AIPPI Submission to WIPO for a treaty to be established on Intellectual Property Adviser Privilege

This submission addresses the need for a treaty to establish laws in the Member States of WIPO providing for minimum standards for the recognition, observance and protection of communications to and from Intellectual Property (IP) advisers as confidential information, in relation to their advice on intellectual property rights (IPR), in other words for the protection of privilege.

1. Introduction – Summary of the issue arising on the need for privilege and the proposed solution

The Problem

1.1 The lack of uniform laws relating to the application of privilege to communications to and from IP advisers and their clients, is causing IP owners to risk loss of and lose confidentiality in advice they obtain from IP advisers. It also causes loss and the risk of loss of privilege in countries where privilege would apply.

1.2 Privilege is dependent upon confidentiality in the communications to which it applies first being established and then being maintained. If privilege is not recognised in one of two countries in which an owner of IP wishes to enforce that IP, communication of the advice obtained in the country where privilege does exist to the country where it does not, brings with it the risk that the advice may be required to be made public in the latter country. If it is thus forced to be published, it is no longer confidential. Thus, privilege in the advice will be lost in the country where privilege would otherwise have existed.

1.3 Privilege exists for the purposes of encouraging those seeking advice and those giving it to be fully frank with each other in the process. The global nature of trade and of IPR which supports that trade, go hand in hand. Thus, the problems of different standards of privilege and of the recognition in one place of privilege and non-recognition of privilege in another place, are inevitably going to cause problems in doing business based on, and in enforcing, IPR.

1.4 The scope of privilege in each country involved in this issue needs to be minimally the same. First, privilege must apply to local IP advisers. Second, it must extend to all those involved in giving instructions for advice and in giving the advice. As to those giving advice, it has to extend to anyone giving IP advice who is qualified in that country to do so and third parties (like experts) who contribute to the advice which is given. Third, it must extend to overseas IP advisers whose advice is sought in relation to the local position including national and international aspects of that position.
1.5 The chain of protection of privilege from one country to the next (like all chains) is only as strong as its weakest link. The implications of weak links or even missing ones in the chain of protection of privilege around the world, is negative for the efficiency of trade in products, processes and methods of use that are the subject of IPR.

The Solution

1.6 AIPPI submits that the solution to the problem described above is a treaty specifying minimum standards for the protection of communications to or from IP advisers, in essence 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.

The subject of the treaty which AIPPI proposes is set out in more detail in Section 5 below.

2. The issue of privilege applying to communications to and from intellectual property advisers

2.1 The obtaining and maintenance of IPR globally involves advice from IP advisers from country to country. The enforcement of IPR from country to country brings owners of IPR up against several issues in this context. Firstly, an issue arises whether they can obtain advice from IP advisers which by local law will remain confidential to the owners unless the person by whom the advice is obtained, chooses to publish it. Secondly, an issue arises whether privilege will be lost because of the differences between the recognition of privilege in one country and another as described in paragraph 1.2 above. Thirdly, the privilege which is applied locally may not extend to all categories of intellectual property advisers who may become involved in giving advice on the same subject transnationally. Thus, for example, a US patent agent (not a lawyer) who comments in writing to the same patentee in the US and Australia on Australian legal advice, may cause the loss of privilege in Australia.

2.2 Further, some countries recognise legal professional privilege locally and with some qualifications, also in respect of legal advice by overseas lawyers. However, when it comes to patent attorney advice, whilst privilege is recognised for those who are qualified locally, privilege does not apply to communications with patent attorneys overseas who are not also lawyers. This applies in Australia for example.

2.3 The lack of uniformity of protection of privilege is widespread, including the fact that in some countries privilege is not recognised at all (which does not apply in Australia). The situation is no better in some countries where there is uncertainty about whether privilege will be recognised either locally or transnationally.
2.4 The principle underlying the recognition of professional advice privilege is that those seeking the advice should provide those giving the advice with all the information they have that could be relevant to the giving of the best advice. This means, of course, that everything which is known for or against the legal position which is being considered, should be openly provided to the adviser. For the adviser’s part, the adviser should be able to be completely frank with the person advised. If the cross-flow of such information (instructions from one side and advice from the other) is restricted because it will, in effect, be at risk of being published, both the process of instructing the adviser and of the adviser giving advice itself, are affected adversely. This is true, of course, whether the restriction is caused by failure to recognise privilege either locally or transnationally. There is therefore a strong need to have privilege applicable in all relevant countries and as between them.

2.5 Recognition of the potential for instructions and advice to be compromised by being published, can in effect be a barrier to trade. This is because owners of IPR may decide that it is not practical to enforce IPR where the consequences of doing so may be that their instructions and advice get published and used against them whether locally or internationally.

2.6 The need for a universal minimum standard of privilege which is to apply locally and as between countries is urgent. There should be minimum standards for protection of privilege wherever IPR might need to be enforced. Obviously enough, there is no point in providing for the recognition of IPR in the first place if there is not also to be a viable process for their protection. The process for protection of IPR is at best compromised if privilege does not apply locally in each of the countries where trade based on the IPR occurs. At worst, the process of protecting IPR and the trade in which that IPR is implicated, may be deemed by the owner of the IPR to be not worth pursuing.

3. AIPPI Q163

The Resolution and Report

3.1 The AIPPI Special Committee Q163 was set up to investigate whether legal attorney-client privilege applied to communications between patent and trade mark attorneys and their clients. We note that this is a narrower category of IP advisers than the category to which the problem we are dealing with now relates. The category of IP advisers dealt with by Q163 is nonetheless a substantial part of the one we are dealing with now.

3.2 In its preliminary work (an informal analysis of privilege in some major countries), the Committee found that there is considerable variation internationally in the treatment of privilege. It noted that there were a number of major factors influencing the type of protection available to patent and trade mark attorneys, including the following.

(a) The availability of discovery or forced disclosure in the jurisdiction.

(b) The status of the patent or trade mark professional in the jurisdiction.

(c) The common law/civil law tradition of the jurisdiction.
3.3 The Committee made some general findings as follows.

(a) Some countries recognise that attorney-client privilege extends to patent and trade mark attorneys: for example, the United Kingdom, United States, Germany.

(b) Some countries do not recognise privilege between patent and trade mark attorneys and their clients: for example, France, Italy, Korea.

(c) In some countries the question is unclear, and legislation/rule changes to clarify that such privilege exists have been proposed: for example, Japan.\(^1\)

(d) In some countries protection of patent attorney communications takes another form or has additional protection, that is, it is a crime or violation of professional obligation rule for a patent or trade mark attorney to disclose a client's confidences: for example, Japan, United States.

3.4 The Committee concluded that the issue of patent and trade mark attorney privilege is a 'real and serious issue' for clients with intellectual property in multiple jurisdictions. It noted as follows.

(a) The role of the patent and trade mark attorney, regardless of whether he or she is also qualified as an attorney at law, is an important one and is becoming increasingly important.

(b) Clients reasonably expect that their communications with their local and international patent attorneys will be treated, with respect to privilege, in the same way as communications between clients and the attorneys at law.

(c) The overall intellectual property system will benefit from this form of privilege because it encourages full and timely disclosure between clients and their patent and trade mark attorneys.

The preliminary report of Q163 was considered by the EXCO of AIPPI at Lisbon in March 2003. That report is Appendix 1 to this Submission.

3.5 Subsequently, the members of 22 National Groups of AIPPI reported formally on the issue of attorney-client privilege and the patent and/or trade mark attorney professions. The Reports of 19 of the National Groups (those that are available on the website), are Appendix 2 to this submission.

3.6 The Reports of National Groups in Q163 were dealt with in the Reporter-General's Report to the members of AIPPI. The Report was considered by the EXCO of AIPPI at Lucerne in 2003. The Report is Appendix 3 to this Submission.

3.7 On the basis of the report, AIPPI passed a Resolution at Lucerne in 2003, the essence of which is as follows.

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\(^1\) Subsequently Japan has introduced statutory protection for patent and trade mark attorneys under articles 197 and 220 of the Civil Proceedings Act 1998.
That 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.

The full Resolution of Q163 is Appendix 4 to this Submission.

3.8 The crux of the AIPPI resolution is that patent and trademark attorneys should be afforded the same level of protection as communications between legal attorneys and their clients.

**Limitations of the AIPPI Q163 Resolution**

3.9 We have noted in paragraph 3.1 above that this Resolution applied to patent and trademark attorneys, a narrower category of intellectual property advisers than the category to which the problem addressed by this submission applies.

3.10 As well, the Resolution of Q163 does not deal with the problem caused by the lack of harmony between countries. As the Australian example shows (see the following Section), it is not enough for the due protection of privilege internationally that the law is adequate within a particular country. For example, as previously cited in paragraph 2.1, privilege which is protected in Australia for some intellectual property can be lost in the United States by disclosure to an IP adviser there to whom the protection in Australia does not extend.

4. An example of the problem of inadequate protection of privilege as to intellectual property advice – the Australian experience

4.1 The Australian experience is a particular example of the problem, as follows.

**Legal professional privilege**

4.2 The protection of communications between clients and their legal practitioners is one of the many characteristics of English law that was imported into the Australian legal system under the common law. This privilege is known in Australia as ‘legal professional privilege’. Under the broad umbrella of legal professional privilege, communications to and from a client and lawyer will be protected where the communications are created for the dominant purpose of giving or receiving legal advice (**advice privilege**) or created for the dominant purpose of preparing for actual or anticipated legal or administrative proceedings (**litigation privilege**). In some jurisdictions of Australia, these forms of privilege have been partially codified by legislation.²

4.3 In Australia, legal professional privilege is a rule of substantive law based on the need to promote the public interest in the due administration of justice by encouraging full and frank

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² See sections 118 and 119 of the *Evidence Act 1995* (Cth), which applies to proceedings in the ACT and Federal Court. See also sections 118 and 119 of the *Evidence Act 1995* (NSW).
disclosure between clients and their lawyers (see Daniels Corporation International Pty Ltd v ACCC (2002) 192 ALR 561).

4.4 In addition to communications between clients and their lawyers, legal professional privilege has been extended to communications by agents for the dominant purpose of the provision of legal advice between a client and their lawyer (see Australian Rugby Union Ltd v Hospitality Group Pty Ltd (1999) 165 ALR 253), and to documents generated by third parties for the same purpose (see Pratt Holdings Pty Ltd v Commissioner of Taxation [2004] FCAFC 122).

4.5 In the recent case of Kennedy v Wallace (2004) 213 ALR 108, advice privilege was held to extend to communications between a client and its foreign legal representative. It should be noted that these decisions have not been confirmed by the highest court of appeal in Australia, the High Court, and may therefore be overturned or modified by later decisions. This is an undesirable uncertainty.

**Patent attorney privilege**

4.6 In Australia, communications between patent attorneys and their clients are not protected under the common law by privilege analogous to legal professional privilege (see Heerey J in Eli Lilly & Company v Pfizer Ireland Pharmaceuticals (No 3) [2004] FCA 185 citing Wilden Pump Engineering Co v Funfield [1985] FSR 159). However, a limited form of statutory privilege attaches to communications between patent attorneys and their clients. Section 200(2) of the Patents Act 1990 (Cth) (Patents Act) states:

> 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.

'Intellectual property matters' are defined as matters relating to patents, trade marks or designs, or other related matters. A 'registered patent attorney' is defined as patent attorney registered under the Act.

**Trade mark attorney privilege**

4.7 Section 229 of the Trade Marks Act 1995 (Cth) provides protection for trade mark attorneys in identical terms.

**The problem in Australia**

4.8 First, because sections 200(2) of the Patents Act and 229 of the Trade Marks Act only apply to patent and trade mark attorneys registered under the respective acts (that is, Australian patent and trade mark attorneys), privilege does not apply to communications with foreign patent or trade mark attorneys. This interpretation of section 200(2) of the Patents Act was confirmed in the recent case of Eli Lilly v Pfizer Ireland Pharmaceuticals (No 3) [2004] FCA 1085. Second, the wording of the sections applying both to patent attorneys and trade mark attorneys, excludes from protection communications between patent and trade mark attorneys and third parties. The same communications by a lawyer
with a third party would be subject to legal professional privilege if the communications were for the dominant purpose of legal advice and were made to or by a lawyer.

4.9 The Intellectual Property Committee (IPC) of the Law Council of Australia has proposed to the Australian government that the *Patents Act* be amended to address these two problems. The IPC submission which fully explains the shortcomings of the current Section 200(2) of the *Patents Act* is Appendix 5 of this submission. Section 200(2) as proposed by IPC would be as follows.

A communication to or from a registered patent attorney or a patent attorney or patent agent of another country in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged as at the date at which privilege is claimed, to the same extent as a communication to or from a legal practitioner.

This addresses two problems – *first*, that privilege would extend to communications with foreign patent or trade mark attorneys and *secondly*, communications with a third party are not excluded from privilege.

4.10 However, this proposal will not (if adopted) completely solve the problem in Australia. IP owners will still be disadvantaged by inadequacies in protection in other jurisdictions. While communications with local and foreign patent and trade mark attorneys will be privileged in Australian proceedings, the same communications made to attorneys in other jurisdictions where privilege does not apply, will obviously not be privileged in those places. Further, if by reason of the loss of privilege of those places, the communications are forced to be disclosed in public, privilege will be lost in Australia. Loss of confidentiality caused by disclosure of what would otherwise have been privileged elsewhere, means loss of privilege everywhere because the maintenance of privilege depends upon the maintenance of confidentiality. These difficulties can only be resolved by treaty.

5. The solution

5.1 The Australian experience demonstrates that even if the law is made adequate within Australia to provide privilege which covers both local and overseas patent and trade mark attorneys, the Achilles heel remains that privilege in Australia may be lost through non-recognition of privilege in another country which causes the subject matter which is privileged in Australia to be published.

5.2 Therefore, AIPPI submits that the making (including subsequent implementation) of a treaty prescribing minimum standards of privilege which are to apply to communications relating to advice given by IP advisers, is required. The protection of privilege in one country must be extended by that country to an IP adviser in any other country. This requirement is to avoid the problem of the local law not applying privilege to overseas IP advice dealing with the same or an equivalent IP subject as local advice does. IP advice given in such circumstances is a frequent requirement for owners of IP around the world. Accordingly, local law needs to recognise the role which overseas IP advisers have and frequently exercise in assisting local ones with the subjects of IP with which they are dealing.
5.3 Consistent with the Resolution of the Committee of AIPPI Q163, the privilege should also cover the following matters.

(a) The privilege should cover all communications between attorney and client arising out of the professional relationship.

(b) The privilege should cover technical and legal matters.

(c) The privilege should cover responses to patent or trademark office actions, to the extent that such information is not publicly available.

(d) The privilege should extend to patent attorneys and agents alike, irrespective of whether they are permitted or qualified to appear before the court.

5.4 Further, it seems right that the privilege should extend to cover communications made (in confidence) with third parties in relation to the advice of IP advisers on IPR.

5.5 Accordingly, AIPPI proposes that the treaty be in the following form.

**Recognising as follows**

1. Intellectual property rights (IPR) exist globally and are supported by treaties and national law: global trade requires and is supported by IPR.

2. IPR need to be enforceable in each country involved in trade in goods and services supported by those IPR, first by law and secondly by courts which apply due process.

3. Persons need to be able to obtain advice in confidence on IPR from IP advisers nationally and transnationally, and therefore communications to and from such advisers and documents or other records relating to such advising need to be confidential (privileged) to the persons so advised unless and until they voluntarily make such communications, documents or other records public.

4. The underlying rationale for the protection of the confidentiality of such communications, documents or other records is to promote full and frank disclosure between IP advisers the persons so advised and third parties which either of them may consult in relation to the advice on IPR.

5. Failure to support confidentiality in such communications documents or other records within particular countries, and the failure in particular countries to extend privilege to IP advice given by IP advisers in other countries, can cause or allow advice on IPR by IP advisers to be published and thus privilege in that advice to be lost everywhere.

6. The adverse consequences of such loss of privilege include owners of IPR deciding not to enforce IPR where the consequences of doing so may be that their instructions and IP advice get published and used against them both locally and internationally.

7. At best, the consequences of loss of privilege or the potential for loss of privilege are negative for the obtaining of advice by those who need advice on IPR and, at worst, they are negative for trade in goods or services related to the IPR and thus, in effect, they are a barrier to trade.

8. Laws need to be adopted nationally applying minimum standards for the protection of privilege in communications to and from IP advisers in relation to advice on IPR.
(including other parties consulted in relation to the giving of that advice), and such laws should also give effect to privilege for communications relating to IPR to and from national and overseas IP advisers, including documents and other records relating to those communications.

**Accordingly Members hereby agree as follows**

Each Member State shall adopt laws giving effect to the due observance in that Member State of the following minimum standard for the protection of privilege in relation to communications with intellectual property advisers.

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 legally qualified in the country where the advice is given, to give that advice.

'**intellectual property rights**' includes any matters relating to such rights.

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**List of Appendices to this Submission**

Appendix 1 – The Preliminary Report of AIPPI Q163

Appendix 2 – The Reports of National Groups of AIPPI on Q163 Attorney-Client Privilege and the patent and/or Trademark Attorneys profession

Appendix 3 – The Report of Q163 Attorney-Client Privilege and the patent and/or Trademark Attorneys profession

Appendix 4 – Resolution of Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Appendix 5 – The Submission of the Law Council of Australia to IP Australia on the need to amend Australian law on the recognition of privilege under the *Patents Act 1990*.

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July 25, 2005
By Email

WIPO
Mr Francis Gurry
Deputy Director General
34, Chemin des Colombettes
CH - 1211 Genève 20
Switzerland

July 26, 2005

Re: AIPPI Submission to WIPO for a treaty to be established on Intellectual Property Adviser Privilege

Dear Francis

1. The inadequacies of laws relating to privilege applying to communications to and from intellectual property advisers.
2. AIPPI Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession.
3. AIPPI Submission in support of the urgent need for a global treaty on the adoption of minimum requirements for applying privilege to communications to and from intellectual property advisers.

The Members of AIPPI identified the need for laws providing minimum standards for privilege as to patent and trade mark attorneys in its Resolution on Q163.

The problems underlying the Q163 Resolution are now having practical adverse effects on owners of IPR in relation to patent and trade mark attorneys and a wider category of IP advisers. Perhaps the worst outcome of the inadequacies of the laws relating to privilege is that the lack of appropriate protection of communications relating to IP advice can cause trade barriers. That occurs where owners of IPR decide that it is not worth the risk of trade relying on the IP they own, in a country which does not recognise privilege in communications of IP advice.

These matters are explained in the AIPPI Submission to you which I attach. I commend the Submission to you.

MEMBERS OF THE BUREAU:
Öjken Granölen (Sweden), Ronald E. Myrick (USA),
Vincenzo M. Pedrazzini (Switzerland), Luis-Alfonso Díaz (Spain), Jacques A. Léger G.C. (Canada),
Michael Brunner (United Kingdom), Jochan Böehling (Germany), Ian Karet (United Kingdom)
Guillermo Carey (Chile), Bertrand F. Micheli (Switzerland), Robert Miller (Australia)

ASSISTANTS TO THE SECRETARY GENERAL:
Dariusz Szloper (France), Thierry Calame (Switzerland), Nicolai Lindgreen (Denmark)
If WIPO is persuaded (as we hope that it will be), to proceed with the establishment of a treaty to provide minimum standards for the protection of privilege, AIPPI is willing in principle to support your effort by providing such further information in this context as WIPO may require which AIPPI may have or be able to obtain from its resources (essentially from its Members).

AIPPI regards the creation of a treaty on privilege as a matter needing urgent attention by WIPO.

Yours truly,

Michael Dowling
Member of Honour

Luis-Alfonso Durán
Reporter General

Encl.: AIPPI Submission
Appendix 2

The Reports of National Groups of AIPPI on Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys profession
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Argentine Group

I. **GENERAL RULES REGARDING ATTORNEY-CLIENT,**
**PRIVILEGE REGARDING PROFESSIONALS IN GENERAL.**

1. The boundary between the conflicting claims of confidentiality, on the one hand, and of
   obedience to judicial orders, on the other, is not a clearcut one.

