zweiseitigen oder mehrseitigen Lösung vorgezogen werden, da die letzte die Vorausschubarkeit des Schutzes gegen die gewaltsame Bekanntmachung kaum erhöhen würde.
RESUME

La situation concernant la protection contre la communication de divulgation forcée quant au conseil professionnel de PI dépend du titre du conseiller professionnel de PI. Le secret professionnel existe pour les avocats. Cependant la situation des mandataires de marque et de brevet quant à la protection contre la divulgation forcée reste ambiguë due à l’absence de toute législation spécifique pour le mandataire de marque et de brevet. La seule disposition disponible qui peut protéger le client contre la divulgation forcée est la disposition générale du Code Criminel Turc. Toutefois, à cause de l’absence de toute décision concernant l’application de ladite disposition, il n’est pas possible d’anticiper ce quelle va être la portée et l’étendue de la protection et qui va être protégé par cette disposition. Le group turc estime qu’il sera approprié de légiférer spécifiquement le secret professionnel pour le mandataire de marque et de brevet au niveau national afin de créer une certitude légale.

Au niveau international, le group turc estime qu’un seul instrument international tel que proposé par AIPPI doit être préférable par comparaison à la recommandation non obligatoire ou à la solution unilatérale, bilatérale ou multilatérale vue le fait que les dernières ne vont pas rendre la protection la communication de divulgation forcée plus prévisible.
Questionnaire Q199

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

January 19, 2010

National Group: UK

Contributors: David Musker, Sarah Johnson, Trevor Cook, Nicholas Macfarlane

Date: 25 March 2010

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 on the IP professional.

(a) Legal professional privilege gives a client the right to withhold from disclosure communications between the client and his lawyer. The lawyer can be a solicitor or barrister (or, in Scotland, advocate), or a foreign lawyer.

Legal professional privilege at common law is divided into two categories: legal advice privilege and litigation privilege.
Legal advice privilege applies to confidential communications between a client and his lawyer, made for the purpose of seeking or obtaining legal advice or assistance. Legal advice privilege can apply both in contentious and non-contentious situations, provided the communication is made in the appropriate legal context.

Litigation privilege applies in the context of actual or reasonably contemplated “litigation” (which, under s103 and s105 of the Patents Act 1977, is extended to include patent proceedings before the Patent Office, the EPO and WIPO), and attaches to confidential communications made between a client and his lawyer, or between a client or his lawyer and a third party, provided that the communication came into existence for the dominant purpose of obtaining information or advice in connection with litigation, or of conducting or aiding in the conduct of such litigation.

(b) Statutory legal professional privilege applies to such communications (insofar as they relate to defined areas of IP) between a client and a UK/EPO registered patent attorney (s280 Copyright Designs and Patents Act 1988) or a UK/OHIM registered trade mark attorney (s87 Trade Marks Act 1994).

(c) No protection applies to such communications with others, unless in the context of actual or contemplated litigation (see answer to (a) above).

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: Outside the context of actual or contemplated litigation (see explanation of litigation privilege at 1.1(a) above), no protection is available at common law for such communications between clients or lawyers or UK/EPO registered patent attorneys or UK/OHIM registered trade mark attorneys and third parties: *Wheeler v Le Marchant* ((1881) LR 17 Ch D 675 CA). Following *Three Rivers (No. 5)* ([2003] EWCA Civ 474; [2003] QC 1556), the "client" within a company is narrowly defined as those persons within the organisation specifically tasked with requesting and obtaining legal advice. Thus, communications between the "client" within an organisation and other employees of the same organisation may be regarded as communications with third parties and may 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: Outside the context of actual or contemplated litigation (see explanation of litigation privilege at 1.1(a) above), no protection is available at common law for such communications between IP professionals and third parties, and the statutes make no extension to that.
Overseas communications

1.4 What protection of clients applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Answer:
(a) Communications relating to advice sought by a client from a foreign IP professional via a local IP professional would be protected by legal professional privilege if:
(i) the foreign IP professional is a lawyer, and
(ii) the local IP professional is merely acting as an agent of communication: McGregor ([1978] FSR 353).
They would also be privileged if the foreign IP professional is a UK/European registered patent attorney or a UK/OHIM registered trade mark attorney.
(b) Communications relating to advice sought by a client from a foreign IP professional directly would likewise be protected if the foreign IP professional is a lawyer: McGregor (or a UK/European registered patent attorney or a UK/OHIM registered trade mark attorney).

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 protections above apply as follows to different classes of
advisors:

(a) Solicitors, barristers and Scottish advocates (and foreign lawyers) are protected by privilege at common law. Registered Foreign Lawyers and Registered EU lawyers (i.e. those resident in the UK) are treated in the same way.

(b) UK registered patent attorneys and UK registered trade mark attorneys, together with those European patent and trade mark attorneys registered at the EPO and OHIM respectively, are protected by a set of similar statutes. These grant protection to communications relating to the following areas: any matter relating to the protection of any invention, design, technical information or trade mark or as to any matter involving passing off (for patent attorneys) and any matter relating to the protection of any design or trade mark or as to any matter involving passing off (for trade mark attorneys).

(c) Employed professionals in any of these categories are treated the same as those in free practice to the extent that they are acting as independent professional advisors (rather than, say business executives).

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).

(c) Capacity-as-such. Only advice sought from a professional acting "in role" as an independent legal advisor is protected.

(d) For litigation privilege to apply, the communication must satisfy the dominant purpose test set out in the answer 1.1(a) above.

(e) Following the House of Lords in Re L [[1997] AC 16], litigation privilege is confined to "adversarial proceedings", and not those which are investigative, inquisitorial or merely fact gathering. However, in Three Rivers (No. 6) ([2004] UKHL 48; [2005] 1 AC 610), the House of Lords has said that legal professional privilege will apply to advice and assistance (including presentational advice) given to parties whose conduct, reputation or integrity may be the subject of criticism by an inquiry.

(f) As explained at 1.2 above, following Three Rivers (No. 5) the "client" for the purposes of assessing whether a communication is a privileged lawyer/client communication where the client is a corporation is narrowly defined and restricted to only those persons tasked with the seeking and obtaining of legal advice.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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) Yes, satisfactory in practice - due partly to the restricted availability of disclosure/discovery in litigation - although a few loose ends (concerning the definition of protected matter) could be improved.

(ii) Yes.

(iii) Yes: s103 of the Patents Act 1977 extends litigation privilege to patent proceedings, and therefore, communications with third parties in this context are protected. We feel this gives a satisfactory level of protection to communications between clients and third parties.

(iv) No. An extension or clarification in this respect would be desirable, to deal with the case where the foreign IP professional is not a lawyer. Lawyers generally experience international comity, however other IP professionals do not.

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. Thus, for example, communications in the international phase with the foreign patent attorney prosecuting a PCT application designating the UK in the international phase, or the foreign trade mark attorney prosecuting a Madrid application designating the UK, would lack privilege where those relating to the national phase, or an equivalent national application, would benefit from it.

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.
2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Answer: Yes.

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.

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 the court, the patent or trade mark office or equivalent government body, so as to imply a control relationship justifying public trust in the advisor. Suitable advisors in the UK are under dual obligations of confidentiality/professional secrecy, and good faith towards the Office with which they are registered. The former is inherent in the rational for privilege and the latter is a safeguard ensuring its fair operation.

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) There is no reservation in the UK on provision of IP advice (or other legal advice), or on provision of IP services.
(ii) No. As outlined in 1.1 above, in the UK, privilege protection is limited to lawyers or registered IP advisors (UK/EPO registered patent attorneys and UK/OHIM registered trade mark attorneys).
(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.

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.

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 proposal.

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: There are a number of separate problems to be addressed, with varying levels of importance, and varying likelihoods of success. It may be difficult to produce a complete definition of privilege in IP cases, and even if that is achieved, it may deter accession by countries who do not wish to adopt a special regime for privilege in IP cases different to that applicable in general. We doubt that it will be possible to persuade the UK to do so, for instance. The most pressing problem appears to be to persuade those common law countries which do have privilege laws to extend to foreign patent attorneys the equivalent protection that they grant their own – precisely as they generally do for lawyers. There seems much less need to persuade civil law countries to do the same, since (lacking a discovery system) they will not generally disclose the advice communications with foreign patent attorneys in any event. As common law countries have a largely common understanding of privilege a redefinition is unnecessary and as civil law countries will not be applying the concept in practice they too do not really need it defined in detail. To summarise: 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.
Questionnaire Q199

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

National Group: United States

Contributors: David W. Hill (Chair)
Robert Wells

Date: April 30, 2010

1. Q.199 - Questionnaire

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?

Answer: The United States traces the origins of its privilege doctrines back to their earliest common law roots. The attorney-client privilege that protects clients against forcible disclosure of communications relating to IP professional advice is subject to the laws of the 50 individual states as well as federal law. As a result, the applied qualifications for, and extent of protection may vary depending on the jurisdiction in which the issue is raised.

Generally, confidential communications between a U.S. lawyer and her client, made for the dominant purpose of providing legal advice, are presumptively protected from forcible disclosure. A U.S. lawyer is distinct from other IP professionals such as U.S. patent agents. A U.S. lawyer is defined as one who is a member in good standing of a state bar.

There is no statutory privilege for communications between non-lawyer IP professionals and their clients. In some U.S. jurisdictions, however, courts have found such communications to be entitled to privilege.

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 of clients with third parties are protected only to the extent that the third party is acting at the direction of a U.S. lawyer for the purpose of providing legal advice. Examples of protected communications between a client and third party might include those with a lawyer’s office staff, or those of a U.S. patent agent acting under the direction of a U.S. lawyer.

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:** Communications of a U.S. lawyer with third parties are protected to the extent that a communication is for the dominant purpose of providing legal advice to a client.

**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?

**Answer:** The communications of a U.S. lawyer with an overseas IP professional, made for the dominant purpose of providing legal advice to the U.S. lawyer’s client are protected from forcible disclosure. No statutory protection exists in state or federal law for the communications of a U.S. non-lawyer IP professional and a third-party, making such protection a matter the common law in each jurisdiction. While some U.S. courts have accorded protection from forcible disclosure of communications between U.S. non-lawyer IP professionals and their clients, the courts have not considered protection for communications of a non-lawyer IP professional with an overseas IP professional.

U.S. courts apply a principle of international comity to attorney-client privilege issues, wherein courts often accord the same privilege to which a foreign IP professional would be entitled in his or her native jurisdiction. This principle then, conceivably covers a foreign IP professional’s communications, both with U.S. clients, and with U.S. IP professionals, so long as the foreign IP professional is entitled to such protection in his or her native jurisdiction. However, the law of the 50 States varies such that the abstract application of international comity to any given circumstances is not productive.

**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?

Answer: See 1.1-1.4 above.

Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges’ discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?
Answer: The protections described in response to questions 1.1-1.4 are subject to the following limitations:

(a) **Dominant purpose**: Privilege applies only insofar as the communication is made for the dominant purpose of providing legal advice. Consequently, if the IP professional is not acting primarily as a U.S. lawyer, or under the direction of a U.S. lawyer, the communication will not be protected.

(b) **Waiver**: The protection of a communication may be waived by a client, either explicitly, or by failing to take reasonable precautions to maintain the confidentiality of the communication (e.g. through intentional or careless disclosure of the communications to third-parties).

(c) **Crime-fraud exception**: When communications between an IP professional and client are made for the purpose of committing a crime or fraud, the privilege is rendered moot. This is the case whether the client consults a lawyer for the purpose of obtaining assistance to engage in a crime or fraud, or later uses the lawyer's advice to engage in a crime or fraud.

Quality of protection

Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

Answer: Yes, with respect to U.S. lawyers. The protection for communications involving non-lawyer IP professionals, such as U.S. patent agents, is not yet well defined across the various jurisdictions of the United States. To the extent that this issue arises in U.S. courts, additional clarity and uniformity across jurisdictions is desirable.

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: Yes, in principle. The general principle of international comity articulated by some U.S. courts is desirable and sufficient. As explained above, however, the application of this principle is not yet well defined or uniformly implemented across all U.S. jurisdictions. To the extent that this issue arises in U.S. courts, additional clarity and uniformity across jurisdictions is desirable.

2. Remedies

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: Protection should be limited to those documents, or those portions of a document, that constitute either communications requesting legal advice, or communications providing such legal advice. This is consistent with the purpose of the protection, which is to facilitate full and frank discussion between a client and legal advisors or the client related to the obtaining of legal advice. Documents, or portions of a document, that contain facts relevant to a legal dispute, but do not contain or constitute such communications, should not be subject to protection.

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: Yes.

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: Questions as to which documents or communications are subject to protection are often difficult to resolve. Courts should have some discretion to deny protection when required in the interests of justice.

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: No answer required.
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. At a minimum, the IP advisor should be registered with some recognized body within the foreign country to provide the IP advice in relation to which the question arises.

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: See answer to 2.6, above.

