Questionnaire Q199

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

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National Group: **Spain**

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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.

Prior Remarks:

The Spanish Constitution establishes that professional secrecy must be regulated by "law" (article 24.2). As a result, Industrial Property Agents are not included given that there is no regulation with the status of a specific law covering this right, something which does exist for lawyers who are exempt from testifying about certain matters they may know of through professional secrecy pursuant to article 437.2 of the Organic Law on the Judiciary. Article 64 of Royal Decree 2245/1986 approving the Implementing Regulations of Law 11/1986 mentions professional secrecy as an obligation of Industrial Property Agents to clients but does not develop the content. The same is the case with articles 7 and 47 of Royal Decree 278/2000 approving the Statutes of the Official Association of Industrial Property Agents.

Article 134.1 d) of the Munich Convention must also be mentioned. Although its scope of application is limited to proceedings before the European Patent Office, it includes the right to refuse to disclose communications exchanged with clients or with

any other person in addition to establishing the obligation of confidentiality for European patent agents, including those European patent agents who are Spanish.

Present position

Local position

1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and IP professionals within your country?

The disclosure of secrets is protected only in cases in which there is a legal obligation to keep secret and not testify, such as in the case of lawyers. There is no "privilege" when there is only a simple obligation of confidentiality, as is the case with non-lawyer industrial property agents.

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

Communications directly between clients and third parties are not protected. It is advisable to communicate with professionals who are legally obliged to secrecy (lawyers) acting as intermediaries, even knowing that the protection is not absolute.

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

Communications with IP professionals who are lawyers are protected regardless of whether those communications are with a client or with a third party in matters regarding legal assistance, albeit with the possible exception mentioned above. The remaining communications of non-lawyer IP professionals are not protected.

Overseas communications

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

In the above terms,

A) Communications between local professionals legally obliged to secrecy (lawyers) and clients or other IP professionals throughout the world would be protected.

B) Foreign IP professionals (except lawyers) are not currently recognized as having "privilege" and neither are their communications with their Spanish clients privileged.

However, if the litigant requests the other party to exhibit correspondence exchanged with his lawyer or makes such a request of the lawyer himself, article 328 of the Law on Civil Proceedings allows the judge to order disclosure although we have no knowledge of this having occurred in any case.

Scope of protection – qualifications of IP professional advisers

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

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

Only in relation to IP professionals who are lawyers. As regards in-house lawyers and secrecy in relation to other people in the company, protection is more than doubtful in view of decisions by the Courts of the European Union.

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

There is no protection.

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

The only communications protected are those of IP professionals who are lawyers.

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

A) Communications are protected when the Spanish IP professional is a lawyer.

B) Communications do not enjoy privilege if the IP adviser is not in Spain.

Limitations and exceptions

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

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

Cases of terrorism, money laundering and crimes threatening or endangering people's life, integrity, freedom or security are always excepted.

Additionally, as mentioned above, the Law on Civil Proceedings accords a certain discretion to judges.

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

There is no protection for direct communications between clients and third parties who are not legally obliged to secrecy.

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

The reply is the same as under (i).

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

A) The same limitations as under point (i).

B) Communications between clients and overseas IP advisers are not protected.

Quality of protection

Local communications

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

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

Inappropriate quality. Privilege should be extended by law to industrial property agents with degrees in fields other than law who provide services giving rise to confidentiality which must be protected so that advice may be given with guarantees.

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

Not of appropriate quality because they are understood as being communications with no special protection. Given that they are instrumental to giving proper advice, they should be protected.

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

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

Communications with overseas IP advisers

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

Inappropriate quality. A foreign IP adviser, regardless of whether he has studied law, is recognized as a lawyer in Spain only if he is authorized to act before the Spanish courts.

2. Remedies

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

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

Limitations

Tests such as the 'dominant purpose' test.

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

The “dominant purpose” test should be applied in an open manner with the exceptions the law currently contemplates such as terrorism, money laundering and damage to persons.

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

Imposing strict measures on judges’ discretion in each country by limiting specific cases would not facilitate reaching an agreement on this point. It would seem easier for each country to recognize and apply the “dominant purpose” test as the main method. The interpretation of this test will always contain an element of discretion for judges.

Judicial discretion to deny protection

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

Yes. By means of reasoned decisions.

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

The lack of scope for discretionary but reasoned decisions by judges, when reality is so rich in nuances, could be seen as an "exorbitant privilege" (a hateful word).

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

Qualifications required of IP advisers

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

Yes.

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

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

There is no category of Industrial Property Agent or IP adviser which requires no qualification.

(i) What category is that?

Non-existent.

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

Not applicable.

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

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

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

As a "civil law country", Spain protects communications of lawyers with third parties as well as with any technical advisers necessary for giving the advice regardless of whether its purpose is defense (litigation privilege) or for advising the client (lawyer-client privilege). The remaining countries should extend the current typical scope of protection, especially protection for

consulting necessary third parties other than the client when it is necessary for giving the advice or making the defense in “common law countries”.

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

Not applicable.

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

We agree provided it did not reduce its scope.

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

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

Exceptions and waivers

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

Yes.

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

Yes.

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it, in particular should e-g- the limitation dor the “3-point- exception” as discussed in for 4.28 above also set limits in this case?

That it not be an indirect means of removing the content from the general principle.

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

No.

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

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

We prefer the AIPPI proposal to the extent that each country would clearly specify which legal advisers would benefit from the treaty. However, we do not have a clear position with respect to the matter of in-house counsel. The General Court of the European Union (decision dated 17 September 2007), cases T125/03 and T253/03 (Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd) and the AM&S decision (case 155/79) delimits protection to the extent that the lawyer must be independent, i.e. he must not be obliged to his client because of his relationship as employee.

Proposals from your Group

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

Not applicable.

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

No new proposals by the Group.

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

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

Note:

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