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CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS: COMPILATION OF LAWS, PRACTICES AND OTHER INFORMATION

Document prepared by the Secretariat

EXECUTIVE SUMMARY

1. Pursuant to the decisions of the Standing Committee on the Law of Patents (SCP) at its twenty-eighth session, held in Geneva from July 9 to 12, 2018, document SCP/29/5 is an updated version of document SCP/20/9 (Confidentiality of Communications between Clients and Their Patent Advisors: Compilation of Laws, Practices and Other Information). The update is primarily based on the information collected from the activities of the Committee between its twentieth and twenty-ninth sessions. The compilation of information does not imply any recommendation or guide for Member States to adopt any particular mechanism contained in document SCP/29/5.

2. Background: It is often the case that an applicant mandates a local patent advisor in his country of origin to assist preparation and prosecution of a patent application according to the national rules and practices. In the course of protecting his/her invention at the international level, the applicant further files corresponding patent applications abroad by engaging foreign patent advisors in different overseas countries, and patents may be issued. In some of those overseas countries, when the applicant (or patentee) or a third party becomes a party to patent litigation, courts may order a party to disclose documents containing confidential communication between the party and his/her patent advisor, including that of his/her local patent advisor in his/her country of origin. This may happen, for example, in the course of "discovery" proceedings during patent litigation in common law countries. While the party might be protected by the rules and practices on the confidentiality of communications with his/her patent advisor in his/her country of origin, such confidentiality relationship might not be recognized and protected in foreign countries where litigations take place.

3. In general, when a client seeks an opinion from a qualified lawyer, communications between the lawyer and his client are accorded the privilege of not being required to be disclosed in a court of law or those communications are protected from public disclosure by a secrecy obligation. The purpose of preserving the confidentiality of such communications is to encourage those who seek advice and those who provide advice to be fully transparent and honest in the process. Those who seek advice should provide the advisor with all the information that could be relevant to obtain the best advice, including the aspects which may run counter to his position. On the other hand, the advisor should be able to be completely frank. Therefore, in order to ensure a high quality of legal advice, the exchange of instructions and advice should not be restricted due to the fear of disclosure of their communications.

4. In general, patent attorneys are not only technical experts filing patent applications, but are also patent law experts providing legal advice related to patent prosecution and litigation. With the understanding that clients should be able to have frank and open communication with their patent attorneys, some countries also protect confidential advice of patent attorneys from forcible disclosure, regardless of whether they are qualified lawyers or not. However, some other countries do not provide for such a mechanism or do not have any specific rules on that issue. Even if the confidentiality of patent attorney's advice is preserved, the scope of communications covered as well as the extent to which an overseas patent attorney's advice is covered are different from one country to another. Consequently, although the confidentiality of communications between patent advisors and their clients may be maintained in their home country, there is a risk of forcible disclosure of such communications in another jurisdiction during the discovery or similar proceedings.

5. International framework: The preservation of confidentiality of communications between patent advisors and their clients is not expressly regulated by any international intellectual property (IP) treaty. However, the provisions of the Paris Convention for the Protection of Industrial Property (Paris Convention), the Agreement on Trade-Related

Aspects of Intellectual Property Rights (TRIPS Agreement) and the General Agreement on Trade in Services (GATS) of the World Trade Organization (WTO) have some relevance to the issue at stake. With regard to the Paris Convention, the issue appears to fall under the permissible exceptions to the general rule of the national treatment, although the Paris Convention does not prevent its Contracting Parties from according the same treatment between national and foreign patent advisors. The TRIPS Agreement, similar to the Paris Convention, does not directly refer to the issue, but contains both rules on the production of evidence which lies in the control of the opposing party, and on the protection of confidential information (see Article 43). The issues of preservation of confidentiality in connection with judicial proceedings appear to be outside the scope of GATS.

6. Different approaches at the national level: Annex III, of document SCP/29/5, provides a compilation of national laws and practices regarding the scope of client–attorney privilege and its applicability to patent advisors in 56 countries (including both common law countries and civil law countries) and three regional frameworks. On the national aspects of the preservation of confidentiality of communications with patent advisors, wherever possible, it reviews the national laws with respect to the following elements: (i) the origin of the privilege and/or secrecy obligation; (ii) professionals bound by the privilege and/or secrecy; (iii) the scope of the privilege/secrecy obligation; (iv) exceptions and limitations to the privilege/secrecy obligation; (v) penalties for breach of secrecy; and (vi) qualifications of patent advisors. Further, in connection with civil law countries, the information as to how professional secrecy obligation interacts with a duty to testify or to produce evidential documents during court proceedings may be provided. On the cross-border aspects, information regarding the recognition of confidentiality of communications with foreign patent advisors is also gathered.

7. Most countries impose confidentiality obligations on patent advisors either under national legislations, under codes of conduct set by professional associations or pursuant to governmental regulations. In general, the duty of confidentiality requires patent advisors not to disclose any information in relation to their advice, obtained in the course of exercising their professional duties. However, there are a few countries where such obligation does not exist. For the issue of how and to what extent confidential communications with patent advisors are preserved from public disclosure, it is important to take into account the particularities of court proceedings in common law and civil law countries.

8. In common law countries, the issues at stake inherently relate to a specific privilege in court proceedings with regard to discovery.

(i) Some common law countries recognize privilege in respect of communications between non-lawyer patent advisors and their clients, similar to the client-attorney privilege.

(ii) However, in some other common law countries, communications between non-lawyer patent advisors and their clients are not privileged.

9. In civil law countries, the issue is addressed by a professional secrecy obligation. The breach of confidentiality may lead to criminal prosecution, and is generally subject to a severe sanction.

(i) In some civil law countries, the right to refuse to testify in court on a matter covered by the professional secrecy obligation and/or to produce documents that contain information covered by the professional secrecy obligation is not applicable to non-lawyer patent advisors.

(ii) However, in some civil law countries, civil and/or criminal procedure law provide that, in principle, communications with non-lawyer patent advisors are also protected from disclosure during court procedures.

10. In addition, there are also differences and uncertainty in national laws with respect to the confidentiality of advice given by overseas patent advisors and how to treat advice from in-house patent advisors. In some countries, communications with any eligible patent advisors acting within the authorized scope of their professional duties, whether domestic or foreign, are protected from disclosure in proceedings before an administrative tribunal/appeal board.

11. Approaches to cross-border aspects: Most countries do not provide specific laws and rules dealing with cross-border aspects of the confidentiality of communications between clients and foreign patent advisors.

(i) Among the countries where the confidentiality of communications with national patent advisors is granted at the national level, there are some where the confidentiality of communications with foreign patent advisors is not recognized due to the fact that, for example, they are not registered under the respective national law or are not admitted to the bar.

(ii) However, in a few countries, statutory law provides that communications with foreign patent advisors, even if they are non-lawyers, are also protected from forcible disclosure. In some other countries, courts may recognize the privileged nature of such communications under the choice of law rule.

(iii) In most civil law countries, there is very little practical experience with cross-border aspects of confidentiality of communications between clients and patent advisors, since there are no or very limited proceedings which might force disclosure of confidential advice. However, the patent advisors in those civil law countries could be subject to a cross-border discovery in some common law countries, even if the protection of confidentiality is provided by their home country. In some civil law countries, statutory law has been amended to provide that patent advisors (including non-lawyer patent advisors) are, in principle, entitled to refuse to testify on any matter falling under the professional secrecy obligation, and/or production of any document containing such matter can be refused, in court proceedings. Such amendment appears to be motivated by an expectation that it would facilitate the recognition of the privilege in the courts of certain common law countries.

12. Issues addressed at the national and international levels: Based on the information gathered in Annex III, of document SCP/29/5, and the discussions held at the SCP, the document contains further elaboration on a number of pertinent issues relating to the preservation of confidentiality of patent advisors' communications. It reviews the argument either in favor of or against preserving the confidentiality of advice by patent advisors: in particular, its effects on the administration of justice, the public and private interests behind the regulation and the issue of development.

13. In relation to the cross-border aspects, the following issues have been addressed: (i) loss of confidentiality in foreign countries due to non-recognition of confidentiality of communications with non-lawyer patent advisors; (ii) legal uncertainty as to the recognition of foreign privileges and secrecy obligations; and (iii) the lack of comprehensive legal and practical measures to avoid forcible disclosure of confidential communications in a cross-

border context. While it is not realistic to seek a uniform rule involving fundamental changes in national judicial systems, the legal uncertainty surrounding the treatment of confidential communications between patent advisors and their clients could affect the quality of the patent system at the international level.

14. Possible remedies for cross-border aspects: One type of possible remedies for cross-border aspects might be recognizing, through national laws, the same effect for communications with national patent advisors and for those with certain foreign patent advisors, including patent advisors from both civil law and common law countries. This approach would allow countries to maintain their flexibilities in terms of substantive law on privilege or professional secrecy obligation, but the asymmetry of the cross-border protection of confidential IP advice would remain.

15. Another approach might be to seek a minimum standard or convergence of substantive national rules among countries. On the one hand, if a common set of substantive rules will be applied to both national and foreign patent advisors in all countries, the confidentiality of IP advice would be recognized beyond their national borders. On the other hand, considering the current differences with respect to national laws in this area, which might touch upon not only patent law but also general law such as procedure law, countries may need some flexibilities, should they implement an international standard.

16. Another mechanism might be to recognize the privileged nature of advice in other countries, as part of the choice of law rules, and grant the privilege for the purpose of court procedures in one's own country. In civil law countries, clarifying the secrecy obligation of patent advisors by their national legislations could facilitate the recognition of confidentiality through the application of the choice of law rule to a certain extent.

17. Another approach, proposed by one non-governmental organization, might be to establish an international framework that extends the recognition of privilege to foreign patent advisors who are designated by the respective foreign authorities.

18. In the absence of an international legal framework that effectively recognizes confidentiality of IP advice at the global level, a number of practical remedies, such as cooperation with lawyers and increased use of oral communications, have been sought by practitioners in order to avoid forcible disclosure of confidential IP advice at the national and international levels.

