

**WIPO AIPPI Conference on Client Privilege in IP professional Advice**  
22-23 May 2008

***Scope of privilege and issues in some civil law systems  
in relation to the EPO in particular***

*Anette Hegner*

***European Patent Attorney***

***Patent manager at NKT Holding A/S***

***Partner in Hegner & Partners A/S***

***Member of EPI Council***

***Vice-chair for the EPPC***

***Tutor for the European Patent  
Academy***

## Do we have client privilege in Europe?

In most European countries clients have privilege in correspondences with Attorneys at law

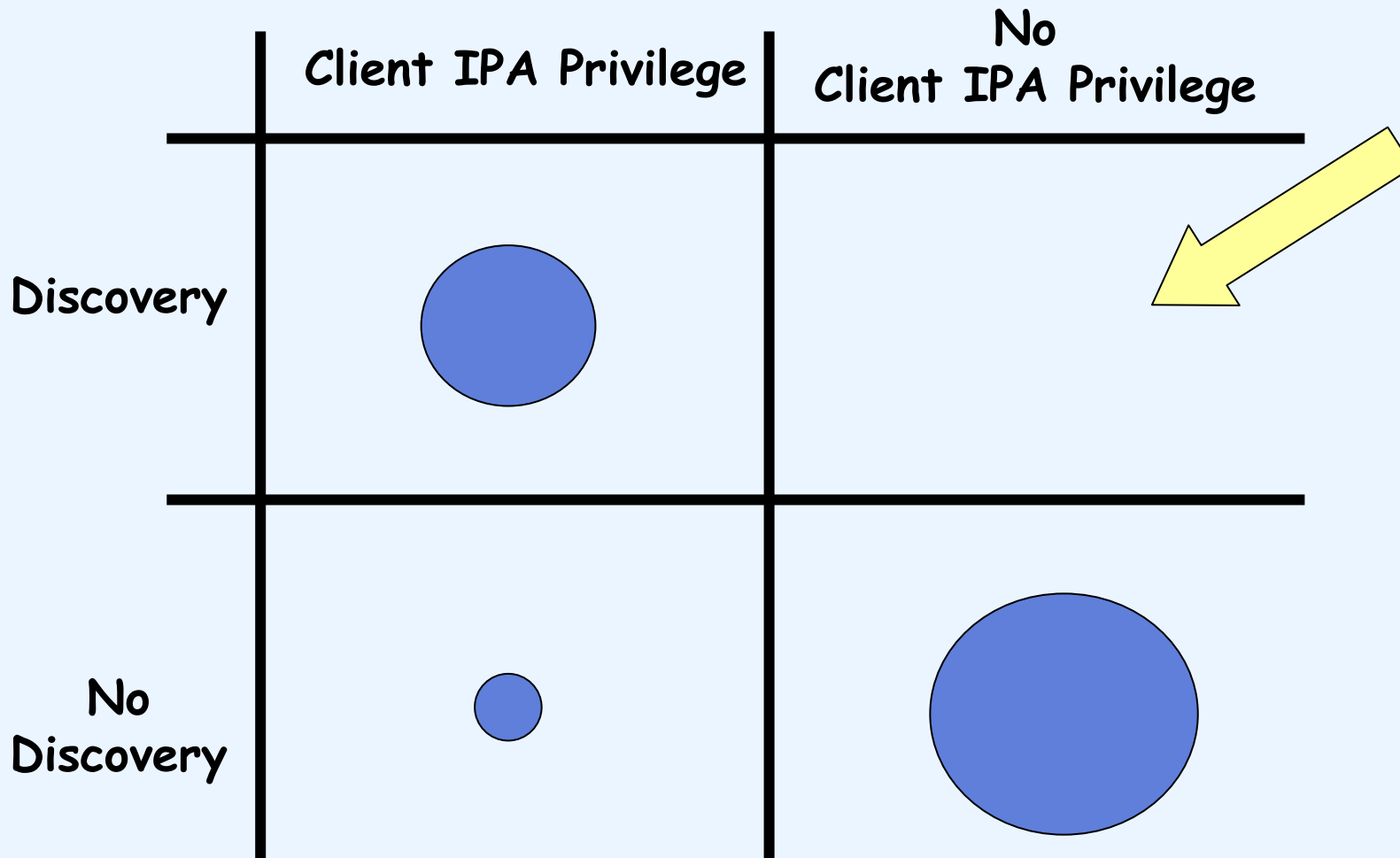


In most European countries clients have no privilege in correspondences with IP Attorneys (Patent agents)