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

(i) What category is that?
(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?
(iii) As to your answer to sub-para (ii), why?

Answer: No answer required, since all categories of IP advisers require qualification.

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.

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: No answer required.

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:** It is not clear at this time what limitation should apply to the right to vary or abolish a previously applied limitation. Further discussion and consideration is needed on this issue.

**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, 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?

**Answer:** It is not yet clear what limitation should apply to the right to vary or abolish a previously applied exception or waiver. Further discussion and consideration of this issue is needed.

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?

**Answer:** Parties can potentially abuse the existence of the protection by attempting to withhold the production of documents or other evidence on the basis of the protection allowed by the law. Courts have dealt with this problem by such techniques as inspecting the documents on an *in camera* basis, where the court reviews the documents in question and decides whether they are subject to the protection.

**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?

Answer: No consensus has been reached yet on this question.

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.

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.

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?

Answer: Introduction of such protection would likely have a positive effect on the willingness of clients to discuss their legal problems and needs for legal advice with IP professionals, in particular, with patent agents.
Questionnaire Q199

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

January 19, 2010

National Group: [Venezuelan Association of Patent and Trademark Agents (COVAPI)]

Contributors: [Maria M. Nebreda]

Date: [May 20, 2010]

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?

All communications are Attorney client Privilege information and they are protected by the Law that regulates the exercise of the Law Career and The Lawyers Code of Ethics.

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?
A court order must be obtained

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?

A court order is needed

**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?

A court order is needed as well

**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?

They are protected under the Law that regulates the exercise of the Law Career and The Lawyers Code of Ethics.

(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?

It is necessary a court order

(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?

A court order is necessary
(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?

A court order is necessary

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) A court order is necessary

(iii) 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?

(iv) A court order is necessary

(v) 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?

(vi) A court order is necessary

(vii) 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?

A court order is necessary

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?

We consider the protection appropriate
(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) 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?

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 consider the protection appropriate

2. Remedies

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a ‘device’ could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations

Tests such as the 'dominant purpose' test.

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

Yes ,our Group agree
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?

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?

In our country is impossible since the court order is compulsory

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?

See above

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?

No it is not possible as explained above

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'?

2.7 Yes we agree

2.8 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?

Legally it is not possible since a court order is necessary

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

(i) What category is that?

In some administrative issues it does not needed to be a qualified IP adviser

(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?
It is difficult in Venezuela to disclose client privilege information

**Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege**

2.10 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

2.11 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?

Currently it is difficult in Venezuela any amendment

2.12 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

2.13 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?

**Exceptions and waivers**

2.14 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 exceptions (such as the crime-fraud exception) and waivers which are already part of the law of that country.

No.

2.15 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?

No
2.16 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?

There is no Agreement with the Venezuelan group and discussions continue in this respect.

**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?

**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.

The group although do not entirely agree with all the matters it believes in the proposal made by the AIPPI.

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.

________________________

**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.
Questionnaire Q199

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

National Group: Miembro Independiente de AIPPI - Américas

Contributors: Nora Morgade - Uruguay

Date: March 23, 2010

As a general response to the questionnaire we would like to point out that in our country, in the different situations you mention, we apply the general norms which regulate the professional secrecy (which include not only the Lawyers but also other technical experts). The information protected by Professional Secrecy can only be disclosed as an exception by an order of the Criminal Court.

It is also worth mentioning that apart from the before mentioned general regulations there can be confidentiality agreements among the parts, in a case by case basis, about the information protected as well as its disclosure.
Attachment 4

Q 199 – Privilege Task Force

Report to the Bureau and ExCo, for the AIPPI Congress in Paris

Epitomes of the Responses from the NRGs
Q199 – Questionnaire:
Epitomes of the Responses from the NRGs

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1. Introduction

1.1 Background.

The purpose of epitomizing the Group Responses is principally to provide a manageable overview of them. The compression of the Responses is risky because nothing can replace reading the Responses in full. However that may not be practical for everyone. If any epitome appears cryptic or for any other reason requires clarification, please read the relevant Response in full.

1.2 Glossary

'AaL' means Attorney at Law.

'CAP' means Client Attorney Privilege.

'EPAs' means European Patent Attorneys.

'IHL' means In House Lawyer.

'IPPs' means IP professional advisers.

'NL' means Non Lawyer.

'NLIP' means Non Lawyer Intellectual Property.


'NLTMA' means Non Lawyer Trade Marks Attorney.

'PA' means Patent Attorney

'O/S' means overseas or in another country.

'protection' is a means of preventing forcible disclosure of IP professional advice in communications to or from an IP adviser in relation to IP legal advice.
2. **NRG Responses epitomised by country**

2.1 **Argentina**

Professional secrecy obligation applies to lawyers. Patent office professional secrecy obligation applies to patent agents but this is of doubtful validity. As to third parties, communications in the hands of lawyers and patent agents are protected as just stated. There is no direct protection of clients and third parties. As to communications with overseas professionals as for lawyers and patent agents as for those categories in Argentina. As to limitations and exceptions, such possibly apply in situations of fairness, just cause or extreme case. The protection available is adequate for lawyers. The protection of patent agents is doubtful. As to overseas professionals, the protection is appropriate for lawyers but doubtful for non lawyers. As to remedies, no to allowing countries to limit protection by tests like dominant purpose (need uniformity); no to judicial discretion (uncertainty). On qualifications of IP professionals elsewhere, need something more than 'qualified locally to give the advice' ie something like 'registered'. Do not agree with countries being allowed to continue current categories of privilege (need uniformity). In principle not in favour of current exceptions and right to vary same, unless same exceptions are agreed for all (uniformity required). Prefer the AIPPI proposal.

2.2 **Australia**

Statutory and common law protection applies to clients and their lawyers, and to the O/S lawyers and third parties the lawyers engage (ie the protection does not apply where third parties are engaged by clients). There is also statutory protection for clients of NLPAs and NLTMAs but not of third parties or O/S NLIP professionals they engage. The protection is inadequate in failing to include third parties and O/S NLIP professionals. Dominant purpose and judicial discretion limitations apply. Crime/fraud/illegal purpose and other exceptions apply. Waiver by client applies. As to the 'device' to achieve remedy, countries should be able to continue to apply the limitations, exceptions and waiver law they already have. They should be able to vary (narrow) or abolish those and apply the rule that the client/NL professional protection cannot exceed that which applies to client/lawyers. As to qualifications required of O/S professional advisers for protection to apply to them in Australia, they should be qualified to give the advice in their country in the sense of being registered there. The AIPPI proposal is preferred over the Section 5 proposal.

2.3 **Austria**

Protection which applies is professional secrecy. That applies to AaLs, NLPAs and non lawyer technical specialists like engineers so controlled by their Institutes. Client not protected. Communications with O/S IP advisers protected from forcible disclosure if that applies under O/S law. Protection near absolute (money laundering exception applies) and is of appropriate quality. As to remedies, the Group wants the scope to include applications for grant of IPRs and oppositions. If those are included, Yes to dominant purpose, No to judicial discretion (unreliable standard). Qualifications – Yes to locally qualified to give the advice. Yes to allowing existing limitations but No to any extensions (including by variations). Same for exceptions and waivers. As to the form of the remedy,
the AIPPI proposal is preferred because the Section 5 proposal would give EPAs an 'enhanced status for advice for which they are not qualified'.

2.4 Belarus

Professional secrecy only. Applies to advocates and NLPAs. So no protection applies to clients, third parties or O/S professional IP advisers. This protection is adequate. Information which the PA gets from the client is not regarded as confidential. IP professionals and clients are required to fully disclose and tell the truth. There are no limitations, exceptions or waivers that are relevant. As to remedies, the Group agrees with countries defining the relationship between the documents and the IP legal advice to which protection should apply (e.g. dominant purpose) and having judicial discretion. Being locally qualified to give the advice is acceptable. Limitations and exceptions currently part of the law and also the right to vary or abolish the same. No adverse effects from this form of protection being introduced. AIPPI reform proposal is preferred.

2.5 Brazil

Professional secrecy only, and that applies to lawyers and NLPAs. What makes the information confidential is the status of the professional to, or by whom, the information is communicated, not the quality of the information itself. Therefore, no protection applies to clients and third parties engaged by either of them. As to communications by IP professionals with O/S IP professionals, they are protected because of their status as IP professionals, provided that the O/S professionals are protected under their law. Limitations and exceptions – only in life threatening situations. This protection is inadequate in relation to protection from forcible disclosure of Brazilian advice in common law countries and the lack of protection of third parties. As for remedies, the Group does not favour applying limitations (ie the dominant purpose or judicial discretion items). It does favour a very broad concept of IP legal adviser to whom protection would be applied. Country by country protection should be capable of being limited to categories of privilege currently a part of the law with right to vary or abolish any exception. AIPPI proposal is preferred but it needs a wider definition of IP adviser – ie any person who provides information contributing to the IP advice.

2.6 Canada

Common law CAP applies to clients and their lawyers. No CAP protection for NLIP and NLIP O/S advisors. Protection for NLIP and NLIP O/S advisors may apply if communications made for the dominant purpose of pending or contemplated litigation under common law litigation privilege. Common law CAP applies to legal advice provided to or from foreign/domestic, external/in-house AaL. CAP protection includes third parties engaged by the AaL. Crime/fraud/illegal purpose, where innocence at stake and waiver exceptions. Protection inadequate as no explicit protection of IP advisor including local and overseas NLIP advisors and potentially a lawyer when acting only as an agent,. As to the ‘device’, the scope of the privilege included in the agreed principle or standard should be akin to CAP, which would include any record or document made for the purpose of, or relating to, IP professional advice. Countries could maintain existing exceptions, waivers, or categories of privileges, but allowing for judicial discretion would create too much
uncertainty. The protection should extend to any lawyer, NLPA or NLTMA or other person professionally qualified in the country where the IP advice is provided, including in-house counsel. AIPPI remedy is preferred.

2.7 Chile

Full protection applies where it can be proved that the communication was between a client and a domestic/foreign professional (AaL, AaL/patent attorney, or AaL/trademark attorney). Communications with a third party protected when assimilated to a professional relationship. Crime/fraud exceptions apply. Adequate protection available in all regards. As to the ‘device’, protection should apply only to serious cases involving communications with an IP professional only (‘qualified to give advice’ insufficient). Clear definition on those protected needed as unlimited protection may result in no protection at all. Countries should be able to continue to apply the limitations, exceptions and waiver law they have in existence, but not have the liberty to vary these in the future. No answer provided as to which proposal is preferred.

2.8 China

Professional secrecy obligations for IP professionals (AaLs, AaLs with patent agent licenses, patent agents, trademark agents, and legal professionals who provide services concerning copyright and computer software). Technical experts not usually considered IP professionals. Possible protection under Constitution which protects as private “correspondence among citizens of China” so long as communication is between a domestic IP professional and a domestic client, but subject to exceptions for state security or criminal investigation. Courts have legal authority to force disclosure of communications where deemed relevant to issue at trial. No explicit protection for communications with O/S IP advisers unless provided for in international agreements, treaties or conventions. No opinion given as to the ‘device’. No answer provided as to which proposal is preferred.

2.9 Czech Republic

Legal duty of secrecy for AaLs and patent attorneys and their staff members, but no protection against forced disclosure in court as the client can be forced to disclose information in court (subject to self-incrimination exception). Legal duty of secrecy subject to crime/tax/judicial discretion exceptions. No protection for communications involving third parties, trade-mark advisors, or in-house advisers, but possible statutory protection for expert witnesses. No protection for client-O/S adviser communications; scope of protection determined via private international law. As to the ‘device’, due to significant differences between common and civil law systems, and the difficulty of finding a universally applicable unified solution, country specific limitations, judicial discretion, exceptions and waivers should be allowed. Countries may vary these so long as the change does not threaten the purpose of the proposed standard. ‘Qualified to give the advice’ okay as client’s responsibility to ensure IP professional qualified under domestic law. The AIPPI proposal is preferred for its "complexity" (Ed. this is taken as meaning ‘having more complete scope’).
2.10 Denmark

Protection applies to lawyers (+ their assistants) as to litigation absolutely, as to all other lawyers' work 'relatively' ie subject to the court. That is, a court may allow disclosure if required (decisive importance). Uncertain whether this protection extends to communications by lawyers with other IP professionals. Other IP professionals are exempted from usual obligation to give evidence if secrecy is involved and maintenance of secrecy is required. IP professionals are obliged by marketing law and professional supervision rules to maintain their clients' business secrets. No third party protection (ie as to client or IP professional communications with third parties) unless third party is in effect a lawyer's assistant. Position of O/S IP professionals in communications with Danish IP professionals, is unclear. Also unclear whether and if so what protection applies to IHLs. Protection is inadequate. The client/lawyer protection (relative privilege from disclosure) should extend to IP professionals (inc. NLPAs) subject to there being professional supervision, and to O/S IP professionals. Qualifications of O/S IP professionals would need to include having local professional supervision. Against adopting 'dominant purpose' test or its equivalent because of lack of clarity. Yes - to judicial discretion, existing categories of privilege, exceptions and waivers and that they should be subject to variation and abolition.

