Standing Committee on Client Attorney Privilege
Draft Resolution in Support of Group B+ MLA
What it is about

• Client Attorney Privilege – CAP
• Or, more precisely:

Protection of communication between IP advisor and client from forcible disclosure, nationally and cross-border
What is the problem?

• Different concepts in civil law and in common law jurisdictions (privilege vs. professional secrecy)
• Lack of protection in some jurisdictions
• Protection may be restricted to communication involving an attorney-at-law
  – non-lawyer IP professional advice may not be protected from forcible disclosure
• Protection may not be recognized cross-border
  – loss of protection if IP legal advice is transmitted cross-border
CAP: A 16 years project of AIPPI

- Michael Dowling initiates project in 2003
- Subsequent Chair of Q199: Steven Garland
- Reporters General: Luis Duran, Jochen Buehling, Thierry Calame, Sarah Matheson, John Osha
Chronology

• 2003: Q163 Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession (ExCo Lucerne)

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.
Chronology (cont'd)

• 2005: AIPPI Submission to WIPO for a treaty to be established on Intellectual Property Adviser Privilege

• 2007: Q199 Standing Committee CAP established
Chronology (cont'd)

• 2008: WIPO/AIPPI Conference on Privilege, Geneva
  – Scope of protection in civil and common law
  – Pitfalls and obstacles for clients operating in multiple jurisdictions
  – Public interests
  – Case studies
  – Protection in the context of in-house IP advisors
Chronology (cont'd)

• Conference brought matter on agenda of WIPO SCP (Standing Committee on Patents)
  – AIPPI submitted numerous reports and attended SCP meetings
  – However: no progress in SCP
  – Points of criticism within SCP:
    • CAP draws veil over information that should be public
      – However: facts as such are not removed from public domain
    • CAP is procedural matter; TRIPS and Paris Convention contain reservation that they do not affect national procedural law
Chronology (cont'd)

- 2013: FICPI/AIPPI/AIPLA Colloquium, Paris
  - Focus on Group B+ countries
  - Governments represented by speakers: AU, DE, JP, CH and US
  - Joint Proposal for a multilateral agreement on Privilege (MLA)

  - First draft MLA, based on Joint Proposal
Chronology (cont'd)

• April|May 2019: advanced draft MLA, to be presented at Group B+ plenary by CH delegation early October 2019
  – Q199 provided comments

• September 2019: further amended draft MLA for Group B+ plenary in October 2019
Draft MLA

• Recognition of protection from forcible disclosure (Article 2)

Article 2

A communication made for the dominant purpose of an patent advisor providing professional advice to a client, shall be confidential and shall be protected from any disclosure to third parties, unless it is or has been made public with the authority of that client.

• Cross-border recognition of protection (Article 3)

Article 3

This Agreement applies to communications between an patent advisor and his client regardless of the territory of the signatory State in which the patent advisor is officially recognised and certified, and regardless of the territory of the signatory State in which the communications take place.
Draft MLA (cont'd)

• Scope: advice given on patent law (Article 1)

‘professional advice’ means advice given on patent law within the patent advisor’s area of expertise, as defined by the national law that stipulate the professional qualifications whether it is transmitted to another person or not.

• Opt-in clause (Article 5)

Article 5

Nothing prevents Nations from extending unilaterally or on the basis of reciprocity the scope and effect of this agreement on their territory to other areas of intellectual property law and to advisors other than those defined in Article 1.
• What is "advice" (Article 1)
  – subjective or analytic view and opinions
  – raw data and mere facts only privileged if communicated with dominant purpose of seeking or giving advice

• Requirements to be met by IP advisor (Articles 1 and 6)

'patent advisor' means an advisor who is authorised to act before a competent administrative or judicial authority in his/her own jurisdiction, and officially certified to provide professional privileged advice concerning patent. The criteria of qualification and the categories of certification are defined by national law.
SC on CAP's position

- MLA within reach is superb achievement
- Draft MLA resolves 2 core concerns: minimal standard of protection and cross-border recognition
- Although scope is not as broad as AIPPI would have hoped, draft MLA covers ± 90% - without rejecting the remaining ± 10%!
- We as AIPPI should do what we can to help this MLA being accepted and adopted
Draft Resolution

• Reminder: not resolution to inform stakeholders about AIPPI's own position – this position, and that is goes further than draft MLA, is known to stakeholders

• Purpose is to send signal: AIPPI supports this important step towards securing a treaty, this being the goal AIPPI has been advocating for many years

• Accept reality: draft MLA is maximum that is politically doable even within group of countries that is most supportive of this project
Thanks for your attention!