2. Nevertheless, it is a general accepted principle in Argentina that a practitioner of the liberal
   arts must in principle refrain from divulging any information concerning his clients, to which
   he has had access in the discharge of his professional duties.

3. This principle has been accepted in Argentina by the National Procedural Codes for
   criminal and for civil and commercial matters.

4. Article 398 of the National Procedural Code for Civil and Commercial Matters provides the
   following:
   "The information requested may be refused only in the event that there is a legitimate cause for
   maintaining confidentiality or secrecy, which circumstance must be made known to the Court
   within five days".

   Article 444 of the same Code provides as follows:

   "Witnesses are entitled to refuse answering questions:
   1) If the answer could expose him to criminal prosecution or jeopardize his reputation;
   2) If the reply would necessarily entail the disclosure of a professional,
      military, scientific, artistic or industrial secret."

5. Article 156 of the Criminal Code in its turn provides as follows:

   "There shall be imposed a penalty or fine from fifteen hundred to ninety thousand pesos, and
   special disqualification if applicable of three months to three years, on those who, having had
Appendix 3

The Report of Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession
Report Q163

Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Introduction
The Committee was established by the Bureau to investigate the new question of the applicability of the attorney-client privilege to communications between patent or trademark attorneys and their clients.

The Committee first conducted an informal survey of several large jurisdictions among the Membership to gain an understanding of the issues surrounding this question. As a result of this preliminary research, the Committee determined that there was a significant amount of variation as to the treatment of the privilege across various countries. In addition, there were several factors suggesting the question was ripe for examination and Resolution on the international level:

1. With the increasing value of Intellectual Property, the role of the patent and trademark attorney, regardless of his or her qualifications as well as an attorney-at-law, is an important one and is becoming more important every day;

2. Clients, on a world wide basis, reasonably expect that communications with their local and international patent and trademark attorneys will be treated with the same degree of confidence and professionalism as are their communications with attorneys-at-law; and

3. As is the case for the attorney-client privilege, the overall Intellectual Property system will be better served if clients are encouraged by the existence of a similar privilege to fully and timely communicate all relevant facts to their respective patent or trademark attorneys.

The Groups were therefore invited to deal in depth with this important question of current interest. The question raised specific issues of national effect on which each of the Member countries were invited to comment. The Reporter General received Comments from 22 National Groups: Argentina, Australia, Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Germany, Greece, Japan, Latvia, Mexico, Netherlands, Philippines, Poland, Republic of Korea, Spain, Sweden, Switzerland, the United States, Ukraine, and United Kingdom.

This Summary Report analyzes the replies from the Groups in the order of the issues were set out in the survey.

The Responses from the Groups:

1. **Privileges protecting disclosure of communications between attorneys-at-law and their clients**

   The Groups were invited to explain the current situation within their jurisdiction in respect of the attorney-client privilege generally, including discussion of the limits, the practice significance, and consequences for violation. The privilege protecting communications between attorneys-at-law and their clients is universally recognized in some form by all of the responding Groups. Although there are slight variations in the treatment of the privilege, the following statements are generally applicable to all of the Groups:

   - The attorney-client privilege protects against forced disclosure to third parties of confidential communications between the attorney and the client in the course of the attorney-client relationship.
The attorney-client privilege is generally not limited in time by the duration of the relationship.

Disclosure of privileged information may subject the attorney to consequences, which could take the form of disciplinary, civil or criminal sanctions.

Nearly all of the responding Groups stated that the attorney-client privilege arose by way of statutory law. The Groups from Poland, Brazil, Japan, Germany and Mexico indicated that the privilege was simultaneously enforced by way of statutory law and professional ethics. In the Philippines, the privilege is established not only by statute, but also by administrative rule and regulations and by case law. The United Kingdom and Canadian Groups stated the duty to maintain confidential communications between attorney and client was created solely by case law. In the United States the privilege is generally regarded as a matter of common law, although the professional obligations laws of the various States also recognize the privilege, sometimes in statutory form.

Although most of the responses described a specific attorney-client privilege, the Argentine and Mexican Groups indicated that the attorney/client privilege within their jurisdictions is grounded in a general secrecy principle that obligates all professionals to keep confidential those secrets that they obtained through the course of performing their profession; no specific rule was articulated regarding attorneys-at-law. Canadian law, on the other hand, not only recognizes a specific attorney-client privilege, but goes further to distinguish between two types known as the solicitor-client privilege and the contemplat ed litigation privilege. Both privileges arise from obtaining professional legal advice from a lawyer, but the latter is narrower in its protection than the former. In Japan, nondisclosure privilege has its basis in the unique position of a person being required to disclose something, and does not require the privileged matter be a certain kind of communication with another person.

The Australian Group described a type of privilege that was broader in its protection in that it extended to communications between the client and another person, or the lawyer acting on behalf of the client and another person, where the communication was for the dominant purpose of the client being provided with professional legal services. The Australian interpretation of the attorney-client privilege therefore turned on a question of the purpose of the communication and was not restricted to communications between attorneys and clients.

There is substantial variation as to the limitations upon the attorney-client privilege across the responding Groups. In some countries, disclosure may be permitted or even required in certain instances. Most countries require client approval in order for disclosure to be permissible. The Argentine, Ukrainian and Polish Groups noted that criminal cases present a situation where disclosure may be necessary. In Argentina, it is generally accepted that the professional retains some discretion in determining what constitutes privileged material; however, such discretion is limited by the requirement that there be "legitimate cause" to maintain secrecy. Similarly, "legitimate cause" is required in order to disclose a confidence and avoid criminal penalty. In Brazil, a similar concept of "reasonable ground" is required in order to avoid punishment for disclosing privileged material.

The attorney-client privilege in Switzerland, however, grants the attorney-at-law discretion over the decision to disclose. The Swiss Group stated that once a communication is determined to be privileged, there is no obligation on the part of the attorney to disclose, even if the client asks him to do so. In effect, an attorney may disclose if authorized, but is not obliged to do so. The Greek Group made a more general statement that an attorney-at-law may never be examined as a witness in cases where the witness was involved as attorney, without the prior authorization of the Bar Association or in urgent cases.
In jurisdictions that have no discovery or disclosure procedure, as articulated by the Chinese Group, the judges do not force interested parties to produce certain documentation or testimony. Thus, the interested parties do not need to rely on the attorney-client privilege for not producing documentation or testimony. However, the Chinese Group acknowledged the practical significance of the privilege in securing client confidence and trust in their attorneys.

Three of the responding Groups (Ukraine, Australia and Canada) stated that the attorney-client privilege was limited to only legal matters. Bulgaria, Switzerland, Brazil, Denmark, Germany, Greece, China and Japan, on the other hand, indicate that the privilege is broad enough to encompass non-legal matter as well, so long as the information was obtained in the course of the attorney's professional assistance. Most of the responding Groups also limit the invocation of the attorney-client privilege to circumstances where the protecting of privileged information will not further the commission of fraud or crime.

Amongst the Groups that included significant specificity as to how the attorney-client privilege arose and was treated in their respective legal systems, the great majority indicated that the privilege could be invoked in all types of cases, be it civil, criminal or administrative. The Australian and Canadian Groups limited the privilege's applicability to civil and criminal matters. The Japanese Group went further and stated that the privilege could only be invoked in every civil case. And, the Latvia Group, although stating that the privilege could be asserted in several contexts, acknowledged that the privilege was most significant within the criminal context.

Although nearly every Group indicated the attorney-at-law to be subject to disciplinary measures for violation of professional conduct rules, some countries go further and impose civil and criminal sanctions as well. In particular, attorneys-at-law in the Ukraine, Bulgaria, Switzerland, Brazil, Spain, United Kingdom, Philippines, Australia, China and Japan may be required to pay damages or receive civil sanctions for violating the privilege. In the United States, disciplinary measures for violation vary by state, but civil penalties (such as a malpractice claim) as well as state bar disciplinary actions (such as suspension of the right to practice or in an extreme case disbarment) are possible. In Argentina, Bulgaria, Germany, Switzerland, Brazil, Denmark, Spain, Mexico, Philippines, China and Japan, it is a criminal offense to violate the attorney-client privilege, and the attorney-at-law may be subjected to possible imprisonment.

2. Privileges protecting disclosure of communications between patent or trademark attorneys and their clients

The Groups were invited to explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents, or trademark attorneys and their clients. It is to be noted that terminology and responsibilities varied across countries as to patent attorneys, trademark attorneys, and patent agents, but the following points are some generalizations that can be made regarding the responding Groups:

- There is a distinction made between attorneys-at-law, who may deal with a range of various legal issues, and patent attorneys, who deal primarily with intellectual property rights or sometimes a more restrictive set of responsibilities limited to obtaining a patent from the Patent Office. Only attorneys-at-law may typically appear before a court in litigation.

- Patent and trademark attorneys are generally not attorneys-at-law. Although they can be both, there is typically no requirement that the patent or trademark attorney also be an attorney-at-law.
Patent agents and patent attorneys are terms used interchangeable. They refer to the same type of position. (For purposes of consistency, the term "patent attorney" will include patent agents.)

Particularly notable is the fact that Greece requires that patent and trademark attorneys are required to be attorneys-at-law. Thus, patent and trademark attorneys are one and the same as attorneys-at-law. In the United States, by definition, patent attorneys are also attorneys at law, although a large number of patent agents who are not attorneys are also registered to practice before the U.S. Patent and Trademark Office.

There was a split amongst the responding Groups as to what level of recognition was given to a privilege protecting the communications between patent or trademark attorneys and their clients. Greece, Germany and Japan noted that the privilege protecting patent or trademark attorney communications was the same as or similar to the privilege protecting attorney-at-law communications, and arise out of the same source of law. The Japanese Group noted in particular, the nondisclosure privilege is considered to have its basis in professional or social responsibility, different from the common law, and therefore is imposed on patent attorneys as part of their professional duties.

The Groups from the Czech Republic, Australia, Ukraine, Bulgaria, Brazil, China, Spain, Poland, Mexico and United Kingdom indicated that a separate privilege exists for patent attorneys, arising either out of statutory law or professional rules that were specific to the patent attorney profession. In Australia, for example, patent and trademark attorneys' communications are privileged, as regulated by the respective Patents Act and the Trademarks Act. Even though the source of the privilege is separate, however, Australian law treats this privilege as the same as when an attorney-at-law communicates with their client. The distinction to be made is that the patent and trademark attorney privilege extends only to Intellectual Property matters, and communications with a dominant purpose of obtaining the patent or trademark attorney's advice.

In Brazil, the patent and trademark attorney privilege is created by the Agents' Ethical Code of Behavior, and limited by the same "reasonable ground" standard as the general attorney-client privilege. Although the Chinese Group stated there was no specific regulation on the patent or trademark attorney-client privilege, Chinese Patent Law and Regulations include provisions requiring keeping client's inventions and information learned by the attorney during the course of their relationship confidential. The Czech Group noted that the privilege afforded to patent and trademark attorneys extends to technical disclosures made during such communications.

Because Argentine and Mexico possess an attorney-at-law privilege grounded in general secrecy principles applicable to all professionals, patent and trademark attorneys enjoy privileges grounded in these very same principles. These two Groups indicate that there is no more specific law that deals with this issue. Communications between patent attorneys and their clients in the United States are treated the same way as communications between attorneys at law and their clients; the same generally holds true as to communications between patent attorneys and their clients, as long as the communications are within the scope of the patent agent's license to practice before the U.S. Patent & Trademark Office.

Finally, no specific privilege is recognized in Latvia, Denmark, the Philippines, Switzerland or Canada. The Canadian Group acknowledged, however, the possibility that a litigation privilege may attach where a non-lawyer patent or trademark attorney was assisting the client or lawyer on contemplated or pending litigation. The Danish Group stated that third parties are able to access any and all correspondence between the patent attorney and the patent office when the application is laid open, but also acknowledged that
internal correspondence and advice between patent owner and patent attorney would probably be considered internal working notes and therefore a court will not request production. The Swiss Group explained the lack of specific privilege was due to the fact that there are currently no specific requirements or qualifications for representing clients before the Federal Institute of Intellectual Property.

3. Proposal for general rules

The Groups were invited to comment on whether the AIPPI should take a position regarding the consistent recognition throughout the Groups of a privilege protecting communications between patent attorneys and their clients. Among the responses received, there was virtually unanimous support for the AIPPI taking a position in support of the existence in the Member countries of a privilege for communications between patent and trademark attorneys and their clients that is equally protective as the privilege protecting communications between attorneys at law and their clients. However, a few of the Groups expressed the desire to leave some control over the implementation of an international rule to the individual countries. In particular, the Czech Republic, Argentina, Poland and the Philippines suggested that the AIPPI make a recommendation to its Member countries, but respect the authority of each country to implement their own internal laws.

With regard to the nature of such a privilege, there was universal support for a general rule that a privilege protecting communications between patent and trademark attorneys and their clients should have the following characteristics:

- The privilege should cover all communications between attorney and client arising out of their professional relationship.
- The privilege should cover both technical and legal matters.
- The privilege should cover responses to patent or trademark office actions, to the extent that such information is not publicly available.
- The privilege should extend to patent agents and attorneys alike, irrespective of whether they are permitted or qualified to appear before the court. No distinctions between these parties is necessary.

Some of the Groups went into further detail as to what they would like to see in a general rule or recognition of this type of privilege. The Ukrainian Group advocated for a privilege that would extend not only to the patent attorney and client, but also to the client’s agents and experts. The Swiss Group noted that not only should the AIPPI support the existence in each Member country of such a patent attorney privilege, but should coordinate its efforts with some of the other professional organizations that are already engaged in this matter, such as EPI and FICPI.

The United Kingdom Group, supporting the implementation of a general privilege in the Member countries, also acknowledged that the variation of treatment of the privilege turns largely upon the various positions regarding discovery across the jurisdictions. The Group suggested the AIPPI assess the issue of discovery and disclosure across the jurisdiction and similarly pursue the adoption of a minimum requirement.

Only the Latvian Group articulated some doubt as to the necessity of such a general rule. Although the Latvian Group suggested that a recommendation by the AIPPI may be of some practical use, it saw this issue as possessing minor importance.
The Australian Group articulated a sentiment shared by the majority of responding Groups regarding the importance of implementing a general privilege, and is therefore reproduced here.

We consider the matter is beyond purely national concerns. In this era of harmonization, globalization and increasingly international issues of Intellectual Property infringement, it is unnecessarily expensive and complicated to deal with a situation where some communications with advisors in one jurisdiction are the subject of privilege, whereas deliberations with advisors in a second country are subject to disclosure in the client’s own country on the basis that as the communications were not in a strict sense privileged in the second country, the privilege in any such communication has been waived.

This is a real and serious issue for clients with Intellectual Property in multiple jurisdictions. It is not apparent to us what alternative arrangements could be made to address the issue.

No response stated that this issue was wholly a national or domestic concern.

In view of the foregoing, the Committee presents the Draft Resolution for consideration to the AIPPI.
access, by reason of their condition, employment, profession or trade, to a secret the
disclosure whereof might cause damage, should divulge it without legitimate cause."

6. In turn, the National Procedural Code for Criminal Matters provides in its article 275:
   "There shall not be admitted as witnesses:
   
   . . . 5) Doctors, chemists, obstetricians and any other persons
   concerning facts which may have been disclosed to them by reason of
   their profession."

7. As you can see, the principle is the same both in criminal and in civil/commercial
   proceedings, except that in the former the prohibition is strict, whereas in the latter each
   witness is allowed to decide whether or not his deposition could violate professional
   secrecy.

8. In practice the Argentine Courts have established certain limitations to the secrecy
   principle, particularly in criminal cases where the professional witness’ testimony may be
   decisive in order to investigate an alleged misdemeanor. If the witness refuses to testify
   the Court can always choose to indict him as an alleged instigator, accomplice or
   accessory.

9. It is general accepted that the professional cited as witness or called upon to provide
   information has a flexible margin of discretion to decide what is and what is not privileged
   material. It is also generally accepted-with reservations in the case of criminal proceedings-
   that the client/litigant/accused, and in some cases the Court, may relieve a professional
   adviser from the secrecy obligation. It is also a general accepted rule that in case of doubt
   as to the nature of information, confidentiality should be presumed.

10. All the above rules and comments refer to information or depositions requested by
   Argentine Courts. If a Foreign Court wishes to hear a witness or to obtain information from
   a firm domiciled in Argentina, then such Court should issue letters rogatory to a similar
   Court in Argentina, with venue in the place of residence of the witness or firm. Then the
   Argentine Court will proceed to summon the witness or to request the information, and if the
   deponent or addressed firm alleges that the matter falls within the realm of professional
   secrecy, then the Argentine Court must decide whether or not the contention is acceptable.

II. COMMENTS REGARDING SPECIFIC QUESTIONS.

1. The domestic situation in relation in any privilege protecting disclosure of
   communications between attorneys at law and their clients

   A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define
      the privilege, explain how it arises, and explain how it is protected (for example,
      by statute or case law.)
A. As explained in Chapter I attorney-client privilege is recognized and is protected by statute and case law.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

B. Please refer to paragraph 1-8.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiating" or overcome?

C. Please refer to paragraph 1-9.

D. In what types of cases can the privilege be asserted?

D. In most cases the privilege can be asserted.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

E. Besides the laws mentioned in Chapter I, most organization in charge of supervision of different professions have their own rules that should be respected by the members of the profession.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients.

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

A. Patent and Trademark attorneys or agents must obtain qualification by the National Institute of Industrial Property. There is no specific difference between agents and attorneys.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)
B. Patent or trademark attorneys are ruled by the same general rules referred to in Chapter I.

C. **What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiating"?**

C. The limits of the privilege are a legitimate cause. Please refer to Chapter I, Nos. 5 and 6. Normally it is up to the professional to determine whether he is entitled to disclose a secret, but of course he will be responsible if he has acted without a legitimate cause.

D. **Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?**

D. In all types of cases.

E. **In what types of cases can the privilege be asserted?**

E. Please refer to Chapter I.

2. **The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients**

A. The qualifications for trademark or patent attorney or agent are not very strict, and attorney and agents may prosecute any application of such rights.

B. throughout F. Please refer to Chapter I.

3. **Proposed for General Rules**

A. **Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?**

A. AIPPI should support an attorney privilege.

1. **If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?**

1. All said rules are useful.
2. Whose communications would qualify for such protection?

2. The communications made by professionals in charge of a duty to their clients.

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

3. The privilege should extend to all kinds of communication made by the attorney or agent in charge of handling the case.

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

4. As long as the file has not been open to the public, even responses to office actions should be covered.

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

5. Yes.

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

B. The Argentine Group believes AIPPI should take a position in favor of attorney-client privilege.

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

1. No

C. Is the matter of purely national concern such that the AIPPI should not take a position?

C. No, we believe should take a position in favor of the privilege, but respecting the right of each country to determine its own laws on the subject.
1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

1. We do not believe it to be inappropriate for AIPPI to adopt a provision which would have uneven impact on the membership. Comparing the different systems may very well highlight the pros and cons of each system, and each country is entitled to select its own pros and cons.

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

2. We do not believe foreign applicants to be more disadvantaged, since the "attorney-client privilege" is widely recognized internationally, but specific details should be left to local rules, if necessary.
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Attorney-client privilege is recognised both at Common Law, and pursuant to statutes. The existence of the privilege at Common Law is inherited from British Law, and has been further refined within the Australian Court System. The statutory provisions are an attempt at partial codification or modification of the Common Law. Constitutionally, power on this issue is shared by the individual states, and by the Commonwealth. Accordingly, statutes in different states may result in some differences between states.

