

Questionnaire Q199

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

January 19, 2010

National Group: [AIPPI TURKEY]

Contributors: [Kerim Yardimci, Aydın Deris, Önder Özden]

Date: [May 19, 2010]

1. Q.199 - Questionnaire

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

Present position

Local position

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

Current situation of the profession must be explained before answering this question. There are three different titles, which can be cumulative in order to be IP professional in this country:

1. Trademark Attorney: Are authorized to use the title only those who have passed the exam in respect of trademark/geographical indication held by the Turkish Patent Institute (T.P.I.)

and who are recorded on the trademark attorneys' registry subject to paying the yearly insurance and attorney fees.

2. Patent Attorney: Are authorized to use the title only those who have passed the exam in respect of patents/designs held by the Turkish Patent Institute (T.P.I.) and who are recorded on the patent attorneys' registry subject to paying the yearly insurance and attorney fees.
3. Attorney-at-law: Are authorized to use the title only those who meet the requirements to be attorney-at-law according to the Code of Attorney-at-law and who are recorded on the bar registry subject to paying attorney fees.

	Capacity to act before T.P.I.	Capacity to act before Court of Justice
Trademark Attorney	For trademark and geographical indications	None
Patent Attorney	For patents, utility models and industrial designs	None
Attorney-at-law	None	For all kind of legal matters including complete IP legislation

For the attorney-at-laws, according to the article 36 of the Code of Attorney-at-law entered into force on 19.03.1969, it is forbidden to disclose any information obtained within their capacity of attorney-at-law even when such disclosure is expressly permitted by the client.

As for the trademark/patent attorney however, no provision with respect to professional secrecy exists within the article 30 of the Law no. 5000 with respect to Institution of the T.P.I. mentioning the qualification to be a trademark and/or patent attorney.

Therefore, it is possible to ascertain that there is professional secrecy -thus protection against forcible disclosure- for attorney-at-law acting before the courts or for a contemplated litigation or for IP legal advice regarding the validity and scope of protection - independent of the question whether the legal advice is provided with respect to the office action involved in administrative level or judicial level. For ease of reference, we may call them "Category Z" of IP professional.

As to the (1) trademark attorney, (2) patent attorney, and (3) in house attorney-at-law working as employee (thus not independent), there seems to be no professional secrecy -thus no protection against forcible disclosure at first sight. That being said, according to the Article 239 of the Turkish Criminal Code, which can be relied upon as a general rule against forcible

disclosure of communications relating to IP professional advice rendered by the professionals mentioned in the preceding sentence;

Disclosure of Confidential Information or Documents as Trade Secret, Banking Secret or Client Secret

Article 239 – (1) A person who delivers or discloses to unauthorized parties the confidential information or documents comprised of trade secret, banking secret or client secret, which are known to him because of his qualification or mission, profession or art, shall be imprisoned up to three years and sentenced to a monetary fine up to five thousand days upon complaint. In case of delivery or disclosure of such information or documents to the unauthorized persons by those who obtain them by illegal means, the penalty shall be enforced in accordance with this paragraph.

(2) The provisions of the first paragraph shall be enforced for the scientific discoveries and inventions or information susceptible to industrial application.

(3) In case of disclosure of such secrets to a foreigner not resident in Turkey or their officers, the penalty to be executed on the offender shall be increased in the rate of one thirds of the due penalty. No condition of complaint shall be sought in such case.

(4) A person, who forces another party to disclose the information and documents under the scope of this article using physical violence or threatening, shall be sentenced to imprisonment for three to seven years.

Considering that there is not a single court decision with regard to the application of the Article 239, it is not possible to ascertain that this provision constitute a sufficient protection against forcible disclosure (request from common law countries where discovery is available) for the second category of IP advisers. For ease of reference, we may call them “Category X” of IP professional.

In addition to the above; communications between the European Patent Attorneys acting in their capacity - i.e. with regard to preparation proceedings and validity/infringement/scope of protection of European Patent - and the client or any other person is privileged in accordance with article 134a(1) EPC and rules 153 EPI.

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

Protection of communications between clients and third parties (such as technical experts) against forcible disclosure shall be provided by the implementation of Article 239 of the Criminal Code. Again there is no court decision with regard to this point.

- 1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third

parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

Communications between the “Category Z” and Technical Experts are protected.

For communications between the “Category X” and Technical Experts, please refer to question 1.1 and question 1.2.

Overseas communications

- 1.4 What protection of clients applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?
- (a) answer of the question 1.1. would apply based on territoriality principle.
- (b) no protection.

Scope of protection – qualifications of IP professional advisers

- 1.5 As to each of the following sub-paragraphs (i) to (iv) inclusive, to what category or categories (eg lawyer, lawyer/patent attorney, non lawyer patent attorney, lawyer/trade marks attorney, non lawyer trade marks attorney etc) of IP professional adviser does the client protection described in your answer to previous questions denoted below, apply or not apply, including whether your answers apply only to external advisers, or also to in-house advisers?
- (i) as to 1.1. ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
Please refer to the answer of the question 1.1.
- (ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
Please refer to the answer of the question 1.2.
- (iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
Please refer to the answer of the question 1.3.

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

Limitations and exceptions

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

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

No limitation/exceptions for "Category Z". As for the "Category X", since there is no specific provision for the protection against forcible disclosure, it is not possible to determine whether there is any the limitation/exception.