INTRODUCTION

19. Pursuant to the decisions of the Standing Committee on the Law of Patents (SCP) at its twenty-eighth session, held in Geneva from July 9 to 12, 2018, this document is an updated version of document SCP/20/9 (Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information). This update is also reflected on the dedicated website "Confidentiality of Communications between Clients and Their Patent Advisors".

20. Between its twentieth session and the current session, the Committee held the following activities with respect to the agenda item on the confidentiality of communications between clients and their patent advisors:

SCP/21: Seminar on the Confidentiality of Advice from Patent Advisors;

SCP/22: Continued discussion on the topic;

SCP/23: Sharing session among Member States concerning confidentiality protection applied to different types of patent professionals and to national and foreign patent advisors;

SCP/24: Continued discussion on the topic;

SCP/25: Document SCP/25/4 (Compilation of Court Cases with Respect to Client-Patent Advisor Privilege);

SCP/26: Continued discussion on the topic;

SCP/27: Sharing session on the experiences of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues;

SCP/28: Sharing session on the experiences and court cases of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues.

In addition, information on national/regional laws and practices, found on the dedicated website "Confidentiality of Communications between Clients and Their Patent Advisors", has been regularly updated based on the inputs from the Member States.

21. The update by the Secretariat therefore is primarily based on the information collected from the above recent activities of the SCP and from the Member States through their inter-sessional inputs. The compilation of information contained in this document does not imply any recommendation or guide for Member States to adopt any particular mechanisms contained in this document.

22. It is observed that, during the recent sessions of the SCP, more time has been spent on the issue of preserving the confidential advice received from patent advisors, in particular from foreign patent advisors, during the court proceedings (or *inter partes* administrative proceedings in some countries).

23. At this point, the Secretariat focused on the update of the contents of document SCP/20/9 when preparing this document. However, since the so-called "cross-border issues" have become the issues that are addressed more than others in the recent SCP

discussions, this document could be restructured, reformatted and simplified in order to improve the readability of the document. Should the Committee consider it useful, such improvement of the texts could be carried out by the Secretariat for a future session, subject to the agreement by the SCP.

Terminology

24. "Patent advisor": In this document, the term "patent advisor" is used to describe a person who is a professional representative on patent-related matters. Such a person is called "patent attorney" or "patent agent" in many countries. Often, subject to a qualification examination, she/he is registered with a national authority.[1] The exact scope of professional activities and qualification of patent advisors are defined in the applicable national/regional laws. Since the purpose of this document is to compile the existing information, and not to present draft international norms or an international legal instrument, it appears that the document does not need to contain a concise definition of that term. However, for the purpose of this document, it is important to note that a patent advisor may be a qualified lawyer or, if the applicable law permits, a non-lawyer.

25. "Client-attorney privilege": The term "privilege" in connection with the qualified lawyers and their clients relationship (so called "attorney-client privilege", "solicitor-client privilege", "legal advice privilege" or "client-attorney privilege") is well established in common law countries. One legal dictionary defines the term "attorney-client privilege" as follows:

> "In law of evidence, client's privilege to refuse to disclose and to prevent any other person from disclosing confidential communications between him and his attorney. Such privilege protects communications between attorney and client made for purpose of furnishing or obtaining professional legal advice or assistance."[2]

As clearly stated in the above definition, the privilege belongs to a client, not to an attorney, and hence only the client has the power to waive it. It is a concept used predominantly in common law countries.

26. "Client-patent advisor privilege": In this document, the term "client-patent advisor privilege" is used in order to describe a similar type of privilege given to a client of a patent advisor (who may be a non-lawyer patent advisor). While the patent advisor could not be compelled to disclose the communication, nothing prevents the client from doing so. If no privilege exists and it is permitted, the client might be compelled by the court to reveal the confidential communications with the patent advisor as part of court proceedings. The privilege protects only the source of information, i.e., the communication between a client and his/her attorney made for the purposes of professional advice, and not the information itself.[3] In that sense, the information itself could be subject to other obligations, for example, the obligation to fully disclose the invention in a patent application, but the communications as source of that information is protected by the privilege.

27. "Professional secrecy obligation": The term "professional secrecy obligation" of patent advisors, often used in civil law countries, refers generally to the legal obligation, imposed to patent advisors, not to disclose communication with their clients made in their professional capacity.

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1 In many countries, only registered patent advisors are entitled to provide the defined professional services. However, in some countries, persons who are not registered are able to perform all or some functions which are normally performed by patent advisors.

2 Black's Law Dictionary, (6th ed. 1990), ISBN 0-314-76271-X.

3 See Cross, John T., Evidentiary Privileges in International Intellectual Property Practice (December 20, 2008). Available at SSRN: http://ssrn.com/abstract=1328481 or http://dx.doi.org/10.2139/ssrn.1328481.

28. "Preservation of confidentiality" / "maintaining confidentiality of communication with patent advisors": Since the issue under discussion in the SCP is not limited to one legal regime or the other, more general expressions, such as "preservation of confidentiality" and "maintaining confidentiality of communication with patent advisors", are used in this document in order to express the notion that communication between patent advisors, made for the purpose of, or in relation to, providing professional advice, is in principle kept confidential and is not forced to be disclosed.

CONFIDENTIALITY OF COMMUNICATION WITH PATENT ADVISORS – BACKGROUND

MECHANISMS TO PRESERVE CONFIDENTIALITY OF COMMUNICATION WITH CERTAIN PROFESSIONS

29. In general, when a client seeks an opinion from a qualified lawyer, communications between the lawyer and his client are kept confidential. The purpose of establishing and preserving such confidentiality is to encourage those who seek advice and those who provide advice to be fully transparent and honest in their communications. Those who seek advice should provide the advisor with all the information that could be relevant to obtain the best advice, including aspects which may run counter to his position. On the other hand, the advisor should be able to be completely frank. Therefore, in order to ensure a high quality of legal advice, the exchange of instructions and advice should not be restricted due to the fear of disclosure of their communications.

30. There is both a public and a private interest underpinning the regulation of the confidentiality of professional advice. On the side of the public interest, encouraging a client to frankly and fully communicate with his lawyer assists the administration of justice, and maintaining such communication confidential ensures the human right to privacy. However, another public interest aspect exists, which is to investigate the truth for the sake of justice, and for that reason, all relevant information needs to be laid down before the court. Consequently, there is a need to balance these competing interests, and the answer of many countries is to provide a mechanism to preserve confidential professional communications only to the extent that it would not compromise the exercise of justice.

31. The legal mechanism to preserve confidential professional communications in each jurisdiction, therefore, is closely linked to the legal framework and procedures for the investigation of the truth in court, such as submission of evidence. Generally speaking, a distinctive framework that governs the legal fact finding process has been developed in the respective legal tradition, notably common law and civil law. At the same time, even within the same legal tradition, various ways to investigate the truth without compromising the confidentiality of communication with certain professions have been developed at the national level.

Discovery proceedings in common law countries in general

32. One general characteristic of civil procedure in common law countries is "discovery" (or disclosure) in a pre-trial phase. There, each party to litigation may be required to provide disclosure of relevant documents and other evidence in the possession of other parties. The discovery system was developed with a view to bringing all evidence to the attention of the court so that the truth can be ascertained. On the other hand, as seen above, there is also a competing public need to keep certain information confidential from public inspection. For example, information received by certain professions, such as lawyers, doctors or priests, in their professional capacity should remain confidential. Considering the overall public interest, common law jurisdictions developed a notion of "privilege" under which a

client is given the right to prohibit certain confidential communications or documents from forced disclosure. In parallel with the professional duty of confidentiality, the client-attorney privilege is intended to promote the broader public interest in the observance of law and the administration of justice by creating a specific exception to the discovery of information in litigation.

No discovery proceedings in civil law countries in general

33. Unlike common law countries, civil law countries do not have a discovery or disclosure process that obliges the parties to disclose all relevant information in their possession during court proceedings. Therefore, the inter-related concepts of discovery and the privilege granted to clients as an exception to it are not common in civil law countries.

34. However, civil law countries also recognize that confidentiality of communications between certain professionals and their clients' needs to be protected in order to ensure frank and open communications necessary to the accomplishment of their professional tasks. They have developed the notion of "professional secrecy obligation", according to which certain professionals, such as lawyers, doctors and priests, are obliged to keep information that they have received through their professional activities secret. This would, in turn, guarantee the clients that the information communicated to those professionals could not be ultimately be disclosed to third parties. Breach of the secrecy obligation is generally a criminal offence.

35. In order to fulfill such legal obligation, those professionals, for example, lawyers, are entitled to refuse to cooperate in court proceedings to the extent that it leads to breach of their professional secrecy obligation. This may include refuse to testify in courts regarding any such confidential information provided to them in their professional capacity. Similarly, in countries where a limited scope of document submission order or seizure of documents is allowed in the court proceedings, provision of documents that cover such confidential information under the professional secrecy obligation can be refused or such documents cannot be seized.

CLIENT- PATENT ADVISOR RELATIONSHIP AND CONFIDENTIALITY

36. Patent law is a unique field where legal understanding and technical/scientific understanding go hand in hand. In many countries, a separate profession called, for example, "patent attorney" or "patent agent", is well recognized for the development and maintenance of a functioning patent system. The role of patent advisor is, in general, to give advice and assist inventors and applicants in obtaining and maintaining patents. Patent advisors may also represent third parties during opposition or invalidation proceedings. Moreover, patent advisors may be asked to provide advice with a view to seek the full range of possible IP protection or enforcement options available to the client. Consequently, the advice given by patent advisors may cover a wide range of legal issues.

37. Similar to the client-lawyer relationship, clients should be able to freely communicate with their patent advisors. If a client does not feel free to discuss issues, both positive and negative aspects, relating to his IP or patent rights with his patent advisors due to a fear that the patent advisor might reveal those issues to third parties and in court, the advisor will not be able to give full and comprehensive legal advice. Further, if the client does not feel confident to provide all information to the patent advisor, it is not fully possible for the patent advisor to ensure that the applicable legal rules on IP and patents are fully complied with. Clients may need certainty that any communication to and from such advisor will remain confidential and will not be revealed to a third party, in court or otherwise made public.