AIPPI proposal preferred subject to three modifications:

(i) it should distinguish between absolute and relative privilege (providing for both);
(ii) it should include quasi IPR, such as trade secrets, in 'intellectual property rights'; and
(iii) limit privilege to particular highly trained and educated IP advisers who are subject to restricted and pro-actively enforced ethical rules.

2.11 Egypt

Absolute obligation of non-disclosure applies to foreign/domestic AaLs, patent and trademark AaL, including in-house. Obligation of confidentiality on any foreign/domestic professional who receives confidential information because of his/her profession, but applies only with respect to court testimony. Felony/misdemeanor exceptions. Inadequate protection due to generality of provisions; creating uncertainty about scope of protection. Regarding the 'device', the standard agreed to should be absolute. Discretionary exceptions (dominant purpose, judicial discretion, categorical limitations) are subject to abuse, create uncertainty, and are unnecessary. Existing exceptions/waivers (i.e. crime/fraud) okay. Protection should cover all IP advice regardless of whether IP adviser is from a qualified category or not. The AIPPI proposal is preferred, but should include all information received by the IP Advisor through the practice of the profession (i.e. from sources other than a client).

2.12 Estonia

Statutory protection of registered domestic AaL and NLIP (patent or trade-mark agents) such that neither the AaL/NLIP or their employees can be called as witnesses and documents ("media") received in the course of their services may not be confiscated.
Same protection applies to communications with third party/foreign IP advisor and domestic/registered NLIP communications, but dominant purpose test applies. No direct protection of clients. No protection for client-third party communications or for client-O/S IP advisor communications. As for the ‘device’, no provision should be made to limit the documents to which protection applies, nor to allow for judicial discretion. Limitations based on categories of privilege do not facilitate open and frank communications between IP adviser and their client. Existing waivers and exceptions could be applied. Section 5 alternative preferred, generally, but do not support the inclusion of in-house IP advisers (including AaLs and European PAs) as deserving of a privilege equal to that given to private practice advisers.

2.13 France

Professional secrecy applies to lawyers admitted to the Bar or being IP advisers or in-house IP advisers under EPC. There is no protection of clients or third parties (ie communications to or by them are not ‘privileged’). Scope of the professional secrecy that applies is all documents related to a given matter. As to client communications with O/S professionals – protection can apply if the client is an in-house IP adviser and the O/S professional can claim privilege under the law applicable to that person, but not otherwise. As to professional secrecy in France, there are no limitations, exceptions or waivers affecting the obligation of non disclosure. There have been no adverse effects from the introduction of this protection. However, the protection thus available in France is considered by the Group to be inadequate because of lack of clarity (including as to communications between clients and IP professional advisers, clients and third parties, IP professional advisers and third parties, and O/S advisers). As to remedies (reflecting sensitivity against diminishing the scope of professional secrecy) the Group does not agree with defining the relationship between documents and the IP advice for which protection can be claimed or for having judicial discretion. As to the qualifications of O/S IP advisers to be protected, the Group requires more than ‘qualified to give the advice locally’, such as being admitted to practise locally. The Group does not favour allowing countries to adopt or maintain the difference between categories of privilege but if there is a ‘limitation’, countries that have it should be able to vary or abolish it. Exceptions and waivers that are currently part of the law should be allowed to continue. The Group prefers the Section 5 remedy to the AIPPI proposal.

2.14 Germany

Lawyers and PAs are bound by professional secrecy and have the right to refuse to testify. An EPA in Germany who is not also a German PA is not protected from forcible disclosure. No protection of clients and third parties unless as to the latter, the person is acting as an assistant to a lawyer or patent attorney. No limitations or exceptions. Protection is adequate. Protection should not apply to communications between clients and third parties unless the third party acts under the supervision of an attorney. Protection from disclosure applies to foreign attorneys acting for a German client. As to O/S advisers generally, privilege should be limited to those qualified to give advice under their national law. The Group prefers the Section 5 solution.
2.15 Greece

Civil law applies; no discovery. Client/lawyer (including IHL) privilege from forcible
disclosure applies. No protection for client/third party communications, generally. NLPAs
are not authorised (to practise). As to lawyer/client communications with O/S
professionals, if privilege is applied O/S it will be applied in Greece. As to exceptions,
there is one – terrorism/organised crime. Clients can waive privilege. The protection thus
provided is not appropriate – it should be extended to NLIP professionals including EPAs.
On remedies, the Group would allow the dominant purpose test to be applied. No to
judicial discretion. The Group accepts the quality of IP professional if qualified to so advise
locally. Yes to countries limiting privilege by their current categories, yes to current
exceptions and waivers being continued and to allowing variation if it is a narrowing the
current exceptions. Prefers AIPPI proposal to the Section 5 one because AIPPI creates a
minimum standard for all and the Section 5 one does not apply to all and therefore creates
uncertainty.

2.16 Hungary

Statutory confidentiality obligations apply to AaL, law firms, individual patent attorneys and
firms of patent attorneys for knowledge gained in the course of carrying out their duties.
Includes information received from third parties for the case of the client. In the case of
AaL/law firms, obligation applies to all documents prepared by an AaL or that contain client
information. Client-third party communications may be protected by business secrets
provisions. No discovery process, but client may be forced to disclose IP advice in the
course of witness testimony, subject to statutory exception (i.e. witness is a relative of
either party, etc.) or judicial discretion. Above principles apply equally to O/S IP advisers.
Crime/public safety exceptions. Additional protection for domestic agents registered with
EPO in proceedings before the EPO unless waived. As to the ‘device’, legal rules which
exactly specify scope of documentary protection would maximize protection over
discretionary test (‘dominant purpose). Judicial discretion should not apply. Protection
should apply to all “qualified to give IP advice” and be uniform across countries.
Limitations and exceptions may be allowed provided it does not reduce the scope/content
of the provision. No answer provided as to which proposal is preferred.

2.17 India

Common law and legislative based CAP applies to communications between clients and
their outside lawyers, subject to crime/fraud/waiver exceptions. Likely that protection does
not apply to IHL. No CAP protection for communications between client and third party, or
AaL and third party, nor for communications involving NLPA (TMA are required to have a
law degree such that CAP would apply). Protection likely available for all of the above in
respect of communications made for the purpose of pending or contemplated litigation
under common law litigation privilege. Although uncertain, possible that communications
between clients and O/S AaLs will be protected by CAP. With respect to communications
between clients and O/S NLIP advisors, any protection would be based on the law of the
country of the O/S NLIP advisor. Protection is inadequate as no explicit protection for NLIP
and also for communications with third parties, and communications with NLIP O/S
advisors is uncertain. In respect of the “device”, countries should be able to limit the extent
to which privilege applies in accordance with their rules, and judicial discretion should apply (at least for crime/fraud exception). The protection should extend to any qualified IP advisor. AIPPI proposal is preferred as terms are clear and well defined.

2.18 Indonesia
Statutory protection applies to communications between clients and domestic IP professionals (AaLs and NLIP (“Consultant of IP Rights”)). No protection of client-third party or client-O/S IP adviser communications, except as provided for in a contractual agreement. Judicial discretion, security and defence, health, public safety and criminal exceptions apply to protection provided. Adequate protection for domestic IP professionals, but inadequate protection in the case of third parties or O/S IP advisors. As for the ‘device’, the new provision should allow countries to limit the scope of documents protected but do not agree that countries should be bound by judicial discretion. There should be standard requirements for an IP advisor to be considered “qualified to give the IP advice”. The AIPPI proposal is preferred.

2.19 Ireland
Protection applies to clients of lawyers and registered patent and trade marks agents. Also to communications by clients and those IP advisers with third parties if for the purpose of advising the clients. As to communications by clients and IPPs with O/S IPPs, protection possibly applies where the clients are protected in the country overseas. Same applies to clients of IHLs as applies to external IPPs. The usual limitations (like dominant purpose) and exceptions (like crime/fraud) and waivers, apply. As to adequacy, OK locally but not as to communications with O/S IPPs (uncertainty). On remedies, Yes to continuing existing limitations, and No to judicial discretion (uncertainty). On qualifications – Yes to locally qualified to advise. OK for countries to continue to apply the limitations, exceptions and waivers they now have. Yes to varying those in future as long as the variations are consistent across the law. No adverse experience with the protection. AIPPI proposal is preferred assuming made subject to usual limitations, exceptions and waivers. Broadening the scope of privilege is not likely to cause problems; narrowing it would likely be prejudicial.

2.20 Israel
Communications between an (in-house or external) AaL and either his client or a third party protected by privilege (ie the protection is directly applicable to clients). Communications between a NLPA and the client are likely protected at common law, but protection is not absolute and subject to judicial discretion. Protection for NLTMA, or for in-house IP advisors unclear, but likely the same as that of NLPAs. Some protection for third party-client or third party-IP adviser communications via litigation privilege if ‘dominant purpose’ test met. Communications with O/S AaLs likely protected by CAP or by litigation privilege. Scope of protection for O/S NLPAs uncertain/has never been addressed. Inadequate protection for NLIP professional as protection yet to be confirmed by Supreme Court and is currently subject to judicial discretion. As to the ‘device’, scope of the privilege should be equivalent to CAP, protecting any communication relevant to the IP advice (‘dominant purpose’ test). IP adviser should be “certified”, which denotes some sort of official training.
Privilege should be absolute, although may be limited to categories of privilege already existing, and subject to exceptions (i.e. crime/fraud). No answer on the particular proposals for remedy (AIPPI/Section 5 etc).

2.21 **Italy**

Professional secrecy obligations apply to IP attorneys (AaL and non-AaL), including “technical consultants”. AaLs also protected by Forensic Code of Conduct which foresees that the duty of confidentiality is also a right. No discovery obligation on clients, unless required by judge. The same principles apply to communications with O/S IP (lawyer or non-lawyer) professionals. Likely no protection for third party-client communications. Adequate protection, although might be improved by creation of a similar provision to Forensic Code of Conduct for non-AaLs. Additional protection for domestic agents registered with EPO in proceedings before the EPO unless waived. As for the ‘device’, countries should be able to continue to apply the limitations, exceptions and waiver law they already have, including judicial discretion. IP advisor need be qualified only; unqualified advisors should not be covered by protection. The AIPPI proposal is preferred.

2.22 **Japan**

Confidential communications between client, lawyer or patent attorney are privileged from forcible disclosure. In Japan, there is no category of professional called ‘trademark attorney’. There is no discovery. So, it is very unlikely that disclosure will be forced, particularly because ‘intent’ is usually irrelevant in IP matters. Client/third party and IPP/third party communications, protected unless court finds their disclosure necessary. Technical or professional secrecy matters are exempted from disclosure. Position of client communications with O/S professionals, not clear. As to what limitations or exceptions apply – lawyer or patent attorney can be exempted from the secrecy obligation. The Group considers there is no problem with the scope of the protection within Japan. As to forcible disclosure O/S, there is an unpredictable problem. As to remedies, the Group agrees that countries may apply their own tests defining what relationship is required for documents to be protected from disclosure, and may apply judicial discretion. As to qualifications of O/S advisers to be protected, they should be both qualified locally to give the advice and have a duty of confidentiality backed by penalty for breach. Protection may be limited to the categories of privilege currently applied and be subject to exceptions such as crime/fraud, waivers. Allowable variations should be subject to the three point exception test. The Group has no experience of adverse effects from the introduction of the protection from disclosure referred to above. It prefers the AIPPI proposal for reform.

2.23 **Korea**

IP professionals (AaL and NLPAs) have professional secrecy obligations. There is no discovery and no protection for clients and third party communications. As to communications of IP professionals with third parties, protection applies to professionals but not the third parties. As to O/S professionals, their communications are protected but not in the hands of the client. Position of IHLs is not certain. As to limitations on the applicable protection, the secrecy obligation can be overcome if required in the public interest. The available protection is not adequate - clients and third parties should be
protected both in relation to local and O/S advice. As to the 'device' to effect remedy, existing limitations on the relationship of documents to legal advice should be allowed and judicial discretion in the cases of need to do justice or to meet the public interest. Existing exceptions (crime/fraud etc) should be allowed. Variation by narrowing or abolition of existing limitations and exceptions should be permitted but not to erode the standard for protection. Being qualified to give the advice locally should be enough to protect the O/S IP professional. The AIPPI remedy is preferred because it provides an agreed principle which will be acceptable to as many countries as possible.

2.24 Lithuania

Protection only applies to lawyers ie not to NLPAs, clients, third parties or O/S IP professionals advising Lithuanians. As to the protection that applies, there are no limitations or exceptions. This is inadequate in failing to protect the clients and NLPAs. Whether there should be protection in Lithuania for O/S IP professional advice for Lithuanians (1.4 and 1.8), is not answered. Remedies – the Group accepts that existing tests should be allowed to continue such as dominant purpose, judicial discretion, current categories of privilege, exceptions and waivers and the right to vary or abolish the same. The qualification required of 'IP advisers' - locally qualified to give the advice in question. would be acceptable. No adverse affects from introduction of the protection which applies in Lithuania and do not expect any from introduction of the remedies. As to whether the international remedy should be AIPPI/Section 5 or something else – not answered.