The scope of legal professional privilege in Federal Courts is stated in the Commonwealth Evidence Act 1995, in the following sections:

118 Legal Advice

Evidence is not to be adduced if, on objection by a client, the court finds that adducing the evidence would result in disclosure of:

a) a confidential communication made between the client and a lawyer; or
b) a confidential communication made between 2 or more lawyers acting for the client; or
c) the contents of a confidential document (whether delivered or not) prepared by the client or a lawyer;

for the dominant purpose of the lawyer, or one or more of the lawyers, providing legal advice to the client.

119 Litigation

Evidence is not to be adduced if, on objection by a client, the court finds that adducing the evidence would result in disclosure of:
a) a confidential communication between the client and another person, or between a lawyer acting for the client and another person, that was made; or
b) the contents of a confidential document (whether delivered or not) that was prepared;

for the dominant purpose of the client being provided with professional legal services relating to an Australian or overseas proceeding (including the proceeding before the court), or an anticipated or pending Australian or overseas proceeding, in which the client is or may be, or was or might have been, a party.

Some states, for example New South Wales, have passed similar legislation.

The Common Law prevails where statute has not modified the Common Law position – however, the Common Law position is not relevantly different. The leading case on the subject is the High Court case of *Esso Australia Resources Limited v. The Commissioner of Taxation* [1999] HCA67 (21 December 1999). This case makes clear that the privilege at Common Law also attaches to any communication for the dominant purpose of providing protected communications to the client.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

The practical significance of the privilege is that it applies to all situations, judicial and quasi-judicial, in which the production of documents or the giving of oral evidence may be otherwise compelled. Litigation processes in Australia very often involve discovery procedures and inspection of document procedures. It is clear that privilege applies to these circumstances. It applies also to where, for example, an order for production for documents is made, or to the execution of a search warrant.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

Privilege does not, as such, extend to non-legal matters. The privilege presupposes that the communications have been kept confidential. The privilege is essentially an exception to the rule that relevant, admissible evidence can be compelled to be produced.

Normal laws relating to confidentiality apply to prevent disclosure outside legal proceedings *per se*.

Privilege may be not applicable in certain, very specific circumstances, where the privilege has been expressly and clearly revoked by statute. For example, this has occurred in relation to some Royal Commissions inquiring into matters such as corruption.

More generally, the privilege may be waived expressly or by implication. The precise circumstances of this vary somewhat between different state and federal jurisdictions. However, it is clear that privilege may be waived if material is voluntarily disclosed, and in some circumstances when it is unintentionally disclosed. Furthermore, if one of the parties seeks to rely upon privileged information, either by direct reference or by implication, then the privilege may also be waived. Considerations of fairness are relevant at Common Law. Privilege may be only partially waived in some circumstances.
D. **In what types of cases can the privilege be asserted?**

Privilege can be asserted in any civil or criminal matter. It is only where the privilege is expressly excluded by legislation, and this circumstance is very rare, that the privilege cannot be asserted.

E. **Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?**

It is clearly a breach of a solicitor’s or barrister’s professional obligations if he discloses privileged information. The outcome of the disciplinary procedures would, of course, be a matter for the facts of the relevant case. This is likely to be considered serious misconduct and it is likely to result in the Practicing Certificate of the relevant offender being cancelled. In general, this would not amount to a criminal offence. Damages may also be claimed.

2. **The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients**

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. **By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.**

The registration and conduct of patent attorneys is regulated by Chapter 20 of the Commonwealth Patents Act 1990. The specific qualifications required by the act and regulations are that the person is ordinarily a resident in Australia; holds such qualifications as specified by the regulations; has been employed for 1 year as a technical assistant in a patent attorney’s practice or the Patent Office as an Examiner of Patents, or in a comparable corporate position for 1 year; is of good fame, integrity and character; and has not been convicted of a prescribed offense during the past five years and is not under sentence of imprisonment for a prescribed offense. The offenses are essentially those under the Patents, Designs or Trade Marks Act; or an offense of dishonesty for which the maximum penalty is imprisonment for two years.

The specific qualifications are specified in the regulations. Firstly, the applicant must have a degree, diploma or similar qualification in a field of technology that contains potentially patentable subject matter. This qualification may be from an Australian or overseas institution. The applicant must then obtain a pass in a course studying each of nine subject groups – Legal Process and Overview of Intellectual Property, Professional Conduct, Trade Mark Law, Trade Mark Practice, Patent Law, Patent System, Drafting Patent Specifications, Interpretation and Validity of Patent Specifications, and Designs.

These subjects may be passed either by examinations conducted by the Patent Attorney’s Professional Standards Board (established under the Patents Act 1990) or, increasingly, by passing subjects offered by Universities or other institutions, notably the Academy of the Institute of Patent Attorneys.

There is no distinction in our jurisdiction between patent attorneys and patent agents. Patent attorneys is the recognised and protected terminology.
The qualifications for trade mark attorneys are similar. Trade mark attorneys must obtain a pass in course of study from the first four subject groups mentioned in relation to patent attorneys. They must also hold a degree or diploma from an Australian or overseas institution.

A registered patent attorney is entitled to prepare all documents, transact all business and conduct all proceedings "for the purposes" of the Patents, Trade Marks and Designs Act. A patent attorney is not entitled to appear in court or prepare court documents.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Patent attorneys' and trade mark attorneys' communications with clients are privileged. Section 200(2) of the Patents Act 1990 states that:

"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/her client."

Similar provisions exist for trade mark attorneys under s 229 of the Trade Marks Act 1995.

Accordingly, within the scope of Intellectual Property matters, the privilege is precisely the same as when a lawyer communicates with their client. This privilege does not derive from Common Law – it is a creature of the statute. It has been applied as such in a number of cases.

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiates"?

The privilege only extends to Intellectual Property matters, which means (section 200(4))

a) matters relating to patents; or
b) matters relating to trade marks; or
c) matters relating to designs; or
d) any related matters.

The courts are yet to test the extent of "any related matters".

The privilege would extend to, for example, a technical document prepared by an inventor for the purposes of disclosing his invention to a patent attorney in order for a patent application to be drafted. The communication embodied in the document would then be brought into existence for the dominant purpose of obtaining the advice from the patent attorney. However, if a technical report was prepared for internal company purposes, and then later supplied to a patent attorney to assist in argument relating to a pending patent application, it is very unlikely that the document would be considered to be protected by privilege from discovery. The principles of what is and is not covered by the privilege are identical to those for lawyer/client communications as explained above. The critical question is simply whether the communication took place for the dominant purpose of obtaining the patent or trade mark attorney's advice. Any document which embodies this communication will similarly be privileged. It is noted that any communication which is not for this purpose or has not been kept confidential, will not be the subject of privilege. The concepts of waiver as discussed in section 1 apply.
It has been held, in *Pfizer v Warner Lambert Pty Ltd*, 89 ALR 625 that the privilege does not extend to material located in a trade mark search for a client, but only to the advice itself.

In *Wundowie Foundry v Clarewood* (1993) 44 FCR 474, patent search materials and results (not comments or opinions) and design and development documents, not being specifically prepared for briefing a patent attorney, were held not subject to privilege.

In *Trade Practices Commission v International Technology Holdings* (1995), AIPC91-159, the following documents were specifically held to be privileged:

- a draft provisional patent specification;
- correspondence from patent attorneys requesting further details from the client to prepare patent applications;
- progress reports on patent application;
- patent attorney’s correspondence with solicitors.

However, correspondence with the Patent Office was held not privileged.

D. **Explain the practical significance of the privilege.** For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

The practical significance of the privilege is identical to that for lawyers – in any litigation, or indeed patent office procedure, privileged communications cannot be compelled to be disclosed, either orally or by the production of documents.

E. **In what types of cases can the privilege be asserted?**

Assuming the limitations of "Intellectual Property matters" are met, the privilege can be asserted in any type of case.

F. **Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?**

Although it has not yet been the matter of disciplinary proceedings, it would seem clear that a conscious breach of privilege would constitute unprofessional conduct and hence subject the patent or trade mark attorney to deregistration. A client could also claim damages.

3. **Proposal for General Rules**

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. **Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?**

1. **If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?**

In the view of the Australian Group, we would support the existence in each country of a privilege protecting forced disclosure to a court (or other person or authority) of
communications between patent or trade mark attorneys and agents and their clients, such communications being otherwise confidential and relating to matters within the scope of the attorney/client relationship.

It would seem preferable the privilege would be implemented by statute, so that its existence would be plain should the question of privilege in a first country need to be determined by a court in a second country.

2. Whose communications would qualify for such protection?

Any confidential communications between a lawyer, patent or trade mark attorney, or patent or trade mark agent (adviser) should be the subject of the privilege, as well as any written or other record of the communication. Communications with other advisers for the client should also be privileged. Other documents brought into existence for the main or dominant purpose of providing such advice - for example, expert reports - should also be the subject of privilege.

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

The privilege should not extend to matter which have not otherwise been kept confidential, or which relate to matters beyond the client's requirement for legal advice. Merely sending a document to a patent or trade mark attorney as well as to other parties should not be sufficient to render the document privileged from discovery. The nature of the work of, for example, a patent attorney is that the correspondence covers both legal, technical and at times commercial issues. It is not practical to separate these. For example, advice in relation to patent infringement will very often include questions about the commercial viability of alternative technical implementations. It is not realistic to dissect this from the rest of the advice.

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

Communications involving responses to patent and trade mark offices should be covered by such a privilege. It is specifically noted that the considerations for an appropriate response to a patent office will very often involve considerations of the substantive validity and scope of protection of intellectual property rights, and not merely formal matters. However, the responses themselves should not be considered privileged, even if the relevant patent office does not make such material available to the public. Responses are submissions to public authorities and should be available for another party to the litigation to review.

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

In our view, the privilege should extend to advisors (as defined above), whether or not they are authorised to appear in court.

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege
protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

The difficulty raised by this approach is that a client may well require advice in multiple jurisdictions on the same issue, for example, an alleged infringement. If the same material and instructions are sent to jurisdictions whether there is no privilege recognised, then the client is potentially in a position of having waived privilege in jurisdictions where such privilege is recognised.

1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**

   We do not consider that in the context there is a different public policy underlying the existence of privilege in communications between clients and their patent and trade mark attorneys, and communications between clients and their lawyers.

C. **Is the matter of purely national concern such that the AIPPI should not take a position?**

   1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the members. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?**

   2. **Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.**

As follows from our comments under A and B, we consider the matter is beyond purely national concerns. In this era of harmonisation, globalisation and increasingly international issues of Intellectual Property infringement, it is unnecessarily expensive and complicated to deal with a situation where some communications with advisors in one jurisdictions are the subject of privilege, whereas deliberations with advisors in a second country are subject to disclosure in the client's own country on the basis that as the communications were not in a strict sense privileged in the second country, the privilege in any such communication has been waived.

This is a real and serious issue for clients with Intellectual property in multiple jurisdictions. See our comments under B. It is not apparent to us what alternative arrangements could be made to address the issue.

D. **Are there other issues which should be taken into account in considering this question?**

   None presently apparent.

Peter Franke
For the Australian Group
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

1.A) Yes, the attorney-client privilege is protected by:

a) section 7, paragraph XIX, of Law 8906/94, which sets forth that lawyers have the right to refuse testifying on facts referred to their current or former clients (even if asked by them) and on any fact which is a professional secrecy; and

b) section III, letter “a”, of the Lawyers’ Ethical Code of Behavior, which declares that lawyers are obliged to keep the secrecy of any information disclosed to them due to their activities.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

1.B) Yes, the privilege may be invoked to prevent disclosure, as mentioned above.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiates” or overcome?

1.C) The Law makes no distinction: the privilege applies both to legal or non-legal matters. Its only limit is the extension of the secret. There are some extensions: lawyers are not punished if the disclosure has a reasonable ground. A reasonable ground is an open concept, to be assessed on a case by case basis. The Agents’ Ethical Code of Behavior (Decree 142/98, enacted by the BPTO) provides for some guidelines: disclosure is accepted whenever there is: a) a serious menace to life or honor; or b) litigation between client and agent.
D. In what types of cases can the privilege be asserted?

1.D) The privilege may be asserted in all kinds of cases.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

1.E) Yes, if lawyers disregard the privilege, without any reasonable ground, they are subject to:

a) professional sanctions imposed by the Bar Association (Law 8906/94, section 34, paragraph VII);

b) criminal sanctions (sections 153 and 154 of the Criminal Code), such as a fine or 1-12 months of imprisonment;

c) civil sanctions (section 159 of Brazilian 1916 Civil Code), for damages.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

2.A) Both lawyers and registered agents are allowed to act before the BPTO. The BPTO’s registration is not mandatory for lawyers. Non-lawyers must take a qualifying exam held at the BPTO. Any citizen, 21 or older, with a clean moral record is allowed to apply. Lawyers and registered agents are entitled to practice all acts aimed at the acquisition, maintenance or extinction of their clients’ patent and trademark rights. However, only lawyers are allowed to file lawsuits or defenses before the Courts.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

2.B) Yes, the patent or trademark agent-client privilege is recognized in Brazil. Such privilege is protected by:

a) sections 153 and 154 of Brazilian Criminal Code (see topic 1.E above); and

b) sections 10 to 14 of the Agents’ Ethical Code of Behavior, enacted by BPTO’s Decree 142/98.
C. *What are the limits of this privilege?* Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or “vitiated”?

2.C) The privilege extends to all issues. According to section 12 of the Agents’ Ethical Code of Behavior, the privilege may be disregarded in case of serious menace to life or honor, and as self-defense in litigation between client and agent.

D. *Explain the practical significance of the privilege.* For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

2.D) Yes, the privilege may be invoked to prevent disclosure.

E. *In what types of cases can the privilege be asserted?*

2.E) The privilege may be asserted in all types of cases.

F. *Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?*

2.F) Yes. See topics 2.B for agents and 1.E for lawyers.

3. **Proposal for General Rules**

*Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?*

A. *Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?*

3.A) Yes.

1. *If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?*

3.A.1) By both statute and professional obligation.

2. **Whose communications would qualify for such protection?**

3.A.2) All communications between clients and agents must earn protection against disclosure (section 14, sole paragraph of Agents’ Ethical Code of Behavior, enacted by BPTO’s Decree 142/98).
3. **Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?**

3.A.3) The protection should not be limited only to purely technical matters. It must extend to all communications.

4. **Should communications involving responses to patent and trademark office actions be covered by such a privilege?**

3.A.4) Yes. All communications between clients and agents must be covered by the privilege.

5. **Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?**

3.A.5) Yes, no distinction should be made between agents or lawyers, in so far as the maintenance of the secrets revealed to them is concerned.

B. **Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**

3.B) No, AIPPI should not take such position. The construction of internal rules is a matter for the Courts of each country, not for the AIPPI. In countries, such as Brazil, in which the activities, rights and obligations of the lawyers are different from the agents', the rules applicable to the first do not automatically apply to the latter.

1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**

3.B.1) In their contacts with the clients, lawyers and agents must abide by the same rules, as stated in topic 3.A.5. However, such equal treatment must be expressed by Law.

C. **Is the matter of purely national concern such that the AIPPI should not take a position?**

1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership**

3.C.1) Yes, such provision would be inappropriate. See topic 3.B above.
2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

3.C.2) Foreign applicants must have the same protection given to national applicants, regarding the agent-client privilege, and this is so in many countries, like Brazil, which prohibits any difference of treatment between nationals and foreigners according to article 5 of the Federal Constitution. To ensure that such privilege is recognized as a standard worldwide, the AIPPI should propose the amendment of international treaties.

D. Are there other issues which should be taken into account in considering this question?

3.D) No.

José Antonio B.L. Faria Correa
ABPI – The Brazilian Intellectual Property Association
President

Lélio D. Schmidt
ABPI – The Brazilian Intellectual Property Association
General Reporter
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Bulgarian Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

A. The attorney-client privilege is recognized in Bulgaria. This privilege is protected by the provisions of Art. 18 and Art. 26 of the Law on the Bar. According to Art. 18 of the Law on the Bar the papers and files of the attorney are inviolable and can not be subject to examination or confiscation. The correspondence between the attorney and the client is also inviolable, can not be examined and can not be used as a proof in a dispute.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiated” or overcome?

C. The privilege extends also to non-legal matters. The attorney bears responsibility for the disclosure of the secrets of his client including after the end of the court case.

D. In what types of cases can the privilege be asserted?

D. According to Art.26 of the Law on the Bar, the attorney is liable for the disclosure of the secrets of his client. The responsibility can be criminal, civil and disciplinary.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:
A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

A. The patent or trademark attorney profession may be practiced in Bulgaria by a person who satisfies the conditions laid down in the Ordinance on the industrial property representatives. The person should:
- be Bulgarian citizen or resident in Bulgaria;
- hold an officially recognized diploma of university education in technical, scientific or legal discipline (it may be a diploma issued abroad);
- have exercised an activity in the field of the protection of industrial property for at least two years;
- have passed an examination before the Patent Office.

Some persons acquire by rights the status of IP representatives, namely:
- experts and lawyers with practice in the Patent Office at least 10 years;
- barristers with legal practice at least 10 years

The right to practice the profession arises at the date of entry into the register of industrial property representatives, kept by the Patent Office. This representatives (except if they are also member of the bar) can act only as representatives before the Patent Office.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

B. According to the Ordinance on the industrial property representatives, the representatives are obliged to keep the secrecy of the information acquired in the course of practicing the profession.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

In our view the AIPPI should recommend to the member countries that if the jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should recognize within the same scope a privilege protecting communications between registered patent or trademark attorneys and their clients.
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Yes, an attorney-client privilege is recognized in Canada and is typically referred to as solicitor-client privilege. It attaches to all direct communications between a solicitor and client or their agents/employees made for the purposes of obtaining professional legal advice.

There is also a second form of legal privilege available that is referred to as “contemplated litigation privilege” and attaches to

(i) communications between the client (or its agents/employees) and third parties for the purpose of obtaining information to be given to the client’s solicitor to obtain legal advice, or

(ii) communications between the solicitor and third parties to assist with giving of legal advice, or

(iii) communications which are created at their inception by the client including reports, schedules and documentation and again pertaining to contemplated or ongoing litigation.

Both forms of privilege arise by way of case law.

While privilege arises by way of case law, certain Provincial and Federal statutes and regulations may impact on privilege. For example, the Federal Income Tax Act contains a definition of solicitor-client privilege that is similar to the case law definition, and the Act recognizes the privilege as a defence to certain procedures under the Act. Additionally, the Canadian Bar Association and the Provincial law societies have codes of professional conduct that deal in part with the obligations of a lawyer to keep privileged information confidential.
However, under certain circumstances, these rules of professional conduct allow for the disclosure of otherwise privileged information by the lawyer without the client's consent, for example, where the lawyer's conduct is at issue, the disclosure of the information is necessary to prevent a crime, or where disclosure is required by law.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

The practical significance of either form of privilege is that any communications to which a privilege attaches need not be disclosed, either at all, or as part of a civil or criminal legal proceeding. This would include the oral and documentary discovery stages and at trial.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiating” or overcome?

Solicitor and client privilege extends to any communications between the client and the lawyer in obtaining professional legal advice from the lawyer. The litigation privilege is more narrow in its application and is limited to communications that take place in view of the contemplated or ongoing litigation. Neither privilege extends to “non legal matters”.

It is for the client's benefit that the privilege exists in order to enable the client to have a full consultation with his solicitor. The most common way in which privilege is lost is through waiver of the privilege by the client. There may be an expressed waiver of privilege where the client voluntarily discloses otherwise privileged communications to third parties. There may also be an implied waiver of privilege if the client's conduct demonstrates an intention to waive privilege. As noted above in the answer to 1A, there may be circumstances under which the lawyer is expected to disclose the otherwise privileged information.

Additionally, facts are not subject to privilege. As such, communications regarding pure matters of fact are protected by privilege.

