

A I P P I



Conference on Client Privilege in Intellectual Property Professional Advice

“Definition and Overview of the Issue”

Geneva - May 22 and 23, 2008

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Who and what is AIPPI ?

- ▶ The world's leading non-governmental organisation dedicated to the development and the improvement of intellectual property systems
- ▶ non-profit and politically neutral
- ▶ represents more than 8000 members in over 100 countries
- ▶ comparative law studies with the National and Regional Groups
- ▶ proposals for improvement of IP systems by way of Resolutions

Why does AIPPI care about client privilege ?

- ▶ IP systems are only as good as the means to protect their users
- ▶ IP advisors are essential
- ▶ Free flow of information between clients and IP advisors
- ▶ Benefits for IP systems as a whole

Role of WIPO

- ▶ International Forum
- ▶ Brings together expertise and political will to improve the systems
- ▶ Education for decision makers and lawmakers
- ▶ Preparation of International Treaty

What is this seminar about ?

CPIPPA

Client **P**rivilege In
Intellectual **P**roperty
Professional
Advice



Where are we ?

Current status and outlook into the future

- ▶ Interests
- ▶ Needs
- ▶ Deficiencies
- ▶ Solutions



Interests

Is this a private or a public interest?

Answer: Privilege is in the interest of private entities (clients) and of the public

Private: Best advice possible for the IP owner

Public: Best advice possible for the IP owner

??? Why is that so ???



Needs

Who is “in need” and what are the needs ?

Clients need IP advice and the best advice wherever they are and from one country to the other (compare and challenge)

Public needs to support the clients in obtaining the best advice as a result of the economic needs of technology transfer and trade (check and balance)

Needs are irresistible !



Are these needs fulfilled ?

NO!

WHY NOT?

Internally: much room for improvement

Externally: almost no solution existent

What are the deficiencies ?

Internally:

Privilege needs to be expanded beyond lawyers/attorneys

“Attorney-client” privilege is too narrow and limiting

Advice needs to come from non-lawyer advisers and third party experts (need to be properly advised)

many countries are recognizing this need, but insufficient progress

What are the deficiencies ? (cont'd)

Externally:

Privilege needs to be acknowledged and recognized

Lack of recognition of confidentiality and privilege as applied to non-lawyer IP advisers and third party experts in relation to IP advice in another country

Unacceptable gaps between countries over the border

Why are these deficits hazardous ?

Technology transfer and trade are dependent on well-functioning IP systems

Limiting the privilege limits the possibility to obtain the best advice needed

Insufficient advice leads to lack of quality of IP (loss of the whole picture)

Quality of IP is key for the acceptance of IP and IP systems in general and for their economic benefits for the countries offering those IP systems



Solutions ?

The problem is obvious and objectively incontestable

The need for a common solution is not controversial

Solutions need to address internal and external issues

Internal: minimum standards for recognition and application of confidentiality and privilege in relation to IP advice

External: respect such advice when transferred from one country to another in that country as confidential and privileged as well

Which is the right way?

CPIPPA

Client

Privilege

in

Intellectual

Property

Professional

Advice

What is “Privilege” ?

- ▶ Right of a person not to have to disclose information which would otherwise have been required
- ▶ Court rules or provisions of law may require production of certain documents or statements (depositions, testimony etc.)
- ▶ **Privilege** allows the person to keep documents secret and to be silent on certain issues
- ▶ Covers confidential communications between the clients and the advisor with regard to certain questions and issues related to the specific case

Who enjoys “Privilege”?

- ▶ Privilege of the clients as a party to a lawsuit or legal action
- ▶ **Not** the privilege of the attorney, counsel, advisor or the court
- ▶ Where privilege applies, only the client can waive it



Specific issues in IP matters

- ▶ Patent and trademark matters
 - ▶ Legal and technical questions
 - ▶ Lawyers and other IP advisers

Critical situations for “Privilege”

- ▶ IP is global despite the territoriality of the IP rights
- ▶ Advice is sought in various jurisdictions regarding the same IPR
- ▶ Law suit in one jurisdiction has effect on advice given in another jurisdiction

Issues in various jurisdictions

- ▶ Common law vs. civil law
- ▶ Acknowledgement of foreign privilege
- ▶ Which communications are covered?
- ▶ Qualification of the IP advisor

In-house counsel issues

- ▶ Who is the client?
- ▶ Does the in-house counsel qualify as the lawyer or IP adviser under the concept of “attorney-client privilege”?
- ▶ If not, what are the reasons given?