2.25 Malaysia

Protection applies to lawyers and clients of lawyers. It does not apply to NLIP advisers. Protection applies to lawyer/O/S lawyer communications. As to what limitations apply – the protection does not apply to communications in aid of illegal purpose. Judicial discretion does not apply to client/ lawyer privilege nor should it to any extension. The quality of the protection is acceptable, the scope is not. It should extend to NLIP advisers (and their clients). The Group accepts that countries should be able to maintain their current limitations, exceptions and waivers but there should be no liberty to change them. Prefer Section 5 proposal to AIPPI's.

2.26 Mexico

No legislation directly providing professional secrecy but lawyer disclosing information to the opposite party is liable for damages and possible criminal sanctions. There is no protection restraining forcible disclosure which is applicable to third parties including O/S professionals. Limitations, exceptions, and waivers do not exist. The quality and scope of protection is appropriate. As to remedies – tests like 'dominant purpose' and 'judicial discretion' are acceptable. The qualifications of O/S attorneys to be protected – it would be okay if qualified in their country to give the advice in question. Exceptions and waivers that currently apply are acceptable. Variations and abolition of those should be allowed. The AIPPI proposal is preferred by the Group.
2.27 Netherlands

Protection applies to lawyers (including IHLs) and patent attorneys. Not to TMAs and design right practitioners. Not to Client/third party communications. It does to IPP/third party communications. Also to IP professionals' communications with IP professionals overseas. As to client/O/S IP professionals communications, yes if protection applies O/S. There are no limitations for exceptions to the protection outlined above. It has appropriate quality. As to the international problem (loss of national protection where advice is communicated to other IP professionals overseas), as there is no surety that Dutch privilege will be respected O/S, the available protection is not of the appropriate quality in that respect. As to remedies, no to judicial discretion; it should be for the IP professional acting to decide what is in and what is out of privilege. As to the qualifications required of professionals, it should be qualified under statute law where there is an obligation of confidence required by the statute. As to allowing countries to continue to apply categories of privilege they currently have – no, because the Netherlands law is broader. As to exceptions, no – they too would produce a result narrower than the present Netherlands law. The AIPPI proposal is preferred because it requires the same minimum standard applying to all.

2.28 New Zealand

There are no trademark attorneys separate from patent attorneys in NZ. Protection applies to clients and their lawyers (including IHLs who have current practising certificates), patent attorneys, and O/S lawyers and patent attorneys (the latter from countries as gazetted in NZ). As to communications by clients with third parties, there would be protection only if the communications related to litigation actual or contemplated. As to IP professionals' communications with O/S IP professionals, as stated above privilege applies where the country is one which is gazetted in NZ (eg US, UK, Australia, EU, Canada, China and Korea are among those so gazetted). On limitations, a judge can disallow a claim to privilege where there is a dishonest purpose or the communications relate to the committing of an offence. Waiver by client applies. Protection is inadequate as to third parties and as to O/S law not recognising NZ privilege. As to remedies, yes to the application of a test limiting the protection to legal advice only, yes to judicial discretion (in order to avoid abuse). It is insufficient to have the test of quality just at the level of qualified to give the advice in the locality – there must also be something along the lines of entitled by law to give the advice. Yes to countries applying their current categories of privilege provided they are not contrary to the minimum standard agreed. So long as the minimum standard is achieved, it is okay to have current exceptions. The right of client waiver is accepted. No answer as to preference for any particular format of remedy (AIPPI or Section 5).

2.29 Norway

No discovery. Protection applies to communications between clients and lawyers in private practice. Some case law indicates IHL protected but not certain. No protection for clients or IPP professionals and third parties unless (in each case) the third party is retained by a lawyer who is protected. As to O/S IP professionals, local lawyer and client communications with O/S lawyer would be protected. As to limitations, exceptions and
waivers – there is only a money laundering exception and waiver by client applies.
Protection is not adequate. Clients of and NLIP professionals should be protected too.
The status of communications with O/S professionals needs to be made clear. As to remedies, 'dominant purpose' type test yes, 'judicial discretion' no, Qualification of O/S IP adviser requires more than merely being qualified to advise – licensed by IP office or registration in either case combined with supervisory authority. Limitation of protection to current categories of privilege – probably no, judicial discretion no, current exceptions, exemptions and waivers, yes, variation and abolition yes but not variation which expands or applies retrospectively. AIPPI proposal preferred 'because it is the only one of the two that deals with the problem of different standards in different countries. Also, it widens the scope of application of the protection to categories of IP advisers other than EPAs.'

2.30 Panama
Statutory protection and professional secrecy obligations for communications with (in-house or external) AaL and their (foreign/domestic) clients or with a (foreign/domestic) third party. Protection subject to judicial discretion, waiver, and to disclosure by lawyer in 'self-defence'. Discovery possible, but seldom granted and cannot be targeted to AaL client communication. Inadequate protection for clients and for NLIP advisers, and should include other IP professionals (i.e. engineers, doctors, agents, etc.). As to the ‘device’, one universal standard should be created protecting all communications related to IP advice given by ‘qualified’ IP advisers. Countries should maintain ability to apply limitations and exceptions, but not where they erode the minimum standard agreed to. Limited discretion okay, but should have clear limits. The Section 5 alternative is preferred as it creates a more universal principle, covers all IP advisers (external and internal), covers all IP advice generally, and allows the client to decide whether or not the communication can and will be disclosed. (Response refers to a WIPO proposal which is taken to mean ‘Section 5’).

2.31 Philippines
Protection provided by Code of Professional Responsibility and Canons of Professional Ethics where IP adviser also a domestic AaL. NLIP advisers have no specific statutory protection, but may be protected by way of non-disclosure contract. The same applies to third-party-client and O/S NLIP adviser-client communications. Inadequate protection for NLIP professionals. No direct protection of clients. Further, differences in the protection afforded to IP professionals globally may give rise to jurisdictional issues and may impede discovery of improper disclosure. As to the ‘device’ adopted, uniformity in standards is desirable but limitations on scope of documents, conformity with categories of privilege, exceptions, and judicial discretion can be allowed to avoid conflicts in the application of the standard in different jurisdictions. Protection should apply to any IP adviser "qualified to give the IP advice", and may also extend to those IP advisers who may not hold degrees but have technical expertise in the specific field where the IP advice is given. The AIPPI proposal is preferred. The terms are clear and well defined.

2.32 Poland
Professional secrecy obligations exist for all IP professional advisors (patent attorneys (AaL and non-AaL, in-house and external), advocates, and legal advisers). No discovery,
therefore no protection of clients of IP advisors. IP professional advisors may be forced to testify where necessary for the interests of justice, at judge’s discretion, unless information sought pertained to legal advice. Inadequate protection as no protection for communications involving third parties or O/S IP professionals. Further, impact of secrecy obligations only national in scope. As to the ‘device’, due to difference in civil and common law systems, countries should be left with flexibility to modify the standard adopted according to existing categories of privilege and limitations, but not where it would prejudice the legitimate interest of the IP rights holder. No judicial discretion, nor exceptions. Protection should apply where IP adviser qualified to provide advice. AIPPI proposal preferred because of its general character, which better suits divergent legal systems.

2.33 Portugal

Legal duty of confidentiality is imposed on AaLs. No duty of confidentiality between NLIP advisers and clients. Some other professions have a duty of confidentiality, and where this exists, communications with that professional third party may be confidential. Communications protected if the domestic law of the O/S IP adviser provides for a duty of confidentiality. Judicial discretion, force majeure exception may override duty of confidentiality. Lack of protection for NLIP advisers results in discrimination in favour of AaL. Protection should extend to communications with any domestic IP professional. As to the ‘device’, countries can continue to apply existing categories of protection to allow for harmonization of IP professional privilege with those professions already subject to that duty. Judicial discretion is acceptable. IP professional need be ‘qualified’ in eyes of domestic law, and should not extend to non-qualified IP advisers. The AIPPI proposal is preferred as it allows each county to specify which advisers would benefit from the treaty.

2.34 Romania

No specific provisions in respect of the protection other than general secrecy obligations imposed on IP professional. For example, where IP professional is also AaL (in-house or external) the communications (with clients, third parties and O/S IP advisors) are protected by professional secrecy obligations. Crime/fraud/waiver exceptions apply. Forced disclosure to a prosecutor under warrant is also possible. Additional protection for domestic agents registered with EPO in proceedings before the EPO unless waived. Adequate protection as rare for judges to force disclosure, save for allegations of crime/fraud. As for the ‘device’, discretionary limitations (i.e. type of document protected, judicial discretion) create uncertainty and would complicate the system. Limiting protection to existing categories of privilege would confuse a client who does not understand the difference between them. Existing waivers or exceptions could be applied. IP adviser should be protected so long as “qualified” to give advice and should include copyright agents. The Section 5 alternative is preferred as it is more reflective of differences between the legal systems of countries and because it proposes a special status for European Patent Attorneys. The Group would favour the harmonization of protection afforded to AaL and NLIP professionals.
2.35 Russia

No protection for IP professional advice, unless IP professional is also registered as advocate (special status of lawyer who is entitled to handle criminal defence cases), in which case the communication is privileged. Possible protection as a commercial secret, which can apply regardless of the parties involved. Crime/fraud exception to protection. Most significant limitation of current protection is the fact that no protection exists for patent attorneys not registered as advocates. But overall, no protection of IP lawyers (if not advocates), patent attorneys, third parties they deal with, including overseas lawyers, patent attorneys and third parties. As to the ‘device’, standard provisions which define the scope of documents protected and the extent of judicial discretion okay. Countries should be able to continue to apply existing exemptions and waivers, and variations should apply and to modify these in the future. Protection should cover all IP advisers ‘qualified to give the IP advice’. The AIPPI proposal presents a more balanced approach.

2.36 Singapore

Statutory CAP for domestic AaLs for communications with (foreign/domestic) clients or third parties. Litigation privilege also applies to communications between AaL and client or 3rd party. Privilege similar to litigation privilege applies to pending or contemplated proceedings before the Patent Registrar. Separate statutory protection equivalent to CAP for all domestic PAs (AaL and NLPA) where agent qualified and where the patent-related information was sought for the purpose of enabling legal advice. Likely this protection includes client-third party communications. Client-O/S IP adviser communications protected by statute where O/S IP adviser also an AaL, uncertain if it would apply to communications with O/S NLIP advisors. The above principles apply equally to IHLs. Thus, as the protection is privilege, the client is directly protected from forcible disclosure. Crime/fraud, waiver exceptions apply. As to the ‘device’, the scope of protection should be reflective of the needs of individual countries and therefore existing, explicitly defined limitations and exceptions should apply. Judicial discretion should not be allowed as it creates uncertainty as to what is or is not privileged. IP advisers should be required to be registered with the court or patent office to ensure that the conduct of the IP adviser is sufficiently monitored. The Section 5 alternative is preferred as it allows for lesser generalization and greater scope for accommodating the laws of individual countries.

2.37 South Africa

Common law CAP and litigation privilege (“dominant purpose”) apply in South Africa. Additionally, statutory client-NLPA and NLTMA protection akin to CAP applies for any communication by or to a patent/trademark agent in their capacity as such. Likely includes in-house advisers so long as ‘dominant purpose’ of communication was IP advice and not commercial or managerial advice and third party-IP adviser communications occurred where client information shared with third party to enable IP legal advice to be obtained or given. Appears that client-O/S IP adviser communications protected if such communications would have been protected by domestic law of adviser, although not certain. No limitations, exceptions or waivers. Adequate protection but statute could be modified to explicitly include third party-IP adviser communications and client-O/S IP adviser communications. As to the ‘device’, clear exceptions may be allowed (i.e. where
fundamental right of another party affected or where crime/fraud), but broad discretionary limitations should not be allowed. The standard should apply to all ‘qualified’ IP advisors. The AIPPI proposal is preferred.

2.38 Spain
Statutory secrecy obligations for AaLs regardless of whether communication is with client or third party, but does not include in-house AaLs. No protection for NLIP agents. Client-third party and client-O/S IP adviser communications not protected. Terrorism, money laundering, crime endangering life, freedom or security exemptions. Judicial discretion applies. Additional protection for domestic agents registered with EPO in proceedings before the EPO unless waived. Inadequate protection for industrial property agents with degrees in fields other than law and technical experts. Also protection should extend to communications with foreign lawyers and other IP advisers. As to the ‘device’, ‘dominant purpose’ test should be applied in an open manner. Countries can continue to apply existing exemptions such as terrorism, money laundering and damage to persons. Judicial discretion needed to adapt protection to nuanced reality. Protection should apply regardless of purpose of advice (i.e. litigation privilege vs. CAP) but if categorical limitations are applied they should not reduce the scope of agreed standard. The AIPPI proposal is preferred as it allows each country to clearly specify which legal advisers would benefit from the treaty.