D. In what types of cases can the privilege be asserted?

The privilege can be asserted in both civil and criminal proceedings.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

There are civil laws and professional obligations that exist, which can come into play if the attorney violates the client's privilege. Please see the answer to Question 1A above.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients
The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

(i) Patent Agents

The qualifications for a patent agent are provided by way of the Canadian Patent Act and Patent Rules. Section 15 of the Act states that a Register of Patent Agents will be maintained by the Patent Office, which should include the names of all persons entitled to represent applicants before the Patent Office. Section 15 (a) of the Rules states that Commissioner shall enter on the Register of Patent Agents, the name of any resident of Canada who has demonstrated a good knowledge of Canadian patent law and practice by passing qualifying examinations for patent agents relating to patent law and practice.

Presently in Canada, to become a registered patent agent, an individual must successfully pass four written exams dealing with claim drafting, patent prosecution, validity and infringement. In order to write the exams, and pursuant to Section 12 of the Patent Rules, the person must have resided in Canada and have been employed for a period of at least twelve months on either the examining staff of the Patent Office or have worked in the area of Canadian patent law and practice, including the preparation of prosecution of applications.

(ii) Trade-mark Agents

In respect of Trade-mark Agents, Section 28(1)(f) of the Federal Trade-marks Act stipulates that there is to be kept under the supervision of the Trade-mark Registrar a list of trade-mark agents. Pursuant to Section 28(2) the list of trade-marks agents shall include the names of persons entitled to represent applicants in the presentation and prosecution of applications for the registration of a trade-mark or another business before the Trade-mark Office. To be registered as a trade-mark agent, the individual must be a resident of Canada who has passed the qualifying examinations relating to Canadian trade-mark law and practice, or be a lawyer (solicitor) or notary entitled to practice in one of the provinces and who has either the passed the same qualifying examinations or worked in the area of trade-mark law, including the preparation and prosecution of applications for registration of trade-marks, for a period of not less than two years. (Rule 21 of the Canadian Trade-mark Regulations)

It is fairly common in Canada for lawyers (solicitors) who practice in the intellectual property field to also be registered trade-mark and/or patent agents. Only registered patent agents are permitted to represent an applicant before the Canadian Patent Office including before the Canadian Patent Appeal Board. Only registered trade-marks agents may represent an applicant before the Trade-marks Office, including before the Trade-mark Opposition Board. Non-lawyer patent agents and trade-mark agents are not permitted to represent clients in Federal or Provincial courts in Canada.
B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law."

A patent or trade-mark form of attorney-client privilege (i.e., solicitor-client privilege) is not recognized in Canada. However, it is certainly possible that if the non-lawyer patent or trade-mark agent is assisting the client or lawyer on a contemplated or pending litigation matter then litigation privilege as discussed above, may attach.

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiates"?

D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

E. In what types of cases can the privilege be asserted?

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

The Canadian group is of the view that the AIPPI should support the existence in each member country of a privilege protecting from forced disclosure to a Court or third party communications between any patent or trade-mark agent and their clients. In Canada, such a privilege would require implementation by way of a Federal statute. The direct communications between the trade-mark and/or patent agent and the client should qualify. The privilege should extend to any communications that take place between the agent and the client as a result of the client seeking professional advice of the patent or trade-mark agent. This would therefore likely extend to both legal and technical matters. This should also include communications between the agent and the client pertaining to responses to patent and trade-mark office actions that would otherwise not be part of the public record.

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

2. Whose communications would qualify for such protection?
3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

C. Is the matter of purely national concern such that the AIPPI should not take a position?

1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

D. Are there other issues which should be taken into account in considering this question?

Steven B. Garland
Questionnaire May 2002

Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession
Answer of the Chinese Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Although there is not any statement on the so-called “Attorney-Client Privilege” in Chinese legal system, it is stipulated in Article 33 of “Attorney Law of People’s Republic of China” that the attorneys at law should keep the state secrets and the commercial secrets of the clients learned through practice under secret, and should never reveal the confidential information of the clients. Furthermore, the “Regulations on the Professional Ethics and Practice Disciplines of Attorneys at Law” does provide some similar provisions as follows:

Art. 8: The attorney-at-law should never reveal state secrets, commercial secrets or the confidential information of the clients.

Art. 39: The attorneys-at-law bear the responsibility of keeping the information in relation to his representation under secret during the representation or thereafter.

Art. 45: Any attorney-at-law or any law firm that violates the Regulations should be subject to the punishment by the Association of Attorney-at-law according to its methods of punishment on membership or even penalties by the judicial department when the case is serious.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

There is no discovery or disclosure procedure in Chinese jurisdictions. So under common circumstances, the judges do not force the interested parties to produce certain documentation or
testimony. So the interested parties do not need to rely on the “Attorney-Client Privilege” for not producing documentation or testimony.

However, it is of practical significance to emphasize the “Attorney-Client Privilege”. The clients may be more willing to be represented by the attorneys, with no fear that their communications with the attorneys would be revealed.

C. **What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiated” or overcome?**

Except for the cases involving great interests of the country, such a privilege should not be limited by any means, even when the communications concerned involve only non-legal business.

D. **In what types of cases can the privilege be asserted?**

In any form of litigation or dispute resolution, the interested parties should have the right to enjoy the “Attorney-Client Privilege”.

E. **Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?**

In accordance with the “Attorney Law of People’s Republic of China” and the “Regulations on the Professional Ethics and Practice Disciplines of Attorneys at Law”, if the attorneys at law does not fulfill the responsibility of secrecy, he/she will be subject to administrative or even criminal sanctions according to the specific cases; in case damages are caused to the clients, the attorneys on duty should also bear the civil responsibilities in accordance with relevant legal provisions.

2. **The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients**

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. **By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.**

In China, the qualification examinations for patent attorneys and trademark attorneys are separate. Only when passing the examinations for patent or trademark attorneys and getting relevant certificates for practice, one can practice patent or trademark agency work before the State Intellectual Property Office or the State Trademark Office. The patent attorneys may represent the clients before the State Intellectual Property Office for all patent-related affairs; while the trademark
attorneys may handle all trademark-related affairs on behalf of the clients in the Trademark Office. Besides, in accordance with Article 58 of the “Civil Procedure Law of People’s Republic of China”, in addition to the attorneys, anyone recognized by the court may act as an agent for one interested party in the civil proceedings. Therefore, patent attorneys and trademark attorneys in China may also represent the interested parties in civil proceedings.

**B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)**

In Chinese laws, there is no specific regulation on “Patent/Trademark Attorney – Client Privilege”. Article 19, paragraph 3 of “Chinese Patent Law” provides that the patent agencies should abide by the laws and administrative regulations and should deal with patent applications and other patent matters according to the commissions of the clients; and except for those applications that have been published or announced, the agencies should bear the responsibility for keeping confidential the content of its clients’ inventions-creations. Furthermore, in Article 23 of the “Regulations on Patent Agency”, it is stipulated that the patent attorneys should keep the information learned in the course of patent prosecution in relation to the contents of the invention concerned, other than those disclosed or publicized in the patent application documents, in secret. It is also stipulated in Article 10 of “Regulations on the Professional Ethics and Practice Disciplines of Patent Agents” that patent agents should keep confidential the technologies and commercial secrets of clients learned through practice, and should not reveal, pirate or take advantage of these secrets in sacrifice of the legal interests of the clients.

**C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or “vitiates”?**

Except for the cases concerned of the great interests of the country, the Privilege protecting the communications between patent/trademark attorneys and the clients should not be limited by any means, no matter the subject matter involved in such communications is of non-legal or purely technical nature.

**D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?**

Likewise, it is also of great importance to recognize a “Patent/Trademark Attorney – Client Privilege”, with which the clients will be more willing to entrust patent/trademark attorneys to represent them in patent/trademark related affairs, especially in patent/trademark infringement litigations. The clients would not fear that the communications with patent/trademark attorneys in the course of patent/trademark acquisition or litigation would be disclosed. Due to the special background of patent/trademark, especially those of patent-related affairs, the clients usually wish to entrust patent/trademark attorneys to represent them in the court during the legal proceedings.
Therefore, it is of practical significance to recognize the "Patent / Trademark Attorney – Client Privilege" in China.

E. In what types of cases can the privilege be asserted?

In the legal proceedings or dispute resolutions related to patent/trademark infringement, the interested parties certainly enjoy the "Patent/Trademark – Client Privilege".

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

There are not any specific regulations in Chinese legal system on the legal responsibilities that the patent/trademark attorneys will be subject to in case they reveal the confidential information of the clients. But there are indeed some general provisions on the sanctions against the acts of revealing the confidential information of others, which also apply to patent/trademark attorneys. Article 25 of the "Regulations on Patent Agency" provides that patent agents should bear the administrative responsibilities for acts of revealing or pirating the contents of the invention-creation of the clients and should be subject to damages for any loss caused to the clients. Article 28 of the "Regulations on the Professional Ethics and Practice Disciplines of Attorneys at Law" provides that patent agents that violating these regulations should be warned and criticized by the All-China Patent Agents Association; where the case is serious, relevant punishments should be imposed by the State Intellectual Property Office.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

The Chinese Group of AIPPI believes that it is necessary to establish a general principle on protecting the communications between patent/trademark attorneys and the clients.

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

It is necessary for AIPPI to reach a resolution on protecting the communications between patent/trademark attorneys and the clients and those between the patent attorneys and the trademark attorneys from forced disclosure to the court or a third party.

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

AIPPI may suggest that the common law or the regulations on the profession provide specific stipulations on Patent/Trademark Attorney – Client Privilege protecting the communications between patent/trademark attorneys and the clients from disclosure, the contents and the duties
thereof, the responsibilities for revealing confidential correspondence, and the means for protecting the communication secrecy.

2. *Whose communications would qualify for such protection?*

The communications between domestic patent/trademark attorneys and domestic clients, those between domestic patent/trademark attorneys and foreign clients, those between domestic patent/trademark attorneys and those between domestic and foreign patent/trademark attorneys should all be protected by such a privilege.

3. *Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?*

Other than in cases of involving great state interests, such a privilege should not be limited by any means. This privilege may be extended to the communications relating to purely technical matters and the matters mixing legal and technical issues.

4. *Should communications involving responses to patent and trademark office actions be covered by such a privilege?*

The communications relating to the responses to the office actions from patent/trademark offices between patent/trademark attorneys should also be protected by such a privilege.

5. *Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?*

No matter whether patent/trademark attorneys would take part in the legal proceedings in the court individually or with the attorneys at law, patent/trademark attorneys should also enjoy this privilege.

**B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**

No matter whether or not a country has recognized the “Attorney-Client Privilege”, AIPPI should raise a resolution or suggestion on the “Patent/Trademark Attorney-Client Privilege”.

1. *Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?*
No matter how different the nature of the profession may be, the privilege protecting the disclosure of the communications between patent/trademark attorneys and the clients should not be discriminated.

C. Is the matter of purely national concern such that the AIPPI should not take a position?

In view of the internationalization of intellectual property protection and the Trips of WTO, AIPPI may propose its own suggestions or resolutions on this matter.

1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

Although there are not discovery procedures available in the jurisdictions of many countries, the Court or other competent agencies do not force the interested parties to produce documentation or testimony relating to the communications between relevant agents and clients. However, considering the specialty of intellectual property agency and the internationalization thereof, it should not be considered as inappropriate for AIPPI to raise relevant resolutions on “Patent/Trademark Attorney – Client Privilege”.

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

Under the present legal system of China, the communications between foreign applicants and Chinese patent/trademark attorneys can be fully protected from any unlawful disclosure. However, to further improve the confidence of foreign patent/trademark applicants as well as that of foreign patent/trademark right holders, it is very necessary to introduce the “Patent/Trademark Attorney – Client Privilege” into relevant laws, regulations and rules on the profession. Therefore, it is of great practical significance and necessity to establish a worldwide recognized “Patent/Trademark Attorney – Client Privilege”. AIPPI should propose detailed suggestions and resolutions to encourage the member countries to establish such an internationally recognized “Patent/Trademark – Client Privilege”.

D. Are there other issues which should be taken into account in considering this question?

(No)
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Czech Republik

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

1. Attorneys at law – client privilege, especially the recitency of the attorney at law is recognized in the Czech Republic. It means that the attorney is not allowed to disclose the content of his communication with the client without client’s specific approval. This privilege extends to the case represented by the attorney notwithstanding whether the case is of civil, criminal or administrative nature. This privilege arises from Act No. 85/1996 as amended by Act No. 210/99 on Legal Profession and respective statutes of the Chamber of Attorneys at Law. If by any chance the attorney violates this privilege, which forms a part of his professional obligations, the disciplinary committee of the Chamber considers the fault and decides about consequences.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

2. There are not patent or trade mark agents – only patent or trade mark attorney. They are qualified by passing special examinations before the Industrial Property Office of the Czech Republic. It is to be noted that applicants can be represented before the Industrial Property Office by patent or trade mark attorneys or attorneys at law only. The patent/trade mark attorney-client privilege is just the same as in the case of attorneys at law. The privilege arises the Act No. 237/1991 on Patent Attorneys and from statute of the Chamber of Patent Attorneys and all steps are similar to those as in the Chamber of Attorneys at law. The privilege naturally extends to technical disclosures. Patent and trade mark attorneys can represent clients before the Industrial Property Office and before courts of first instance, but not before the court of second instance. In court proceeding before a court of second instance a client has to be represented by an attorney at law, even if it is a patent or trade mark case.

3. Proposal for General Rules

3. According to our opinion may support the existence of the above privilege, but as a recommendation only due to the existence of special situation and rules in each member country. We are afraid that any AIPPI steps cannot overrule national legislation.
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the German Group

1. The domestic situation in Germany in relation to any privilege protecting disclosure of communications between attorneys-at-law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

A. There exists a very strict attorney-client privilege in Germany. It is protected by the Attorney-at-Law Act i.e., a Federal law regulating the basics of the attorneys-at-law professional activities including their professional obligation of secrecy. The code of civil procedure and the code of criminal procedure regulate, among other things, the right of attorneys-at-law to refuse to give evidence. Criminal law provides a threat of punishment of an attorney-at-law who will betray his client.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

B. In practice, the importance resides in that, neither in a civil procedure nor in a criminal procedure, the attorney-at-law can be forced to supply information about facts or opinions that have become known within the scope of his activity for a client, with the only extremely narrow exception of the client dispensing his attorney from discretion, in which case the attorney may communicate those facts to a third party.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiated” or overcome?

C. The privilege is valid only to the extent an attorney obtains information from a client. He must not become an accomplice himself.

D. In what types of cases can the privilege be asserted?

D. The privilege can be asserted in all cases where the attorney-at-law is working for a client as an attorney-at-law.
E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

E. As mentioned above, the Federal criminal law, the Federal code of criminal procedure, the Federal code of civil procedure, the Federal attorneys-at-law Act and the professional attorneys-at-law statute apply if the attorney-at-law violates the privilege.

2. The domestic situation in Germany in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

A. According to section 1 of the Federal Patent Attorneys Act, the patent attorney is an independent organ of the judicial system of Germany within such area of tasks and activities as stipulated by the Act.

Section 3 of the Patent Attorneys Act stipulates i.a.: A patent attorney has the professional task of a counsel or representative vis-à-vis third parties in matters of attainment, maintenance, defence and dispute of a patent, supplementary certificate, utility model, topography protection, trademark or any other mark protected by Trademark Law (industrial property rights) or plant variety protection; to represent third parties before the Patent Office and the Patent Court in matters that belong to the sphere of business of the Patent Office and the Patent Court; to represent third parties before the Federal Supreme Court in procedures of annulment or withdrawal of a patent or supplementary certificate or in cases of grant of compulsory licence; to represent clients before the Federal Office of Plant Variety Protection in matters of plant variety protection; to function as a counsel or representative vis-à-vis third parties in matters that involve issues relating to industrial property rights, designs, data processing programs, non-protected inventions or miscellaneous technological achievements, plant variety protection or non-protected achievements in the field of plant growing that imply an expansion in plant cultivation; or in matters that involve legal questions directly relating to any such issues; to represent clients in the matters listed above before arbitration tribunals and before administrative authorities other than those listed above.

According to section 4. of the Patent Attorneys Act, the patent attorney has the right to cooperate in any cases where intellectual property rights are involved. Furthermore, the patent attorney is entitled to cooperate before courts in any cases where software or other questions relating to technological innovations or plants etc. are involved.

As a basic qualification, a patent attorney must have a master degree in engineering or natural sciences; in addition, he has to pass practical training at a patent attorney office or at a company’s patent department in industry. He must spend two years of legal studies of the basics of civil law, the code of civil procedure, antitrust law, intellectual property law, administrative law etc. These legal studies are finished by an examination. The practical training is combined with working groups and sessions. Then the candidate will complete his training at the German Patent Office and then at the German Federal Court, after which he must pass a legal examination comparable to the attorney-at-law second state
examination, with the difference that the examination only involves such fields of law that belong to a patent attorney's scope of activity.

As mentioned above, the patent attorney may represent his client before the German Patent and Trademark Office, the German Office for Plant Variety Protection, the German Federal Patent Court (in patent, utility model, trademark and plant variety protection cases, including nullity cases) before the German Federal Supreme Court with regard to patent validity cases and compulsory licensing, and before all the authorities where representation by an attorney-at-law is not obligatory.

Patent agents do not exist in Germany.

B. *Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)*

B. Identical with 1. A.

C. *What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiated"?*

C. Identical with 1. B.

D. *Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?*

D. Identical with 1. C.

E. *In what types of cases can the privilege be asserted?*

E. Identical with 1. D.

F. *Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?*

F. Identical with 1. E.

3. **Proposal for General Rules**

A. *Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?*

1. *If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?*

1. It would be preferable to suggest implementation by statute.

2. *Whose communications would qualify for such protection?*
2. Any confidential communications between a patent attorney and his client should be subject to the privilege.

3. **Should there be a limit on the scope of the protection?** Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

3. There should be no limit to the scope of the protection. Privilege should extend to purely technical communications as well as to communications mixing legal and technical matters and to purely legal opinions.

4. **Should communications involving responses to patent and trademark office actions be covered by such a privilege?**

4. Yes.

5. **Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?**

5. No.

B. **Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**

1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**

1. No.

C. **Is the matter of purely national concern such that the AIPPI should not take a position?**

1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership**

1. No.

2. **Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.**

2. We do not see any possibility for AIPPI to minimize said disadvantage.
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Our jurisdiction recognizes the attorney-client privilege. It is protected by statute and specifically by Article 49 of the Lawyers' Code (Legislative Decree 3026/6.8.1954) and it has been accepted in various cases by respective Court decisions.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

An attorney at law can never be examined as a witness in cases in which he has been involved as a lawyer, without the prior authorization of the Bar Association or in urgent cases of the President of the Bar Association.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiates” or overcome?

The attorney-client privilege extends to any type of information revealed by the client to his attorney including non-legal matters. However, when very important reasons arise said privilege may be overcome:

a) by the client’s consent or

b) by the authorization of the Bar Association upon the attorney’s request.
D. In what types of cases can the privilege be asserted?

The privilege can be asserted in all types of cases in which an attorney may be involved (civil, criminal, administrative).

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

In case the attorney at law violates the privilege he may face disciplinary penalties by the Bar Association.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

In the Greek jurisdiction there is no distinction between a patent agent, a patent attorney and a trademark attorney. Attorneys at law only are authorized to act as patent agents, patent attorneys and trademark attorneys. The extent of the representation allowed by this qualification is: a) the filing of trademarks, b) their renewal, c) their prosecution through to their registration, d) the filing and prosecution of oppositions, interventions and cancellation actions, e) the recordal of licenses, f) the filing and prosecution of Patent and European Patent applications and g) respective litigations.

No definition of a patent or trademark agent exists in the Greek jurisdiction.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiated"?

D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

E. In what types of cases can the privilege be asserted?

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

Since as stated hereinabove a patent or trademark attorney can be an attorney at law only the answers referring to Qu.1 – A, B, C, D and E apply to the above-captioned Qu.2 B too.
3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

The AIPPI should support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients.

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

It would be preferable to suggest implementation by statute.

2. Whose communications would qualify for such protection?

The communications between patent or trademark attorneys and their clients and patent agents and their clients would qualify for such protection.