38. In general, patent advisors are required to keep the information received from their clients undisclosed. This is often regulated under a code of conduct set by a professional association and/or under governmental regulations or law. Any breach of a client's confidential information may result in disbarment, suspension or other disciplinary measures against improper conduct. In civil law countries, it can often result in criminal sanctions such as fine or imprisonment as well as civil sanctions for damages.

Discovery in patent-related cases in common law countries with regard to patent advisors

39. Where a legal action for patent infringement is filed in common law countries, in the course of discovery proceedings, it is common for one side or the other to oblige another party to disclose any documents relating to communications between the patent advisor and the party in the hope that damaging statements may be found on the record which would destroy an alleged infringer's defense or show that there had been abuse of rights by the patentee. Communications between patent advisors and clients often contain technical matters which are closely inter-related with legal questions under consideration by a court. Therefore, some common law countries provide a privilege with respect to advice from patent advisors, even if they are not qualified lawyers. What is called "client-patent advisor privilege" is the right to resist requests from authorities or other parties to disclose communications between a person and that person's patent advisors on patent advice. Privilege is thus regarded as a form of guarantee for the confidentiality of communication between clients and their patent advisors. However, when a client seeks the opinion of a patent advisor who is not a qualified lawyer, not all countries provide privilege to the advice the patent advisor gave to his client. Consequently, keeping the communication between the patent advisor and the client confidential in court proceedings becomes challenging.

40. Although it might not be called "professional secrecy obligation" in common law countries, the general notion that patent advisors shall maintain confidentiality of communication with their clients exists in common law countries as well. Failure to maintain the confidentiality may result in severe sanctions.

Preservation of patent advisor professional secrecy in legal proceedings in civil law countries

41. In civil law countries, in general, patent advisors are subject to professional secrecy obligation. Such obligation is often stipulated in laws governing the statute of patent advisors. With a view to fulfilling the obligation, in some countries, patent advisors are entitled to refuse to testify in court on any matter falling under the professional secrecy obligation. Where a limited scope of production of evidential documents or seizure of documents is a general rule, some countries allow the possessor of the documents to refuse submission, or seizure, of documents that contain any matter falling under the professional secrecy obligation of patent advisors. In other words, some civil law countries also provide a mechanism that where confidential information under the professional secrecy obligation can be withheld in the court proceedings, in principle.

42. Therefore, although the term "privilege" may be not used, the notion of preserving the confidentiality of communication between patent advisors and their clients during court proceedings is not absent in some civil law countries.

Diversity of national laws

43. The national rules in respect of maintaining confidentiality of communications with patent advisors, particularly in court proceedings, vary significantly from one country to another. To begin with, in some countries, the rules apply only to attorneys at law, but not to IP advisors. In some others, it applies to both categories, although IP advisors are covered only where they are also law attorneys and give legal advice. In some other countries, the

rules are also applicable to non-lawyer patent advisors who are officially registered with the IP office of the country concerned. Yet in some other countries, preventing forcible disclosure of communications with qualified patent advisors in the respective country is possible, but not for communications with patent advisors qualified overseas. The situation is no better in some other countries where there is uncertainty about whether privilege is recognized with respect to communications with either local patent advisors or foreign patent advisors.

44. With respect to submission or seizure of documentary evidence in court proceedings, in some civil law countries, it is not fully clear whether any party (such as a client) who possesses a document containing the confidential communication with a patent advisor could refuse to produce such a document.

45. Even if the confidentiality of communications with patent advisors is preserved, the scope of such communications and the extent of the coverage of overseas patent advisors vary. There are significant differences in both the substantive law, i.e., the scope of the confidentiality of communications between clients and patent advisors, and the choice of law/international private law rules, which determine whether the substantive law of a foreign country is recognized by the courts. While the substantive law deals with the scope of confidentiality, the choice of law rules address the international recognition of a foreign law. Therefore, two related, but distinct issues are involved in this area of law. The first aspect relates to how confidentiality of communications with patent advisors is treated under the applicable national law. The second aspect concerns how confidential communications with patent advisors in one country would be treated in another country.

46. The issues relating to discovery and compelled disclosure of confidential communications between a client and his patent advisor were initially raised by some international associations of IP or patent practitioners who had been involved in providing IP advice to their clients (see Annex II). Their primary concern was the risk of losing confidentiality of such advice through the discovery procedure before common law courts. According to the IP practitioners, such an inadvertent loss of confidentiality could have a negative impact on the quality of IP advice obtained from patent advisors, since a frank and open dialogue between the patent advisors and their clients could be discouraged due to the fear that the advice could be made public in the future. In order to contribute to a fair, transparent and effective legal system, their opinion has generally been that there needs to be some similarity of rules that would minimize, at the international level, the risk of forcible disclosure of confidential advice from patent advisors.

Issues observed at the national level

47. There have been some discussions on various aspects of maintaining confidentiality of communications with patent advisors at the national level. The primary issue is whose communications may be covered. Should it apply to local patent advisors, in particular, those who are not lawyers? Should it be extended to in-house patent advisors? Should it be extended to overseas patent advisors who are not registered in the country concerned? If so, under which criteria should overseas patent advisors be protected? Further, in view of the complexity of patent advice involving both legal and technical aspects, not only a qualified patent advisor but also other parties may be involved in advising a client. In those cases, should it be extended to all those involved in giving instructions for advice and in giving the advice? As to those giving advice, should it be extended to anyone giving IP advice who is qualified in that country to do so and third parties (like experts) who contribute to the advice which is given?

48. Another essential question is what type of communications should be prevented from forcible disclosure. It may only apply to communications made for the predominant purposes of giving legal advice, or it may cover all communications given in relation to IP matters. Naturally, the type of communications corresponds to the scope of professional activities of patent advisors, prescribed in the applicable law.

Cross-border (or international) aspects

49. Where business activities remain within a national territory, the question of IP advice has also to be answered only in respect of that territory. Consequently, the main issue for a client is whether the applicable national law ensures the maintenance of confidentiality of communications with patent advisors. Once the business extends beyond the territorial border, the situation changes. Since patent law is territorial in nature, the services of different patent advisors in each country or region may be required with respect to the same invention. Where a client faces litigation in a foreign country, advice obtained from a patent advisor in another jurisdiction (for example, a patent advisor of the client's home country) may be relevant to that lawsuit in the foreign country. In that case, depending on the rules of the foreign court, the client might be required to disclose the confidential IP advice from the patent advisor of the client's home country in the legal proceedings.

50. For example, if the confidentiality of advice given by a patent advisor in one country is not recognized in one of the several countries in which a patent owner is involved in litigation relating to his patent, there is a risk that he receives an order by a court of the latter country to disclose the contents of the confidential advice obtained in the former country. Consequently, the confidentiality of advice given by the patent advisor will be lost across borders, including in the country in which the rule to preserve the confidentiality of such advice exists. In other cases, if only clients of patent advisors who are qualified and registered in the country can enjoy a professional privilege before the court of that country, a client is not protected from a court's order that requires the disclosure of communication between the client and an overseas patent advisor with respect to the patent and other applications and patents in the same family.

51. Not knowing all practices in different countries, a client may find himself unexpectedly in a position where he has to unwillingly disclose his communications with his patent advisors in a foreign court. Clients and patent advisors in both common law and civil law countries can be affected, since the central issue is the preservation of confidentiality of communications with patent advisors beyond the national borders.

INTERNATIONAL LEGAL FRAMEWORK

52. As regards the recognition of foreign evidentiary privilege in general, in 2004 the Governing Council of UNIDROIT adopted the Principles of Transnational Civil Procedure prepared by a joint American Law Institute/UNIDROIT Study Group. The Principles served as guidelines for national law projects and reforms, and consist of 31 provisions, which aim at reconciling differences among various national rules of civil procedure, taking into account the peculiarities of transnational disputes. Article 18 deals with evidentiary privileges and immunities, and states that "effect should be given to privileges, immunities, and similar protections of a party or non-party concerning disclosure of evidence or other information". The comments to that Article note that privileges protect important interests, but they can impair the establishment of the facts. They highlight the differences of the conceptual and technical bases of the privileges from one system to another and the choice-of-law problems in applying such rules.

53. The preservation of confidentiality of communications between patent advisors and their clients is not expressly regulated by any international IP treaty. However, there are provisions within those treaties which may have some relevance to the issue at stake. The present chapter explores provisions within the Paris Convention and the TRIPS Agreement. In addition, the relevance of the General Agreement on Trade in Services (GATS) of the World Trade Organization (WTO) is addressed as well.

PARIS CONVENTION

54. The Paris Convention was the first major international treaty designed to facilitate the acquisition of multi-country protection for industrial property rights. The issue of client-attorney privilege, or preservation of confidentiality of communications with patent advisors in general, is not regulated in the Paris Convention. Each Contracting Party, therefore, may regulate such matters under its national law according to its own needs. However, a question may arise as to whether the principle of "national treatment" embodied in Articles 2 and 3 would apply to different treatments between local patent advisors and foreign patent advisors. Under these provisions, as regards the protection of industrial property, each Contracting State must grant nationals of the other Contracting States the same protection to its own nationals, without being allowed to require reciprocity.[4] Article 2(1) and (2) read as follows:

> "(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.
>
> "(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights."

55. Nationals of non-Contracting States are also entitled to national treatment under the Convention if they are domiciled or have a real and effective industrial or commercial establishment in a Contracting State.[5]

56. The national treatment rule guarantees not only that foreigners will be protected, but also that they will not be discriminated against. An exception to the national treatment rule is provided in Article 2(3) of the Convention which reads:

> "(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved."

57. This reservation of national law means that certain requirements which impose different or additional conditions on foreigners for the purposes of judicial and administrative procedures may be applied to foreigners who are nationals of other countries of the Union.

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4 Article 2 of the Paris Convention.
5 Article 3 of the Paris Convention.

58. An example of such permissible discrimination against nationals of other countries is expressly stated: the requirement that foreigners should designate an address for service or appoint a local agent in order to facilitate the procedure in the country in which protection is sought.[6] Another example of permissible discrimination as to procedure could be a requirement for foreigners to deposit a financial guarantee to cover costs and lawyers' fees (*cautio judicatum solvi*). Another example could be the right to sue a national of another country in a court of the country where the plaintiff is domiciled or established.

