

WIPO/AIPPI Conference on
Client Privilege in Intellectual Property
Professional Advice

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

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United Kingdom

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FICPI - UK

1. England has a common law system so that in litigation we have the process of "disclosure" previously known as "discovery". "Disclosure" is generally thought to have a less wide effect. (Scotland has a different legal system. Disclosure is not automatic but must be requested, and may be more focussed than in England)
2. CPR (Civil Procedure Rules) Rule 31.6 specifies that a party to litigation should disclose:
 - a. the documents on which he relies;
 - b. the documents which
 - (1) adversely affect his own case;
 - (2) adversely affect another party's case; or
 - (3) support another party's case.
3. This is less exhaustive than before as it omits the previous requirement for documents "which may lead to a train of enquiry ..." and the underlying principle is nowadays to restrict to what is relevant and in proportion to the value and importance of the individual case. Indeed, where patent validity is concerned only communications made within the two years before and the two years after the priority date are normally required. But in general you must disclose what may be adverse to your case or help the other side.
4. When during litigation a list of documents is served it must indicate those documents of which it is claimed, as a right or a duty, that they should not be inspected by the other side, that is to say privilege is claimed at that point.
5. Other parties can challenge the claim to privilege. The Court will decide, if the parties can not agree, and may for example order that such documents should be inspected by some specific advisers only, and under a confidentiality order.
6. Two types of legal privilege are recognised.
 - a. litigation privilege which concerns documents and materials brought into being

for the purposes of litigation, that is to say documents which are communications to or from the solicitor seeking or giving legal advice in regard to existing or contemplated litigation;

- b. legal advice privilege which concerns communications between lawyers and their clients whereby legal advice is sought or given; that is to say communications between a party and its solicitors, if written by or to the solicitors in their professional capacity, for the purpose of obtaining legal advice or assistance.

Of course, many types of communication may fall into both categories.

- 7. As a general statement both types of legal privilege are enjoyed by a client in his dealings with legally qualified persons in respect of any legal matter. The system has been respected and recognised as desirable for centuries. It has, though relatively recently, also been extended to non-lawyer, IP professionals (patent and trade mark attorneys) in respect of communications relevant to their fields of professional activity. It is only registered attorneys, i.e. those on UK-IPO registers (or the European list) whose communications immediately qualify for privilege.
- 8. There are perhaps 1600 registered patent attorneys practising in the United Kingdom, that is to say people recognised by the UK-IPO as being on the Register of Patent Attorneys. These are nearly all non-lawyer IP professionals. They are almost always European Patent Attorneys as well. Further, the UK has the profession of Trade Mark Attorney, there are fewer of these but those on the Register of Trade Mark attorneys are recognised by the UK-IPO in a similar way to Patent Attorneys.
- 9. The Copyright, Design and Patents Act 1988 gives the legal basis for the registers of patent attorneys (by Section 275) and trade mark attorneys (by Section 282). These are protected titles (by Sections 276 and 282 respectively). "Patent Attorneys" means UK registered attorneys or European Patent Attorneys. European patent attorneys are free to use their title 'EPA' in UK (by Section 277). Entry to the UK registers, and the European list of patent attorneys, is by

examination.

10. The Civil Evidence Act 1968, Section 15, extended legal advice privilege to communications with patent agents (as we were then known) in connection with proceedings under the Patents Act of the time. Such communications were then privileged in civil proceedings as though made with a solicitor. This provision was replaced in 1977 by Section 104 of the Patents Act 1977 which was itself replaced from 13 August 1990 by Section 280 of the Copyright, Design and Patents Act 1988. That section remains in force and reads:

"280.—(1) This section applies to communications as to any matter relating to the protection of any invention, design, technical information, or trade mark or service mark, or as to any matter involving passing off.

(2) Any such communication—

- (a) between a person and his patent agent, or
- (b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent,

is privileged from disclosure in legal proceedings in England, Wales or Northern Ireland in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

(3) In subsection (1) "patent agent" means—

- (a) a registered patent agent or a person who is on the European list,
- (b) a partnership entitled to describe itself as a firm of patent agents or as a firm carrying on the business of a European patent attorney, or
- (c) a body corporate entitled to describe itself as a patent agent or as a company carrying on the business of a European patent attorney.

(4) It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications

extend to such communications as are mentioned in this section."

