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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 - United Kingdom -

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ENGLISH LITIGATION

- England has a common law system
- In litigation we have the process of "disclosure" previously known as "discovery"

DISCLOSURE

- 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.
- In practice disclosure is limited to what is relevant and in proportion to the value of the case.

PRIVILEGE

- Privilege is claimed when the list of documents being disclosed is served. The list indicates which documents are “privileged”, that is to say they should not be inspected by the other parties.

- Other parties can challenge the claim to privilege. If agreement can not be reached, the Court will be asked to decide and make an order.

- The Court may order that certain documents should be inspected by some specific advisers only, and under a confidentiality order

TYPES OF PRIVILEGE

Two types of legal privilege are recognised.

a. litigation privilege which concerns documents and materials brought into being for the purposes of litigation.

b. legal advice privilege which concerns communications between lawyers and their clients whereby legal advice is sought or given.

NON-LAWYER IP PROFESSIONALS

- Both types of legal privilege are enjoyed by a client in his dealings with legally qualified persons in respect of any legal matter.

- They have been extended to non-lawyer, IP professionals, but it is only those on the UK-IPO registers (and European patent attorneys) whose advice qualifies for privilege and only when the advice concerns certain topics relevant to their professions.

- The UK-IPO registers are of patent attorneys and trade mark attorneys qualified by examination.

LEGISLATION

- Section 280 of the Copyright, Design and Patents Act 1988 applies to patent attorneys.

- Under this section, "- - - communications - - relating to the protection of any invention, design, technical information, or trade mark or service mark, or as to any matter involving passing off - - between a person and his patent agent - - - is privileged from disclosure in legal proceedings - - in the same way as a communication between a person and his solicitor --."

EXTENT OF PRIVILEGE

- Section 284 grants similar privilege to communications with Trade Mark Attorneys concerning trade marks, service marks, designs and passing off.
- These sections 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 on matters outside those particular fields.

EUROPEAN PATENT ATTORNEYS

- UK Registered Patent Attorneys are usually European Patent Attorneys as well. 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).

ACTIVITIES OF NON-LAWYER IP PROFESSIONALS

- Patent and trade mark attorneys 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.
- They also 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 or trade marks, and in the European Patent Office and OHIM. They advise, also, in respect of rights existing outside the UK.
- Many cases which are prepared in the UK are subsequently filed abroad, perhaps in all parts of the world, and potentially litigated.

IN PRACTICE : 1

- The UK system works well. Advice can be given on the basis of all the facts, opinions can be full and frank. Parties know that confidence will be maintained. This has for long been seen as the best approach.

- 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.

- It is of concern that material protected in the UK by privilege might be revealed by failure to apply privilege in discovery procedures elsewhere.

IN PRACTICE : 2

- In litigation in the UK relevant communications (i.e. those in the specified fields) between a client and a British patent or trade mark attorney are privileged from discovery as though the attorney were legally qualified.
- If the client is foreign, relevant communications between him and such a UK non-lawyer IP attorney are also prima facie privileged.
- English law recognises foreign qualified lawyers on the same basis as UK ones, so communications between them and their clients are privileged.
- Communications involving a European Patent Attorney and his client are also privileged in England (Section 280) as are those of US Patent Attorneys (regarded as lawyers).

IN PRACTICE : 3

- As to communications with non-lawyer IP professionals in other countries, the principle of “comity” (mutual recognition of laws) will apply.
- Certain countries do not grant privilege to communications with non-lawyer IP professionals.
- As a result, privilege is not granted in English litigation to communications between those non-lawyer IP professionals in those countries and their clients. Their clients are disadvantaged as a result, and the attorneys hampered in their duties.

RESULT

- Relevant communications with UK registered non-lawyer IP professionals are privileged from discovery in English litigation,

but

- the same communications with UK professionals may not be privileged in equivalent litigation elsewhere,

and

- communications of non-lawyer IP professionals in other countries, if not privileged in their own countries, may not be privileged in UK litigation.

The End

Thank You

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