Work of AIPPI Special Committee Q163

- ▶ Set up in 2001
- ▶ Questionnaire May 2002
- ▶ Reports in 2002 (ExCo Lisbon) and 2003 (ExCo Lucerne)
- ▶ Resolution in 2003 (ExCo Lucerne)
- ▶ Submission to WIPO 2005

Resolution

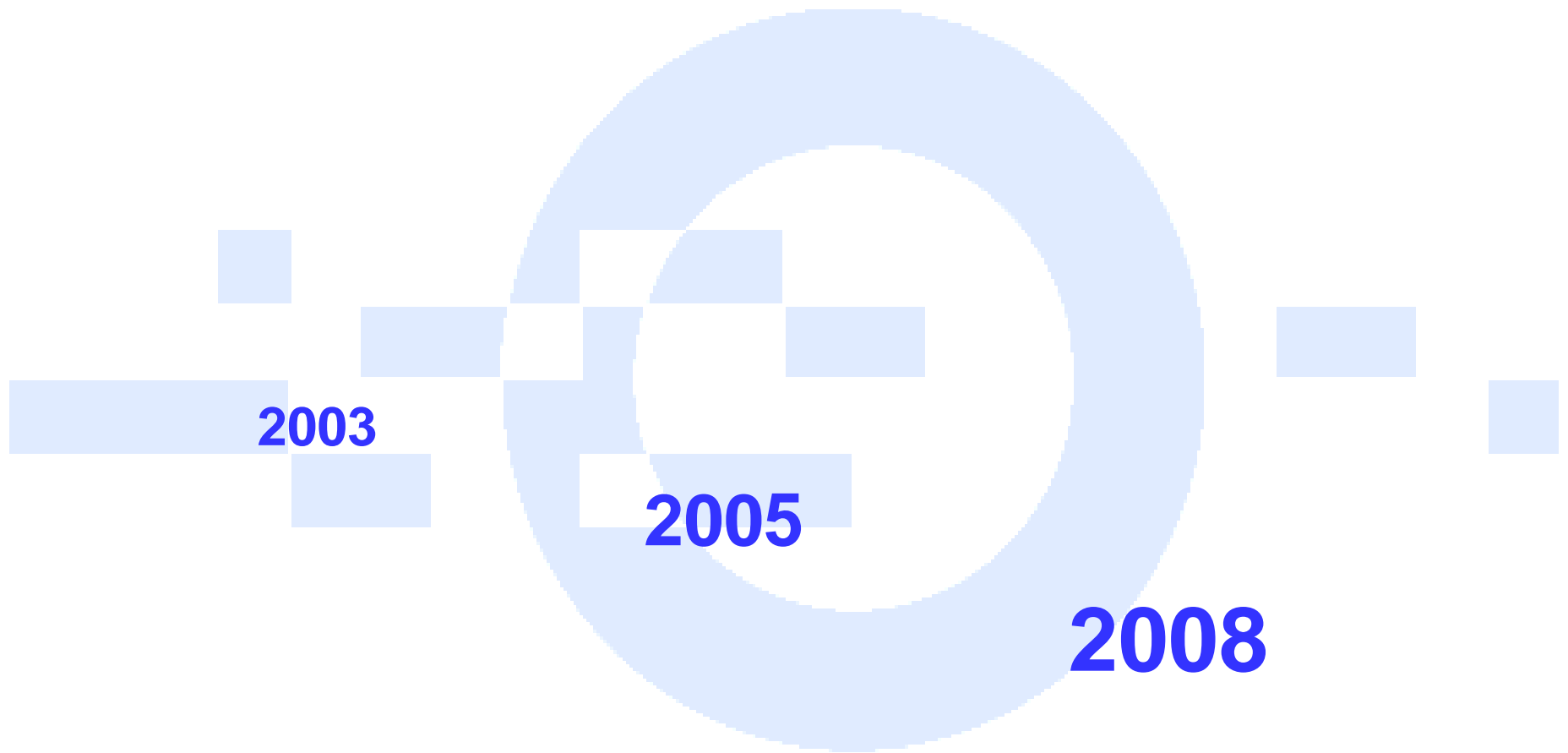
(ExCo Lucerne 2003)

“AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize that the protections and obligations of the attorney-client-privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.”

Submission

(to WIPO in 2005)

“AIPPI submits that the making (including subsequent implementation) of a treaty prescribing minimum standards of privilege which are to apply to communications relating to advice given by IP advisers, is required. The protection of privilege in one country must be extended by that country to an IP adviser in any other country.”



What now?

Solutions or proposals

- ▶ Develop and harmonize national legislation
- ▶ Set minimum standards for the expansion of privilege to IP advisors who are not lawyers
- ▶ Accept foreign privilege as equal with own national privilege

Purpose of the seminar with WIPO

- ▶ Use Forum
- ▶ Explain the problems and issues at stake
- ▶ Exchange views and reach a common understanding
- ▶ Develop ideas and proposals for solutions
- ▶ Explore and pave the way for those ideas and proposals

THANK YOU!

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