

WIPO Standing Committee on the Law of Patents (SCP)  
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Seminar on the Confidentiality of Advice from Patent Advisors

Patent Advisors' Perspectives

AIPPI, AIPLA, FICPI

November 5, 2014  
Geneva



# Protection of Confidentiality in IP Advice

## Summary of National Positions: The Way Forward

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Geneva, Switzerland

# Summary

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## **The Issue:**

Protecting confidential client-IP advisor communications from forced disclosure on a global scale

## **The Problem:**

- Lack of coverage domestically in certain countries
- Lack of coverage in cross-border scenarios

# Common Law Countries

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- **Attorney-client privilege** between clients and lawyers
  - Does not apply to facts (e.g. prior art)
- **Litigation privilege** for all communications relating to contemplated/actual litigation (even with third parties such as non-lawyer IP professionals)
  - Dominant purpose
  - Time limited
- Relevant because of scope of discovery

# Common Law Countries

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- **Issues/Uncertainties:**
  - No common law protection for communications with non-lawyer IP professionals
  - No protection for lawyers acting in non-legal adviser capacity (e.g. as an agent)
- **Special statutory privilege** between clients and non-lawyer IP professionals in some countries:
  - Australia , New Zealand (domestic and foreign non-lawyer patent attorneys)
  - United Kingdom (domestic non-lawyer patent attorneys)

# Common Law Countries

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- **Problems/uncertainties remain**
  - **E.g. Canada:** provides no protection for communications with non-lawyer IP professionals (including lawyers acting in capacity other than as lawyer), and no protection for communications with foreign non-lawyer IP professionals
  - **U.S. :** no single approach to domestic and foreign non-lawyer agent/attorney communications
  - **Other jurisdictions:** status of protection of foreign communications uncertain (other than Australia/N.Z.)

# Civil Law Countries

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- **Professional secrecy obligation** on lawyers and/or patent attorneys preventing the disclosure of confidential information to third parties
- Typically **no attorney-client privilege** *per se*
- However, discovery obligations are not the same as those found in common law countries

# Civil Law Countries

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- **Special statutory professional secrecy obligation** for non-lawyer IP/patent professionals akin to privilege exist in some jurisdictions:
  - E.g. Germany, Switzerland, Sweden, France, Japan
  - U.S. courts have upheld such “privilege”: e.g. Japan, France
- In some cases, combination of professional secrecy obligations and a right to refuse to disclose information/documentation



# Civil Law Countries

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- **Problems/uncertainties remain**
  - **Foreign communications:** Status is uncertain in many jurisdictions

# European Patent Convention

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- **Rule 153:**
  - Advice from “professional representatives” to client are **privileged** from disclosure in proceedings before European Patent Office

# European Unified Patent Court (UPC)

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- **Proposed Rule 287:**
  - Advice from lawyers and non-lawyer patent attorneys are **privileged** from disclosure in proceedings before UPC

# In-house Counsel

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- In common law countries, privilege attaches if counsel is acting in his/her capacity as a lawyer
- In many civil law countries, there is generally no protection

# Recognition of Foreign Privilege?

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- May depend on qualifications of foreign IP professional
  - E.g. May require foreign professional to be a lawyer
- May depend on nature of advice (e.g. is lawyer qualified to give advice?)
- May be protected in some civil law countries based on respect of foreign professional secrecy obligations
- May depend on the doctrine of comity (civil and common law countries)
- May depend on status of communication in foreign jurisdiction (U.S. approach in some cases – “choice of law”)

# AIPPI/FICPI/AIPLA

## June 2013 Paris Colloquium

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- **AIPPI/FICPI/AIPLA Colloquium** on the Protection of Confidentiality in IP Advice
- **Goal:** To assist governments to develop model framework for international protection of confidentiality in IP professional advice
- **Attendees: Government representatives** (e.g. Australia, Germany, Japan, Switzerland, U.S., Canada, Denmark and Norway); **practitioners** from around the world
- **Result:** AIPPI/FICPI/AIPLA Joint Proposal for multilateral agreement

# AIPPI/FICPI/AIPLA Joint Proposal

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- Functional approach
- Not based on an explicit privilege being created
- No distinction between common law/civil law countries
- Proposal is simple in nature:
  - The protection
  - What communications are covered
  - With whom (definition of IP advisor)
  - Permits exceptions

# AIPPI/FICPI/AIPLA Joint Proposal

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## The Definition Clauses:

**intellectual property advisor** means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person, where such advisor is officially recognized as eligible to give professional advice concerning intellectual property rights

**communication** includes any oral, written, or electronic record

**professional advice** means information relating to and including the subjective or analytic views or opinions of an intellectual property advisor but not facts ... (for example, the existence of relevant prior art)



# AIPPI/FICPI/AIPLA Joint Proposal

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## The Operative Clauses – The Protection

2. Subject to the following clause, a communication made for the purpose of, or in relation to, an intellectual property advisor providing professional advice on or relating to intellectual property rights to a client, **shall be confidential to the client and shall be protected from disclosure to third parties**, unless it is or has been made public with the authority of that client.

[Emphasis added]

# AIPPI/FICPI/AIPLA Joint Proposal

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## The Operative Clauses - Exceptions

**3. Jurisdictions may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in clause 2** provided that such limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of clause 2 having due regard to the need to support the public and private interests described in the recitals to this Agreement which the effect of the provision in clause 2 is intended to support, and the need which clients have for the protection to apply with certainty.



# Thank You

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