59. The issue of preserving confidentiality of communications between patent advisors and their clients seems to fall within the permissible exceptions to the general rule of non-discrimination allowing Contracting States to regulate it as they deem fit. On the other hand, the Paris Convention does not prohibit a Contracting Party from according the same treatment between its nationals and nationals of other countries on this matter.

TRIPS AGREEMENT

60. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) does not directly refer to the issue of client-patent advisor privilege. However, the following provisions could be relevant to the issue at stake.

61. First, as far as patents are concerned, Article 2 of the TRIPS Agreement provides that members shall comply with Articles 1 to 12 and 19 of the Paris Convention in respect of Parts II, III and IV of the TRIPS Agreement. Consequently, obligations arising from the above Articles of the Paris Convention became obligations of WTO Members, and are enforceable under the Dispute Settlement Understanding.

62. Further, Article 3 of the TRIPS Agreement provides rules on national treatment obliging Members to accord to the nationals of other Members treatment no less favorable than that it accords to its own nationals with regard to protection of intellectual property. The same provision stipulates that the national treatment principle of the TRIPS Agreement is subject to the exceptions provided in the Paris Convention.[7]

63. In relation to those exceptions, Article 3(2) of the TRIPS Agreement, albeit indirectly, refers to Article 2(3) of the Paris Convention allowing exceptions to be made with respect to the appointment of agents, designation of an address for service and other special rules applicable to foreigners in judicial and administrative proceedings. The use of those exceptions under the TRIPS Agreement is limited to cases that are necessary to secure compliance with laws and regulations which are consistent with the provisions of the TRIPS Agreement and where such practices are not applied in a manner which would constitute a disguised restriction on trade.[8]

64. Accordingly, with respect to national treatment issues, Members of WTO seem to have a free hand in their treatment of the confidentiality of communications with patent advisors, provided that their policies are not inconsistent with other provisions of the Agreement and are not applied in a manner that would constitute a disguised restriction on trade. Naturally, such freedom for a WTO Member also includes freedom to treat nationals and non-nationals equally in judicial and administrative procedures with respect to the issue under consideration.

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6 G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIPRI 1969, WIPO Publication.

7 Article 3 of the TRIPS Agreement. In addition, the provision refers to exceptions allowed under the Berne and Rome Conventions.

8 Article 3(2) of the TRIPS Agreement.

Most-favored nation treatment

65. Article 4 of the TRIPS Agreement provides that "With regard to the protection of intellectual property, any advantage, favor, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members [...]." Further, the same provision stipulates four exceptions to the most-favored nation (MFN) rule. The relevant exception for the purpose of this paper is provided under paragraph (a) which exempts from the MFN obligation international agreements on judicial assistance or law enforcement in general, which are not particularly confined to the protection of intellectual property of the client-patent advisor issue. The main question which arises in the current context is whether the MFN principle could suggest that any recognition of confidentiality of advice by a patent advisor in a foreign jurisdiction (of a WTO Member) be extended to all other jurisdictions of WTO Members. In the light of the MFN principle, any obligation of extension may depend on the specific criteria and factual circumstances for the recognition of the foreign privilege.

Enforcement of IP

66. Article 43 on "Evidence" concerning civil and administrative procedures and remedies provides that:

> "The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information."

67. While this provision has not been analyzed in WTO dispute settlement proceedings, and no interpretation is proposed in this document, the last part of the provision "subject in appropriate cases to conditions which ensure the protection of confidential information" may have some relevance to the issue under consideration. In particular, this provision is relevant to the scenario in which one party in litigation holds evidence relevant to the substantiation of the claims of the other litigant.

GENERAL AGREEMENT ON TRADE IN SERVICES (GATS)

68. The General Agreement on Trade in Services (GATS) extends the basic pillars of the multilateral trading systems, such as transparency to international trade in services among WTO Members, and the MFN and national treatment principles. The GATS applies to measures affecting trade in many service sectors, including professional services and more specifically services supplied, for instance, by lawyers and IP advisors, including patent advisors.

69. The GATS distinguishes among four different modes through which services can be provided (or "modes of supply"). Lawyers and IP advisors can supply their services to consumers located in foreign countries for instance via telecommunication (phone, fax or e-mail) or postal means (mode 1 - cross-border supply); through the establishment of a commercial presence in the country of the client (mode 3 - commercial presence); or by traveling to the country of the client (mode 4 - movement of natural persons). Finally, the consumers can visit the lawyers and IP advisors in the latter's country (mode 2 - consumption abroad).

70. GATS obligations can be classified into two main groups: "horizontal" (or unconditional, such as the MFN and transparency obligations) which apply to all measures affecting trade in services, and "specific" (or conditional) obligations, the application of which is dependent upon the existence of obligations taken by Members on an individual basis and contained in their "schedules of specific commitments". Market access, national treatment and domestic regulation fall into the latter category.

71. Under GATS, the issue of "privilege" for any professional service provider (including patent advisors) falls under the realm of domestic regulation. Each Member is free to regulate the provision of services in its own market. However, in sectors where specific commitments are undertaken, each Member shall ensure that measures are administered in a "reasonable, objective and impartial manner."[9] Qualifications and licensing requirements and technical standards must be based on objective and transparent criteria, and should not be more burdensome than necessary to ensure quality of service.[10] The provision aims to make it easier to obtain the qualifications necessary for suppliers to operate in a foreign country. However, it is to be noted that in sectors in which a Member has not undertaken specific commitments, for instance in the sector of legal services, it remains "unbound" and retains freedom in regulation of the activities of foreign suppliers of legal services in its domestic market.

72. The provision of GATS on "Recognition" may also have some relevance to the current issue. Pursuant to Article VII, a WTO Member may recognize the education or qualifications obtained abroad by a service supplier. Such recognition may be done on an autonomous basis or through an agreement with the other country. GATS Article VII nevertheless requires such recognition not to be exclusive. Other WTO Members are to be afforded an opportunity to negotiate their accession to a recognition agreement or, in the case of autonomous recognition, to demonstrate that their qualifications should be recognized as well. Recognition of education and qualifications of foreign lawyers and IP advisors, which may result from the application of this provision, would facilitate their access to foreign markets and their eligibility to the same treatment as domestic ones. However, the recognition of qualifications of foreign lawyers and IP advisors under this provision would not necessarily guarantee that any recognition of confidentiality of IP advice would be extended to those foreign service suppliers as Members retain their right in the application of their judicial proceedings. A key principle in the GATS is the flexibility it accords to Member States with respect to their ability to regulate. This is in line with the principle of progressive liberalization under GATS where Members are allowed to liberalize the service sector at their own pace.

73. As long as discussions in the SCP are confined to the preservation of confidentiality of communication between a client and its patent advisor in connection with judicial proceedings, it appears that those issues are outside the scope of GATS.

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9 Article VI:1 of GATS

10 Article VI:5 of GATS. The same provision in paragraph 4 mandates the development of multilateral disciplines on domestic regulation that would prevent domestic regulations from constituting unnecessary barriers to trade. Little headway has been made so far under this negotiating mandate, with the exception of the accountancy sector. Even in the case of the accountancy sector – the draft disciplines have yet to enter into force.

SUMMARY OF NATIONAL LAWS AND PRACTICES

74. Annex III provides a compilation of national laws and practices regarding the confidentiality of communications with patent advisors in 56 countries (including both common law countries and civil law countries) and three regional frameworks.[11] Wherever possible, it reviews the national laws with respect to the following elements: (i) the origin of the privilege and/or secrecy obligation; (ii) professionals bound by the privilege and/or secrecy; (iii) the scope of the privilege/secrecy obligation; (iv) exceptions and limitations to the privilege /secrecy obligation; (v) penalties for breach of secrecy; and (vi) qualifications of patent advisors. Furthermore, in connection with civil court proceedings, the information as to how the confidentiality obligation imposed to patent advisors interacts with a duty to testify or to produce documents is also provided, where available. On the cross-border aspects, information regarding the recognition of confidentiality of communications with foreign patent advisors is presented. Depending on the availability of information, the extent and depth of collected information of each country is not necessarily the same.

75. This Section contains the summary of the compilation of laws and practices contained in Annex III.

ORIGIN AND SCOPE

Origin of the client-attorney privilege and secrecy obligations

76. The need for a client to disclose all facts to his or her legal advisor in order to obtain the best advice to respect the law is common to all countries. To that end, the desirability of the confidentiality of communications between the legal advisor and the client is probably uncontested, unless the maintenance of confidentiality is overridden by a fundamental public policy such as the prevention and punishment of criminal acts.

77. One of the important points of departure between common law countries and civil law countries is the different approaches taken in protecting confidential communications with certain professions in those countries, which are closely related to the different legal procedures in court for the investigation of the truth.

78. Civil law countries impose secrecy obligations on the part of professionals in ensuring that clients' confidential information is kept secret from disclosure to third parties. This may be regulated under the laws governing the activities of professionals and/or through the respective national criminal law. In general, the disclosure of such confidential information by legal advisors, such as making documents containing such information public, is subject to severe sanctions.

79. In civil law countries, the rule of evidence is that a plaintiff needs to substantiate his or her claim, and the fact that a document is in the possession of the defendant does not change this burden of proof. Parties obligation to disclose documents is in general very limited. Consequently, the potential risk of public disclosure of confidential information under the professional secrecy obligation during the legal proceedings is very low. This could be

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11 They include: Argentina, Australia, Belarus, Belgium, Brazil, Bulgaria, Canada, China and Hong Kong (China), Chile, Colombia, Costa Rica, Croatia, Cyprus, Czech Republic, Denmark, Dominican Republic, Estonia, Finland, France, Georgia, Germany, Guatemala, Hungary, India, Israel, Japan, Kenya, Kyrgyzstan, Latvia, Lithuania, Malaysia, Mexico, Monaco, Morocco, New Zealand, Norway, Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, South Africa, Spain, Sweden, Switzerland, Thailand, Turkey, Ukraine, United Kingdom, United Republic of Tanzania, United States of America and Zambia, as well as the frameworks established under the European Patent Convention (EPC), the Unitary Patent Court (UPC) Agreement and the Eurasian Patent Convention (EAPC).

regarded as a reason why the concept of "client attorney privilege" has not developed in civil law countries. Nevertheless, often regulated by civil/criminal procedure law, attorneys may, in principle, refuse to testify any information received from a client during the course of professional duty. Similarly, submission of any document that contains such confidential information may be refused.

