

# Conference on Client Privilege In Intellectual Property Professional Advice

WIPO Headquarters  
Geneva, Switzerland  
May 22 and 23, 2008

## *Intellectual Property Advisor-Client Privileged Communications: Canada and Other Jurisdictions*

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*Intellectual Property Advisor–Client  
Privileged Communications:  
Canada and Other Jurisdictions*

**Pitfalls and Obstacles for Clients in  
Multiple Jurisdictions**

# Pitfalls for Clients

- Primary Concern:

Potential forced disclosures of communications and related documents during litigation and potential for adverse effects on legal position.

- Modern IP Reality:

- (i) Multi-jurisdictional rights;
- (ii) Multi-jurisdictional litigation;
- (iii) Non-harmonized, jurisdictional approaches to issue of privilege.

- Therefore imperative that IP Owners/IP Advisors be:

- (i) Aware of jurisdictional approaches to issue of privilege;
- (ii) Aware of legal processes in jurisdictions of interest;
- (iii) Aware of possible adverse effects of forced disclosure

# Pitfalls for Clients

## A. Examples of Jurisdictional Approaches to Privilege

(i) Australia

(ii) United States

(iii) Canada

- No privilege for domestic agent/client communications
- No privilege for foreign agent/client communications

# Pitfalls for Clients

- Canada and Foreign Agents:

“The law in this country does not recognize this [the U.K.] patent agent–client privilege and there is no reason to create such a privilege on an *ad hoc* basis...

Judicial comity between countries does not require Canada to recognize a privilege not established in Canada...

Pfizer chose to market their products in Canada and therefore take both the benefits and burdens of the Canadian legal regime when they sue or are sued in this country.”

[*Lilly Icos v. Pfizer*, FC 2006]

# Pitfalls for Clients

## B. Legal Processes in Jurisdictions of Interest

- Documentary/oral discovery?
- Scope of Discovery?
  - Agent's files relevant?
- Letters rogatory?

# Pitfalls for Clients

## C. Potential Adverse Results

### (i) Validity Attacks:

- Admissions regarding anticipation (novelty) / obviousness (inventive step) – e.g. prior art and prior disclosures.
- Duty of good faith (duty of candor)
- Broader than invention made
- Insufficient disclosure
- Utility and sound prediction

### (ii) Allegations of Infringement

- E.g. United States: willful infringement; treble damages; punitive damages

# Pitfalls for Clients

## (iii) Equitable Remedies and “clean hands”

- Permanent Injunction
- Accounting of Profits
- Delivery Up Order

## (iii) Legal Costs

- *Stamicarbon v. Urea Casale*, FC 2002  
Solicitor and client costs



# Pitfalls for Clients

## D. Conclusion

- Potential mine field of problems/adverse results.
- Imperative to be aware of multi-jurisdictional differences in approach to privilege.
- Imperative to be aware of multi-jurisdictional differences on discovery obligations/requirements.

# Thank You

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