2.39 Sweden
Protection applies to client-AaL communications, but not in respect of IHL or third party communications. Protection does not extend to NLIP advisors. Possible protection for Swedish client-O/S IP adviser communications if the domestic law of O/S adviser provides for protection. Crime/fraud/waiver exceptions apply. Starting Sept. 1, 2010, communications between a client and a properly qualified professional (e.g. registered with EPO or as a Swedish patent agent (with IPS)) in respect of patent related subject matter will be protected. This would include IHLs and NLPAs. It will not apply to NLTMAs. Adequate protection where protection exists, but not all IP advisers covered and protection should apply to both client and IPP communications with third parties. As to the ‘device’, explicit limitations (i.e. type of document, categories of privilege), exceptions (crime/fraud) and waivers can be applied. Countries should be able to vary these if change does not narrow scope of protection. Judicial discretion creates too much uncertainty and defeats the purpose of the protection (i.e. so clients can be certain that their information will be protected). IP advisor should be required to be licensed by a court, patent or trade-mark office (or equivalent) to receive protection. Neither proposal preferred. Would favour a proposal which would extend the same or equivalent privilege as that afforded under protection of client/AaL communications to intellectual property advisors qualified and licensed to act before regional, international, or foreign national courts or intellectual property registration offices.

2.40 Switzerland
Communications between clients and AaLs are protected by professional secrecy requirements. Starting Jan. 1, 2011, this professional secrecy protection will be extended
to PAs. The professional secrecy protection does not apply to IHLs. The professional secrecy protection applicable to AaLs and (shortly) to PAs would apply to communications between such individuals and O/S IP advisors. Also effective as of January 1, 2011 will be additional statutory provisions whereby courts will be bound to protect business secrets, and documents related to correspondence with an AaL need not be produced. This protection for business secrets may protect client communications with third parties, in-house AaLs, NLTMs, or O/S IP advisers. For professional secrecy protection there are no exceptions. For the new business secrets protection, it will subject to crime/public interest exceptions. Overall, adequate protection for independent AaLs and NLPAs, but inadequate for all others. As to the ‘device’, there should be no limit on the scope of protection applicable to IP advisors (all communications should be included). Exceptions and waivers, if any, should be explicitly defined and harmonized. Judicial discretion is unnecessary, but alternative could be for judge to ask the parties to disclose documents under assurance of preservation of secrecy of court. ‘Qualified to give advice’ under domestic law okay. The AIPPI proposal is preferred.

2.41 Thailand

Lawyers and other IP professionals are protected from forcible disclosure, but subject to court orders to the contrary. Clients are not protected except indirectly by the protection that applies to lawyers and NLIP professionals. The protection is inadequate re the maintaining O/S of the confidentiality of communications originating in Thailand. This applies to IP professionals' advice and trademark 'creators and developers'. No to allowing other countries to have their existing limitations. Yes to judicial discretion. Yes to O/S qualification for protection being no more than qualified locally to give the relevant advice. Yes to existing exceptions and waiver and the power to vary or abolish them. AIPPI proposal is preferred. The remedy should however not be mandatory whatever it is.

2.42 Turkey

Protection depends on the category of IP professional of which there are three – lawyers, TMAs and PAs. Professional secrecy applies to lawyers. It does not apply to TMAs and PAs. There is no civil law protection which applies directly to clients. There is criminal law protection which on the face of it applies indirectly to protect clients because disclosure of client secrets is embargoed and subject to criminal sanctions. That law provides protection for clients, IP professionals and third parties against disclosure because it would be a breach of the criminal law for disclosure to be made. The Group does not say whether 'legal advice' equates to 'client secrets'. However, as there is no case law on the criminal law protection, its application and effect are uncertain. As to protection of communications between Turkish IP professionals and overseas IP professionals, the 'principles of territoriality' would apply. There is no protection in Turkey of communications between Turkish clients and overseas IP professionals. Protection of lawyers is adequate. As to the adequacy of the protection of other categories (TMAs and PAs), and communications with third parties, and with overseas IP professionals, the protection is inadequate because of uncertainty. As to remedies, dominant purpose is not relevant in Turkey; no to judicial discretion. As to qualifications of overseas IP professionals for recognition locally, being locally qualified to give the advice should be sufficient. Yes to maintenance of categories
of privilege now part of the law, also yes to current exceptions and waivers. AIPPI solution is preferred to Section 5 as the Section 5 solution is not complete.

2.43 UAE

No direct client privilege. Clients are indirectly 'protected' because generally there is no discovery. There is a possibility of an order for specific discovery but it only applies in the narrow circumstances of a joint document on which the requesting party bases its case. As to client/third party communications, a court appointed expert can bring privileged information to the court's attention. As to IP professionals/third parties and IP professionals and clients' communications with O/S IP professionals, there is no direct protection from disclosure. There is nothing to which limitations and exceptions can apply. No answer was given on the adequacy of protection. As to the quality of protection of communications with O/S IP advisers, these are also indirectly protected (by having no discovery) but are also subject to the possibility of a court appointed expert bringing privileged information before the court. As to remedies, no answers supplied. It was noted that UAE have no formal mechanism to force parties to disclose information during litigation.

2.44 United Kingdom

Legal professional privilege (LPP) gives the right to the client to withhold relevant communications from disclosure. LPP has two categories – legal advice privilege (LAP) and litigation privilege (LP). LAP applies to confidential communications re legal advice. LP applies for actual or reasonably contemplated litigation including patent proceedings in the UK Patent Office, the EPO and WIPO. Dominant purpose applies. As to client communications with UK/EPO registered patent attorneys or UK/OHIM registered trademark attorneys - statutory legal professional privilege applies. As to client/third party communications, no protection applies if not in context of actual or contemplated litigation. As to IP professionals/third party communications, there is no protection outside the context of actual or contemplated litigation. As to local IP professionals' communications with O/S IP professionals, there is protection if the O/S professional is a lawyer and the local professional is acting as an agent to make the communications. Privilege would also apply if the foreign IP professional is a UK/European registered patent attorney or a UK/OHIM registered patent attorney. Thus, communications with other NLIP professionals, they are not protected. As to communications relating to advice sought by a client from a foreign IP professional directly, they would likewise be protected if the foreign IP professional is a lawyer or a UK/European registered patent attorney or a UK/OHIM registered trademark attorney. Employee IP professionals (IHLs) in any of these categories are subject to protection in the UK (as they would be in free practise) to the extent that they are acting as independent professional advisers. As to scope, crime/fraud exception and waiver apply, and (as already mentioned) the limitation of dominant purpose. As to qualities of protection, it is satisfactory except as to O/S non lawyer IP professionals. As to remedies, it is acceptable to define the relationship required between the documents and the IP legal advice for protection to apply, judicial discretion should not apply because of uncertainty and 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 (correct) legal advice. As to qualification required of O/S advisers
for protection to apply, the adviser should be licensed by the court, the patent or trademark office or equivalent government body so as to apply a controlled relationship justifying public trust in the adviser. Countries should be allowed to limit the protection they provide according to categories of privilege which are currently part of their law. Variations or abolition should be permitted but any standard should include in the protocol a reservation that a country is only allowed to widen the privilege protection it affords, not narrow any existing privilege protection as that would detract from the good faith expectations of parties seeking advice. Exceptions and waivers should be allowed and again as to variation, countries should only be allowed to widen privilege for the same reasons as above. As to the form of minimum standard, neither AIPPI nor Section 5 is accepted but elements of both would be. A country which applies LPP (whether LAP or LP) to its own NLIP advisers, should extend the same privilege to equivalent IP advisers specially qualified and licensed to act before regional, international or foreign national courts or IP registration offices. 'Intellectual property' should be defined widely with reference to WIPO treaties or as per the ICC proposal. As to further comments, the most pressing problem appears to be to persuade those common law countries who do have privilege laws to extend to foreign NLPAs the equivalent protection they grant to their own as they generally do for lawyers. The aim should be to extend what already exists in a country to a defined group of foreign advisers in just the same way as is done for lawyers, on the basis of comity.

2.45 Uruguay (Independent Member – Nora Morgade)

Professional secrecy normally applies. It can only be overturned by an order of a criminal court.

2.46 USA

CAP protects clients and their lawyers from forcible disclosure of communications having the dominant purpose of legal advice. No statutory privilege for NLIP professionals but privilege has been applied in some cases (State decisions). As to client/third party communications, no privilege applies unless the third party is acting under a lawyer's directions. As to lawyer/third party communications, privilege applies. As to lawyer to O/S IP professionals, privilege applies. As to US NLIP professionals' communications with O/S NLIP professionals, not decided but application of comity probably means such communications would be protected if privilege applies to the O/S adviser in the other country. Dominant purpose, waiver, crime/fraud exceptions apply. Quality of protection is okay for client/lawyers, but as to NLIP professionals and other country IP professionals, the law is in need of further clarification. On remedies, yes to dominant purpose type test, yes to judicial discretion, qualifications required of IP advisers – require more than just qualified to advise locally – eg registration with some recognised IP body re entitlement to give the advice. Yes to allowing existing categories of privilege to be continued and yes to variation/abolition, same for exceptions and warranties, but as to all variations that are to be applicable, they should be the subject of further study. As to adverse effects, possibly so in relation to the introduction of privilege, parties can unjustifiably withhold disclosure but this is resolved by supervision of the process by the court. No consensus in the Group on the form of remedy – AIPPI, Section 5 or something else.
2.47 **Venezuela**

Client communications with attorneys (and vice-versa) are protected. Other communications (with third parties and O/S attorneys) are subject to 'court orders'. What limitations and exceptions apply, are also determined by courts. Such protection is adequate. As to remedies, limitations such as 'dominant purpose' test should be allowed, judicial discretion also (ie as involved in supervision by court orders), being locally qualified to give the advice should be enough, countries should not be allowed to limit the protection they provide according to their existing categories, but if they have them, they should have the right to vary them by limitation or abolition. There should be no exceptions or waivers or right to vary same. The Group is not agreed on any of the two proposals for reform – AIPPI or Section 5.
Attachment 5

Q 199 – Privilege Task Force

Report to the Bureau and ExCo,
for the AIPPI Congress in Paris

Graphs of the results extracted from the Responses from the NRGs
Q1

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>1</td>
<td>1</td>
<td>45</td>
</tr>
</tbody>
</table>

Is there national protection or not?

- Yes: 96%
- No: 2%
- DNA: 2%
- Yes: 96%
Q2

<table>
<thead>
<tr>
<th></th>
<th>Both</th>
<th>Client</th>
<th>DNA</th>
<th>Professional</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>11</td>
<td>5</td>
<td>1</td>
<td>30</td>
</tr>
</tbody>
</table>

Is the protection of the client, the professional or both?

- Professional: 64%
- Client: 11%
- Both: 23%
- DNA: 2%
Q3

<table>
<thead>
<tr>
<th>No protection</th>
<th>Lawyers</th>
<th>NLPA</th>
<th>NLTMA</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>14</td>
<td>23</td>
<td>5</td>
</tr>
</tbody>
</table>

Is national protection extended to overseas IP professionals – lawyers, non-lawyer patent attorneys, non-lawyer trade marks attorneys?

- Lawyers: 48%
- NLPA: 11%
- NLTMA: 11%
- No Protection: 30%
### Q4

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>2</td>
<td>6</td>
<td>39</td>
</tr>
</tbody>
</table>

**Do any limitations, exceptions or waivers apply to the national protection?**

- Yes: 83%
- No: 13%
- DNA: 4%

[Pie chart showing distribution of responses]
Q5

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>2</td>
<td>34</td>
<td>11</td>
</tr>
</tbody>
</table>

Does the National Group consider the national protection to be adequate?

- Yes: 23%
- No: 73%
- DNA: 4%
### Q6

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>3</td>
<td>16</td>
<td>28</td>
</tr>
</tbody>
</table>

**Should the device allow limitation on protection based on the relationship between the communications and the legal advice for which protection is claimed?**

- **Yes**: 60%
- **No**: 34%
- **DNA**: 6%
Q7

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>3</td>
<td>27</td>
<td>17</td>
</tr>
</tbody>
</table>

Should the device allow judicial discretion to disallow protection where required on reasonable grounds?

- Yes: 36%
- DNA: 6%
- No: 58%
Should the device require the qualification of IP professional involved to be ‘qualified in the country to give the advice’?

- Yes: 59%
- More: 32%
- DNA: 9%
Table: Q9

<table>
<thead>
<tr>
<th>Number Of Responses</th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>3</td>
<td>13</td>
<td>31</td>
<td></td>
</tr>
</tbody>
</table>

Question: Should the device allow countries to limit protection according to limitations currently part of their law (e.g. dominant purpose)?