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

The privilege should extend to both legal and purely technical matters and generally to all type of information which may harm the client’s interests.

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

Communications involving responses to patent and trademark office actions should be covered by such a privilege.

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

The privilege should definitely extend to patent agents who do not make court appearances as well as to patent and trademark attorneys who are authorized to appear in court with attorneys at law.

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

In the Greek jurisdiction there is no practical difference between the professions dealing with protecting industrial and intellectual property rights since attorneys at law only are authorized to do so.
C. Is the matter of purely national concern such that the AIPPI should not take a position?

1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

We believe that AIPPI should take a position on the matter and adopt provisions in order to minimize the non-uniformity among the member groups due to their different legal systems.

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

We believe that foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege.

AIPPI might serve to minimize such a disadvantage by providing information easily accessible to all interested parties on the existence of the privilege in the various countries.

D. Are there other issues which should be taken into account in considering this question?

There are no other issues which should be taken into account in considering this question.

Mrs. Elly Ladas
President of the Greek Group
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

D. In what types of cases can the privilege be asserted?

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

Answers

Attorney-client privilege in the same form as it exists under common law does not exist in Japan. The non-disclosure privilege for an attorney at law is not considered to be integral with that for a client, and both of them are protected as different privileges based on different grounds. Furthermore, the Code of Civil Procedure in Japan establishes two different types of non-disclosure privilege between when a party gives testimony as a witness (non-disclosure privilege as a witness) and when documents, etc. are submitted to the courts as evidence (non-disclosure privilege when documents are submitted).
There is no difference between non-disclosure privilege for attorneys at law and that for patent attorneys under the Code of Civil Procedure. However, the wordings of provisions of the Lawyer Law and the Patent Attorney Law are different regarding their professional duties. Art. 30 of the Patent Attorney Law provides non-disclosure only as a professional duty, by stipulating that “a patent attorney or a person who was a patent attorney must not disclose or appropriate secrets which have become known through performance of his duty.” On the other hand, Art. 23 of the Lawyer Law emphasizes that non-disclosure constitutes a professional right as well as a professional obligation, describing that “a lawyer (attorney at law) or a person who was a lawyer shall have the right and power to (as well as undertake obligations to) keep secrets which have become known through the performance of his duty, unless otherwise required under statutes.” It is understood, however, that the difference is merely the result of legal ignorance by persons in charge of legislation who were involved in revising the Patent Attorney Law, and such difference was not made with any intention to differentiate these two laws.

We would like to respond to individual questions based on the above comment.

1-A. Attorney-client privilege is also recognized in Japan. However, the non-disclosure privileges of attorneys at law and of clients need to be explained separately.

With regard to attorneys at law, under Art. 197(1)(2) of the Code of Civil Procedure, an attorney at law can refuse to testify, regardless of whether such person is or was an attorney at law, concerning other person’s secrets which have become known through the performance of the profession. This privilege is also granted to a person who comes to know another person’s secrets under the performance of his or her profession, such as a patent attorney or a medical doctor. Such privilege not only applies to testimony, but also to the submission of documents under Art. 220(4)(c) of the Code of Civil Procedure. There are no differences between attorneys at law and patent attorneys concerning such privileges.

With regard to clients of attorneys at law, there do not exist any special regulations that allow non-disclosure privileges, different from ordinary privileges, for communication between an attorney at law and a client. However, Art. 197(1)(3) of the Code of Civil Procedure stipulates that “(In the following case, a witness may refuse to testify: (3) Where a witness is questioned with respect to matters relating to technical or professional secrets,“ which allows refusal of testimony to any person regardless of whether the person is a client of an attorney at law or patent attorney. In addition, the refusal to testify is allowed for cases where a testimony would defame the witness (Art. 196 of the Code of Civil Procedure). Therefore, although this is different from the form of protection under the common law where refusal to testify is allowed as a part of the non-disclosure privileges of attorneys at law, refusal to testify is also allowed in Japan almost in the same form as that allowed under common law.

With regard to the obligation of submitting documents held by a client, the refusal to submit such documents seems to be allowed under Art. 220(4)(d) of the Code of Civil Procedure in many cases. However, whether memos or similar items, which employees of a patentee company have
informally made, are considered to be documents that "are offered only for the use of the holder of the document" seems to be a disputable issue. In this sense, with regard to a client's privilege to refuse the submission of documents, a slight ambiguity remains, and there is no court decision regarding documents held by the client of an attorney at law or a patent attorney. However, when considering the issue of a client's privilege not to submit documents, it seems that the following circumstances should be sufficiently taken into account. This is to say, in Japan, when making an order for submitting documents, documents to be submitted must be strictly specified. The request to submit documents in the form of "all and any documents relating to...," as seen in the U.S., is not allowed as a fishing expedition or unspecified request.

1-B. As mentioned above, non-disclosure privilege provides exemption from general disclosure under the Civil Code.

1-C. There do not exist any limitations to the effect of non-disclosure privilege as to whether or not the contents of confidentiality privileges are considered to be a legal matter. In particular, technological secrets are considered to be intrinsically subject to non-disclosure privilege under Art. 197(1)(3) of the Code of Civil Procedure.

In Japan, non-disclosure privilege under the Code of Civil Procedure has its basis on the unique position of a person being required to disclose something. It does not necessarily require that the matter to be protected is a certain kind of communication with another person (for example, an attorney at law). Therefore, the issue of vitiation or "overcoming" are irrelevant to non-disclosure privilege under the Code of Civil Procedure and this privilege will always and consistently be protected.

1-D. Non-disclosure privilege can be asserted in every civil case regardless of the type of dispute.

1-E. When an attorney at law violates the privilege, it will be considered to be grounds for applying disciplinary measures under the Lawyer Law, and an appropriate disciplinary measure will be undertaken by the bar association. The offense of divulging under Art. 134 of the Penal Code can also apply to such a conduct, but in this case, accusation by an injured party will be required in order to punish the divulging attorney. Furthermore, in cases where a client's secret is leaked intentionally or due to negligence by his attorney, including cases where an attorney fails to assert non-disclosure privilege and discloses a secret of his client which should be protected by the privilege, if damage is inflicted on the client, the liability of compensation for the damage occurs as far as the requirements of general wrongful acts under Art. 709 of the Code of Civil Procedure are met.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients
The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. **By the way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.**

B. **Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law).**

C. **What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosure? Under what circumstances will the privilege be lost or “vitiates”?**

D. **Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?**

E. **In what types of cases can the privilege be asserted?**

F. **Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?**

**Answers**

2-A. In Japan, there is no qualification for patent agents or trademark attorneys other than that of "patent attorney." Only patent attorneys and attorneys at law are statutorily allowed to have the power and entitlement to represent a party with regard to intellectual property rights, including patents. While being an attorney at law is a qualification for dealing with the entire range of legal issues, a patent attorney is allowed to deal only with issues relating to intellectual property rights. Therefore, all attorneys at law are allowed to register as a patent attorney as well.

In the infringement proceedings before ordinary courts, patent attorneys must represent disputing parties in cooperation with attorneys at law (Art. 5 of the Patent Attorney Law). They may, however, represent disputing parties in other dispute resolution proceedings, such as nullification proceedings, including patent nullification proceedings at the JPO, and arbitrations for infringement disputes.

2-B. As already discussed in 1-A, there is no difference between an attorney at law and a patent attorney with regard to non-disclosure privileges under the Code of Civil Procedure. Their non-disclosure privileges are based on Provisions of the Code of Civil Procedure: Article 197 for non-disclosure privilege regarding testimony and Article 220 for that regarding submission of
documents. Non-disclosure privilege of a patent attorney is protected as a reflection of his professional duty. Non-disclosure privilege for a client is protected as a general right to preserve secrecy held by individuals and a general right to preserve professional and technical secrecy held thereby. Although such situation in Japan seems different from the common law form of protecting information – it protects information in a rather relative manner (i.e. in the form of attorney-client/patent attorney-client communication) – it can be understood that the essence is the same.

2-C. In Japan, non-disclosure privilege is considered to have its basis in professional or social responsibility, different from common law. Therefore, there could not be a case where the basis of privilege is nullified or overcome. The privilege and obligation of non-disclosure are also given to or imposed on employees of patent offices as a part of their professional duties (Art. 77 of the Attorney Law).

2-D. As already discussed in 1-A, disclosure of the matter which should keep secret can be prevented by non-disclosure privileges under the Code of Civil Procedure.

2-E. With regard to whether or not the exercise of non-disclosure privilege is allowed, there is no difference according to types of civil actions.

2-F. Art. 80 of the Patent Attorney law provides a specific criminal penalty of imprisonment for a period not greater than 6 months or a monetary penalty not greater than 500,000 yen for violation of non-disclosure duty. However, accusation by an injured party must be made in order to penalize the violation of non-disclosure duty by that provision. This provision can be said to be parallel with Art 134 of the Penal Code for attorneys at law. In addition, unlawful disclosure by a patent attorney can be grounds for disciplinary measures by the patent attorneys association. Furthermore, in the event that damage is inflicted on clients due to leakage of secrets, the liability of compensation for the damage occurs as far as the requirements of general wrongful acts under Art. 709 of the Code of Civil Procedure are met.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?
   (1) If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?
(2) Whose communications would qualify for such protection?

(3) Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

(4) Should communications involving responses to patent and trademark office actions be covered by such a privilege?

(5) Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believe that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

(1) Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

C. Is the matter of purely national concern such that the AIPPI should not take a position?

(1) As many jurisdictions do not allow any from of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership.

(2) Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

D. Are there other issues which should be taken into account in considering this question?

Answers

Basically, we think that the position described as alternative A should be adopted.

However, we should take into account the fact that the contents and nature of non-disclosure privilege differ among countries due to the structure and nature of the civil actions in each country, rather than due to the nature of the service of patent attorneys. For example, the discovery system in the U.S. has not been adopted in Japan, because it is thought that the possible danger of infringing upon the rights of the parties holding information is too high. When collection of proof by a party with burden of proof is considered to be particularly difficult, mitigation of the burden of proof is thought to be more appropriate than the discovery procedure. And, with regard to submission of documents, the general document production request, as seen in the U.S., will be
refused by the courts as a fishing expedition or unspecified request. Therefore, although the necessity of increased protection for non-disclosure privileges cannot be denied, sufficient attention should be paid to the differences in the judicial systems of each country, which constitute the background of non-disclosure privilege. Also, we think that it will be necessary not only to discuss the possible international standards for non-disclosure privileges, but also to seek a way which will allow foreign patent attorneys and their clients to enjoy the same level and nature of protection that domestic patent attorneys and their clients can enjoy.

(End)
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Latvian Group

Please regard this opinion of the Latvian Group as an attempt to respond to the new question for AIPPI which according to the preamble "is of great practical importance".

It cannot be denied that the Attorney-Client Privilege is of great practical importance concerning the activities of an Attorney, however a little bit less important with respect to cases, where a Patent (Trademark) Attorney is involved.

The importance of the so called Attorney-Client Privilege can be clearly seen in cases of criminal affairs, where the client naturally expects that the content of his communications with his Attorney will not be disclosed to other persons and the Attorney as a rule will never be forced to break his obligations before his client.

Understandable that this principle and its role cannot be fully denied in cases where for instance the Intellectual Property Attorney is engaged in a dispute over patent or trademark rights. But the role which said principle plays in such cases is of much minor importance.

Nevertheless in our neighbour country, Estonia, where the Patent Attorney Law was adopted by the Estonian Parliament on February 21, 2001, a special provision was included as Para 7 under the name "Keeping of professional secret". Here is an excerpt of this Paragraph:

§ 7. Keeping of professional secret

(1) A patent attorney is required to keep secret the business secrets of which he has become aware in the course of providing legal service. This obligation is not limited in time and is also valid after termination of the professional activity of the patent attorney.

(2) The obligation set out in subsection 1 of this section also applies to employees of the company of a patent attorney and to public servants who have become aware of the professional secret of a patent attorney in connection with performing service duties.

(3) A person or the legal successor of a person may release a patent attorney from the obligation to maintain professional secret by written consent.
We do not have in Latvia a Patent Attorney Law. We do have a so called Latvian Bar Law, Article 6 of which is repeating approximately the same about Attorney-Client-Privilege as written in the Estonian Patent Attorney Law. In respect of Latvian Patent and Trademark Attorneys there is only one document in which their rights and duties are more or less defined: the Regulation concerning the activities of a Patent (Trademark) Attorney. But there is nothing said about his obligation to keep secret of any information he has become aware during his communication with his client and his right not to disclose said information to any other parties or persons.

Therefore a recommendation taken by AIPPI in this matter - to include such a rule into any existing Patent Attorney Law or to adopt such a Law in any country where it does not exist in general, or to issue a Decision, according to which it is recommended to extend the Attorney-Client Privilege to Intellectual Property Attorneys (or better - to Patent and Trademark Attorneys) could be of some practical importance and help.

Although, as it was said at the very beginning, we do not suggest, that the necessity to refer to said Privilege could appear in cases, in which Patent or Trademark Attorneys are involved, very often and in our opinion they will have to face this problem rarely.

Dr. Abraham Fogel

President of the Latvian Group
1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

D. In what types of cases can the privilege be asserted?

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

A. Under the Federal Criminal law, it is considered a felony sanctioned with 30 to 200 work shifts of community work to anyone that without a justified cause and by affecting a third party reveals a secret or reserved communication that he knows or he has received as consequence of his employment or duties inherent to his position.

In the same criminal code it is punished with 1 to 5 years in prison; a fine of 50 to 500 Mexican pesos (USD$50.00) and a two month to one year suspension of his license to practice his profession, on individuals providing professional or technical services, officers of an entity, or government employees when the secret disclosed or published is an industrial secret.

Under section 36 of the Law Regulating Article 5 of the Mexican Constitution Governing the Practice of Professions in the Federal, all professional services providers shall keep
confidential any matters entrusted to him/her by his/her clients, except for the reports contemplated by law.

The above are the only provisions that could be applied to the attorney client privilege. However, this provision can be applied to any profession and is not restricted to attorneys-in-law.

Although there is the legal framework according to the research carried out, we did not find court precedents or Mexican doctrine on which we can rely on to response letters A to D.

However, Art. 36 of the Law Regulating Article 5 of the Mexican Constitution Governing the Practice of Professions in the Federal, sets forth in a very broad manner the obligation to keep the attorney client privilege, but no definition whatsoever is precised.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiates"?

D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

E. In what types of cases can the privilege be asserted?

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

A.- In Mexico, an attorney can obtain his degree after five years to attend the law school, and approve a professional exam, based on a written thesis. He has to prepare it through the supervision of a law professor. In some cases, they might obtain the degree without the professional exam and thesis, provided he achieved a high standard academic average. There is no bar exam, as in some other countries.

He could start working as a part-time law student, in a law firm (specialized in Intellectual Property, or combined with general practice); at the Mexican Institute of Industrial Property or the Mexican Copyright Institute, or in a corporation.
He could be specialized on trademarks, depending the activities he performs. He could take postgraduate courses (such as masters in foreign universities), specialized on Intellectual Property matters.

The Mexican attorney will not be qualified to be a patent attorney, as in other countries, since he might not have the technical background. However, in law firms, it is common, that there is a technical staff, composed by engineers, chemists, biologists, who deal with the technical issues of patents, and join efforts with the attorneys.

The chemists, chemical engineers, biologists, engineers, etc. (hereinafter "engineers") can not litigate intellectual property matters, neither in the administrative, civil or criminal courts. They are trained to prosecute patents, carry out patent searches and prepare technical opinions supported by an attorney. They could be identified as a patent agent.

An engineer, after five years of University, can obtain his degree and their experience are gained at law firms, patent agencies, the Mexican Institute of Industrial Property (MIIP) or corporations.

Some of them take postgraduate courses, but most of them are experienced on patents as consequence of their practice.

There is no specific certification or authorization by MIIP or any other authority to be qualified as a patent agent or as mentioned, as a patent attorney.

Having set forth the above, under general basis, the attorney client privilege, as it is set forth in the Law Regulating Article 5 of the Mexican Constitution Governing the Practice of Professions in the Federal, or Criminal Code, can be applicable to patent and trademark matters. However, to our knowledge there is no court precedents or doctrine to rely on in order to provide the information requested on letters B, C, D and E.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?
2. Whose communications would qualify for such protection?
3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?
4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?
5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?
B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?
   1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

C. Is the matter of purely national concern such that the AIPPI should not take a position?
   1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?
   2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

D. Are there other issues which should be taken into account in considering this question?

Considering the different standards of qualifications for a patent and/or trademark attorneys or patent agent, in the group's jurisdiction, it could be convenient that a harmonization process of qualification might be analyzed by AIPPI, before it can take a clear position as suggested in letter A. Therefore, it is considered that the position indicated on letter B of point 3 seems to be the more convenient at this present time.

We are of the opinion that there are no real practical differences in the professions which would justify to file a different treatment for communications with the respective clients. It is an ethical issue and a correct behaviour of the parties, specially those to which has been entrusted to handle a patent and/or trademark case regardless it is a patent and/or trademark attorney, or patent agent.
Questionnaire May 2002
Q163 Attorney–Client Privilege and the Patent and/or Trademark Attorneys Profession

Answer of the Philippine Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

The attorney client privilege is recognized in Philippine jurisdiction by statute law, administrative rules and regulations promulgated by the judiciary, and by case law.

(1) Statute Law

(a) The Revised Penal Code (RPC) provides:

ART. 209. Betrayal of trust by an attorney or solicitor-Revelation of Secrets- In addition to the proper administrative action, the penalty of prison correccional in its minimum period, or a fine ranging from P200 to P1,000 pesos, or both, shall be imposed upon any attorney-at-law or solicitor (procurador judicial) who, by any malicious breach of professional duty or inexcusable negligence or ignorance, shall prejudice his client, or reveal any of the secrets of the latter learned by him in his professional capacity.

The same penalty shall be imposed upon an attorney-at-law or solicitor (procurador judicial) who, having undertaken the defense of a client or having received confidential information from said client in a case, shall undertake the defense of the opposing party in the same case, without the consent of his first client.

The RPC prohibits and penalizes any revelation of secrets of the client by the attorney learned by him in his "professional capacity". This revelation is punishable whether it be through malicious intent or otherwise, i.e., through negligence or ignorance.
The statute likewise prohibits an attorney to defend a client’s opponent in the same case wherein he undertook to defend the said client, or reveal any confidential information from said client to the opponent, without consent from the former.

The RPC however, does not expound on how the privilege arises; specifically, on how an attorney enters into such “professional capacity” and is thus covered by the attorney-client privilege mandate.

(2) Judicial Rules and Administrative Regulations

(a) The Rules of Court (RoC)¹

The Revised Rules on Evidence of the RoC provide how the privilege arises, the extent and scope of the protection and the persons covered by the disqualification by reason of privileged communication:

An attorney cannot, without the consent of his client, be examined as to any communication made by the client to him, or his advice given thereon in the course of, or with a view to, professional employment, nor can an attorney’s secretary, stenographer, or clerk, be examined, without the consent of the client and his employer, concerning any fact the knowledge of which has been acquired in such capacity.²

For the privilege to arise, first and foremost is the requisite that an attorney-client relation exist. “The test is whether the communications are made to an attorney with a view to obtaining professional assistance or advice”.³

The phrase “with a view to obtaining professional assistance or advice” includes preparatory consultations prior to the formalization of a professional employment, but with an intent on the part of the would-be client to engage the services of the attorney in the future.

Another requisite is that the communication is made in confidence, i.e., that it be intended as confidential. Hence, communications made as to general principles of law are not covered.⁴

As to the extent and/or scope of the privilege, the rule explicitly states “any communication”. Hence, any subject intended by the client to be confidential is covered. The manner of communication of such subject matter may be verbal, written or be made by any other means.