80. Common law privilege originates from the solicitor–client privilege under the common law system which would later be known as legal professional privilege. The main purpose of the legal professional privilege in common law countries is to avoid confidential communications between an attorney and his or her clients from being disclosed to the court during the discovery stage. Privilege in common law countries applies to communications relating to legal advice whether there is litigation or not, subject only to the dominant purpose test and any established common law exceptions (such as for crime/fraud) and any statutory limitations.

Professionals bound by the privilege and secrecy

81. Generally, in common law countries, there are two legal bases of privilege: common law privilege and statutory privilege. The former, applies only to communications between qualified lawyers, including in-house lawyers, and the clients. In general, it is not applicable to patent advisors who are not qualified lawyers. The Court of Appeals for Federal Circuit of the United States of America, however, ruled in March 2016 that a client's communication with a non-attorney patent agent is privileged coextensive with the rights granted to patent agents by the Congress. At the State level, privilege has not been consistently applied to communications with non-attorney patent agents. In February 2018, the Texas Supreme Court reversed the decision of lower courts, and decided that a client's communication with a registered non-attorney patent agent is covered by the attorney-client privilege as defined by the Texas Rule of Evidence.

82. In some common law countries such as Australia, Canada, New Zealand, Singapore, South Africa and the United Kingdom, the common law privilege has been supplemented by Statute, which extend the client attorney privilege to patent attorneys and patent agents. In the United States of America, privilege applies to communications with US patent agents and with foreign patent agents during the proceedings before its administrative tribunal, i.e., the Patent Trial and Appeal Board (PTAB).

83. In civil law countries, generally speaking, the professional secrecy obligation is created by statutes governing lawyers and many other professionals. In general, non-lawyer patent attorneys and patent agents are also bound by the professional secrecy obligation.

Scope of the privilege/secrecy obligations

84. The client-attorney privilege protects confidential communications between a lawyer and client made for the purpose of obtaining and giving legal advice. In some common law countries, the same scope of privilege is provided for the client with respect to communications between a patent attorney (agent) and client under the relevant statute or case law. The exact types of communications covered by the client-patent attorney (agent) privilege are not the same among countries, since the scope of the professional activities of those professionals (for example, whether copyright matters can be dealt with or not) is different from one country to the next.

85. According to the information gathered in Annex III, the professional obligation to keep secrets in civil law countries attaches to information and documents obtained from clients in the course of the professional relationship as between an attorney or a patent attorney and a client. It does not apply in other situations, for example, where attorneys act in their non-professional capacity such as that of a director, business advisor or business partner to the client.

86. In civil law countries, due to no or very limited disclosure proceedings in civil litigations, strong imposition of professional secrecy obligation for lawyers coupled with their right to refuse to testify in court any matter falling under the professional secrecy obligation is regarded as a sufficient mechanism to preserve the confidentiality of professional advice. In many countries, a similar mechanism applies to patent advisors: Strong obligation of professional secrecy with severe sanction in case of breach, coupled with the right to refuse testify such confidential matters. In some other countries, while patent advisors are under the professional secrecy obligation, no immunity in respect of testimony in court is granted to non-lawyer patent advisors. With respect to documents that contain information covered by the professional secrecy obligation, in some countries, a patent advisor may refuse to produce such document. In some other countries. the owners of such documents, who may be patent attorneys, their client or any third party, may refuse to produce such documents in court.

87. The obligation of confidentiality extends beyond the life of the attorney–client relationship. It is typically the result of rules of professional conduct that are put in place by the appropriate body responsible for regulating the legal profession in any given jurisdiction or of the statutory rules.

88. As regards in-house attorneys, in common law countries, privilege attaches if counsel is acting his/her capacity as a lawyer. In many civil law countries, there is generally no protection,[12] although in some countries, the professional secrecy obligation and the right to refuse testimony apply to in-house attorneys as well.

89. In general communications with patent advisors that are protected from forcible disclosure are those for the purpose of or in relation to professional advice sought from a patent advisor. More precise scope of the protected communications may be nuanced. They may be communications made for the predominant purposes of giving legal advice or all communications given in relation to patent matters under the duty of the patent advisor.

90. Furthermore, the question of whether the privilege does extend to communications by lawyers and clients with third parties is dealt with differently among the countries.[13]

91. With respect to the communications with overseas patent advisors, the situation is largely uncertain. In general much depends on, for example: (i) the formal as well as substantive qualification of a foreign patent advisor; (ii) nature of advice given; (iii) doctrine of comity; or (iv) status of communication in foreign jurisdiction.

Exemptions and limitations of the privilege and secrecy obligations

92. The privilege that prevents the disclosure of communications concerning legal advice belongs to the client. Therefore, one of the limitations of the legal professional privilege under the common law system is the fact that clients may decide to waive the privilege and thus allow the privileged communication to be disclosed to the court. Express and implied

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12 Steve Garland, Seminar on the Confidentiality of Advice from Patent Advisors, 21st Session of the SCP, November 4, 2014.

13 For Australia, see *Pratt Holdings Pty Ltd and Another v. Commissioner of Taxation* [2004] FCAFC 122.

waivers are available under the common law systems of the United Kingdom, Australia and New Zealand. Malaysia only recognizes express waiver by the client. In general, there is an exception to the privilege, if such confidential communications involve fraud or criminal acts.

93. Exception to the professional secrecy obligation, if such confidential communications involve fraud or criminal acts. Consequently, cannot refuse testimony etc. in court.

Penalties for breach of secrecy/disclosure

94. Among the countries in the compilation, a breach of the secrecy obligation in civil law countries may lead to criminal prosecution. In both civil law and common law jurisdictions, a breach of secrecy and disclosure of privileged information may lead to professional disciplinary actions.

Qualifications of patent advisors

95. Qualifications to become a patent attorney or patent agent vary from one country to another. Many countries such as Germany and the United Kingdom require patent agents and patent attorneys to be technically qualified. The United States of America allows non-lawyers who are technically and scientifically qualified to become patent agents, although patent attorneys must have legal qualifications. In some countries such as Brazil, Malaysia and South Africa, both lawyers who are not technically qualified and non-lawyers who are technically qualified may become patent agents.

APPROACHES TO CROSS-BORDER ASPECTS

96. Cross-border aspects concern whether the confidentiality of communications between clients and patent attorneys could be recognized and respected across national borders, in particular by courts in another jurisdiction. Cross-border aspects are not necessarily related to providing professional legal services abroad. The applicable laws of the different countries take different approaches to the cross-border aspects of the client-patent advisor privilege. In some countries, the patent law or evidentiary law expressly provides that communications with foreign patent advisors are protected from forcible disclosure. In the absence of such statutory provision, some common law countries courts recognize the legal mechanisms regarding the confidentiality of communications between clients and patent attorneys established in another jurisdiction as foreign privilege, in accordance with choice of law rules. Other common law courts apply the domestic *lex fori* and therefore deny foreign privileges.

97. Recognition of foreign law: The standard applied by the courts of some countries in deciding whether the privilege should apply in relation to communications with foreign patent advisors is to consider whether or not such communications would have enjoyed privilege in the foreign law of the country concerned. Although it is an essential element, confidentiality of communication in itself is not sufficient to render the communication privileged. Therefore, the confidential nature of the advice given by patent advisors in the foreign law alone is most likely not considered as privileged advice.

98. The recognition of foreign law is practiced in some States of the United States as part of the choice of law/international private law rules. In terms of the recognition of foreign law with respect to confidentiality of communications with patent advisors, two main approaches have been adopted across the Federal District Courts based on either the non-choice of law or the choice of law approach. Under the non-choice of law approach, no privilege for a foreign patent practitioner is recognized, because he or she is neither a United States' attorney nor the agent or immediate subordinate of an attorney. Most courts, however, use the choice of law approach, which is based on either the "Touching Base" approach, the

"Comity Plus Function approach" or the "Most Direct and Compelling Interest approach". Under the Touching Base approach, communications with foreign patent agents regarding assistance in prosecuting foreign patent applications may be privileged, if the privilege applies under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States.

99. A similar approach has been chosen by other common law countries, such as South Africa. The communications between a local and a foreign patent advisor are considered to be privileged in South Africa, if the communications were made for the purpose of giving or receiving legal advice to, or from, a particular client. The communications between clients and a foreign patent advisor are considered to be privileged if the representative of the client acting on the client's behalf is a legal advisor and the communications were made for the purpose of obtaining legal advice from the foreign patent advisor. If the representative of the client is not a legal advisor, the issue has not been settled by the courts.

100. Extension of principles of substantive law: In some common law countries, for example, Australia, Canada and New Zealand, the domestic patent law (Australia and Canada) or law of evidence (New Zealand) provides an extension of the substantive principle of privilege to foreign patent advisors. In recognizing the foreign client-patent advisor privilege, the courts of those countries must review either: (i) whether the functions of overseas patent advisors "correspond" to those of a registered patent attorney (New Zealand); (ii) whether a foreign patent advisor is "authorized" to do patents work under the law of his/her country (Australia); or (iii) whether the law of a foreign patent advisor also recognizes those communications as privileged (Canada). In the United Kingdom, the Copyright, Designs and Patents Act 1988 stipulates that privilege applies to a more limited scope of foreign patent advisors, i.e., it applies to patent agents who are either registered in the United Kingdom or on the European patent attorney list.

101. Facilitating recognition of foreign law: In civil law countries, the confidentiality of communications with patent advisors is underpinned by the professional secrecy obligation imposed to patent advisors. However, some non-lawyer patent advisors of those civil law countries have faced a loss of confidentiality of communications with their clients in foreign countries, in particular, in common law countries, because the foreign courts could not identify a corresponding privilege in those civil law countries.