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

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

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

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Quality of protection

Local communications

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

- (i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?
Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure. Therefore, there is a need for specific article in the law at least for trademark and patent attorneys.
- (ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?
In the view o the absence of any established jurisprudence there is legal uncertainty whether the Article 239 provide sufficient protection against forcible disclosure.
- (iii) as to 1.3 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?
Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure.

Communications with overseas IP advisers

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

Except for the “Category Z” which can be considered appropriate quality, there is legal uncertainty -due to the absence of any established jurisprudence- as to whether the Article 239 provides sufficient protection against forcible disclosure.

2. Remedies

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

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

Limitations

Tests such as the 'dominant purpose' test.

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

The dominant purpose test is irrelevant for our country so much that the only communications that are surely privileged are with respect to "Category Z" i.e. in case of litigation or contemplated litigation.

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

Please refer to the answer of the question 2.1.

Judicial discretion to deny protection

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

No.

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

It may lead to the misuse of the protection unless judicial discretion can be exhaustively listed.

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

Exhaustive list of judicial discretion must be enumerated, if possible, in order to avoid any abuse.

Qualifications required of IP advisers

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

Yes.

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

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

(i) What category is that?

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

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

Not applicable.

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

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

Such a distinction is not required in our country. However, for the sake of harmonization, the Turkish Group agrees that the standard should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law.

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

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2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a

limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?

Yes to the right to abolish a limitation or the right to vary if it further restricts the limitation.

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

Please see above.

Exceptions and waivers

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

Yes.

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

Yes.

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

Only right to broaden the scope of the limitation should not be allowed.

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

No.

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

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

AIPPI proposal is preferable as the alternative in Section 5 would create a mitigated solution.

Proposals from your Group

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

Not applicable.

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

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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?

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Note:

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

ABSTRACT

The situation regarding the protection against forcible disclosure of communications with regard to IP professional advice depends on the title of the IP professional adviser. The professional secrecy exists for attorney-at-laws, however due to absence of any specific legislative act, the situation of trademark and patent attorneys with respect to the protection against forcible disclosure remain ambiguous. The only provision available that can protect the client from forcible disclosure is the general provision of the Turkish Criminal Code. However due to the absence of any decision regarding the application of the said provision, it is not possible to anticipate what would be the scope and the extent of protection and who would be covered from this provision. The Turkish Group believes that in order to create legal certainty, it would be appropriate to specifically legislate the professional secrecy for trademark and patent attorney at national level.

At international level, the Turkish Group believes that a single international instrument such as proposed by AIPPI would be preferable compared with non-binding recommendation or unilateral, bilateral or multilateral solution as the latter would hardly make the protection against forcible disclosure more predictable.

ABSTRAKT

Der Zustand betreffend den Schutz gegen die gewaltsame Bekanntmachung der Kommunikationen hinsichtlich professioneller Beratung bezüglich IP ist abhaengig von dem Titel des professionellen IP Beraters. Die professionelle Geheimhaltung ist aber für die Rechtsanwaelte bestimmt, deshalb ist sie nicht eindeutig für den Marken- und Patentanwalt, wegen der Abwesenheit eines speziellen legislativen Gesetzes so bleibt der Zustand der Marken- und Patentanwaelte hinsichtlich des Schutzes gegen die gewaltsame Bekanntmachung mehrdeutig. Die einzige Klausel, welche den mandant gegen die gewaltsame Bekanntmachung schützen kann, ist die allgemeine Klausel des Türkischen Kriminalgesetzes. Doch kann man den Geltungsbereich und den Umfang des Schutzes nicht voraussehen, auch nicht, wer durch diese Klausel geschützt wird, weil ein Urteil hinsichtlich der Anwendung dieser Klausel fehlt. The Türkische Gruppe glaubt, es sei angemessen, für den Grundsatz der Rechtssicherheit auf dem nationalen Niveau ein spezifisches Gesetz für die professionelle Geheimhaltung für einen Marken- und Patentanwalt zu erlassen.

Die Türkische Gruppe glaubt, auf dem internationalen Niveau, ein einziges internationales Instrument wie dasjenige vorgeschlagen von AIPPI könnte einer nicht bindenden Empfehlung oder einer einseitigen, zweiseitigen oder mehrseitigen Lösung vorgezogen werden, da die letzte die Voraussehbarkeit des Schutzes gegen die gewaltsame Bekanntmachung kaum erhöhen würde.

RESUME

La situation concernant la protection contre la communication de divulgation forcée quant au conseil professionnel de PI dépend du titre du conseiller professionnel de PI. Le secret professionnel existe pour les avocats. Cependant la situation des mandataires de marque et de brevet quant à la protection contre la divulgation forcée reste ambiguë due à l'absence de toute législation spécifique pour le mandataire de marque et de brevet. La seule disposition disponible qui peut protéger le client contre la divulgation forcée est la disposition générale du Code Criminel Turc. Toutefois, à cause de l'absence de toute décision concernant l'application de ladite disposition, il n'est pas possible d'anticiper ce quelle va être la portée et l'étendue de la protection et qui va être protégé par cette disposition. Le group turc estime qu'il sera approprié de légiférer spécifiquement le secret professionnel pour le mandataire de marque et de brevet au niveau national afin de créer une certitude légale.

Au niveau international, le group turc estime qu'un seul instrument international tel que proposé par AIPPI doit être préférable par comparaison à la recommandation non obligatoire ou à la solution unilatérale, bilatérale ou multilatérale vue le fait que les dernières ne vont pas rendre la protection la communication de divulgation forcée plus prévisible.