---

Country (Examples)	Patent Attorneys (at law)	Other Patent Attorneys
GB	Yes	Yes
DE	Yes	Does not exist
Scandinavia	No	No
CH	No	No
BE	?	No
GR	Yes	Does not exist
CZ	Yes	Does not exist
ES	Yes	Yes

# Client-IP Attorney (IPA) Privilege versus Discovery



## Client-IP attorneys non-privileged communications

Clients communications with IP attorneys in European countries with no privilege for such communications will be subjected to discovery in **US**

---

US court generally respects Client-Attorney privilege for communications with foreign Attorneys – provided that similar Client-Attorney privilege exist on national level for communications with the Attorney in question

---

For example US court generally respects privilege for communications between a client and

- a UK IP attorney/agent
- a DE IP attorney

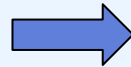
---

Communications between clients and IP attorneys from countries with no Client-IP attorney privilege are discoverable in US litigations

## The European Patent Institute (epi)

### Regulation on discipline A. 2

A professional representative shall be bound not to disclose information accepted by him in confidence in the exercise of his duties, unless he is released from this obligation.



### Bristol-Myers Squibb v. Rhône Poulenc Rorer<sup>1)</sup>

epi disciplinary rule did not confer the equivalent of the US attorney-client privilege on an EPA.

To provide that the secrecy relating to confidential communications provided under A. 2 of the Regulation on Discipline for professional representative be respected in US litigations, article 134a(1)(d) was introduced in EPC 2000

## European Patent Convention 2000

New A.134a (1)(d) provides that the Administrative Council is competent to adopt and amend provisions governing the obligation of confidentiality on the professional representative and the privilege from disclosure in proceedings **before the EPO** in respect of **communications** between him and his client or any other persons

Specific provisions are given in R. 153

## European Patent Convention 2000

### Rule 153 (1)

Where an advice is sought from an EPA in his capacity as such, all **communications** between him and his client and any other person relating to that purpose and falling under A. 2 of the Regulation on Discipline are permanently privileged from disclosure in proceedings before the EPO, unless such privilege is expressly waived by the client.

## European Patent Convention 2000

### Rule 153 (1)

Such privilege from disclosure shall apply, in particular, to any communication or document relating to:

- (a) The **assessment of the patentability** of an invention;
- (b) The **preparation or prosecution** of a European patent application ;
- (c) Any **opinion** relating to the validity, scope of protection or infringement of a **European patent or a European patent application**.



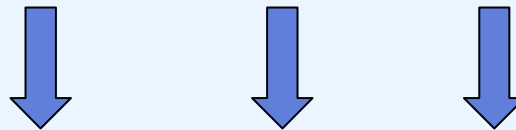
**The questions are now...**

**Will this EPA-Client Privilege be invoked in US?**

(Can the EPA-client privilege be said to be equivalent to the US constitutional Attorney-Client privilege, even though the EPA-Client privilege does not relate to disclosure before a court?)

**If so...what will be covered and under which conditions?**

**Will the fact that Rule 153(2) extend beyond Article 134(1)(d) have any effect?**



**UNCERTAINTY**

**The questions are now...**

**Will this EPA-Client Privilege be invoked in Australia?**



**Probably not so much uncertainty**



**The answer is likely: NO**

## **The AIPPI suggested minimum standards of privilege**

**Due to the uncertain and probably very limited scope of privilege in Europe any improvement will be a great step forward**

**EPI will support any initiatives to introduce suggested minimum standards of privilege**

**EPI even wish that the suggested minimum standards of privilege also explicitly include**

**opinions and analysis on/of IP matter even if no advice is connected therewith**

**and**

**communications between IP firms and client even if the correspondence does not address or is not signed by a specific IP advisor**

Thank you for **YOUR** attention

I also wish to thank **WIPO** for  
given us the opportunity to  
address the challenge of  
privilege

*Anette Hegner*