Finally, it must be noted that not only attorneys are covered by the disqualification by reason of privileged communication. The attorney’s secretary, stenographer and/or clerk are likewise prohibited from communicating any information obtained from the client in their

¹ The Rules of Court was promulgated by the Supreme Court and took effect on 1 January 1964.
² Rule 130, Sec 24 Revised Rules of Court.
³ FRANCISCO, Evidence, p 150, 1996.
⁴ Ibid., p. 151
capacities as such, without the consent of both the client and his employer.

In addition, Rule 138 of the RoC on rules on Attorneys and Admission to the Bar likewise provides under Sec. 20 (e) thereof that “it is the duty of an attorney x x x to maintain inviolate the confidence, and at every peril to himself, to preserve the secrets of his client x x x”

(b) The Code of Professional Responsibility (CPR)

The CPR provides:

**CANON 21**—A LAWYER SHALL PRESERVE THE CONFINDENCES AND SECRETS OF HIS CLIENT EVEN AFTER THE ATTORNEY-CLIENT RELATION IS TERMINATED.

Rule 21.01 — A lawyer shall not reveal the confidences or secrets of his client except:

a) When authorized by the client after acquainting him of the consequences of the disclosure;

b) When required by law;

c) When necessary to collect his fees or to defend himself, his employees or his associates or by judicial action.

Rule 21.02 — A lawyer shall not, to the disadvantage of his client, use information acquired in the course of employment, nor shall he use the same to his own advantage or that of a third person, unless the client with full knowledge of the circumstances consents thereto.

Rule 21.03 — A lawyer shall not, without the written consent of his client, give information from his files to an outside agency seeking such information for auditing, statistical, bookkeeping, accounting, data processing, or any similar purpose.

Rule 21.04 — A lawyer may disclose the affairs of a client of the firm to the partners or associates thereof unless prohibited by the client.

Rule 21.05 — A lawyer shall adopt such measures as may be required to prevent those whose services are utilized by him, from disclosing or using confidences or secrets of the client.

Rule 21.06 — A lawyer shall avoid indiscreet conversation about a client’s affairs even with members of his family.

Rule 21.07 — A lawyer shall not reveal that he has been consulted about a particular case except to avoid possible conflict of interest.

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5 The Code was promulgated by the Supreme Court on 21 June 1988.
Canon 21 states points worth noting: the attorney-client privilege remains operative even after the termination of the attorney-client relation subject to certain exceptions; the privilege applies not just in courts of law, but in all kinds of outside agencies; a lawyer is advised to refrain to converse on the confidential information given by the client even with the members of his own family; and the privilege applies even to mere consultations about a particular case made by the client with the lawyer.

(3) Case Law

Perhaps one of the more celebrated cases decided by the Supreme Court upholding the attorney-client privilege is Regala v. Sandiganbayan, First Division⁶.

At issue is whether, as a condition precedent for the exclusion of the attorneys from an ill-gotten wealth case as party defendants, the said attorneys may be compelled to disclose the identity of their client and submit documents substantiating the lawyer-client relationship, among others, without violating the attorney-client privilege.

It was held that although as a general rule, a lawyer may not invoke the privilege and refuse to divulge the name or identity of the client, an exception would be when there is a strong probability that revealing the client's name would implicate the said client in the very activity for which he sought the lawyer's advice.

It was also held that the privilege may likewise be invoked when client identity disclosure would expose the client to civil liability.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

An obvious practical significance of the privilege and which perhaps is recognized in other jurisdictions is that it is founded in the interests of public policy and the administration of justice; it allows the client to make an open and full disclosure of all the facts and circumstances that support and surround his claim without fear of recrimination. Such unrestrained and absolute confidence in his attorney in turn would assure the client of the proper defense of his cause by the attorney in whom he has reposed his trust and confidence.

Privileged information or communication have been expressly excepted from the coverage of the different modes of discovery made available to parties to a case in the RoC. This includes all types of modes of discovery be they depositions pending action, depositions before action or pending appeal, interrogatories to parties, admission by adverse party, production or inspection of documents or things, and physical and mental examination of persons.

⁶ 262 SCRA 122
Rule 23 Section 2 of the RoC, which rule is made applicable to all modes of discovery, provides for the scope of examination, to wit:

"Unless otherwise ordered by the court x x x the deponent may be examined regarding any matter, not privileged x x x" (italics supplied)

Hence, any communication obtained under an attorney-client relation is not covered by the rules on modes of discovery for being privileged. This is of significance since the testimonies and evidences perpetuated through most of the forms of discoveries, such as depositions and interrogatories, are considered admissible in evidence and may be used in any action involving the same subject matter subsequently brought. Thus, the client is afforded protection from being forced to divulge confidential information not just in cases presently pending but in future cases that may arise out of the same subject matter.

Further, the express exception to privileged matters from the coverage of modes of discovery saves the attorney and his client, as case parties, from the consequences of refusal to comply with modes of discovery. These may range from judicial compulsion to comply with the modes of discovery, pay the proponent the reasonable expenses incurred in obtaining the order to comply with the mode of discovery, citation for contempt of court, dismissal of actions, judgment by default, and even to arrest.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

The limits of, and exceptions to, the privilege are as follows:

1) When the lawyer is authorized by the client after the latter is acquainted of the consequences of the disclosure.
2) When the disclosure of the privileged communication is required by law.
3) When the disclosure by the attorney is necessary to collect his fees or defend himself, his employees or his associates or by judicial action.
4) Communications voluntarily made to an attorney after he has refused to accept employment.
5) Where only abstract and general legal opinions are sought and obtained on general questions of law.
6) If the privileged communication is for an unlawful purpose.
7) If the communication is made in the presence of third persons not agents of the attorney, the communication is not privileged as to said third persons.
8) Implied waiver of the privilege.

As previously discussed, all communications, whether legal or non-legal matters, are covered by the privilege.

D. In what types of cases can the privilege be asserted?

Section 2 of the RoC provides:

Sec. 2. Scope – The rules of evidence shall be the same in all courts and in all trials and hearings, except as otherwise provided by law or these rules.

The said rule does not qualify whether the trials and hearings in all courts are civil or criminal. Hence, the privilege applies in all civil and criminal cases in judicial proceedings.

Although the rules of evidence are applicable only in judicial proceedings, the said rules may apply by analogy or in a suppletory character, and whenever practicable and convenient, to quasi-judicial and administrative proceedings. Therefore, the attorney-client privilege may be asserted in judicial, quasi-judicial, and administrative proceedings.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

The attorney who violates the privilege may be held criminally, civilly and administratively liable.

His criminal liability is based on Article 209 of the RPC, the penalty for which is imprisonment (prisión correccional in its minimum period) and/or a fine ranging from P200 to P1,000. The article provides that these penalties are in addition to the proper administrative sanction/s.

Since Article 100 of the same code provides that “every person criminally liable for a felony is also civilly liable”, it follows that the attorney who violates Article 209 of the said code is likewise civilly liable.

As for administrative liability, the attorney who violates the privilege may be subject to such disciplinary actions from admonition, suspension, to disbarment under Rule 138 Section 27 of the RoC on Attorneys and Admission to Bar, to wit:

A member of the bar may be disbarred or suspended from his office as attorney by the Supreme Court for any deceit, malpractice, or other gross misconduct in such office, grossly immoral conduct, or by reason of his conviction of a crime involving moral turpitude, x x x

16 Rule 143, Revised Rules of Court.
2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

Under Philippine law, all attorneys who are members of the Bar may practice law. Since the practice of law "embraces any activity, in or out of court, which requires the application of law, legal principle, practice or procedure and calls for legal knowledge, training and experience"\textsuperscript{17} it necessarily includes the practice of intellectual property law.

As held in the case of Philippine Lawyer's Association vs. Agrava\textsuperscript{18}, any person who has been duly licensed as a member of the bar and who is in good and regular standing is entitled to practice intellectual property law. Hence, a quasi-judicial agency such as the then Bureau of Patents cannot restrict this privilege by first requiring an examination that is not provided by law as a prerequisite to appearing before such agency.

Under the current applicable law, i.e., the Intellectual Property Code, ("IP Code", Rep. Act. 8293), there is no express provision for, or recognition of, patent trademark attorneys or agents. The term "attorney" may be used only by an attorney-at-law who has been admitted to the Bar.

Philippine laws do not recognize nor allow non-lawyers to practice before the Intellectual Property Office (IPO), although before the passage of the IP Code, there was a move to allow non-lawyers meeting the requirements set by the then Bureau of Patents, Trademarks and Technology Transfer to prosecute patent and trademark applications.

The IP Code, however, provides for the registration of Resident Agents or Representatives to wit:

Except employees of the IPO or any bureau, office or attached agency of the Department of Trade and Industry and their relatives to the fourth degree of consanguinity or affinity, Filipino citizens domiciled in the Philippines representing applicants, owners, or parties before the IPO may be included in the IPO Registry of Resident Agents and Representatives after completion of the IPO seminar for resident agents/representatives and upon payment of a registration fee applicable to the calendar year in which the payment was made.

\textsuperscript{17} AGPALO, Legal Ethics p.28 (1997)
\textsuperscript{18} 105 Phil. 173 (1959).
After the initial registration for each calendar year may be made
by paying the registration fee for each year. 19

Impliedly, the Resident Agents/Representatives are authorized to represent their
respective clients in the registration, maintenance, and prosecution of intellectual
property cases before the IPO. However, it can be safely assumed that they will not
be allowed to appear before the IPO's Bureau of Legal Affairs in inter partes cases
without the assistance of, and representation by, an attorney-at-law. 20

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction?
If so, please define the privilege, explain how it arises, and explain how it is
protected (for example, by statute or case law.)

B. Does not apply. A patent or trademark attorney-client privilege is not recognized in
Philippine jurisdiction

C. What are the limits of this privilege? Does the privilege extend to issues beyond
questions of patent or trademark law and practice? Does the privilege extend to
technical disclosures? Under what circumstances will the privilege be lost or
"vitiated"?

C. -same-

D. Explain the practical significance of the privilege. For example, does some form of
discovery or disclosure obligation exist generally in court proceedings in the
jurisdiction during which the privilege may be invoked to prevent disclosure?

D. -same-

E. In what types of cases can the privilege be asserted?

E. -same-

F. Are there criminal laws, civil laws or professional obligations which exist which
can come into play if the patent or trademark attorney at law violates the
privilege?

F. Criminal, Civil, Professional Obligations which come into play in the event the Patent or
trademark attorney-at-law violates the privilege.

The same liabilities that may be incurred by the attorney-at-law in violating the attorney-
client privilege may attach to the patent or trademark attorney-at-law who divulges his
clients' intellectual property affairs and matters.

The laws and rules providing for the said liabilities do not qualify the nature of the legal
work done by the attorney-at-law. Hence, divulging Intellectual Property matters derived

19  Section 8, IPO Structure
20  Rule 138, Sec. 1, Revised Rules of Court.
from an attorney-client relation which were meant by the client to be confidential would render the patent/trademark attorney-at-law liable.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

Although current Philippine laws do not recognize the term "patents/trademark attorney", we believe that:

1. It would be preferable to implement the patent/trademark attorney-client privilege among member countries via an international agreement or if possible, via a treaty. As for the manner by which each member country shall implement the mandates of such international agreement or treaty, will largely depend on each member country's own local laws, and shall best be kept to each member country's decision. For instance, a member country of the civil law tradition will find it best to implement the treaty through a local statute or law. As for common law jurisdictions, then a common law recognition would probably be employed.

2. Whose communications would qualify for such protection?

2. The communication made by the client, his authorized agents and assignees, to the patent or trademark attorney-at-law should qualify for the protection.

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

3. The privilege should extend to both technical and legal matters since these matters inevitably become largely intertwined at some point in the protection of the intellectual property rights of the client. For instance, confidential data on technical matters are afforded secrecy and protection from divulgence through the mechanics of legal matters. It would be highly impractical, not to say, defeatist of the very purpose of the privilege, to include only technical matters under the scope of the privilege and leave out legal matters.

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

4. Communications involving responses to patent and trademark office actions should be covered by the privilege, with qualifications.

Substantive matters such as technical data, trade secrets and legal defenses should be covered by the privilege.
Non-substantive matters such as perfunctory data on the patent/trademark, the
owners thereof, official actions, findings and rulings, and the like need not be
protected under the privilege.

5. Should the privilege extend to patent agents who do not make court appearances
as well as to patent or trademark attorneys who are authorized to appear in court
with attorneys-at-law?

5. The privilege should extend to patent agents and patent or trademark attorneys.

Under local jurisdiction, the underlying difference between an attorneys-at-law
and a patent/trademark agent in terms of intellectual property practice would
seem to be founded only on venue, or the courts before which one could appear
and before which the other could not. Beyond venue, the patent/trademark
agent technically as is acquainted with the factual information relating to a
client’s intellectual property case as an attorney involved in the practice of
intellectual property. Hence, it would be most logical to extend the privilege to
the patent/trademark agent if protection of the client’s intellectual proprietary
rights is to be upheld.
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Answer of Poland

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

   The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

   A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

   B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

   C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be “vitiating” or overcome?

   D. In what types of cases can the privilege be asserted?

   E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

In Poland the “attorney-client privilege” results from the Law on patent attorneys and the Principles of the professional ethics, adopted by the Polish Chamber of Patent Attorneys being a corporation of patent attorneys (all patent attorneys are by law members of the Chamber).

Case law is not applied in Poland.

According to Polish practice, each professional corporation (e.g. barristers, legal advisers, patent attorneys) establishes its own principles of professional ethics, which are obligatory for the practitioners. In each of this professions keeping professional secrets is obligatory and its violation is subjected to disciplinary responsibility within the corporation.

Information obtained in client-attorney relations are covered by a professional secret, however the refusal to reveal of these information e.g. in a criminal prosecution is estimated by the court.
2. **The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients**

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. **By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.**

B. **Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)**

C. **What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or “vitiating”?**

D. **Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?**

E. **In what types of cases can the privilege be asserted?**

F. **Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?**

In Poland there is no differentiation into patent attorneys, trademark attorneys or patent agents. Only patent attorneys are authorized to represent clients before the Patent Office. They are also authorized to represent clients before the Supreme Administration Court as well as civil courts in the matters relating to the protection of industrial property.

The required qualifications for patent attorneys are given in the Law on patent attorneys of 11 April 2001. The patent attorney has to be a Polish citizen of a full capability to perform legal activities and to enjoy fully the public rights. He has to have a Master degree in a field suitable to practice the profession, especially technical or legal one. It is also necessary to finish apprenticeship and pass the examination foreseen by law.

According to the Law on patent attorneys, when performing professional activities, the patent attorney enjoys the freedom of speech and freedom of writing within the limits of law and his privileges in this respect are the same as barrister. Moreover, the Principles of the professional ethics for patent attorneys state that:

- patent attorney is not responsible for the truthfulness of the data and facts provided to him by the client;

- patent attorney is obliged to keep professional secrets within the limits of law and client’s interest (it relates also to the revealing patent attorney’s files of the case wherein he represents his client);
- the obligation to the professional secret continues even after dissolving relations with the client, resulting from the power of attorney.

- patent attorney may refuse to render his help or to terminate the power of attorney only on important reasons, which he is obliged to communicate to his client. Nevertheless, even after termination of the power of attorney, he is obliged to perform all activities for two months;

- patent attorney may also terminate the power of attorney in case when the trust in mutual relations between him and his client has been lost;

- patent attorney cannot approve the power of attorney or render his help in a case, in which he acted on behalf of the opposite site.

In case of violation of the above obligations, patent attorney is subjected to the disciplinary proceeding. The Law on patent attorneys includes the whole chapter relating to the disciplinary responsibility in case of violation the rules by the patent attorney, and also covers the client – patent attorney relation.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?
   1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?
   2. Whose communications would qualify for such protection?
   3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?
   4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?
   5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

C. Is the matter of purely national concern such that the AIPPI should not take a position?
   1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary
considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

D. Are there other issues which should be taken into account in considering this question?

In our opinion it would be very important to support by the AIPPI a client – patent attorney privilege, however the way of implementation of this privilege should be left to the decision of each State. In countries, which differentiate between the patent attorneys, trademark attorneys and patent agents, all these professions should enjoy the same rights in this respect.

Because of a very short time to prepare a reply to Question 163, the above remarks are only very general. We support the proposal of the Dutch National Group to handle the question Q 163 on normal basis and discuss it more detail in Seoul.
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Spanish Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

A.- In Spain the confidentiality of the communications attorney at law-client is protected, and in a wide way indeed.

Section 437.2 of the Judiciary Organic Law (Organic Law 6/1985, of July 1st) clearly provides that “the attorneys at law must keep secret on all the facts or news that they know of by reason of any of the varieties of their professional performance, and they cannot be forced to declare on the same”.

It is, as it can be seen, a rule that on one side imposes on the attorneys at law the duty to keep secret and on the other side grants them the right to keep it.

The same rule is included in the General Statute of the Spanish Legal Profession, approved by means of Royal Decree 658/2001, of June 22nd, which section 32.1 reproduces the text of section 437.2 of the Judiciary Organic Law.

Furthermore, paragraph 2 of same section 32 of the General Statute of the Spanish Legal Profession includes a provision for those cases wherein it is ordered that the professional office of an attorney at law be searched.

In those events, the Dean of his/her Bar Association or his/her legal Deputy, should he/she be required by virtue of legal rule or notice by the Legal Authorities, or Governmental Authorities where appropriate, must appear in person in said office and attend to the proceedings that take place in it, caring for the safeguard of the professional secret.
Furthermore, it must be mentioned the provision set forth in section 416.2nd of the Criminal Law of Procedure, according to which the attorney at law of the Defendant is released from the obligation to declare with respect to the facts that the latter have entrusted him/her in his/her quality of counsel for the defence.

And finally, it must be mentioned section 199 of the Penal Code that provides the following:

"1.- That who disclose somebody else's secrets, of which he/she has knowledge of by reason of his/her profession or his/her labour relationships, will be punished with a prison penalty from one to three years and with a fine of six to twelve months.

2.- That professional who fail in his/her obligation of secrecy or discretion and disclose the secrets of another person, will be punished with a prison penalty from one to four years, a fine from twelve to twenty four months and a special disqualification to perform said profession for a period from two to six years".

Hence, it may be said that the confidentiality of the communications attorney at law-client is well established in Spain as a right and as a duty for the attorneys at law.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

B.- In Spain, as a general rule, it does not exist, in the case of civil lawsuits, a generic obligation of the parties to discover or disclose documents.

Notwithstanding, section 328 of the Civil Law of Procedure provides that each party is entitled to request to the other parties that discover the documents that are not at their disposal and that refer to the subject matter of the action or to the effectiveness of the evidence means.

The Court must decide whether the adducing of the document is proper and, where appropriate, may require the corresponding party to adduce it.

Nevertheless, it is commonly accepted that the communications attorney at law-client are not documents that may be required to be discovered.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

C.- The privilege of secret or confidentiality of the communications client-attorney at law, as its own name states, is limited to the communications concerning the professional assistance that the attorney at law serves to whom is his/her client. The communications or other documents sent or received by persons that, being attorneys at law, do not act as such in their quality of senders or receivers of such communications, are not protected by the privilege.
D. *In what types of cases can the privilege be asserted?*

D.- The professional secret is a privilege that can be invoked in any cases, including criminal cases, as results from section 416.2nd of the Criminal Law of Procedure above transcribed.

E. *Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?*

E.- Section 199 of the Criminal Code, above mentioned, may be applied, according to the seriousness of the case, to the hypothetical case that an attorney at law violates his/her duty of secrecy. Section 1.902 of the Civil Code that refers, in general, to damages occasioned to third parties, may also be applicable when such damages arise from the violation of the professional secret. And finally, the violation of the secret is an infringement of the ethic rules of the profession and, as such, may be disciplinarily punished by the Bar Associations.