- Yes: 66%
- No: 28%
- DNA: 6%
Q10

<table>
<thead>
<tr>
<th></th>
<th>Absolute Yes</th>
<th>DNA</th>
<th>No</th>
<th>Qualified Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>18</td>
<td>3</td>
<td>9</td>
<td>17</td>
</tr>
</tbody>
</table>

Should the device allow the right to vary or abolish such a limitation absolutely or qualified in some way?

- Absolute Yes: 39%
- Qualified Yes: 36%
- No: 19%
- DNA: 6%

Allens Arthur Robinson
Q11

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Qualified Yes</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>4</td>
<td>4</td>
<td>2</td>
<td>37</td>
</tr>
</tbody>
</table>

Should the device be subject to any exception (e.g. crime-fraud) and waivers already part of the law absolutely or qualified?

- Yes: 78%
- DNA: 9%
- No: 9%
- Qualified Yes: 4%
Q12

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Qualified Yes</th>
<th>Absolute Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>6</td>
<td>6</td>
<td>26</td>
<td>9</td>
</tr>
</tbody>
</table>

Should the device allow the right to vary or abolish any such exception or waiver absolutely or qualified in some way?

- Qualified Yes: 55%
- DNA: 13%
- No: 13%
- Absolute Yes: 19%
### Q13

<table>
<thead>
<tr>
<th></th>
<th>DNA</th>
<th>No</th>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>13</td>
<td>32</td>
<td>2</td>
</tr>
</tbody>
</table>

**As to existing national protection, have there been any adverse effects from it?**

- **Yes**: 4%
- **DNA**: 28%
- **No**: 68%
Q14

<table>
<thead>
<tr>
<th></th>
<th>AIPPI</th>
<th>DNA</th>
<th>Other</th>
<th>Section 5</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number Of Responses</td>
<td>26</td>
<td>11</td>
<td>3</td>
<td>7</td>
</tr>
</tbody>
</table>

Should the device be AIPPI proposal, Section 5 or something else?

- AIPPI: 56%
- DNA: 23%
- Other: 6%
- Section 5: 15%
Attachment 6

Synthesis
Summary Report

Q199 – Privilege Task Force

Remedies to Protect the Right of Clients against Forcible Disclosure of their IP Professional Advice

The Q199 Committee is a special committee of the AIPPI focused on the issue of the protection from forced disclosure of communications between IP owners and their IP advisors in relation to the provision of professional IP advice.

Part of the mandate of the Q199 Committee is to promote and support WIPO, and the Standing Committee on Patents (SCP), in the study of the problem of forced disclosure of IP professional advice with the goal of developing some form of harmonized approach to the problem at both the national and international level.

With this in mind, the basic purpose of the Questionnaire herein was to ascertain the views of the members of AIPPI as to potential remedies for the protection problems and issues relating to them. The Questionnaire was also designed to provide data and a basis upon which AIPPI could encourage the SCP to pursue the study of remedies going forward.

In a general sense, the Questionnaire sought to obtain some basic information from the National and Regional Groups (NRGs) as to the extent of domestic protection, if any, that is currently provided against the forced disclosure of IP advice, the types of IP advisors (lawyers, patent agents, trade-mark agents, etc.) in respect of which this protection may apply, any exemptions or exceptions to such protection, and the protection, if any, provided for advice received from off-shore IP advisors. The Questionnaire also sought the NRGs’ input in respect of possible remedies that AIPPI may wish to pursue with the SCP in seeking some form of harmonized national and international approach to the problem.

A total of 48 Reports were received by the Reporter General. Reports were received from the National Groups of Argentina, Australia, Austria, Belarus, Brazil, Canada, Chile, China, the Czech Republic, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Korea, Lithuania, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Panama, the Philippines, Poland, Portugal, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Thailand, Turkey and from the Arab Regional Group, the United Kingdom, the United States, Uruguay and Venezuela.

As might be expected, the responses to the Questionnaire show a wide variety of approaches to protection against forcible disclosure, though there are some commonalities even among civil law and common law countries.

It is of some significance to note that the responses from many NRGs acknowledged the inadequacy of the present scope of protection for particular categories of IP professionals (particularly in the case of non-lawyer IP professionals) whose clients should be protected, either by privilege or by an obligation of professional secrecy. Summaries of how the NRGs responded to the particular questions are provided below.
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?

Generally, most common law countries (where there is often some type of documentary and/or oral discovery as part of the litigation process) such as Australia, Canada, Malaysia, New Zealand, Singapore, South Africa, the United Kingdom, and the United States have both attorney-client privilege for communications between clients and lawyers and litigation privilege, which would include communications with third parties, which might include non-lawyer IP professionals.

In certain common law countries such as Canada and Malaysia, communications between clients and non-lawyer IP professionals are not protected by attorney-client privilege. In other common law countries, such as Australia, New Zealand and the United Kingdom, there are statutory provisions that provide for client/non-lawyer IP professional communications to be protected by a privilege equivalent to that of attorney-client privilege. Such protection is also extended to registered patent agents in Singapore and South Africa.

Additionally, in most common law countries, in-house counsel are treated as equivalent to external lawyers for the purposes of the application of attorney-client privilege, provided the in-house lawyer is acting in his/her capacity as a lawyer (and not in some other executive or business capacity within the company).

Generally, for civil law countries (e.g. Argentina, Austria, Belarus, the Czech Republic, Egypt, France, Germany, Italy, South Korea, Mexico, Poland, Turkey and Uruguay), there is a professional secrecy obligation upon lawyers that would prevent them from disclosing the client’s confidential information to third parties. While civil law countries typically do not provide for attorney-client privilege per se, such countries do not usually have the discovery obligations as found in common law jurisdictions.

A number of civil law jurisdictions such as France, Argentina, Germany, Belarus, Brazil, the Czech Republic and Estonia also feature obligations of confidentiality for non-lawyer IP professionals such as patent agents.

Additionally, civil law countries generally do not provide any such protection for in-house counsel.

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?

Belarus, France, Greece, Indonesia, South Korea, Lithuania, Malaysia, Mexico, the Netherlands, Norway, Poland, Romania, Spain and Sweden do not provide any such protection.

In Germany, there is only protection if the third party acts as an assistant to a patent lawyer or attorney.

In Hungary, Russia and Switzerland, there is limited protection by virtue of business/trade/commercial secret protection.
Argentina, Austria, Chile, Brazil, the Czech Republic, and Portugal only provide such protection where the profession of the third party is one that is the subject of its own professional secrecy or confidentiality obligation.

As noted above, most common law countries (e.g. Australia, Canada, India, South Africa, the United Kingdom, and the United States) may provide protection under certain circumstances by virtue of litigation privilege. However, litigation privilege only lasts for the duration of the litigation.

Denmark, Finland, Panama, the Philippines, Singapore and the United States provide protection if communications with third parties are carried out at the instruction of a lawyer or a lawyer is involved in carrying out the acts.

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?

Argentina, Austria, Brazil, Chile and Portugal may have protection depending on whether the profession of the third party is one that is the subject of its own professional secrecy or confidentiality obligation.

Belarus, Mexico, Poland, Romania and Sweden do not have any such protection.

Many common law jurisdictions (e.g. Canada, India, South Africa, the United Kingdom and the United States) have protection by virtue of litigation privilege.

In addition, in many common law jurisdictions such as Australia, Canada, Malaysia and the United States, the common law doctrine of legal professional or attorney-client privilege may apply, depending on the circumstances, to communications between lawyer IP professionals and third parties. However, since the Australian statutory protection for non-lawyer patent and trade-mark attorneys (mentioned in 1.2 above) only applies between IP professionals and their clients and not third parties, there would be no protection for communications between non-lawyer IP professionals and third parties in Australia.

Indonesia and the Philippines may only receive protection through domestic contracts providing for confidentiality.

France, Spain, Lithuania and Turkey only have such protection if the third party is a lawyer/attorney. In France, there is no similar protection for in-house IP advisors.

Denmark, Germany, Norway and Panama have protection if the third party is acting under the direction of a lawyer or a lawyer is involved in giving instructions.

In Japan and Ireland, there is full protection from disclosure.
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,

Argentina and Chile may have protection depending on the profession of the overseas IP advisor.

Canada, Malaysia, Norway, the Philippines, Switzerland and the United Kingdom have protection if the overseas IP advisor is a lawyer.

Belarus, Indonesia, Lithuania, Poland and Romania have no such protection.

In Austria, the Czech Republic, Ireland, Sweden and Turkey, there may be protection depending on the law in the native jurisdiction of the overseas IP advisor.

In Brazil, Egypt, Estonia and Mexico, there is protection on the basis of professional confidentiality obligations.

In Australia, if a lawyer communicates with an overseas IP professional (lawyer or non-lawyer), the communication will be protected if it satisfies the dominant purpose test. Where a non-lawyer IP professional communications with an overseas IP lawyer, legal professional privilege will similarly attach. However, where a non-lawyer IP professional in Australia communicates with an overseas non-lawyer IP professional, there will not be any protection.

In the United States, communications between a lawyer and an overseas IP professional (lawyer or non-lawyer) may be protected, but the protection for a non-lawyer overseas IP professional would seem to depend on the principle of comity and whether any protection would extend to that overseas professional in their native jurisdiction.

and (b) between clients and overseas IP professionals?

Argentina, Brazil and Chile may provide protection to clients depending on whether the profession of the overseas IP advisor is one that is the subject of its own professional secrecy or confidentiality obligation.

Protection of this kind is not provided in Belarus, Estonia, South Korea, Lithuania, Poland, Romania and Turkey.

Austria, the Czech Republic, Ireland, Portugal, Sweden and the United States may have protection depending on whether any protection would extend to that overseas IP professional in their native jurisdiction.

In Australia, Canada, Malaysia, Finland, Norway, Spain and Switzerland, there may be protection if the overseas IP professional is a lawyer, but not if the overseas IP advisor is not a lawyer.

In most common law countries (such as Australia, Canada and the United States), these communications may also attract litigation privilege.
Limitations and Exceptions

1.5 What limitations (e.g. dominant purpose test, judges’ discretion to do justice, etc.) and/or exceptions (e.g. 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?

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?

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?

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 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?

The following comments apply in respect of questions 1.5(i)-(iv):

Argentina, China, Indonesia, Israel, Panama and Venezuela have exceptions based on the discretion of the judge.

Australia, Austria, Brazil, Canada, Chile, the Czech Republic, Egypt, France, Hungary, India, Ireland, Malaysia, Norway, Romania, Russia, Singapore, Spain, Sweden, the United Kingdom and the United States have an exception for criminal activity or fraud (including money laundering).
Most common law countries, and also Greece, Ireland, South Korea, Norway, Panama, Romania, Singapore and Sweden have an exception for waiver by the client.

Canada, Brazil, Hungary and Spain have an exception for situations in which the life or security of a person is in jeopardy.

Finland, Germany, the Philippines and South Africa have no exceptions.

Additionally, in many common law countries where there is litigation privilege, such a privilege only applies if the communication was made for the dominant purpose of the contemplated or pending litigation.

**Quality of Protection**

**Local communications**

**1.6** 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 (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The Chilean, Australian, Austrian, Estonian, Finnish, German, Greek, Hungarian, Indonesian, Irish, Japanese, Mexican, Dutch, Romanian, Singaporean, South African, Swedish, Swiss\(^1\), Thai, United Kingdom, and Venezuelan Groups feel the current protection is adequate.

The Argentine, Canadian, Czech, Danish, Egyptian, French, Indian, Israeli, Italian, South Korean, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Portuguese, Russian, Spanish, Turkish and American Groups feel the current protection is inadequate.

**Common Reasons for Insufficiency of Protection**

The Egyptian, French, Polish and Turkish Groups feel there should be clear regulations as to who and what is protected.

The Canadian, Indian, Malaysian, Norwegian, Panamanian, Filipino, Portuguese, Russian and Spanish Groups feel the protection is insufficient for non-lawyer IP professionals.

The American Group feels the protection for communications involving non-lawyer IP professionals, such as patent agents, is not well-defined across various jurisdictions and that uniformity is desirable.

The Israeli and Lithuanian Groups feel the protection is insufficient because it is not based in statute.

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\(^1\) The Swiss Group felt the protection was excellent for lawyers and patent attorneys, but relatively weak for in-house counsel and pure trade-mark agents.
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?

The Austrian, Chilean, Danish, Finnish, Hungarian, Irish, Israeli, Japanese, Mexican, Dutch, Portuguese, Romanian, Singaporean, South African, Thai, United Kingdom and Venezuelan Groups feel the current law is adequate.

The Argentine, Australian, Brazilian, Canadian, Czech, Egyptian, French, German, Greek, Indian, Indonesian, Italian, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Russian, Spanish, Swedish, Swiss and Turkish Groups feel the current law is inadequate.

**Common Reasons for Insufficiency of Protection**

The Egyptian, French and Turkish Groups feel the current protection is inadequate owing to unclear rules and uncertainty.