102. In order to alleviate the problem, some of those countries, such as France, Japan and Switzerland, expressly regulate the secrecy obligation of both lawyer and non-lawyer patent advisors, and correspondingly provide exemptions from the duty to give evidence in court proceedings as far as the information in question is covered by the professional secrecy obligation, with the aim of obtaining the foreign recognition of confidentiality in common law countries. These exemptions may include refusing testimony and withholding documents that contain information subject to secrecy obligation. The number of such countries has been increasing, in particular, in recent years. Such an approach, however, is not effective in common law countries which categorically deny the foreign privilege to non-lawyer patent advisors.

DISCUSSION OF THE RELEVANT ISSUES

PROTECTION AGAINST FORCIBLE DISCLSOURE OF COMMUNICATIONS WITH PATENT ADVISORS

103. Various arguments exist, either in favor of or against providing a legal mechanism to protect confidential communications with a patent advisor against forcible disclosure, particularly in court proceedings. The survey of various literature[14] has shown that, in general, the questions regarding the feasibility of applying such protection can be roughly grouped as follows:

- whether preservation of confidentiality of communications with patent advisors in court proceedings would ensure the quality of advice and administration of justice or impede justice by withholding certain information;

- whether non-lawyer patent advisors[15] merit the same treatment as lawyer patent advisors; and

- whether communications with patent advisors who act as intermediaries between clients and patent Offices and prepare documents for public disclosure deserve such protection.[16]

104. The following paragraphs will consider these questions in order.

Effects on the administration of justice

105. One of the arguments supporting protection of communications with patent advisors in court proceedings is that the existence of such privilege could encourage open and frank discussions and communications between patent advisors and clients. Clients and patent advisors may discuss a broad range of issues such as patentability of inventions and the possibility of infringement of existing patents. If privilege is not applied, the client may be discouraged from revealing all related details. Such restricted communications can lead to difficulty in preparing an application and taking other necessary actions in a proper manner.

106. The role of patent advisors in promoting innovation and supporting dissemination of technical information is acknowledged. They carry out their missions through providing professional advice. If clients cannot fully trust their patent advisors due to a lack of complete confidentiality, it would be almost impossible for the patent advisors to defend and represent their clients, and to ensure that clients meet the requirements and enjoy full rights as prescribed in the patent law and other relevant laws. In short, it is suggested that the overall IP system and the public in general will benefit from privilege granted to communications between patent advisors and their clients, because it would ensure full compliance with the applicable laws.

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14 For example, see John E. Sexton, Developments in the Law – Privileged Communications, 98 Harv. L. Rev. 1501 (1985); Berta Suchorukovaite, Should the Attorney-Client Privilege Be Applicable to Patent Agents? International Journal of Baltic Law, Vol. 3, No.1, March, 2007; Michael Dowling, Prospects for Improvement, What are the Options? Conference on Client Privilege in Intellectual Property Professional Advice (*CPIPPA*) organized by the World Intellectual Property Organization (WIPO) in collaboration with the International Association for the Protection of Intellectual Property (AIPPI), WIPO Headquarters Geneva, Switzerland May 22 and 23, 2008; Paul R. Rice, Attorney-Client Privilege in the United States, Second Edition, West Group, MN (1999); John M. Romary and Robert D. Wells, The Forced Disclosure of Professional Intellectual Property Advice, A Prelude of International Deliberations, May 2009.

15 In some countries, a patent attorney has legal qualifications, but this does not apply to all countries.

16 In some countries, patent advisors may represent their clients before a court in certain cases, but in some other countries, patent advisors can only represent their clients before a patent Office.

107. On the other hand, there is a view that public interest requires disclosure of information to public tribunals in order to allow justice to be served. This is based on the argument that transparency of information is necessary to allow a tribunal charged with resolving a controversy to reach an impartial and just result. When a tribunal standing in judgment is not given access to all available information, its ability to reach a fair result is limited, if not compromised. In a way, the view therefore questions the concept of "privilege" in court proceedings in general. This contrasts with the practice of a number of countries granting "privilege" with a view to promoting public interest in the observance of the law. Since in many civil law countries, a general "discovery" of documents in the possession of the other party is lacking or exists only in very limited case, the extent to which such protection is considered necessary for the administration of justice might be non-existent or might be limited.

Non-lawyer status of patent advisors

108. One of the arguments against the grant of common law client-attorney privilege to patent advisors is that in some countries, patent advisors do not have legal qualifications, nor are they admitted to the bar. Therefore, they cannot expect the same treatment with respect to the client-attorney privilege. Attorneys who are entitled to represent their clients before a court have a unique role to play in the administration of justice. Consequently, supporters of the argument consider that confidentiality between attorneys and clients should be treated differently from other confidential professional relationships.

109. On the other hand, some consider that the above view is formalistic, and differentiate the types of advice patent advisors offer to their clients. While technical knowledge is important in preparing a patent application, patent advisors provide legal advice relating to patentability and other relevant elements of the patent laws. An inventor knows best about his invention from the technical point of view. The major role of a patent advisor is to support the inventor by describing the legal scope of protection that meets all the requirements of the patent law. Therefore, while an understanding of the technical features of inventions is indispensable, the major contribution of patent advisors appears to be more of a legal nature. Further, the advice of a patent advisor may not necessarily be limited to the stage of filing a patent application, as he/she continues to provide advice after that stage in relation to the legal scope of protection throughout the life of the patent.

110. In some countries, while a legal qualification is not a requirement to become a patent advisor, he/she may also represent a client before a court with respect to certain IP cases. This could be considered as an indication of the existence of the special legal expertise of patent advisors. Further, in many countries, patent advisors are also bound by professional secrecy obligation, non-compliance with which could result in a severe sanction. Such an obligation is imposed on non-lawyer patent advisors in the same manner as on lawyer patent advisors. Consequently, bearing in mind the legal nature of their activities, some consider that protection against forcible disclosure in court proceedings should be applicable to the same extent to non-lawyer patent advisors.

Intermediary work of patent advisors

111. In some countries, patent advisors are entitled to represent clients only before a patent office but not before a court. The fact that patent advisors act only as intermediaries or conduits between their clients and the patent office has led to the argument that patent advisors do not deserve to be granted the client-attorney privilege understood as such under the common law system. According to the conduit theory, a patent advisor is simply an

intermediary between the patent Office and his or her client (i.e. an inventor or his or her successor in title). Since his or her task is limited to preparing documents for filings, the client should not expect coverage of the client-attorney privilege to communications with patent advisors.

112. Since one of the objectives of the patent system is to promote the dissemination of technological knowledge, all information disclosed in patent applications prepared by patent advisors will be made available to the public when the patent applications are published or patents are granted. Some consider that since both a patent advisor and his or her client know that the application will be disclosed at some point, such prior knowledge of disclosure defeats the purpose of client-attorney privilege.

113. On the other hand, the scope of patent advisors' work is not just explaining technologies underpinning the invention in a patent application. Obviously, a patent application should be prepared in such a way that the enabling disclosure requirement and other requirements relating to disclosure of an invention are complied with in accordance with the applicable patent law. A patent advisor should fully and completely describe all features of the invention and explain how the invention works and what the advantages of the invention are. However, drafting a patent application requires additional expertise that is not necessarily needed when writing an article for a technical journal or writing a technical book. While ensuring technical disclosure, a patent advisor also provides advice relating to the legal scope of protection, for example, how the claims should be drafted or how the description should be worded since it may be taken into account when interpreting the scope of the claims. This kind of advice which goes beyond the provision of technical disclosure may be protected from forcible disclosure.

114. The above discussion supports the argument that the work of patent advisors as intermediaries throughout the procedures before a patent Office has dual characteristics: technical as well as legal.

Disclosure requirement of patent applications and disclosure of communications with patent advisors in court proceedings

115. There needs to be a clear distinction between the public disclosure of inventions in patent applications and the public forcible disclosure of communications between patent advisors and their clients within the discovery procedure. Since the dissemination of technological information is one of the key objectives of the patent system, many national patent laws require that an applicant describe his/her invention in a patent application in a clear and complete manner so that a person skilled in the art would be able to carry out the claimed invention. In some countries, the applicant must also describe the best mode for carrying out the invention known to the inventor at the filing date (priority date). Further, in some countries, there is a duty of candour to faithfully disclose prior art, and in some countries disclosure statements have to be signed by applicants or patent attorneys to confirm the fulfilment of those requirements. In other countries, less strict requirements are applied, or there is no general obligation to provide a comprehensive list of prior art as part of disclosure.

116. Those requirements vary from one country to another, and are unrelated to the preservation of confidentiality of communications between patent advisors and their clients, such as privilege or professional secrecy obligation. For example, even if what had been discussed between a patent advisor and an applicant for the preparation of a patent application can be kept confidential, the applicant is obliged to publicly disclose all information necessary to comply with the disclosure requirements under the applicable patent law. Further, each country provides different sanctions for the non-fulfilment of

disclosure requirements in patent law, such as invalidation of the patent and measures related to inequitable conduct. Thus, preservation of confidentiality of communications with a patent advisor in court proceedings does not affect the general obligation of disclosure is fulfilled.

117. Although the public disclosure of inventions may not be compromised by privilege or professional secrecy, concerns have been expressed that the confidentiality of communications between a patent advisor and his client may hinder courts and patent offices from reviewing evidence relevant to the determination of the case, such as a document relevant to patentability. For example, a case has been cited where a patent agent, who had received from an inventor a draft patent specification containing a reference to a book that could become critical prior art for the determination of the patentability of an invention, had deleted the reference to that book from the patent application as filed, and the patent was granted. As this example suggests, although the deletion of the reference to the prior art book from the patent application does not remove the existence of that book as prior art, the privilege for patent advisors could result in keeping important information away from public inspection.

118. However, it could be argued that the patent advisor's advice to delete a relevant reference from the patent application was not in conformity with his professional ethics and code of conduct. He was in fact advising the applicant to seek the grant of a patent which was not valid or at least at risk to be invalidated if the prior art contained in the book was found and the patent challenged. In order to prevent such misuse, high standards of codes of conduct, disciplinary measures and sanctions are common mechanisms contained in national laws. It has to be noted that the objective of discovery in civil proceedings is not to monitor or sanction such misuse, but to provide the other party and the court with relevant evidence.