2. *The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients*

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. *By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group’s jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.*

A.- We notice that the questionnaire is intended to know the qualification, competence and differences between the figures of the patent or trademark attorney and the patent agent. Nevertheless, in Spain there is no such difference, there is an only profession, clearly differentiated, that of the industrial property agent, that may intervene before the Spanish Patent and Trademark Office with regard to any kind of industrial property (patents, utility models, designs and trademarks). The industrial property agent cannot appear in Court to defend the interests of his/her clients, though it can act as a legal expert, to report on technical questions related with the different kinds of the industrial property that my be the subject-matter of a legal proceeding.

The Industrial property agents are defined, in section 156 of the Spanish Patent Act, as "those individuals entered as such in the Spanish Patent and Trademark Office which, as liberal professionals, usually offer their services to advise, assist or represent third parties to obtain the
different kinds of the Industrial Property and the defence, before the Spanish Patent and
Trademark Office, of the rights arising from the same”.

Therefore, the legal definition of the profession makes it clear that the official
industrial property agent is the professional that advises and represents their clients to obtain
Patents, Models, Trademarks, etc. and defends those rights before the Spanish Patent and
Trademark Office.

Note that the sentence “the defence before the Spanish Patent and Trademark
Office” has a clearly restrictive character. In fact, the industrial property agents, as such, are not
entitled to represent their clients in Courts.

The requirements to acquire the status of Industrial property agent are set up in

Those requirements are:

1.- To be a Spaniard or to have the nationality of one of the Member States of the
European Community. To be of age and to have a professional office in Spain.

2.- Not having been indictee nor having been find guilty of fraudulent offence, unless
discharge has been obtained.

3.- To have the official degrees of Licentiate, Architect or Engineer, issued by the
Presidents of the Universities or other official degrees that are considered, by law, equal to those
mentioned.

4.- To pass an aptitude exam accrediting the necessary knowledge to perform the
professional activity defined in the above section.

5.- To grant a bail deposit at the disposal of the Spanish Patent and Trademark
Office and to contract a civil responsibility insurance.

Royal Decree 278/2000 dated February 25th, by means of which are approved the
Statutes of the Industrial Property Agents Official Association, sets up, by means of section 2, that
the “Association will be made up of all the Industrial Property Agents, which must be included in it
as an indispensable requirement to perform such profession”. Therefore, section 157 of the Patent
Act is complemented with this provision, insofar as to perform the profession of industrial property
agent it is necessary to become a member of the professional association.

B. Is a patent or trademark attorney-client privilege recognized in your
jurisdiction? If so, please define the privilege, explain how it arises, and
explain how it is protected (for example, by statute or case law.)
B.- Nevertheless, section 64 of the Implementing Regulation of the Patent Act, which is among those related to the profession of industrial property agent, sets down, as a requirement prior to the entering of the Agent in the Spanish Patent and Trademark Office, that the interested person must take an oath or promise to faithfully and loyally perform his/her position, keep professional secret and not to represent adverse interests in a same matter.

The Statutes of the Official Association of Industrial Property Agents, in its section 7, rules the rights and duties of the industrial property agents, and in said section 7.2.b it is provided, as a duty of the agent, "to faithfully and loyally perform the tasks of the profession, to keep the professional secret, not to represent adverse interests and to put forth the due diligence in the performance of the professional duties". In these same Statutes, section 41, is provided that the industrial property agents are subject to disciplinary responsibilities in the event of infringement of their professional duties. The penalties envisaged, that may be imposed, may reach, should be deemed the performance of the agent in the execution of his/her profession as a very serious misdemeanour, to the expulsion of the Association, and, consequently, to disqualification to perform the profession, and section 47 includes as a very serious disciplinary misdemeanour "the serious non-fulfilment of the duty of professional secret".

Likewise, the Industrial Property Agents Official Association has a Professional Behaviour Code that includes several provisions dealing with the duty of professional secret. Hence, section 1.c., General Provisions, sets forth that the members of the Association are compelled not to disclose the information accepted by them, by way of confidentiality, in the performance of their profession, unless they have been expressly relieved of such duty by their clients. In sections 2 (publicity) and 4 (relationship with clients) the members of the Association are requested, within the right of carrying out publicity, to respect the professional secret, and section 4 requests also from the members of the association not to put in danger the duty of professional secret in the event of information that may become to public knowledge.

As we will see in this regulation, the professional secret is set down as an obligation, though it is only logic to infer that to this obligation corresponds the right of the Agent that be respected his/her professional secret, that is, that he/she be not forced to disclose the information provided by a client which he/she has known of due to the performance of his/her profession.

C. **What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or “vitiated”?**

C.- In principle, the duty and the right to secret must be limited to matters belonging to the professional field, that is, to that information that the agent has received from his/her client by
reason of the performance of his/her profession. It is doubtful that the information received that may fall out of this frame is protected by the privilege. Nevertheless, it must be understood that it includes technical information, as this kind of information is inseparable from the performance of the profession of the industrial property agent as patent agent.

It must be pointed out that the performance of the profession of industrial property agent is not incompatible with the performance of the Legal profession. In the event that the same person gathers the two positions, that is, patent agent and attorney at law, it would be even more difficult to fix the limits of which information received from its client is privileged.

D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

D.- In order to answer to this question, it must be reiterated what has been said in paragraph D of section 1 of the questionnaire. It can be added that, in principle, there is no opposition to the fact that an industrial property agent claims his/her right to professional secret in order not to disclose, neither to third parties nor to the Legal Authority, the information known by him/her, exclusively, because of the disclosure made to him/her by his/her client. The rule that would protect this opinion would be that of the repeated section 64 of the Implementation Regulation of the Patent Act.

E. In what types of cases can the privilege be asserted?
F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

E and F.- What has been said referred to attorneys at law in paragraphs D and E of section 1 of the questionnaire is valid for the industrial property agents.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

A.- It is deemed reasonable that the communications between the patent agents and their clients be deemed confidential and that, therefore, does not exist the obligation to disclose them to third parties or even to Courts.
1. **If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?**

1.- We understand that it would be desirable that the privilege be recognised by the Industrial Property Act and also by the Professional Statutes.

2. **Whose communications would qualify for such protection?**

2.- The communications qualified for such protection would be those transmitted by clients to their agents when those latter where acting in the performance of their profession.

3. **Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?**

3.- The limits should be established according to the professional performance and should extend both to technical matters and to legal-technical matters, specially bearing in mind that, in the field of Patents, many times it is difficult to fix the boundaries of the aspects purely technical or purely legal of an information.

4. **Should communications involving responses to patent and trademark office actions be covered by such a privilege?**

4.- It does not seem that most of the responses of the agents to the Patent and Trademark Offices should be covered by the professional secret. They are official documents that are included in files deposited in public bodies to which, usually by Law, at least the interested persons, are entitled to accede.

5. **Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?**

5.- The privilege of professional secret should extend both to agents acting before the Administration and to those acting in the Courts. Nevertheless, in Spain this duality does not exist, as the profession of agent qualifies to act before the Spanish Patent and Trademark Office, though not in Courts.

**B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**
B.- It seems reasonable that the AIPPI takes a position on the matter, as it is a question that may largely affect to inventors, industrials and, in general, to any person that wish to obtain or protect Industrial Property rights, and, specially to member professionals of the Association.

1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**

1.- The professional secret may be deemed a unanimous concept. It is the duty-right of the professionals not to disclose to third parties the information obtained, in confidentiality, from their clients, by reason of their professional activity. It is obvious that in the case of the attorneys at law, the professional secret may cover actions that are offences carried out by their clients. It does not seem that this may be the case of the patent agents. Anyway, the latter are the trustees, in confidence, of technical-legal information, which financial significance may be substantial.

C. **Is the matter of purely national concern such that the AIPPI should not take a position?**

C.- In our present globalised world, the question of the professional secret goes beyond the purely national limits.

1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership**

1.- It does not seem that the differences among the domestic legislations concerning discovery or forced disclosure are a reason for AIPPI not to adopt a position on the matter. It is a question of setting up some principles or basic rules that may be generally accepted and that mean an adequate protection of the professional secret between the industrial property agents and their clients.

2. **Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.**

2.- It seems obvious that a foreign applicant, in a country that does not cover the professional secret of the industrial property agents, could suffer the disadvantages arising from the professional performance itself and from the disclosure of the information to which third parties, that in principle are not entitled to, may accede due to the lack of the corresponding regulation. Without a general regulation that respects, as a principle, the professional secret, it seems difficult to protect, globally, the rights of those hypothetical foreign applicants.
Questionnaire May 2002
Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Answer of the Swiss Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

Yes. The privilege is protected by statute. The violation of the privilege is a criminal offense under article 321 of the Swiss criminal code. The privilege covers all information that an attorney at law receives from his client or of which he learns in the course of his activity as an attorney at law, i.e. as counsel. It does not however extend to information that he may acquire as a director of a company, even if the company is one of his clients.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

If the information is privileged, the attorney at law has no obligation to disclose it, even if his client asks him to do so. The attorney at law can disclose the information if he is duly authorised (but in no way obliged) by the cantonal authority in charge of supervising the attorneys at law. An attorney at law may request the authorisation to disclose privileged information if his professional honour is at stake or if he can only defend himself by disclosing such information (eg in a malpractice case).

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

The privilege extends to all matters, even of a non-legal nature. Exceptions only exist if the attorney at law obtained the information in the course of an activity which is not a typical lawyer's activity e.g. when acting as a director of a Company or as a financial intermediary or in any other commercial function.
D. In what types of cases can the privilege be asserted?

In all types of cases.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

Criminal law states that the violation of the privilege is a criminal offense. An attorney at law can be held liable for any damages caused by the violation. He can also be subject to administrative sanctions, warned, fined, suspended or disbarred in the event he violated the privilege.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

In Switzerland, there is unfortunately no recognition of the patent/trademark attorney or patent/trademark agent profession as such. There are no specific requirements nor specific qualifications for representing clients before the Swiss Federal Institute of Intellectual Property. Patent attorneys that have the qualification for acting before the European Patent Office are bound by the EPI rules and code of conduct. The patent attorneys who are members of Association of Swiss Patent Attorneys (ASPA) representing the FICPI in Switzerland are bound by the FICPI rule and more particularly the LUGANO Code of conduct that specifies in rule 5 that each member should keep secret information received by a client unless he is released of this obligation. In any case a Judge may release a Patent Attorney from its secrecy obligation. The Patent Law however provides in art 68 that the trade and manufacturing secrets should be preserved.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

NO

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiolated"?
D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

NA

E. In what types of cases can the privilege be asserted?

NA

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

NA

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

YES, this should be done in cooperation with the other professional organizations (EPI, FICPI), which are already engaged with this matter.

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

   By statute

2. Whose communications would qualify for such protection?

   The same communications as for attorneys at law as far as these are of technical and/or legal nature

3. Should there be a limit on the scope of the protection?

   NO

   Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

   YES
4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

YES, as long as they are not open to public inspection

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

YES

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

NO

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

C. Is the matter of purely national concern such that the AIPPI should not take a position?

NO

1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?

NO

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

YES, the present situation may cause a discrimination between the home applicant and the foreign applicant and thus it is desirable that AIPPI support member countries in the definition and implementation of general rules

D. Are there other issues which should be taken into account in considering this question?
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark
Attorneys Profession

Answer of the Ukrainian Group

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorney at law and their clients

A. Is an attorney-client privilege recognised in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law).

The attorney-client jurisdiction is recognised in Ukraine and is protected by the statute law.

Article 4 of the Law of Ukraine “On the Profession of Attorney” reads:
“The Attorney of Ukraine shall perform its activity based on the principles of supremacy of law, independency, democracy, humanity and confidentiality.”

The privilege in question arises from the provisions of Article 9 of the Law “On the Profession of Attorney” under which an attorney at law is obliged to keep the attorney’s secret. The attorney’s secret is constituted by matters in which a citizen or a legal entity applied to the attorney, a subject of consultations, advices, explanations and other information obtained by the attorney in the course of his duties.

Attorneys at law guilty of disclosure of the inquest results shall be liable under the current legislation.

Also, this privilege is defined by the “Rules of Attorney’s Ethics” under which keeping confidentiality of the information obtained by the attorney from the client and the information about the client and other persons in the course of his duties constitutes the attorney’s right in his relations will all subjects of law who may require disclosure of such information.

The principle of confidentiality is not limited in time.

The attorney-client privilege is protected under Article 10 of the Law of Ukraine “On the Profession of Attorney” which states:

“The professional rights, honour and dignity of an attorney shall be protected by the law. Any interference in the attorney’s activity, demanding of disclosure of the information which is the attorney’s secret from the attorney, his assistant, officials and technicians working for attorneys associations shall be prohibited. They can not be interrogated in these matters.”

At the same time, the documents related to the attorney’s duties shall not be subject to examination, disclosure or withdrawal. Also, listening to telephone conversations of attorneys
related to the investigatory activity without the General Executor's or his deputies' sanction is prohibited.

Neither preliminary investigation authority, nor investigator and executor can make a statement, nor can the court issue a ruling about the position of the attorney in the case.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

Some form of disclosure obligation may exist only in the criminal proceedings, in particular under Art. 21 of the Criminal Code relating to non-reporting about a crime. However, the information obtained by the attorney in the course of his duties can not be disclosed (See the section above).

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiated" or overcome?

The privilege extends only to legal matters and can not go beyond these matters. The premise for asserting this privilege is exchange of information between the attorney and his client in the course of their professional relations. When the attorney's activity extends beyond the professional activity, the privilege can not be asserted.

The law does not provide for the circumstances under which the privilege can be vitiating.

D. In what types of cases can the privilege be asserted?

The privilege extends to all types of cases.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

The law of Ukraine "On the Profession of Attorney" provides that the criminal proceedings can not be instituted against an attorney by any court, except for the Executor General of Ukraine. The attorney can not be liable under the criminal or substantive law (art. 10).

In the cases of violation of the privilege by the attorney, the legislation provides for civil, in particular disciplinary measures (Art. 117 of the Civil Procedure Code).

The disciplinary liability is, in particular, provided for by the Rules of Attorney's Ethics. The attorney may be called to account for the violation of the professional obligations, or for the violation of these obligations by his assistant.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the difference if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

The Decree "On Representatives in Intellectual Property Matters (Patent Attorneys)" defines the powers of a patent attorney and the extent of representation allowed by the qualification as follows. A patent attorney provides natural persons and legal entities with the assistance and services related to the protection of intellectual property rights, represents their interests at the Patent Office
and authorities supervised by the Patent Office, as well as at courts, credit institutions, in their relations with other natural persons and legal entities.

The Patent Office is charged with certification and registration of patent attorneys. For this purpose, it forms the Certifying Commission and the Commission of Appeal. The Certifying Commission determines the qualifying examinations, examination tasks, appoints examiners and takes decisions on admittance of candidates to examinations and certification.

Patent attorney nominees must submit documents confirming their degrees in technical or humanities fields, their IP degree (patent engineer or IP manager qualification), as well as confirmation of at least 5 years work experience in the field. The nominees determine their future specialty (mark the subjects of intellectual property rights in which they wish to become representatives) which is taken by the Certifying Commission into account during the qualifying examination.

The information about the specialisation of a patent attorney is entered in the State Register and in the Certificate.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law).

The patent or trademark attorney-client privilege is recognised in Ukraine. This privilege arises from the right of the patent attorney to determine whether the information which constitutes professional, business or other interest may be available to the public and whether it is confidential, as well as from his right to provide security systems for this information unless otherwise is provided by the law or by the Power of Attorney issued by the client (paragraph 12 of the Decree "On Representatives in Intellectual Property Matters (Patent Attorneys)").

Under paragraph 16 of the Decree "On Representatives in Intellectual Property Matters (Patent Attorneys)", the patent attorney shall keep the information obtained in the course of his duties in secret, in particular the information related to the matters in which he represents his client, the subject of consultations, advices and explanations, etc.

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiated"?

The privilege is limited to the information obtained by the patent attorney in the course of his duties, which is the matters in which he represents his client, the subject of consultations, advices and explanations.

The law does not contain any provisions specifying the scope of privilege with respect to different subjects of intellectual property, namely in the cases where a consultation relating to one subject involves consultations, advices and discussions for another subject.

At the same time, there are no direct provisions in respect of technical disclosures. However, as far as the patent attorney is entitled to determine which documents and information are confidential, the privilege may extend to technical disclosure if it is considered to be confidential. Confidential documents relating to the IP subject prepared for the purpose of acquainting the attorney with the case (if they are necessary for the consultation) and documents such as patent specification are covered by the privilege.

There are no provisions in the legislation regarding the vitiation of the privilege.
D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

No provisions.

E. In what types of cases can the privilege be asserted?

In all types of cases.

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

The Decree "On Representatives in Intellectual Property Matters (Patent Attorneys)" provides the following measures for violation of the privilege in question:

Warning;

Suspension of the Patent Attorney’s Certificate for the term of one year, which suspension prohibits him to act as a patent attorney during this period;

Cancellation of the Certificate.

The Certificate can be cancelled in the case of violation of the provisions of this Decree and the IP legislation by the patent attorney.

3. Proposal for General Rules

Would the Group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc.?

It is desirable that the privilege protecting from forced disclosure of communications between patent or trademark attorneys or their clients to a court or third party existed in each member country.

To this end, the status of a patent or trademark attorney must be clearly defined. Thus, it would be preferable if the privilege in question was implemented by statute law and professional obligations.

2. Whose communications would qualify for such protection?

These must be communications between patent/trademark attorneys and their clients. The term "client" should imply persons acting as his agents. Also, communications between the patent/trademark attorney and experts, as well as between experts and clients should be subject to privilege.

3. Should there be a limit on the scope of protection? Should the privilege extend to purely technical communication as well as communications mixing legal and technical matters?

Yes.
Since division of technical and legal aspect in any consultation, advice or any other communication between the patent attorney and client is mainly unreasonable, the scope of privilege should cover both technical and legal matters. At the same time, it is desirable to develop unified standards for classifying technical disclosures as confidential.

4. **Should communications involving responses to patent and trademark office actions be covered by such a privilege?**

   Yes, provided that they contain confidential information.

5. **Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?**

   Irrespective of the differences in qualifications and the scope of powers in the case of the above-mentioned representatives, all they deal with matters which may be considered to be confidential information. It would be advantageous for foreign applicants if the privilege also extended to patent agents.

   B. **Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organisation believes that if a jurisdiction recognises a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**

   1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**

   No.

   In both cases, there should be a definition of the confidential information.

   C. **Is the matter of purely national concern such that the AIPPI should not take a position?**

   1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership?**

   Although such a provision may have uneven impact in different jurisdictions, the adoption of such a provision will be appropriate from the standpoint of introduction of uniformity throughout the member countries in respect of the patent/trademark attorney-client privilege.

   2. **Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.**

   The lack of uniformity in the matters of patent/trademark attorney-client privilege in the member countries is certainly disadvantageous for applicants. First of all, the lack of the privilege may result in disclosure of confidential information (for example, this may happen at the stage of consultations, before publication of an application, etc.), which violation can not be properly prosecuted.

   Also, in the case of court proceedings, right owners appear to have different chances in different jurisdictions.
At this point, the AIPPI may analyse the existing practice in different jurisdictions and develop the unified criteria for confidentiality, as well as determine the scope of the privilege, which would form a basis for the model provisions relating to the attorney-client privilege.

D. Are there other issues which should be taken into account in considering this question?
Questionnaire May 2002
Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorney Profession

Answer of the United Kingdom Group

1. **The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients**

   A. *Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)*

   Yes. A solicitor (or barrister) cannot be compelled to disclose communications, whether oral or written, passing directly or indirectly between him and his client, or between him and a person who is communicating with him professionally with a view to becoming his client for the purpose of giving or receiving legal professional advice if they are legitimate communications.

   There is a separate head of privilege which protects communications between a solicitor and a non-professional agent or third party which come into existence after litigation is contemplated and made with a view to obtaining information to be used as evidence in that litigation or for giving advice.

   Privilege was established and is governed by case law not statute law.

   B. *Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?*

   Disclosure obligations exist generally in English Court proceedings. The effect of the privilege is that neither the lawyer nor his client can be compelled to disclose privileged communications in the course of legal proceedings.