The Malaysian, Norwegian, Filipino, Russian and Spanish Groups feel the current protection is inadequate owing to insufficient protection for non-lawyer IP professionals.

The Swiss Group felt the protection was weak for communications between clients and third parties that were not lawyers or patent attorneys.

The Australian, Indonesian and Lithuanian Groups feel the current protection is inadequate because it is not contained in a statute. The Australian Group also feels the protection of communications between clients and third parties for the purposes of enabling a non-lawyer IP professional to give advice is insufficient, as statutory privileges may not apply (even if for the dominant purpose of enabling legal advice related to IP to be obtained and given).

The Panamanian and Polish Groups feel the current protection is inadequate because there is no protection at all in this situation.

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?

The Austrian, Chilean, Finnish, German, Hungarian, Irish, Israeli, Japanese, Mexican, Dutch, Romanian, Singaporean, Spanish, Swiss, Thai, United Kingdom and Venezuelan Groups feel the current protection is adequate.

The Argentine, Australian, Brazilian, Canadian, Czech, Danish, Egyptian, French, Indian, Italian, South Korean, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Portuguese, Russian, South African, Swedish, Turkish and American Groups feel the current protection is inadequate.
Common Reasons for Insufficiency of Protection

The Malaysian, Norwegian, Filipino, Portuguese and Russian Groups feel the protection is inadequate for non-lawyer IP professionals.

The Australian and Belarusian Groups feel the protection is inadequate because the law is not based in statute. The Australian Group also feels that the protection of communications between non-lawyer IP professionals and third parties is inadequate, as statutory privilege may not apply to communications between clients and third parties.

The American Group feels the protection for communications involving non-lawyer IP professionals, such as patent agents, is not well-defined across various jurisdictions and that uniformity is desirable.

The Egyptian, American, French, South African and Turkish Groups feel the protection is inadequate because the law is unclear.

The Indian, Panamanian and Polish Groups feel the protection is inadequate because there is no actual protection in this situation.

Communications with overseas IP advisors

1.7 Does your Group consider that the protection described in answer to question 1.4 above (Overseas Communications) is of appropriate quality or not, and if not, why not – what are the problems in practice?

The Austrian, Chilean, Belarusian, Finnish, German, Greek, Hungarian, Israeli, Italian, Japanese, Malaysian, Portuguese, Romanian, Swiss, Thai, Middle Eastern, American and Venezuelan Groups feel the protection is adequate.

The Canadian, Australian, Czech, Finnish, French, Indian, Indonesian, Irish, South Korean, Dutch, Norwegian, Filipino, Polish, Singaporean, South African, Spanish, Swedish, Turkish and United Kingdom Groups feel the protection is inadequate.

Common Reasons for Insufficiency of Protection

The Czech, Dutch, Egyptian, Finnish, French, Irish, Norwegian, Filipino, Turkish and American Groups feel that the law in this area is unsatisfactory because it is uncertain and unclear.

The Argentine and Singaporean Groups feel the law is unsatisfactory because there is inadequate protection for non-lawyer IP professionals.

The Indonesian, South Korean, Malaysian, South African, Swedish and United Kingdom Groups feel that the law is unsatisfactory because there is insufficient protection for overseas IP professionals.

The Canadian Group feels protection is insufficient in light of the lack of privilege for communications between IP owners and non-lawyer agents (both foreign and domestic), and the lack of privilege for lawyers acting in their capacity as agents.
The Australian Group feels that privilege attaching to communications between non-lawyer IP professionals and overseas IP professionals (especially where not a lawyer) needs to be established or made certain by statute.
Remedies

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?

The Australian, Austrian, Belarusian, Canadian, Chilean, Czech, Greek, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Mexican, Dutch, Norwegian, Filipino, Polish, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, United Kingdom, American and Venezuelan Groups agree.

The Argentine, Brazilian, Danish, Egyptian, Estonian, Finnish, French, German, Hungarian, Malaysian, Panamanian, Romanian, Swiss, Thai and Turkish Groups disagree.

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?

The Australian, South Korean, Polish, South African, Spanish and Swedish Groups agree because they feel that any approach to protecting IP professional advice at an international level is more likely to be widely adopted if countries are allowed to continue applying features from their existing national laws.

The Czech Group agrees because it believes this discretion would be helpful in accommodating the various differences between civil law and common law approaches to protection.

The Hungarian, Panamanian, Swiss and Turkish Groups disagree because they feel there is better protection under the current national law in their countries than there would be under any approach to protection that allows countries to keep applying features from their existing national laws.

The Canadian and Malaysian Groups believe the protection granted to non-lawyer IP professionals should be akin to solicitor-client privilege, which they believe has sufficient limiting features (e.g. only communications for the purpose of giving legal advice would be protected) to ensure that protection would not extend too broadly. The American Group agrees for similar reasons, namely that protection should only extend to documents that constitute communications relating to legal advice, and not so far as to include documents that merely contain facts relevant to a dispute without constituting communications.

The Brazilian, Finnish, Japanese, Filipino and Romanian Groups disagree because it would cause uncertainty.

The Egyptian and German Groups disagree because they want blanket protection with as few limitations and exceptions as possible.
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 Australian, Belarusian, Chilean, Czech, Danish, Indian, Israeli, Italian, Japanese, South Korean, Lithuanian, Mexican, Filipino, Portuguese, Russian, Spanish, Thai and American Groups all favoured such an approach.

The Argentine, Austrian, Brazilian, Canadian, Egyptian, Estonian, Finnish, French, German, Greek, Hungarian, Indonesian, Irish, Malaysian, Dutch, Norwegian, Panamanian, Polish, Romanian, Singaporean, South African, Swedish, Swiss, Turkish and United Kingdom Groups were all opposed to such an approach.

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?

Of the Groups that agreed with the allowance of judicial discretion to deny protection, the Belarusian, Indonesian, Israeli, Italian and South Korean Groups did so on the basis that such an approach was already consistent or compatible with their existing national law.

The Thai, American, Spanish, Australian and Japanese Groups agreed on the basis that there is a need for flexibility in the law. Australia also agreed on the basis that there would not be widespread adoption of any proposed approach to protection without allowing some flexibility for each National Group.

The Argentine, Austrian, Brazilian, Canadian, Egyptian, Finnish, Greek, Indian, Irish, Malaysian, Norwegian, Panamanian, Romanian, Singaporean, South African, Swedish, Turkish and United Kingdom Groups disagreed with the idea of judicial discretion on the basis that the law would be rendered vague and unpredictable, which would cause clients to use caution when disclosing information to IP professionals, instead of giving clients the confidence to make full and open disclosure.

The German, Polish and Danish Groups disagreed because they want to minimize the limitations on protection (though they agreed with the crime/fraud exception).

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?

The Italian and Swiss Groups believe the judge should be able to consider explicit requests from parties for the production of documents.

The Danish, South Korean, South African and Portuguese Groups would add an exception to the effect of a public interest exception, where the judge may determine production to be in the public interest or justified as a result of constitutional imperatives.
The United Kingdom, Swedish and Singaporean Groups believe that, in effect, the crime/fraud exception adequately covers anything a judicial discretion exception would cover.

The Australian Group feels a judicial discretion limitation would be acceptable if it were only to apply to disclosure in respect of communications between lawyers and clients in the same country.

**Qualifications required of IP advisors**

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 advisor ‘to be qualified to give the IP advice in relation to which the question arises, n the country in which the advice is given’?

The Austrian, Australian\(^2\), Belarusian, Canadian, Czech, Estonian, Greek, Hungarian, Indian, Indonesian, Irish, Italian, South Korean, Mexican, Filipino, Polish, Romanian, Russian, South African, Spanish, Swiss, Thai, Turkish and Venezuelan Groups agreed with this proposition.

The Brazilian, Danish, French, Argentine, Danish, Egyptian, Finnish, French, Israeli, Malaysian, Norwegian, Panamanian, Portuguese, Singaporean, Swedish, United Kingdom, American, German and Japanese Groups disagreed.

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?

The Argentine, Australian, Danish, Egyptian, Finnish, French, Israeli, Malaysian, Norwegian, Panamanian, Portuguese, Singaporean, Swedish, United Kingdom, American and German Groups all felt that IP advisors should be required to register or obtain legal qualification from a regulatory body or agency, so as to gain the public’s confidence.

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

i) What category is that?

In Argentina, Chile, the Czech Republic, Egypt, Finland, Ireland, Italy, Japan, Malaysia, Mexico, Netherlands, the Philippines, Romania, Sweden, Thailand, the United Kingdom and Venezuela, certain classes of IP professionals are permitted to practice without any qualification.

Additionally, in Argentina, Malaysia, Mexico, the Philippines, Sweden and the United Kingdom, anybody can give advice in IP matters.

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?

\(^2\) The Australian Group stated that it agreed with the way the standard was expressed, but noted that in Australia, patent and trade-mark attorneys are required to be registered.
The Argentine, Brazilian, Egyptian, Finnish, Filipino, Romanian, Thai and Venezuelan Groups agree that there should be protection for these categories of IP professionals that do not require any qualifications.

The Chilean, Czech, Irish, Italian, Japanese, Malaysian, Mexican, Swedish and United Kingdom Groups do not agree that there should be any protection for these groups.

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

The Brazilian, Egyptian, Filipino, Thai and Venezuelan Groups believe there should be protection because generally, IP advice to a client should be confidential. Allowing a break in this ‘chain of confidentiality’ would effectively render all communications unprotected.

The Swedish and United Kingdom Groups do not think there should be any protection because only registered IP advisors should be entitled to protection. The extra protection would be an incentive to encourage IP professionals to register.

Scope of protection against forcible disclosure – the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.5 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?

The Australian, Austrian, Belarusian, Brazilian, Canadian, Czech, Danish, Finnish, Greek, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Malaysian, Mexican, Filipino, Polish, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, Turkish, United Kingdom and American Groups agree that any approach to the protection of IP professional advice should allow countries to limit the protection according to categories of privilege which are currently part of their law.

The Argentine, Egyptian, Estonian, French, German, Hungarian, Dutch, Norwegian, Panamanian, Romanian and Venezuelan Groups do not agree with this proposition.

2.10 If no to 2.9, (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

The Argentine, Estonian, Hungarian, Panamanian and Swiss Groups disagree because they take the view that the absence of such limits will lead to uniformity and predictability in the law and encourage clients to give full and frank disclosure to IP advisors without worrying about exceptions from one country to the next.

The Dutch and Norwegian Groups disagree because their current national protection schemes already provide better and more predictable protection than any approach that would allow for countries to keep existing limitations.
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?

The Australian, Austrian, Belarussian, Canadian, Czech, Danish, Egyptian, Finnish, French, Greek, Hungarian, Indian, Irish, Israeli, Italian, South Korean, Lithuanian, Mexican, Norwegian, Panamanian, Filipino, Polish, Portuguese, Romanian, Russian, Singaporean, South African, Spanish, Swedish, Swiss, Thai, Turkish, United Kingdom, American and Venezuelan Groups agree.

The Argentine, Chilean, German, Indonesian, Malaysian and Dutch Groups disagree.

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 Austrian, Egyptian, French, Hungarian, Indian, Israeli, Norwegian, Panamanian, Singaporean, Spanish, Swedish, Turkish and United Kingdom Groups believe that there should only be liberty to abolish or vary a previously applied limitation for a result that increases protection. The Groups do not want countries to be able to reduce protection by varying or abolishing limitations.

The Danish, German, Polish, South African and Swiss Groups believe that there should not be any limits on privilege.

The Portuguese and Russian Groups agree because they do not think it is realistic that countries will surrender their power to modify their domestic law.

The Australian Group felt the only limitation should be to ensure that if any applicable categories of privilege are varied or abolished in respect of IP advisors, they should be similarly varied in respect of lawyers.

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.

The Australian, Austrian, Belarussian, Brazilian, Canadian, Chilean, Czech, Danish, Egyptian, Estonian, French, German, Greek, Hungarian, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Malaysian, Mexican, Norwegian, Panamanian, Filipino, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, Thai, Turkish, United Kingdom and American Groups agree.

The Argentine, Dutch, Polish, Swiss and Venezuelan Groups disagree.

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3 The Argentine Group did not agree in principle and said it should be treated on a case by case basis.
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 to waiver?

The Australian, Austrian, Belarussian, Brazilian, Czech, Danish, Egyptian, Estonian, Greek, Hungarian, Indian, Indonesian, Irish, Israeli, Japanese, South Korean, Lithuanian, Mexican, Dutch, Norwegian, Panamanian, Filipino, Polish, Portuguese, Romanian, Russian, Singaporean, Spanish, Swedish, Swiss, Thai, Turkish, United Kingdom and American Groups agree.

The Argentine, Canadian, German, Italian, Malaysian and Venezuelan Groups disagree.

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?

The Austrian, Hungarian, Indian, Israeli, South Korean, Dutch, Panamanian, Singaporean, South African, Spanish, Swedish, Turkish and United Kingdom Groups feel that there should only be a power to expand protection.

