

# Conference on Client Privilege In Intellectual Property Professional Advice

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## *Intellectual Property Advisor-Client Privileged Communications: Canada and Other Jurisdictions*

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*Intellectual Property Advisor–Client  
Privileged Communications:  
Canada and Other Jurisdictions*

**Scope of Privilege and Issues in Some  
Common Law Systems**

**CANADA**

# Scope of Privilege in Canada

## The Canadian Legal System:

- 13 provinces and territories
- Provincial/Federal Court systems
- Common law system (but for Quebec)
- Broad scope of documentary/oral discovery (including inventors)
- No juries – judge only IP trials

# Scope of Privilege in Canada

The Patent/Trade-mark System:

- Federal statutory jurisdiction
- Commissioner of Patents/Registrar of Trade-marks
- Registered Patent/Trade-mark Agents

# Scope of Privilege in Canada

- Historical Perspective
- Modern Rationale:

“The *prima facie* protection for solicitor–client communications is based on the fact that the relationship and the communications between solicitor and client are essential to the effective operation of the legal system. Such communications are inextricably linked with the very system which desires the disclosure of the communication.”

[*R. v. McClure*, SCC 2001]

# Scope of Privilege in Canada

- General Forms of Privilege
  - Class:
    - Solicitor–client
    - Litigation
    - Others (*e.g.* marital communications)
  - Case–by–case:
    - The “Wigmore” test

# Scope of Privilege in Canada

- Solicitor–client Privilege:
  - Confidential legal advice given by solicitor to client
  - Client’s privilege; can only be waived by client
  - Many privilege assertions during discovery
- Litigation Privilege:
  - Communications made in respect of pending/contemplated litigation
  - “Dominant purpose” test
  - Lasts for duration of litigation

# Scope of Privilege in Canada

- Communications between Canadian non-lawyer Trade-mark Agents/Patent Agents and their clients are not privileged:

“It is clear that, in this country, the professional legal privilege does not extend to patent agents. The sole reason for that, however, is that patent agents as such are not members of the legal profession. That is why communications between them and their clients are not privileged even if those communications are made for the purpose of or giving legal advice or assistance.”

[*Lumonics*, FCA 1983]



# Scope of Privilege in Canada

- Communications between clients and Canadian lawyers working solely in their capacity as a Trade-mark Agent/ Patent Agent may not be privileged:

“In particular, the courts have held, depending on the facts before them, that privilege might not arise where the lawyer who is also a patent agent acted in his or her capacity as a patent agent.”

[*Laboratoires Servier v. Apotex Inc.*, FC 2008]

# Scope of Privilege in Canada

- Communications between clients and non-lawyer Canadian agents working in law firms may not be privileged:

“The fact that a patent agent was part of a firm that also carries on business as barristers and solicitors and as patent agents under the same name is not material...the correspondence at issue ...is directed to and from one of the patent agents rather than one of the lawyers in the firm.”

[*Whirlpool Corp. v. Camco Inc.*, FC 1997]

# Scope of Privilege in Canada

- The future:

- (i) *Chancey v. Dharmadi*, Ontario Court 2007

- Privilege for paralegals

- (ii) Intellectual Property Institute of Canada (IPIC)

- Draft legislation presented to Canadian Government proposing a self-regulated College of Patent and Trade-mark Agents.

- Would include a statutory provision pertaining to privilege

## Other Common Law Countries?

- United States
- United Kingdom
- Australia
- New Zealand

# Thank You

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