11. In summary, this Section 280 protects, in any UK legal proceedings, communications with patent attorneys (including European Patent Attorneys) arising in connection with protection of inventions etc (see sub-section 1). Section 284 grants similar privilege to communications concerning trade marks, service marks, designs and passing off with trade mark attorneys. They thus cover communications such as are routine for a patent or trade mark attorney in obtaining protective rights for an invention, trade mark etc and communications concerned with their enforcement and validity. But they do not extend privilege to communications with patent or trade mark attorneys outside those particular fields. The situation falls short of the full privilege accorded to solicitors' communications, which extends to all legal advice.
12. Section 103 of the Patents Act 1977 extends the privileges that arise in Court proceedings to proceedings before the Patent Office and "convention courts" under the EPC, CPC or PCT, while Section 105 extends privilege in Scottish proceedings to communications about patent matters.
13. It was mentioned above that UK Registered Patent Attorneys are usually European Patent Attorneys as well. As an aside I note that EPC 2000, which took effect in December 2007, established that relevant communications between a professional representative and client are privileged from disclosure in proceedings before the EPO (emphasis added).
14. Members of the patent and trade mark agent/attorney professions in UK are retained to act for clients in the preparation and prosecution of patent and trade mark applications, advising on the prospects of success and the likely scope of protection that may be obtained. They also frequently advise on the scope of third party rights, and in disputes involving patent and trade mark rights, such as in the UK-IPO for both patents and trade marks, in the European Patent Office, such as in opposition proceedings, and also in proceedings contested in Courts. They advise, also, in respect of rights existing outside the UK.

15. During drafting, filing, prosecution and post-grant questions are likely to be asked and information to be passed between the agent and the client which are very relevant to the scope of the application and resulting protection. Not only that, many cases which are prepared in the UK are subsequently filed abroad, perhaps in all parts of the world, and potentially litigated.
16. It obviously is desirable that there should be an even-handed approach throughout the world to the question of privilege in communications between the patent agent or the patent attorney and his client in circumstances of disclosure or discovery. From the UK point of view it is undesirable and potentially inefficient that work in the United Kingdom, performed in good faith on the local basis of protection by privilege might be undone or revealed by failure to apply privilege during discovery elsewhere.
17. In litigation in the UK relevant communications between a British patent or trademark attorney and a UK client are privileged from discovery. The attorney is in the same position as a legally qualified person. Likewise, if the client is foreign, communications between him and the UK attorney are privileged, whether the client is himself legally qualified or a non-lawyer IP professional or a direct corporate or individual client. This is *prima facie* the case where the communication relates to the protection of an invention, design, trademark etc.
18. English law also recognises foreign qualified lawyers on the same basis as UK qualified lawyers and extends both legal and litigation privilege (see para 6) to their communications with their clients.
19. Communications between a European Patent attorney and his client are also privileged in England on the basis of Section 280 discussed above. Communications between US Patent Attorneys and their clients are also privileged in England but in their case it is because they are legally qualified.
20. So far as the communications of non-lawyer IP professionals in other countries are concerned, these may or may not be privileged in proceedings in England. The principle of 'comity' (mutual recognition of laws) will apply. In certain countries

privilege is not granted upon discovery to the communications of UK non-lawyer agents or attorneys. This is itself a matter of concern to UK based potential litigants in those countries. As a result, too, it is not granted, upon discovery in English litigation, to the communications of non-lawyer IP professionals in those countries, which is to the disadvantage of their clients.

21. So far as litigation outside UK is concerned, in countries where there is a discovery procedure, the position of UK attorneys' communications should, at first glance, also be judged on the basis of comity. This may place UK attorneys in a stronger position than others in Europe, despite the recent change in the EPC as this is not perhaps seen as being as far-reaching as the UK law.
22. Why is privilege thought important? From the British practitioners' point of view the answer is the same as with any legal advice, namely that it is important for parties to be given good advice, and to achieve that aim they must with no hesitation give full and complete information to the advisor. Parties need to be able to fully disclose all facts in the knowledge and confidence that what they say will not go further. To give sound advice an advisor needs to be aware of all the facts. It has been recognised for hundreds of years that it is best that clients should be prudently and sensibly advised on what they should do, and that what passes between client and advisor should be kept confidential.
23. The situation was fully reviewed recently by the House of Lords in the "Three Rivers" case, 2004 UKHL 48, that is the House of Lords Opinion of November 2004. While this considers in great depth the background and history of legal advice privilege, the particular question addressed was a narrow one on where the line should be drawn as regards 'legal advice'. The conclusion was that the line should not be drawn so that the privilege is confined to telling the client only what the law is. Instead it can extend to advice on what it is sensible and prudent to do, that is to say how to act in a legal context, including what was termed "presentational" advice. This case concerned advice given to the Bank of England in connection with submissions to a public inquiry, but the teaching applies generally to legal advice and to communications with patent and trade mark attorneys.

24. There are further heads of privilege, details of which are beyond the scope of this note, which may apply to communications with patent and trade mark attorneys, e.g. privilege against self incrimination, public interest privilege and privilege afforded to "without prejudice" communications.

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