

Questionnaire Q199

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

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National Group: Romanian

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1. Q.199 - Questionnaire

The Groups are asked to reply to the following questions in the context of what applies or what they may consider ought to apply in their own country or by agreement between their country and others, as may be appropriate to the particular question. The responses of each Group need to be endorsed by that Group. It will be helpful and appreciated if the Groups follow the order of the questions in their reports and use the questions and numbers for their responses.

Present position

Local position

1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between **clients** and **IP professionals** within your country? When was this protection introduced into your law?

R. The general rule is that there are no specific provisions in respect the protection against forcible disclosure of communications relating to IP professional advice. The IP professional advisor has the obligation-according to the specific Law regarding the profession of IP attorney- no to divulge the information and documents received from his client or with regards to the client except for the limits given by the power and within the applicable framework.

There are two exceptions to the rule, cases in which there is a certain degree of protection having features defined by the Law:

- i) In case the IP professional is equally a lawyer member to the Bar, the communication between him and his Client falls within law that is governing the profession of Lawyer According to this Law, in order to ensure professional secrecy, both the acts and professional work of the lawyer in his premises are inviolable. The inspection at the workplace and home of the lawyer and the seizure of the documents can only be done by the prosecutor, under a warrant issued according to the Law. Also, in case when the IP professional is a lawyer, the Law clearly states that the contract between the lawyer and his client can not be embarrassed or controlled directly or indirectly by any State organ.
- ii) In case the IP professional is a European Patent Attorney and the object of the communication is a European Patent or European Patent Application, there is a protection pursuant to, Art. 133, 134, 134a (1)//European Patent Convention and Rule 153 apply in respect to the communications that have as object a European Patent.

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

R. No specific protection. The Rule 153 EPC refers to the communication between the professional representative and [...] any other person and not to the communication between the Client and...any other person.

1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between **IP professionals** and **third parties** (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given? –

R. The general rule is that there are no specific provisions in respect the protection against forcible disclosure of communications relating to IP professional advice. There are two exceptions to the rule, cases in which there is a certain degree of protection:

- i) In case the IP professional is equally a lawyer member to the Bar, the communication between him and his Client falls within law that is governing the profession of Lawyer – In this Law, it is mentioned that the Lawyer can enter into cooperation agreements with third parties such as experts with no specific provisions about the protection against forcible disclosure other than the one illustrated at 1.1.i) . Indirectly we may infer that there is a protection of the home and workplace of the lawyer, and that according to this protection the documents that are found in the premises of the lawyer (including those that refer to the contract with third parties) can not be disclosed without a warrant.
- ii) In case the IP professional is a European Patent Attorney and the object of the communication is a European Patent or European Patent Application, there is a protection pursuant to, Art. 133, 134, 134a (1)//European Patent Convention and Rule 153 apply in respect to the communications that have as object a European Patent, because, according to art. 153 the object refers to “all communications between the professional representative and his client or any other person”, this any other person possibly an expert.

Overseas communications

- 1.4 What protection of clients applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

R. – no specific provisions other than the ones already indicated at 1.1.

Scope of protection – qualifications of IP professional advisers

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

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

R– applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

- (ii) as to 1.2 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

R. N/A

- (iii) as to 1.3 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

R. applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

- (iv) as to 1.4 i.e. the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

R. See (i) applies if the professional is a lawyer and an IP professional at the same time or if the professional representative is a European Patent Attorney (in the latter case

the object is only European Patent or European Patent Application. In house-advisers and external advisors as well.

Limitations and exceptions

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

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

R- The warrant issued by the prosecutor is a limitation. The waiver provided in the EUROPEAN PATENT CONVENTION (“unless such privilege is expressly waived by the Client”). In addition, the lawyer cannot be heard as a witness and can not provide any information in respect to the pending file to any authority or person without the express consent of all his clients who have an interest in said file.

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

R. Same as (i) above

(iii) as to 1.3 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

R. Same as (i) above

(iv) as to 1.4 i.e. the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

R. Same as (i) above

Quality of protection

Local communications

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

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

R- Fairly appropriate, because in Romania's legal system, the judges usually do not ask for submitting as evidence the communication between the IP professional and his client. Warrants are issued in exceptional circumstances such as large fraud or crime.

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

R. Same as (i) above

- (iii) as to 1.3 i.e. the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given? ?

R- Same as (i) above

Communications with overseas IP advisers

- 1.8 Does your Group consider that the protection described in answer to question 1.4 above is of appropriate quality or not, and if not, why not – what are the problems in practice?

R. If the lawyer has the domicile in Romania, then the applicable law in respect to the communication between lawyer and client is the Romanian one, irrespective of the place of business of the lawyer. The protection is fairly appropriate, because in Romania's legal system, the judges usually do not ask for submitting as evidence the communication between the IP professional and his client. Warrants are issued in exceptional circumstances such as large fraud or crime.