119. A similar criticism in respect of the confidentiality of legal advice from lawyers, and the necessity for judges to access all relevant evidence has also been expressed with respect to the privilege for lawyers. In the end, the issue comes down to a global policy consideration on balancing the various interests involved, and many countries have made conscious policy choices with a view to promoting the public interest in having the law respected.

120. In general, administrative *inter partes* procedures before patent offices apply, *mutatis mutandis*, to many aspects of the general civil procedural law. Therefore, the way in which the preservation of confidential communications with patent advisors affects administrative procedures before patent offices may be another element that could be examined. Since patent advisors, including non-lawyer patent advisors, represent their clients in such administrative procedures in many countries, Member States may be interested in looking into the experiences of national/regional administrative bodies that provide privilege for patent advisors or that allow patent advisors to refuse to testify or submit documents relating to confidential communications with clients.

Public interest and development

121. As discussed previously, there are both public and private interests behind the regulation of the confidentiality of communications with patent advisors, including non-lawyer patent advisors. In relation to the public interest, an environment that encourages a client to frankly communicate with his patent advisors would ensure a high quality of advice given by patent advisors and would overall benefit the patent system and the public in general through full compliance with applicable laws. However, there is another public interest aspect, namely, to investigate the truth for the sake of justice, which may require tabling all relevant information before a tribunal. Both at the national level and,

where the international dimension is considered, at the international level, there is a need to balance these competing interests. At the national level, many countries appear to be inclined to provide a mechanism allowing a limited scope of protection of confidential patent advice, which would not compromise the exercise of justice.

122. Although their qualifications and competence vary among national and regional applicable laws, in general, patent advisors play an important role in the "checks and balances" mechanism of the patent system. In particular, in many countries, technically qualified patent advisors, who are specialists in IP laws and technology, are essential players in a functional patent system. This has become more important in recent years, as the technology becomes more complex and the application of IP laws to cutting-edge technology becomes more challenging. Further, in addition to the preparation and prosecution of patent applications before a patent office, some patent advisors provide comprehensive business and IP advice, including general IP consulting, licensing strategies, and dispute resolution. A good understanding of technology and IP laws certainly helps giving such business-oriented IP advice. If a client is not able to frankly communicate with his patent advisors due to the fear of potential loss of confidentiality, this could have a direct impact on the quality of services provided by patent advisors. In view of the functions that patent advisors can assume for the promotion of innovation and transfer of technology, in general, high-quality services by patent advisors support the public interest.

123. Fewer options of professional IP services or the absence of patent advisors in developing countries does not mean that the issue under consideration is irrelevant to those countries. It is believed that, in those countries, lawyers carry out the tasks entrusted to patent advisors elsewhere and, therefore, the confidentiality of communications between an inventor and his lawyer providing advice on patent prosecution, litigation and other patent related questions needs to be respected both in the national and international contexts. Therefore, the information contained in this document may provide a good opportunity for these countries to consider the usefulness of establishing or strengthening a regulatory mechanism for a special IP profession in their countries.

124. The obligation for patent advisors to respect the confidentiality of information that becomes known to them in the course of their professional practice is a prerequisite to any kind of protection of such information. In this regard, high standards of professional codes of conduct and their binding effect, disciplinary measures as well as high standards of professional training may facilitate the recognition of protection of confidentiality of communications with patent advisors in court proceedings.

125. According to the information contained in this document and the result of the AIPPI Questionnaire[17], the current laws regarding preservation of confidentiality of communications with patent advisors seem to be deeply rooted in the legal tradition of each country, and the level of economic or technological development does not seem to be a determinant factor. Thus, while consideration of particular situations of countries in respect of their development may be important, on this particular topic, the different legal traditions may be more pertinent to the consideration of flexibility in the international system.

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17 https://www.aippi.org/download/onlinePublications/AIPPISubmissionto WIPOonConfidentialityof CommunicationsBetweenClients andtheirPatentAdvisiorsSeptember6-FINAL.pdf

COMMON LAW APPROACH TO THE PRESERVATION OF CONFIDENTIALITY

126. As seen, one general characteristic of civil procedure in common law countries is "discovery" (or disclosure) in a pre-trial phase. There, each party to litigation may request disclosure of relevant documents and other evidence in the possession of other parties. The discovery system was developed with a view to bringing all evidence to the attention of the court so that the truth can be ascertained. On the other hand, there is also a competing public need to keep certain information confidential from public inspection.

127. The reasons justifying the client-patent advisor privilege are similar to the justifications put forward in respect of the client-attorney privilege, i.e. the client's need for frank, honest and open communications with patent advisors to obtain the best intellectual property advice, and the competing public interest to use all rational means for ascertaining truth during an *inter partes* procedure. Another argument supporting the client-patent advisor privilege is that, even if not all patent advisors are qualified lawyers, patent advisors provide legal advice relating to patent law, such as the patentability of inventions or the legal scope of patent protection.

128. On the other hand, it could be noted that the client-attorney privilege was introduced in the common law systems not with the sole reason of the legal nature of the advice given by lawyers. The lawyers' strict adherence to a code of ethics plays an important role. In addition, the lawyers' ability to professionally represent their clients before the courts may require special consideration. Therefore, this particular difference between lawyers and non-lawyer patent advisors could be one of the factors that may justify different treatment with respect to the recognition of the privilege.

129. It appears that the common law countries, where the client-patent advisor privilege exists, provide a vigorous regulatory environment for patent advisors. Patent advisors must be registered with the competent authority, are required to pass an official examination to obtain the relevant professional title under the applicable national/regional law (for example, "patent attorney" or "patent agent"), and only those who have been registered with the competent authority can use such professional title and conduct professional services. They are also bound by high standards of professional codes of conduct. Therefore, it is assumed that a high professional qualification of patent advisors is an important consideration in those countries. However, in some other common law countries, the client-patent advisor privilege is not recognized even if patent advisors in these countries adhere to similar high standards. Further, some common law countries provide the client-patent advisor privilege even if non-lawyer patent advisors are not allowed to represent their clients before the courts.

130. The above differences suggest that, at least for some common law countries, the full legal qualification of patent advisors or the entitlement to act before courts is not a decisive factor to establish the privilege. Considering the above, are there any common factors applicable to all common law countries for the determination of either applying or not applying the client-patent advisor privilege? From the information gathered to date, no such common factor emerged.

CIVIL LAW APPROACH TO THE PRESERVATION OF CONFIDENTIALITY

131. In general, civil law countries protect the confidentiality of communications between lawyers and their clients in both criminal and civil procedures. Although they may be invoked less frequently in civil law countries than in common law countries, mechanisms exist that allow courts in civil law countries to issue an injunction order to the defendant, upon the admissible request of the plaintiff, to disclose a document which the plaintiff knows to be in the possession of the defendant. [18] There are also the so-called "*saisie contrefaçon*" procedure under French law or the possibility of a court ordering provisional measures to preserve relevant evidence, including seizure of documents. [19]

132. It appears that, in those circumstances, it is a well-established principle that confidential communications exchanged between lawyers and their clients would not be forced to be disclosed, recognizing the necessity of protecting the confidentiality of legal advice.[20] Further, in general, lawyers should refuse to testify as witnesses about any information provided to them in their professional capacity. The nature of the professional secrecy obligation, however, seems to be considered differently in different jurisdictions. In some, it is an absolute obligation derived from public order, and therefore, a client is not entitled to allow his lawyer to disclose the protected confidential communications. In others, it is a relative obligation where a client remains a custodian of the secret information. Therefore, they provide the possibility for a client to allow his lawyer to disclose the confidential communications.

133. With respect to communications with patent advisors, patent advisors are, in general, bound by the obligation not to disclose the communications made with his/her clients in their professional capacity. In an increasing number of countries, non-lawyer patent advisors are entitled to refuse to testify in court on any matter falling under the professional secrecy obligation. In some countries, they are also entitled to refuse to produce documents that contain information covered by the professional secrecy obligation. The right given to patent advisors to refuse production of the documents, however, does not fully avoid forcible disclosure of confidential information in court proceedings, since a client, who is often a party to the litigation, may be ordered to submit the document that contains such confidential information. In some countries, therefore, any party may, in principle, withhold in court proceedings documents containing confidential information under the professional secrecy obligation.

134. Therefore, communications with patent advisors (including non-lawyer patent advisors) are withheld from forced disclosure in litigation in some civil law countries in a manner similar to confidential communications with lawyers. Here again, taking into account the need to keep certain information confidential from public inspection, the broader public interest has been the key consideration of policy makers. Similar to common law countries, the above mechanism that is designed to maintain the confidentiality of communications with

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18 Article 6.1 of the EU Directive on the Enforcement of IP Rights (Directive 2004/48/EC) provides the following: "Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information."

19 The provisional measures, however, may be less relevant to the issue of confidentiality, since these procedures do not automatically lead to the disclosure of the seized documents.

20 See Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd v European Commission (Case C-550/07 P), Opinion of Advocate General Kokott, delivered on April 19, 2010 ("legal professional privilege is currently recognized in all 27 Member States of the European Union, in some of which its protection is enshrined in case-law alone, but in most of which it is provided for at least by statute if not by the constitution itself."

patent advisors during litigation does not seem to be applied uniformly in all civil law countries. This may be due to the various reasons, for example, the differences among national laws with respect to the evidence gathering rule in civil procedure, significance of the professional secrecy obligation, seriousness of sanctions in case of breach of confidentiality, professional duties and a code of conducts of patent advisors etc.

CROSS BORDER ASPECTS

The international dimension: cross-border recognition of confidentiality

135. Once a client seeks patent protection beyond the national territory, the territoriality principle requires him/her to obtain a patent in each country in which patent protection is sought. Obtaining and maintaining patents in foreign countries often involve advice from patent advisors in each of those countries either directly or via a national patent advisor. This is because a client often seeks advice from each national expert who is an expert on the relevant national patent law, and many national laws require that foreign applicants shall be represented by a national patent advisor authorized to act before the national office concerned. Similarly, if a third party seeks to extend his business beyond the territorial border by, for example, exporting his products to a second country, he/she may find a patent relevant to his/her product in the second country. It is most likely that the third party will first consult an IP specialist in his country and, in addition, will seek advice from a patent advisor in the second country.