The Czech, Danish, Egyptian and Thai Groups feel there should not be any limits or exceptions to the law of privilege.

The Brazilian, Estonian, Japanese, Norwegian and Polish Groups feel that the 3 point exception would or could be appropriate.

2.16 Since the introduction of protection against forcible disclosure of IPP 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?

The American Group was the only to have reported any problems, namely the abuse of privilege, though this has been dealt with through inspection of documents on an in camera basis.

The Australian, Belarussian, Brazilian, Canadian, Danish, French, German, Hungarian, Indian, Irish, Israeli, Japanese, South Korean, Lithuanian, Malaysian, Polish, Portuguese, South African, Spanish, Thai and Turkish Groups have not experienced any adverse effects.

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 above), does your Group prefer and if so why?

The Argentine, Australian, Austrian, Belarusian, Brazilian, Canadian, Czech, Danish, Egyptian, Finnish, Greek, Indian, Indonesian, Irish, Italian, Japanese, South Korean, Dutch, Norwegian, Filipino, Polish, Portuguese, Russian, South African, Spanish, Swiss, Thai, Turkish and Venezuelan Groups prefer the AIPPI proposal.

The Japanese, South Korean, Dutch, Norwegian and Thai Groups prefer the AIPPI proposal because it reduces unpredictability and provides minimum standards on a larger scope for every country.

The Estonian, French, German, Malaysian, Panamanian, Romanian and Singaporean Groups prefer the Section 5 proposal.

The French and Panamanian Groups prefer the Section 5 proposal because it appears to be more compatible with the Civil Law, and settles the most detrimental issues with the most sophisticated countries.

The Swedish and United Kingdom Groups do not favour either proposal.

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.

The Thai Group would prefer an approach that provides protection against the disclosure of confidential information and can be adopted on a voluntary basis.

The Swiss Group would prefer that all countries simply adopt the new laws on protection that Switzerland has just passed.

The Austrian and Estonian Groups would prefer Section 5 if in-house IP counsel were not protected, or if privilege for in-house counsel were not required in countries which do not provide for it locally and do not accept it from other countries.

2.19 The Groups are invited to submit and 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.

The Norwegian Group would like to make it so that communications between clients and IP professionals belonging to a registered group are protected, whether or not they are overseas.

The Romanian Group would like to harmonize the rules for communications between IP professionals and clients with the rules for IP professionals (who are also lawyers) and clients.

The United Kingdom Group believes the aim should not be to define privilege, but to instead extend what already exists in a country to a defined group of foreign advisors in the same way as is done for lawyers.
2.20 With the introduction of protection against forcible disclosure of IP professional advice to 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?

The Swiss Group believes there may be a conflict since Switzerland’s new legislation (Art. 321) does not apply to in-house counsel.

The Australian, Belarusian, Danish, French, Hungarian, Indian, Indonesian, Irish, Japanese, South Korean, Lithuanian, Norwegian, Panamanian, Portuguese, Romanian, South African, Spanish, Thai and American Groups do not expect any adverse effects.
Conclusions

While 96% of the countries for which a response was provided offer some form of national protection, 73% of the National Groups acknowledged the inadequacy of the current scope of protection for particular categories of IP professionals (particularly non-lawyer IP professionals) whose clients should be protected, either by privilege or by an obligation of professional secrecy. Additionally, 30% of the countries presently extend no protection to communications with overseas IP professionals.

In terms of the qualifications required to give IP advice, there was a wide range of answers, but two categories of responses stood out. 59% of the National Groups felt that it would be sufficient if the IP professional was ‘qualified’ in the country from which the advice came. 32% of the National Groups felt that the IP professionals should be ‘registered’ or ‘permitted’ to provide services for clients in relation to the local IP office.

In terms of exemptions and exceptions, 58% of National Groups were not in favour of a judicial discretion exception. Its detractors cited the unpredictability of judicial discretion and its souring effect on disclosure from clients. The majority of National Groups agreeing with a judicial discretion exemption were countries whose national law already featured such an exemption. Several National Groups felt that the crime/fraud exception would likely cover all of the situations where a judicial discretion to force disclosure might arise. The crime/fraud exception is adopted in almost every country.

In terms of a country’s power to modify or abolish existing limitations to privilege, 55% of the National Groups felt this power should be restricted to use only for the purposes of expanding protection, as opposed to allowing it to be used to narrow protection.

The majority of National Groups preferred the AIPPI proposal when compared to the Section 5 proposal. Common reasons cited were the AIPPI proposal’s potential reduction in uncertainty in the law and setting a minimum standard for protection across all countries.
Indications for the Study of Remedies

1.1 The Committee of Q199 considers that the following indications (non-exhaustive) for the study of remedies should be referred to the SCP in support of AIPPI's submission that the SCP should mandate the Secretariat of WIPO to study remedies and recommend the preferred options for remedies. The Questionnaire probed the effects both of national law per se and national law in the international context (ie where IP professional advice is transmitted over the border).

1.2 The need for recognition by each country of effective protection from forcible disclosure that applies in another.

The Committee observes as follows.

(a) International arrangements need to avoid affecting existing national laws as much as possible.

(b) As to the respective positions of civil and common law countries, it seems a somewhat blunt instrument of remedy that the one system's protection should have to be adopted by the other country, when each has a system which works well in that country to protect advice against disclosure.

(c) On the other hand, some civil law countries see and foresee forcible disclosure creeping into their system against clients (particularly in relation to anti-trust actions which, of course, could also involve IP issues and advice given by IP professionals) and foresee the need for (client) privilege to provide protection of
IP professional advice which would otherwise be forcibly disclosed by requiring disclosure by the client.

1.3 The need to identify and study in the context of potential remedies, the inadequacies and anomalies of the protection which currently applies.

As to both civil and common law protection, there is a need to study the inadequacies of the scope of the protection they currently provide looking forward to prospective remedies.

The Committee observes as follows.

(a) The Responses (or a substantial number of them) in effect complain as to the inadequacy of the scope of protection for particular categories of IP professionals whose clients should be protected by privilege (common law) or by an obligation of professional secrecy (civil law) but who presently do not have that protection.

(b) Particular issues raised by the Responses relate to communications between IP professionals and their clients on the one hand and third parties on the other, where advice is required to enable them to either obtain or give IP professional advice.

(c) If remedies are being considered, it would be unfortunate to propose as a remedy a principle or protocol which was subject to an existing inadequacy or anomaly if that was avoidable.

(d) New Zealand amended its law of privilege in relation to IP practitioners in 2006. By those amendments, NZ protects communications between clients and overseas IP practitioners who carry out functions equivalent to its own, including non-lawyer patent attorneys. NZ does not require reciprocity for the benefit of privilege to apply to the clients of overseas IP professionals.

(e) Amendments to national laws extending the reach of protection from forcible disclosure in relation to local and overseas non-lawyer patent attorneys is proposed by Australia. Amendments to national laws extending the local reach of protection from forcible disclosure are proposed or being considered in Norway, Sweden and Switzerland. These developments should be studied and considered.

1.4 Limitations, exceptions and waivers

There are established limitations. For example, there could be limitations on the scope of protection by a test like – whether the contents of communications subject to a claim of protection were prepared for the ‘dominant purposes’ of obtaining or giving legal advice. There are also established exceptions (eg crime/fraud). That one not surprisingly seems to apply almost universally whether it is civil or common law. Judicial discretion applies in some cases to the application of common law privilege. As to the civil law professional secrecy obligation, it is not surprising that there are virtually no limitations (ie everything related to the advising process is protected by the obligation of non-disclosure which applies to the professional). Particularly, but not only, in order to determine what any
putative remedy is up against in relation to its adoption as an appropriate outcome, the study needs to define these differences and work out how they should be handled including possibly, how anything which cannot be universally accepted, may be avoided by the remedy which is proposed.

The Committee observes as follows.

(a) The Questionnaire had the intended bias of seeking responses on the concept of a civil law country adopting privilege with the limitations and exceptions which normally attend the application of privilege, but not seeking responses of a common law country adopting professional secrecy. This ‘bias’ is because the international problem has come about through common law countries not accepting the protection which applies in civil law countries because it is not privilege (which is a right which protects the client from forcible disclosure).

(b) It was not surprising that some of those responding from civil law countries in effect objected to the concept of there being any limitations or exceptions applicable to protection from forcible disclosure. The reason for that is that the form of protection with which they are familiar (professional secrecy) has no limitations and few exceptions (depending upon which country it is).

(c) A more complex response (taking the Responses globally) came on the issue raised by the Questionnaire as to whether countries in which privilege now applies, should be allowed to continue to apply the same limitations and exceptions as they currently have and if so, what right they should have in future to vary those. There was even less consistency in the Responses to this issue possibly because there is uncertainty about having limitations and exceptions when you are not familiar with those.

(d) On the right to vary established limitations and exceptions, there was an underlying concern that if the opportunity is being taken to harmonise, the outcome should be one of uniformity which is needed to achieve the related benefits of certainty and predictability.

(e) However, the impression remains from the Responses that given a better understanding of how privilege might be applied, eg as an ‘add on’ to existing professional secrecy which would remain unaffected, the requirement in some of the Responses of the need for absolute or near absolute privilege, might not be so real.

1.5 The need for ‘certainty’ of protection to achieve the confidence necessary for full and frank transfer and sharing of information between clients and their IP professional advisers (including third parties involved in the clients being so advised)

The Committee observes as follows.

(a) The purpose of having protection from forcible disclosure will not be achieved unless national amendments and the international arrangement for respecting
and supporting the protection which applies in another country, are certain in their effects.

(b) The AIPPI survey shows that there are numerous differences between the scope of protection and the applicable limitations and exceptions that apply around the world, but not so much as to waivers.

(c) We assume that within any given country the IP professional advisers manage the application of the protection which now applies there well, and thus the requisite confidence for full and frank transfer and sharing of information is achieved, at least as far as the protection which presently applies, extends.

(d) This present reason for confidence which applies in particular countries should not be disturbed by amendments that are made to achieve an international solution.

(e) The study of this subject is an essential part of the process of achieving a solution to the international problem.

1.6 Qualifications required of overseas/cross border IP professional advisers for their recognition in any other country

The Committee observes as follows.

(a) There was a wide range of answers to this issue in the Responses but two categories of answers stood out. The first was that for many Responders, it would be sufficient if the IP professional was 'qualified' in the country from which the advice comes, to give that advice. The second was that for even more Responders than those in the first category, there has to be something more than just being 'qualified', like being 'registered', or 'permitted' to provide services for clients in relation to the local IP office.

(b) The legal theory which underlies the question of what qualification(s) should be required, is that qualification of the professional is part of the basis for trust by the client in the IP professional. That trust and the protection of it encourage the full and frank transfer and sharing of information required for the advice to be given correctly.

(c) How this issue should be resolved is another matter connected with attracting the one country to recognise and respect the protection that applies to communications between a client and an IP professional in another country.

1.7 The definition of the protection to be applied – whether a minimum standard is required and if so, what will be its scope.

The Committee observes as follows.

(a) The NRGs were invited to consider the AIPPI proposal, the Section 5 proposal or to put forward their own.

(b) The AIPPI proposal was accepted by many on the basis that it was comprehensive. The Section 5 proposal was predictably accepted by some
European countries (and others) because it would solve the current problem of the non-recognition of non-lawyer European Patent Attorneys. The problem with that solution is that it does not deal with the problem of the non-recognition of non-lawyer patent attorneys elsewhere. The UK Group would accept ‘elements of both’.

(c) However, the UK Group suggests that the international problem is one which may be fixed by the common law countries applying the same protection they provide for their own non-lawyer patent attorneys to overseas equivalents. (We interpolate that this is what NZ has done and what Australia is proposing to do but not on the basis that it will solve non-recognition of their IP professionals overseas).

(d) The UK proposal should be considered and studied but does it on its face solve the international problem? If there was a dispute in US courts over the application of protection from disclosure overseas, they would not now accept that communications between clients and non-lawyer patent attorneys overseas were relevantly protected unless there is a law equivalent to privilege (ie client protected from having to disclose) in the foreign jurisdiction. If the US applied the same protection as it applies to its patent agents (ie nil), the protection applied to non-lawyer European Patent Attorneys would not be improved.

(e) Perhaps there is a more effective alternative in having common law countries accept that professional secrecy where there is no discovery means in effect that the client is protected from forcible disclosure and that should be accepted as equal to privilege.

(f) However, the ‘alternative’ suggested in the previous paragraph does not deal with the fact that whilst there is no discovery in most civil law countries, in theory some civil law courts can still require disclosure by a client of documents in which the client’s legal advice is involved.

(g) As mentioned above, the NRGs of some European civil law countries foresee the greater use by courts of forcible disclosure of IP advice particularly in anti-trust cases and would prefer that clients had privilege to protect them from disclosure of that advice.

1.8 Essentially, these comments on the Responses to the Questionnaire indicate the need for the matters raised in this paragraph (among others), to be studied.