



PATENT ATTORNEY PRIVILEGE IN NEW ZEALAND

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Context

- The New Zealand Evidence Act 2006 came into force on 1 August 2007.
- Protects communications between registered patent attorneys and their clients (also known as “patent attorney privilege”).
- Reformed the former Evidence Amendment Act (No. 2) 1980.

- Part of a wider review of the New Zealand Patent Attorney profession and the Patents Act itself.
- The majority of the Patent Attorney profession in New Zealand are also lawyers. Effect mainly on non-lawyer Patent Attorneys.
- Non-lawyer Patent Attorneys will include those Australian Patent Attorneys who are also registered in New Zealand. The majority of the Australian profession not being lawyers.

Evidence Amendment Act (No. 2) 1980 – Patent Attorney Privilege

- Privilege only in relation to information or advice relating to any patent, design, or trade mark, or to any application in respect of a patent, design, or trade mark, whether or not the information or advice related to a question of law.
- Critical omission - absence of privilege attaching to copyright related advice.
- No reference to extension to overseas Patent Attorneys.

The Evidence Act 2006 – Patent Attorney Privilege

- Privilege may be claimed for communications with "legal advisers".
- "Legal Advisers" includes lawyers, registered patent attorneys, or overseas practitioners whose functions wholly or partly correspond to those of a registered patent attorney, and their client, in respect of communications relating to the obtaining or giving of information or advice concerning "intellectual property".

“Intellectual property” is defined as one or more of the following matters:

(a) literary, artistic, and scientific works, and copyright;

(b) performances of performing artists, phonograms, and broadcasts;

(c) inventions in all fields of human endeavour;

(d) scientific discoveries;

(e) geographical indications;

(f) patents, plant varieties, registered designs, registered and unregistered trade marks, service marks, commercial names and designations, and industrial designs;

(g) protection against unfair competition;

- (h) circuit layouts and semi-conductor chip products;
- (i) confidential information;
- (j) all other rights resulting from intellectual activity in the industrial, scientific, literary, or artistic fields.

- Therefore, communications between patent attorneys and their clients concerning patents, trade marks, copyright, performing artists' rights, unfair competition, and commercial rights now all attract privilege.
- It appears that (j) is intended to protect communications which are not otherwise specifically listed such as regulatory compliance matters.

- New Zealand patent attorney privilege is now specifically intended to protect communications generated offshore by overseas patent attorneys and their clients.
- Overseas practitioners include admitted Australian barristers and solicitors, Australian registered patent attorneys and registered trade mark attorneys and any overseas practitioners who are in a country specified by an Order in Council.
- Privilege may attach to such communications if the overseas practitioner's function wholly or partly corresponds to those of a registered patent attorney.
- Not reliant on reciprocal privilege rights being offered to New Zealand Patent Attorneys.

Privilege for Preparatory Materials for Proceedings

- Patent Attorney privilege can also be claimed for communication or information made, received, compiled, or prepared for the dominant purpose of preparing for a proceeding or an apprehended proceeding.

Privilege can be claimed for:

- (a) communication between the party and any other person;
- (b) communication between the party's legal adviser and any other person;
- (c) information compiled by the party or the party's legal adviser;
- (d) information compiled at the request of the party, or the party's legal adviser, by any other person.

- "legal adviser" - includes lawyers, registered patent attorneys or overseas practitioners.
- "proceeding" - refers to proceedings before New Zealand courts and therefore patent attorney privilege extends to communications and information in relation to court proceedings.

- Registered patent attorneys (who may not also be lawyers) in New Zealand regularly advise and directly brief barristers in relation to infringement and revocation proceedings before the New Zealand courts. Confirmation of the right to claim privilege in relation to such proceedings is clearly welcome.
- Patent Attorneys cannot appear before the New Zealand Courts.

ISSUES

Overseas Practitioners?

- Privilege extends to overseas practitioners in a country specified in an Order in Council.
- To date no countries have been specified in an Order in Council.
- Therefore - no privilege attaches to the communications of overseas practitioners (aside from Australian practitioners) with their clients.

- This is currently being addressed by officials in the Ministry of Justice and it is expected that a suitable Order in Council will issue shortly.
- The Ministry of Justice has not confirmed the criteria for selecting countries
- Retrospective?
- It will be a question of fact as to whether an overseas practitioner's function wholly or partly corresponds with those of a registered patent attorney in New Zealand.
- Registered Trademark attorneys/agents may be included as Australian registered Trademark attorneys are specifically referred to.

Pre and Post Grant Oppositions before the Intellectual Property Office of New Zealand (IPONZ)

- The definition of "proceeding" is restricted to New Zealand courts
- "proceeding" does not include tribunals, such as the Intellectual Property Office of New Zealand (IPONZ) Hearings Office
- New Zealand allows both pre-and post-grant oppositions before IPONZ

- Patent attorney privilege may not extend to oppositions before IPONZ (this will affect lawyers as well as registered patent attorneys).

CONCLUSION

- The majority of registered patent attorneys resident in New Zealand are also legally qualified as barristers and solicitors.
- The changes to patent attorney privilege will likely have little effect on most members of the New Zealand profession as most have been able to rely on legal professional privilege – this may be dependent on whether privilege extends to opposition proceedings before IPONZ.

- For those patent attorneys who are not also lawyers, the extended privilege provisions will be welcomed.
- The majority of Australian registered patent attorneys are not legally qualified and thus the extension of privilege is more meaningful.
- The extension of privilege to overseas practitioners is an issue that urgently needs to be addressed.

- Privilege Treaty?
- This may assist in providing direction as to which countries should have patent attorney privilege extended to them.