2. Remedies

The 'device' to be agreed and applied within

and between countries

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

Limitations

Tests such as the 'dominant purpose' test.

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

R. NO

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

R. In practice it very difficult to define such relationship with accuracy, creating an additional difficulty to the system.

Judicial discretion to deny protection

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

R. NO

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

R. Judicial discretion is difficult to be put in practice in this matter where the forcible disclosure in IP matters does not constitute a rule, therefore it would complicate more the way the system works.

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

Qualifications required of IP advisers

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

R. YES

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

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

(i) What category is that?

R. Copyright

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

R. YES

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

R. Because copyright is one of IP rights, and secondly because in some cases there is overlap of protection of more types of rights.

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

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

R. NO

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

R. Because in the course of providing advice to a client for practical it is very hard if not impossible to make a clear delimitation between the two forms of privilege and their corresponding objects. In many situations the areas could contain overlap or could evolve in time in such a way to contain overlap. For the Client it is difficult to understand with two different standards that may apply to what is for him one single matter where he expects guidance and action.

2.11 As to any country which applies a limitation referred to in Para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?

R. YES, there should be liberty.

2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it?

R. The limitation should be in conformity with the other laws in force applicable to the matter.

Exceptions and waivers

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

R. YES

2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPPI, does your Group agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such an exception or waiver should it wish to do so in the future, in other words, that there should be liberty to vary or abolish a presently applied exception or waiver?

R. YES

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it, in particular should e.g. the

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

R. The limitation should be in conformity with the other laws in force applicable to the matter.

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

R. No experience

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

2.16 **Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section 5 above), does your Group prefer and if so why?**

R. The Alternative described in Section 5 (the one that has been made to WIPO) is preferred because its implementation is more realistic having in view that there are many differences between the systems of law of different countries. Secondly the Alternative proposes a special status for the European Patent Attorneys. Having in view that a large portion of the potential litigation is in relationship with the validity and/or the infringement of European Patents, this clarification of the status of the European Patent Attorneys is more than welcome.

Proposals from your Group

2.18 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

2.19 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

R. If at all possible, we would favour a harmonization of the provisions related to the protection of the communication between the IP professional and his client when said IP professional is a lawyer with the cases when said professional is not a lawyer.

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

R. Cannot be anticipated at this time. Overall there should not be any other adverse effects than those arising from the misinterpretation of the law.

Note:

It will be helpful and appreciated if Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.

SUMMARY

The current situation in Romania shows that there is a fairly appropriate protection of the Clients against forcible disclosure of their IP professional advice, mainly because the current practice of the Courts rarely asks such disclosure in matters of intellectual property. There are no specific provisions for the protection of the advice given by IP professionals at large, but there are some specific provisions for the cases when the IP professionals are at the same time either lawyers or European Patent Attorney.

Romanian group is in favour of adopting the Alternative that has been made to WIPO and not the AIPPI proposal because its implementation is more realistic and because it proposes a special status for the European Patent Attorneys.

Résumé

La situation législative en Roumanie est suffisamment acceptable en ce qui concerne la protection des clients contre le dévoilement du conseil donné par un conseiller en propriété industrielle parce qu'en pratique, les Tribunaux ne le demandent que rarement dans les dossiers de propriété industrielle. Il n'y a pas de provisions spécifiques pour la profession de conseiller en général. Il y a seulement deux exceptions ou la loi prévoit une protection spécifique : si le conseiller est à même temps avocat ou si le conseiller est en même temps conseiller de brevet européen.

Le group roumain serait en faveur de l'adoption de l'Alternative plutôt que la proposition AIPPI parce que son implémentation est plus faisable et parce qu'il prévoit un statut spécifique pour le conseiller de brevet européen.

Zusammenfassung

Die aktuelle Situation in Rumänien zeigt, dass es einen ziemlich angemessenen Schutz der Kunden gegenüber der erzwungenen Offenlegung des Inhalts der Beratung ihrer IP-Fachberater gibt. Vor allem, weil die derzeitige Gerichtspraxis nur selten in Angelegenheiten bezüglich geistigen Eigentums nach einer solchen Offenlegung verlangt. Es gibt zwar im allgemeinen keine konkreten Bestimmungen zum Schutz gegen eine solche erzwungene Offenlegung, jedoch gibt es einige spezielle Bestimmungen im Fall, dass der IP-Fachberater gleichzeitig Rechtsanwalt oder Anwalt des Europäischen Patentamtes ist.

Die rumänische Gruppe spricht sich für den alternativen Vorschlag der WIPO und gegen den Vorschlag der AIPPI aus, weil ihre Umsetzung realistischer ist und einen besonderen Status für die Anwälte des europäischen Patentamts vorschlägt.