   C. *What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiating" or overcome?*

   There are limits to the communications protected by privilege - it has to be legitimate communications ie not made in furtherance of a fraud or crime to a solicitor/barrister in their professional capacity.

   Documents that are in the public domain are not privileged.

   The privilege belongs to the client. However privilege is overridden if the lawyer suspects the client is involved in money laundering, in which case he is under an obligation to report the details to the
police. In addition the lawyer is not bound if he knows or suspects a crime is about to be committed by his client or in relation to certain knowledge about terrorist offences. It is also possible to make an application to the Court for an order that privilege be overridden.

D. In what types of cases can the privilege be asserted?

All types

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

Client could bring a civil action for Breach of confidence against the lawyer. A solicitor would also be in breach of his professional code of conduct.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

A. Persons Permitted to carrying on business of a patent agent

Any individual, partnership or body corporate may carry on the business of acting as agent for others for the purpose of applying for or obtaining patents in the United Kingdom or conducting proceedings before the Comptroller of the Patent Office relating to applications for patents. No qualification is required to act as a patent agent.


Under the provisions of the Copyright, Designs and Patents Act 1988, there is a Register of Patent Agents set up in accordance with rules made by the Secretary of State. These rules include provisions for educational qualifications, training and examination requirements to be met as the basis for qualification for entry in the Register of Patent Agents. The responsibility for the management and control of the examinations is delegated to the Chartered Institute of Patent Agents in conjunction with the Institute of Trade Mark Attorneys and those bodies have delegated their respective responsibilities for the qualifying examinations for both patent agents and trade mark attorneys to a joint Examination Board. The entry of an individual's name in the Register of Patent Agents entitles the person to use the title "Patent Agent" or "Patent Attorney".

Registered Trade Mark Attorneys

There is a Register of Trade Mark Attorneys established and maintained in a similar manner to that for Registered Patent Agents and the requirements for entry on the Register are by way of experience and examination under the direction of the joint Examination Board referred to above.

B. Privilege for communications with Patent Agents was established under Section 280 of the Copyright, Designs and Patents Act 1988 as follows:

(1) This section applies to communications as to any matter relating to the protection of any invention, design, technical information, or trade mark [or service mark], or as to any matter involving passing off.

(2) Any such communication:
   (a) between a person and his 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 privileged from disclosure in legal proceedings in England, Wales or Northern Ireland 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.

(3) In subsection (2) “patent agent” means-
(a) a registered patent agent or a person who is on the European list,
(b) a partnership entitled to describe itself as a firm of patent agents or as a firm carrying on the business of a European patent attorney, or
(c) a body corporate entitled to describe itself as a patent agent or as a company carrying on the business of a European patent attorney.

(4) It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications extends to such communications as are mentioned in this section.

C. What are the limits of this privilege?

See B above

D. Explain the practical significance of the privilege.

See the answer to B in Part 1 above.

E. In what types of cases can the privilege be asserted?

Privilege can be asserted in the forms of proceedings set out in B above.

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

See the answer in Part 1 E above.

3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Yes

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

   1. Statute.

2. Whose communications would qualify for such protection?

   2. The persons indicated in the answer 2C above.

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?
3. Subject to the communication falling within the test of 2C above it should be privileged.

4. **Should communications involving responses to patent and trademark office actions be covered by such a privilege?**
   
   4. Yes.

5. **Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?**
   
   5. Yes.

B. **Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?**
   
   B. No

1. **Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?**
   
   1. No.

C. **Is the matter of purely national concern such that the AIPPI should not take a position?**
   
   C. No

1. **As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership**

1. If organisations such as AIPPI do not have a recommended minimum provision relating to privilege in communications between professionals and their clients the position as between different jurisdictions will remain uneven. It is only by focussing on the differences that there may be possibilities for harmonisation which is a fundamental AIPPI policy.

2. **Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.**

2. The parties can obviously be disadvantaged if they are forced to disclosure documents in some jurisdictions but not in others which could result in Courts reaching different conclusions on essentially the same issues. It is hard to see how this could be dealt with other than by having uniform privilege provisions in all jurisdictions.
D. Are there other issues which should be taken into account in considering this question?

D. Parallel with any study on privilege, AIPPI should obviously study the position on discovery in different jurisdictions with a view to possibly adopting a minimum requirement.
Appendix 4

Resolution of Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession
QUESTION 163

Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Yearbook 2003/II, page 341
Executive Committee of Lucerne, October 25 - 28, 2003

Question Q163

Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Resolution

AIPPI

Recognizing:

1. the importance of intellectual and industrial properties to the world's economy;
2. the importance of the role of patent and trademark attorneys and registered agents to the world's intellectual property systems for the benefit of their clients and society;
3. that clients and legal systems are both well-served by maintaining in strict confidence and protecting from disclosure to third parties communications between the clients and their attorneys made for the purpose of obtaining and providing legal advice; and
4. that such communications between attorneys and clients regarding technical matters are as deserving of protection as are communications involving purely legal matters due to the fact that technical and legal matters are often closely interrelated in regards to intellectual and industrial property rights.

Resolves:

That AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize 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.
Appendix 5

The Submission of the Law Council of Australia to IP Australia on the need to amend Australian law on the recognition of privilege under the Patents Act 1990
19 May 2005

Dr Ian Heath
IP Australia
PO Box 200
WODEN ACT 2606

Dear Dr Heath

Inadequacies of patent attorney privilege in Australia

1. Summary

1.1 This is a submission by the Intellectual Property Committee of the Law Council of Australia. We address this letter to you as the person directly responsible for the Patents Act 1990 (Cth) (the Act).

1.2 It seems now well established that:

(1) patent attorney privilege is confined to those qualified under the Act and therefore does not extend to overseas patent attorneys and patent agents,

(2) patent attorney privilege does not extend to communications between patent attorneys, whether local or overseas, and third parties,

(3) there is a rebuttable presumption that communications with foreign lawyers by those seeking legal advice will be protected by legal professional privilege,

(4) the difference between the scope of privilege applicable to patent attorney communications and patent lawyer communications is causing substantial legal problems and additional otherwise avoidable legal cost in the conduct of patent litigation in Australia,

(5) the difference referred to in (4) risks communications between patentees and foreign patent attorneys and agents first being compromised by enforced disclosure in Australian legal proceedings and secondly where those communications involve an Australian patent attorney or Australian patent lawyer communications with the patentee, loss of the privilege that would otherwise have applied in Australia to either or both of those categories of professionals, and
(6) There is uncertainty whether S200(2) of the Patents Act applies only as at the date of enactment as opposed to the date on which privilege is claimed which, if the former applies, has the undesirable consequence that patent attorney privilege is not as the legislation states ie of the same extent as the privilege applicable to a solicitor if the latter has changed in some way.

1.3 Therefore in the interests of obtaining a more equitable and effective regime of privilege in relation to patent advisers (lawyers, patent attorneys and patent agents) and to reduce the high cost of discovery of documents in Australian patent litigation caused by the difference referred to in 1.2(4) above, we submit that urgent action be taken to amend the Act to extend patent attorney privilege to foreign patent attorneys and patent agents and to ensure that the privilege afforded to patent attorney communications is to the same extent as that afforded to lawyers.

2. Patent attorney privilege under the Patents Act 1990

2.1 Patent attorney privilege in Australia is derived solely from statute, and in particular from the Act. Section 200(2) of the Act provides:

_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._

Section 200(4) defines intellectual property matters to include matters relating to patents; trade marks, designs and related matters.

2.2 The term 'registered patent attorney' which is used in Section 200(2) of the 1990 Act is defined in Schedule 1 of the Act to mean 'a person registered as a patent attorney under this Act'. Section 198 of the Act deals with the registration of patent attorneys. In particular, Section 198(4) sets out a list of requirements for registration. Inter alia, patent attorneys must be ordinarily resident in Australia.

2.3 On a literal reading of the Act, foreign patent attorneys and/or foreign patent agents do not fall within the definition of 'registered patent attorney' set out in Schedule 1. Arguably, the exclusion of overseas patent attorneys/agents from the scope of the privilege occurred by the _Intellectual Property Laws Amendment Act 1998_ (Cth) (the 1998 Amending Act). The 1998 Amending Act introduced a new registration scheme for patent attorneys. The exclusion of foreign patent attorneys from the scope of the privilege may have happened by the introduction of a new defined term, 'registered patent attorney', and the consequential use of that term in Section 200. In that case, the exclusion was possibly unintentional. We note that the limitation of the scope of the privilege
which so occurred, is not referred to in the Second Reading Speeches or the Explanatory Memoranda for the 1998 Amending Act.

2.4 We concede however that it is possible that the meaning of 'patent attorney' in the original Patents Act 1990 could have been read down to a patent attorney registered in Australia. Whatever the position may have been under the 1990 Act as it commenced, the present position in unsatisfactory.

2.5 The privilege created by Section 200(2) of the Act does not extend to communications between patent attorneys and third parties under any circumstances.

2.6 In *Re Colina; Ex parte Torney* (1999) 166 ALR 545 (*Re Colina*), the High Court addressed the validity of Section 35 of the Family Law Act in this form.

Subject to this and any other Act, the Family Court has the same power to punish contempts of its power and authority as is possessed by the High Court in respect of contempts of the High Court.

McHugh J stated at [42] that if Section 35 purports to 'define the content of the law of the parliament by reference to the doctrines of judge-made common law, arguably it cannot do so'. He went on to say that if it did no more than pick up and apply as Commonwealth Law the precise content of the rules of contempt which were recognised by the Supreme Court of Judicature as at the commencement of the *Judiciary Act*, then it may be valid because its content does not depend upon judicial development but is frozen as at a particular date (1903). Gleeson CJ and Gummow J left open the question of whether the content of Section 35 was 'frozen in time'. By analogy with *Re Colina*, Section 200(2) of the Patents Act is uncertain as to whether it is frozen in time as at the date of its commencement or the date at which privilege is claimed under it.

2.7 Section 200(2) of the Act uses the term 'solicitor', rather than the defined term 'legal practitioner' which is used elsewhere in the Act. This inconsistency is undesirable. As well, the term 'solicitor' is likely to drop out of use by amendments proposed under State laws.

3. **Judicial consideration of patent attorney privilege**

Justice Heerey's recent decision in *Eli Lilly v Pfizer Ireland Pharmaceuticals (No 2)* [2004] FCA 850 (*Pfizer*) confirmed that the patent attorney privilege conferred by Section 200(2) will not apply to foreign patent attorneys and/or agents. Justice Heerey held that the privilege is confined to communications with patent attorneys registered in Australia. However, it appears that the judge was not called upon to decide whether privilege should be recognised for other reasons like comity. Therefore it is possible that Justice Heerey's decision is not the
final word on the scope of patent attorney privilege in Australia. The present uncertainty is undesirable.

4. The scope of general advice privilege

4.1 At common law, legal professional privilege applies to:

... any communication between a party and his professional legal adviser if it is confidential and made to or by the professional adviser in his professional capacity and with a view to obtaining or giving legal advice or assistance; notwithstanding that the communication is made through agents of the party and the solicitor or the agent of either of them ... any document prepared with a view to its being used as a communication of this class, although not in fact so used ... communications between the various legal advisers of the client, for example between the solicitor and his partner or his city agent with a view to the client obtaining legal advice or assistance ... notes, memoranda, minutes or other documents made by the client or officers of the client or the legal adviser of the client of communications which are themselves privileged, or containing a record of those communications, or relate to information sought by the client’s legal adviser to enable him to advise the client ...


4.2 Legal professional privilege will also apply to any document prepared by a lawyer or client from which the nature of the advice sought or given might be inferred: see Commissioner of Australian Federal Police v Propend Finance Pty Ltd (1997) 188 CLR 501 at 543. These applications of privilege can be described as general advice privilege. General advice privilege can be distinguished from the privilege which applies to documents prepared for the purpose of litigation (litigation privilege), although the rationale behind both types of privilege (collectively legal professional privilege) is the same.

4.3 In Esso Australia Resources v Federal Commission of Taxation (1999) (Esso) 201 CLR 49, Gleeson CJ, Gaudron and Gummow JJ stated that legal professional privilege protects the confidentiality of communications made in connection with giving or obtaining legal advice or the provision of legal services (at 64-65). However, the judgment noted that not all confidential communications are protected from compulsory disclosure, and continued:

The privilege exists to serve the public interest in the administration of justice by encouraging full and frank disclosure by clients to their lawyers.

4.4 Given the important nature of the public interest which is served by legal professional privilege, privilege is frequently described as a fundamental
common law right, rather than a procedural or evidential one: see Daniels Corporation International Pty Ltd v ACCC (2002) 192 ALR 561; Baker v Campbell (1983) 153 CLR 52; and Pratt Holdings.

4.5 Traditionally, general advice privilege was not considered to extend to communications with third parties (rather than agents). However, Pratt Holdings suggests that communications with third parties may be privileged where they are made ‘to enable the principal [i.e., the client] to make the communication necessary to obtain legal advice as required.’ (Finn J at [42]).

4.6 Kennedy v Wallace [2004] FCAFC 337 establishes that there is a rebuttable presumption that communications with foreign lawyers will be protected by legal professional privilege. This principle is consistent with the rationale behind legal professional privilege (to serve the public interest and the administration of justice by encouraging frank and full disclosure between clients and their lawyers). The Full Federal Court held that this rationale would be undermined by a geographically restricted privilege.

4.7 As the case law indicates, one of the chief advantages of legal professional privilege is that the principles applicable to it are capable of evolving to meet circumstances different from those before.

5. The grounds of the need for Amendments to amend S200 of the Patents Act

The following particulars are not intended to be exhaustive.

5.1 The same essential need for full and frank disclosure between clients and their advisers applies whether those advisers are lawyers, patent attorneys, or patent agents.

5.2 It runs counter to providing appropriately for that need to recognise privilege of different scope for Australian and overseas patent lawyers on the one hand and Australian and overseas patent attorneys/agents on the other.

5.3 That the need is presently inappropriately provided for is made out first because the same client in Australia (eg an overseas company with patents on the same subject registered here and overseas) has a greater scope of privilege if dealing with Australian and overseas lawyers than with Australian and overseas patent attorneys/agents in respect of the same subject (eg validity of the Australian patent and the overseas equivalent).

5.4 Secondly, and by reason of making the full and frank disclosure referred to in 5.1 which is required to obtain the best advice, the patentee can lose the privilege it would otherwise have had in making the same communication with its Australian patent lawyers or patent attorneys. It is common practice, for example, to copy Australian legal and patent attorney advice to overseas patent attorneys/agents in global litigation.
relation to the Australian patent and its equivalent overseas. That is done in aid of getting wide contributions in pursuit of the best Australian advice that can be obtained.

5.5 **Thirdly**, it is also frequently the case that foreign patent attorneys/agents will be involved in coordinating the provision of legal advice including providing background information to lawyers or reviewing and advising patentees on legal advice received. In the latter situation, the privilege in *legal advice* may be waived if there is no privilege in the patent attorney advice which comments on the legal advice, thus undermining the application of legal professional privilege.

5.6 **Fourthly**, foreign patent attorneys are frequently involved in communicating with the Australian patentee on issues relating to an Australian patent in aid of obtaining fully informed advice by Australian patent attorneys. The privilege in the Australian patent attorney advice will be waived if the foreign patent attorney comments in writing on the Australian advice.

5.7 **Fifthly**, in relation to discovery in patent litigation, the difference in the scope of the two categories of privilege (legal professional and patent attorney privilege) causes the need for Australian lawyers to research the issue of the relevance of overseas patent attorney/agent communications very closely. There can be a vast number of documents and thus this exercise can be enormously expensive. Frequently, it will be no answer to the need to make this investigation that the communications might on the authority of *Temmler v Knoll Laboratories (Aust) Pty Ltd* (1969) 43 ALJR 363 and *Wellcome Foundation v VR Laboratories (Aust) Pty Ltd* [1981] 34 ALR 213 not be relevant (ie overseas patent application documents are generally not relevant). For example, where there are issues of the court's discretion involved (eg whether to grant equitable relief or allow an amendment), the documents may be relevant to the exercise of discretion. Failure to disclose documents that are not privileged and which might affect the court's exercise of discretion, could be negative to obtaining the relief sought.

5.8 **Sixthly**, it is uncertain whether patent attorney privilege (even as it applies to communications between Australian patent attorneys and clients) is of the same extent as that which applies between a solicitor and the client of that person. This uncertainty exists even though the wording of Section 200(2) indicates that patent attorney privilege is intended to be generally analogous to legal professional privilege (ie '... are privileged to the same extent as a communication between a solicitor and his or her client'). It is clear that patent attorney privilege is not of the same extent as legal professional privilege in relation to communications between patent attorneys and third parties on one hand and lawyers and third parties on the other.
5.9 There is no need for the distinction between:

(1) patent attorneys registered in Australia and those overseas in relation to their giving advice in and around the same issues for the same client; and

(2) the privilege applicable to communications with patent attorneys and the privilege applicable to communications with a lawyer.

On the contrary, there is a need for the scope of privilege to be the same (see 5.1 to 5.8 above).

5.10 Many multinational patentee companies employ patent attorneys/agents (who are not also legally qualified) to assist in the management of their IP portfolios. These patent advisers, whether employed in-house or externally, constitute trusted advisers of the company in relation to intellectual property issues, and the same relationship of confidence exists between such advisers and the client as between lawyer and client. Where such companies are based overseas (as they frequently are), they will usually have and use patent attorneys/agents who are not registered in Australia.

5.11 Just as in accordance with Kennedy v Wallace there is a rebuttable presumption that communications with foreign lawyers will be protectable by legal professional privilege, so there should at least be such a presumption for foreign patent attorneys/agents.

5.12 The difference in the treatment of communications between the patentee and its Australian patent attorneys on the one hand and its foreign patent attorneys on the other in respect of the same subject (eg the validity of the Australian patent) is inconsistent with the aims of the 1990 Act and the 1998 Amending Act. Inter alia, the explanatory memorandum to the 1998 Amending Act notes the importance of ensuring that our major trading partners have confidence in the Australian system. The explanatory memorandum to the 1998 Amending Act further states that in 1995-96, approximately one third of patent applications emanated from overseas. The need for adopting a system which applies consistently to Australian patentees in respect of their Australian and foreign patent attorneys is supported by these points drawn from the explanatory memorandum.

5.13 If patent attorney privilege were extended to foreign patent attorneys/agents, that would be consistent with the recognition by Australian courts that communications with third parties may be subject to legal professional privilege where they are made to enable clients to make the communications necessary to obtain legal advice as required.

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1 See paragraph 12 of Section 2 of the First Explanatory Memorandum to the Intellectual Property Laws Amendment Bill 1997 (Cth).

2 Ibid, paragraph 6
5.14 If patent attorney privilege were to apply to patent attorneys to the same extent as legal professional privilege applies to lawyers when privilege is claimed in each case (i.e. not frozen in time but developing by having the same scope as lawyers' privilege at the time when privilege is claimed), that would be consistent with the aim of protecting communications with patent attorneys 'to the same extent' as communications with lawyers.

5.15 Finally, consistency in the language used to refer to lawyers should be consistent throughout the Act.

6. Proposed Amendments

We consider that the following amendments to the 1990 Act would deal with the deficiency in the scope of patent attorney privilege as presently drafted. New words are underlined.

Section 200(2):

A communication between to or from a registered patent attorney or a patent attorney or patent agent of another country and the attorney's client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged as at the date at which privilege is claimed, to the same extent as a communication between to or from a solicitor legal practitioner and his or her client.

7. Scope for treaty

7.1 The Committee acknowledges that there is a need for harmonisation of the law relating to privilege around the world. That would probably be best pursued by the treaty process through WIPO.

7.2 The Committee does not consider that pursuit of such a treaty is an option for dealing with the need described in this submission. That need is related to an inadequacy of Australian law and that applies whether or not other countries have the same or similar problems.

Yours sincerely

[Signature]

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