



## **Conference on Client Privilege in Intellectual Property Professional Advice**

**Organized by WIPO in cooperation with AIPPI  
Needs in Relation to Client/IP Professional Privilege in  
Canada**

**Outline of Canadian Efforts to Achieve Statutory Agent  
Privilege— Linkage Between Regulatory Scheme and  
Statutory Privilege**

**Joan M. Van Zant  
Ogilvy Renault LLP/Swabey Ogilvy Renault**

**Geneva, Switzerland  
May 22 & 23, 2008**

# Canadian Jurisprudence and Privilege



**Confidential communications with clients of non-lawyer agents are not considered to be privileged by Canadian Courts**

**Uncertainty if lawyer agent – client confidential communications are considered to be privileged by Canadian Courts**

**Information found in files of a non-lawyer patent agent have been found by a Canadian Court to affect damages awarded**

**Canadian Courts are not prepared to recognise statutory privilege for agents in other jurisdictions because there is no equivalent privilege in Canada**

## Efforts to Persuade the Canadian Government to legislate Privilege for Agents



- Intellectual Property Institute of Canada (IPIC) has led efforts for over ten years, with support from FICPI and AIPPI
- IP Lawyers were initially opposed
  - Non-lawyer agents were not properly educated
  - No accountability in regulatory structure
- IPIC commissioned *Report By Gavin Mackenzie On The Regulation Of Patent And Trade-Mark Agents (September 1999)*
- MacKenzie stated “*current regulatory regime is seriously flawed*”

# Current Regulatory Regime for Canadian Patent and Trade-mark Agents



- Patent Agents governed by Sections 12, 15 and 16 of the Canadian *Patent Act* and Sections 12 to 19 of the *Patent Rules*
- Trade-mark Agents governed by Section 28 of the *Trade-marks Act* and sections 18 to 23 of the *Trade-mark Rules*
- Section 16 of the *Patent Act* allows the Commissioner of Patents “for gross misconduct or any other cause that he may deem sufficient” to remove a patent agent from the register of patent agents
- No provision relating to the conduct of trade-mark agents at all

# What else is missing?

- No guidelines as to how agents should conduct themselves
- No indication of how the public can make complaints about agents
- No provision for discipline, but removal from the register if a complaint is made
- Nothing precludes an agent who has been removed from the register from practicing, except that he cannot correspond with the Canadian Intellectual Property Office (CIPO)
- No provisions to deal with unauthorized practice



## IPIC's Modernization

- IPIC, in existence since 1926
- Modern code of ethics and adherence to highest professional standards
- Education at all levels to its members
- Liaises with Canadian Government and internationally with other government and professional organizations
- Works with CIPO to set and mark exams for agents
- Expulsion from IPIC for gross misconduct
- But IPIC is a voluntary organization and cannot stop its members or others from practicing



# Mackenzie's View of Potential of Achieving Privilege for Agents

- Opposition in some quarters from two sources
  - First source
    - Shortcomings of regulatory regime for agents
    - Agents have little or no training in professional responsibility
    - Agents not subject to a code of professional conduct that is capable of effective enforcement





# Mackenzie's View of Privilege for Agents Cont'd



- Second source of opposition
  - With extension of privilege to agents, government would embark upon a slippery slope that may well have the effect of diluting privilege generally
  - Government would have to acknowledge the legitimacy of claims for similar treatment of other professional groups such as accountants, customs agents and immigration consultants
  - MacKenzie was concerned about a privilege backlash being created



# Would Regulatory Regime Cure the Problems?

- MacKenzie thought that it might or might not be possible to obtain privilege if a suitable regulatory regime were put in place, but without it, privilege was impossible
- MacKenzie advocated for the current regulatory regime to be replaced regardless



## IPIC's Response

- Modernize IP Practice in Canada and work towards a regulated profession
- Purpose was to protect the public and IP owners
- National college for agents to regulate the profession
- Modern code of ethics
- Compulsory professional insurance
- Continuing education
- Regulations concerning handling of client trust funds
- A client indemnity fund
- An effective and transparent disciplinary process
- Prepared draft federal legislation for the creation and operation of the national college



# IPIC's Consultations, Strategies and Challenges



- Major stakeholders including all types of IP owners, business and professional organizations and users of the IP system
- Lawyers' provincial and national regulatory bodies
- Adoption of “Soft” Privilege language
  - “prohibition against forced disclosure of confidential client-agent communications”
- Attitude of Canadian general legal community has not changed
- Government would only consider non-controversial legislation, if any

## Questions to be answered

1. Is a voluntary organization such as IPIC appropriate for the regulation of patent and trademark agents who have statutory privilege or must the proposed college or some equivalent structure be put in place?
  - What would the minimum standards be for such an organization?
  - Could membership in IPIC re a requirement for registered agents?



## Questions to be answered



2. Has there been any erosion of or negative impact on solicitor client privilege in the broader sense in those countries where statutory privilege for patent and trademark attorneys or agents is in existence?

## Questions to be answered



3. Has the agent or attorney privilege led to any other professions seeking similar legislation in such countries?

# Evolution of the Initiative

## Change in Attitudes

- Lawyer agents who initially opposed have recognized the value of a college and privilege for all agents
- More robust regulatory environment is good for everyone
- Seen as an important part of a modern IP Infrastructure
- Harmonization very important for the global economy for IPR's to receive more uniform treatment





# Privilege is needed in Canada

- Jurisprudence will not create legal basis for agent privilege or recognition of foreign agent privilege
- Profession is small
- IP Professionals in high demand and even shortages in some technical areas
- Treaty would be of great assistance to achieve goals





**THANK YOU!**

[www.ogilvyrenault.com](http://www.ogilvyrenault.com)