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Outcomes of litigation and needs arising in relation to client/IP professional privilege in particular countries - Australia

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Outcomes of litigation ... Australia

The nature of privilege in Australia

- ‘Privilege’ is an exception to the normal rule in legal proceedings – discovery is required of all documents and oral communications which are material and relevant to matters in issue.
- ‘Privilege’ is the right of a party in legal proceedings not to have to make disclosure in accordance with the previous point.

Outcomes of litigation … Australia

Australia – a federation of States

- First step in understanding the outcomes of litigation in Australia on privilege of clients in relation to IP advisers in Australia – Australia is a federation.
- On the establishment of the Commonwealth of Australia in 1901, States transferred the exclusive power to make law relating to patents and trade marks (among other things), to the Commonwealth.

Outcomes of litigation … Australia

Sources of law in Australia – Common law and Statute

- Second step in understanding Australia's position on privilege – the common law applies to the Commonwealth law subject to the effects of statute law made by the Commonwealth.
- The relevant effects of statutes on common law depend upon the existence of relevant common law when the statute law is made and the wording of the statute concerned.

Outcomes of litigation … Australia

Lawyers and Non-Lawyer Patent and Trade Mark Attorneys

- Potential sources of client privilege are common law and/or statute.
- Lawyers are creatures of common law and are also affected by statute.
- Patent attorneys are creatures of statute.
- Common law does not apply to them as a source of privilege.
- Look to the *Patents Act 1990* as to client privilege in dealing with patent attorneys, mutatis for the *Trade Marks Act*.

Outcomes of litigation … Australia

What does Section 200(2) of the *Patents Act 1990* stipulate?

> "(2) A communication between a registered patent attorney and the attorney's client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client."

Does this mean that clients of patent attorneys and clients of patent lawyers (solicitors) have privilege of the same scope?

No – why not?

Outcomes of litigation … Australia

***Eli Lilly Co and Others v Pfizer Ireland Pharmaceuticals* (2004) 61 IPR 292**

- Did privilege apply to documents between Pfizer and its UK patent attorneys where they were brought into existence for the dominant purpose of Pfizer being advised by its patent attorneys and where the advice was privileged under UK law.
- Answer – No.
- The patent attorneys to whom S 200(2) applies are those registered in Australia only.
- What's missing from the words – well, at least, overseas patent attorneys and third parties (like independent expert witnesses).
- This notwithstanding that, clients dealing with UK lawyers in similar circumstances, would have privilege in such communications.

Outcomes of litigation … Australia

Comparison of privilege applicable to lawyers and non-lawyer patent attorneys

Lawyers

- Under common law, client/lawyer privilege is capable of definition case by case.
- By that law, privilege extends to communications by a lawyer with third parties required to give legal advice to a client.
- By that law, privilege clearly extends to obtaining advice from a lawyer overseas in relation to a subject matter litigated in Australia.
- Thus, case by case, the boundaries of privilege are determined.
- Statute law could affect (including limiting or expanding) client privilege in relation to lawyers but there is no such law affecting overseas lawyers and third parties.

Outcomes of litigation … Australia

Comparison of privilege applicable to lawyers and non-lawyer patent attorneys

Non-lawyer patent attorneys

- Everything depends upon what the statute says.
- Arguable on the authorities that communications with third parties for searches or inquiries to be made for the purposes of communication between the patent attorney and the client, **may** be subject to privilege.

Outcomes of litigation … Australia

What do the Australian NGO's concerned with IP matters, propose in relation to the inadequacies of Section 200(2) of the *Patents Act*?

- Who are these NGO's – Law Council of Australia, Institute of Patent and Trade Mark Attorneys, FICPI Australia and AIPPI Australia.
- A new provision.
- The new provision as proposed anticipates but is not dependent upon the CPIPPA Treaty proposal made by AIPPI to WIPO in 2005.

Outcomes of litigation – Australia

The proposed Section 200(2) of the *Patents Act*.

"(2) A communication to or from, or for the purposes of providing information to, ~~between~~ a registered patent attorney or a patent attorney or patent agent of another country ~~and the attorney and the attorney's client~~ in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged as at the date at which privilege is claimed in the same way and to the same extent as a communication to or from, or for the purposes of providing information to, a legal practitioner~~between a solicitor and his or her client~~."

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