136. In general, if a client (who could be an applicant, a patentee or a third party) obtains advice from patent advisors from more than one country, each patent advisor is bound by the confidentiality obligation pursuant to each national law. This is the case regardless of whether the patent advisor is from a common or civil law country, or whether the patent advisor is a lawyer or a non-lawyer. In essence, although the exact wording of national laws varies, at least any confidential information that patent advisors receive from their clients in the course of their professional activity must be kept secret.

137. The question, then, arises as to how a confidential communication with a national patent advisor will be treated by foreign courts and how such communication with a foreign patent advisor will be treated during litigation in the client's home country.

138. As described above, not all courts in all countries recognize the confidentiality of communications between a party and his foreign patent advisor during a court procedure. In particular, where the foreign patent advisor is not a qualified lawyer, the risk of non-recognition of the confidentiality by courts increases. Consequently, even if communication between the party and his foreign patent advisor can be kept secret in the jurisdiction of the foreign patent advisor, the same communication could be subject to disclosure during litigation in another country.

139. Applying a privilege to foreign patent advisors at the international level may be made more complex by the fact that the so-called "patent advisors" are defined differently from one country to another. Each national law provides the qualification requirements of patent advisors, and the scope of their professional activities depends on the applicable law.

Legal uncertainty

140. The lack of explicit laws and rules dealing with cross-border aspects of confidentiality brings uncertainty as to whether the courts are bound to recognize confidentiality arising under the law of other jurisdictions. Even if there are applicable laws and rules, in reality, there is much uncertainty in many countries in this area: firstly, the issue often has not been

addressed, and therefore, the laws and rules have never been interpreted; and secondly, where the treatment of communications with foreign patent advisors is decided by local courts on a case-by-case basis, varied decisions have been rendered by courts. Such unpredictable court decisions impose additional costs for parties. In addition, the parties have to fight over procedural questions and spend their resources on those matters before addressing the substantive issues. Such uncertainty is obviously a risk factor for clients who have to seek advice from foreign patent advisors or who are increasingly exposed to patent disputes in foreign countries. In this regard, there are no differences among clients and patent advisors from common law and civil law countries.

International solution respecting national realities

141. Many issues surrounding the protection of confidential communications with patent advisors relate to national judicial procedures and national legal tradition. It is neither practical nor realistic to expect that a single uniform judicial procedural rule governing each country could be established in the near future. At the international level, however, the fundamental issue relating to the preservation of confidentiality of communications with patent advisors is that the confidentiality accepted in one country may not be recognized in another country. Although the similarity between national laws may render an international recognition easier, it might be possible to find a solution through international cooperation while preserving the various national legal traditions. It appears that an appropriate level of flexibility is essential, taking into account different national judicial procedures.

142. In many countries, the rules regarding the preservation of confidentiality of communications between patent advisors and their clients are not found in the patent law. However, patent advisors are often registered with a competent national patent office, and they work closely with patent offices. Above all, a strict adherence to the professional confidentiality by patent advisors affects the quality of professional advice, and has implications for the patent system at large. While the preservation of confidentiality of communications with patent advisors has an impact on the proper functioning of the patent system, the issue under consideration may be an integral part of civil and criminal procedural rules, and therefore, it cannot be considered in isolation by patent offices only. Similar to any other issues that touch upon the competence of more than one administrative unit, close coordination among relevant administrative units at the national level is indispensable in order to advance discussions at the international level.

OTHER ISSUES

143. Another issue which is often raised by patent practitioners is whether communications between an in-house patent advisor and his/her client, i.e., an employer, should be given the same level of preservation of confidentiality of advice as in the case of independent patent practitioners. Some advocates that the same treatment should not be given, since in-house patent advisors are not sufficiently independent from their employer to form an unbiased opinion.[21] However, some others consider that communications with in-house patent advisors should be treated in the same manner as external patent advisors, since all practitioners are under the professional duty that exceeds loyalty to the employer.[22] In their

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21 In Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd v Commission (Case C-550/07 P) [2010], the Court of Justice of the European Union confirmed that privilege does not apply to communications between a company and its in-house lawyers in the context of EU antitrust investigations.

22 In Alfred Crompton Amusement Machines, Lord Denning said that salaried legal advisers are 'regarded by law as in every aspect in the same position as those who practice on their own account. The only difference is that they act for one client only, and not for several clients.

view, the same protection is justified, since in-house patent advisors are the first to get in touch with patent conflicts and are indispensable for quick legal action, provide first aid to the employer, contribute to industry-specific interpretation of patent cases, are frequently coordinating multi-national conflicts, and make proposals for strategy to the client's management.[23]

POSSIBLE REMEDIES IDENTIFIED ON THE CROSS-BORDER ASPECTS

144. In the context of the cross-border aspects of preserving the confidentiality of communications between patent advisors and their clients, the issues described above arise, in principle, where the following two conditions are simultaneously met:

(i) the national procedural law provides a mechanism (discovery proceedings or any other similar proceedings) that obliges the production of information with respect to confidential IP advice by patent advisors to a court; and

(ii) the national law does not fully recognize the privilege or confidentiality of IP advice given by foreign patent advisors.

In those circumstances, confidential IP advice given by a patent advisor may be kept secret in some jurisdictions, but risks forcible disclosure in others. In order to remedy this situation, a mechanism could be envisaged under which the confidentiality of IP advice by patent advisors is recognized beyond the national border.

145. In order to achieve seamless cross-border recognition of confidentiality, it may be useful to consider two aspects, i.e., the standards regulating the substantive law of the privilege of patent advisors, and the standards for the recognition of foreign law on privilege. These two aspects are reflected in the possible remedies identified below. In addition, even if they are not perfect solutions, practical approaches to remedy the problems have been applied by practitioners in the absence of legal rules. The following paragraphs will describe those different approaches.

146. In preserving the confidentiality of IP advice beyond national borders, none of the approaches identified above oblige civil law countries to introduce, in their national procedural laws, an evidentiary privilege akin to that of common law countries, as long as their procedural laws do not provide any proceedings that would require a party to produce communications containing confidential IP advice to a court.

RULES CONCERNING THE RECOGNITION OF FOREIGN PATENT ADVISOR PRIVILEGE

Extension of national patent advisor privilege to foreign patent advisors

147. One type of possible remedy would consist in extending, through national laws, the legal professional privilege provided in relation to communications between national patent advisors and their clients to communications with certain foreign patent advisors from both civil law and common law countries. In more general terms, the applicable national rules that govern the preservation of confidentiality of communications with national patent advisors would be also extended to such communications with certain foreign patent advisors.

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[23] Hans Blöchle, Seminar on the Confidentiality of Advice from Patent Advisors, SCP/21, Nov. 5, 2014.

148. The tests found in the laws of Australia and New Zealand in defining certain foreign patent advisors whose privilege is recognized are inclusive rather than limiting. The law of New Zealand recognizes the privilege of foreign patent advisors whose functions correspond to those of registered patent attorneys in New Zealand. According to the Raising the Bar Act of Australia, the privilege of foreign patent advisors who are authorized to do patents work under the law of their country or region is recognized. In determining the conditions for recognition, national courts have to look into the respective foreign law in order to identify whether a foreign patent advisor has the "corresponding functions" or the "authorization to carry out patents work". To provide administrative guidance to courts and interested parties, a list defining the recognized countries may be established by the government, which is the case in New Zealand.[24]

149. The extension of the privilege could, but would not necessarily have to be, based on reciprocity. As the merit of this type of remedy lies in its simplicity, adding additional layers of reciprocity might complicate the determination of the recognition of the privilege granted to foreign patent advisors. Another merit of introducing inclusive conditions for the recognition of the privilege for foreign patent advisors is that parties in litigation are able to focus on the substantive issues under dispute, rather than spending money and time on procedural issues. Further, since the substantive law on privilege is defined by each national law, countries are free to define, in their law, the scope, exceptions and limitations, types of communications covered and the categories of foreign patent advisors to whom such substantive law of privilege applies. In other words, countries can maintain their flexibilities in terms of substantive law on privilege or professional secrecy obligation.

150. The asymmetry of the cross-border protection of confidential IP advice, however, does not entirely disappear through this type of approach. For example, even if the confidentiality of communications with a non-lawyer patent advisor is recognized in another country, if those communications are not privileged under the national law of his/her country, the confidential IP advice given by that patent advisor may be subject to discovery in his/her home country. Privileged communications with patent advisors in one country may not be privileged in another country, and communications with patent advisors from countries without privilege will continue to be subject to potential disclosure.

151. As regards the types of instruments to achieve the extension of national patent advisor privilege to foreign patent advisors, various types of instruments can be envisaged, for example, a binding instrument, a soft law approach or a unilateral adoption of similar rules by each country. So far, the unilateral extension of the recognition is achieved by including a provision in domestic laws on evidence or patent laws. Depending on the national legal tradition, it could also be possible to apply the principle as part of conflict of law rules through case law. No international action is required for such a unilateral action. While countries may have some incentives to introduce privilege in their national law (in particular, if the extension is subject to reciprocity), such a unilateral process may take a long time to be generally applicable among countries, and the diversity of different national practices will remain. The soft law approach can take different forms. For example, WIPO Member States or a WIPO body may adopt non-binding principles that could be applied at the national level, or model provisions that could be utilized and adjusted to the legal systems at the national level may be prepared.

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24 Evidence (Recognition of Overseas Practitioners) Order 2008: http://www.legislation.govt.nz/regulation/public/2008/0202/latest/whole.html.

Recognition of confidentiality established in foreign countries

152. A similar mechanism would be to recognize the privilege existing in other countries, or/and grant the same privilege for the purpose of the court procedures in one's own country. For example, even if country X does not provide full privilege with respect to communications with patent advisors under its national law, the court of country X would recognize the privilege with respect to communications with a patent advisor in country Y, if the latter communications are privileged in country Y.

153. Under this mechanism, at least the client will not lose confidentiality of the privileged communication with his patent advisor in another country. However, the national differences with respect to the entitlement to privilege will remain. Further, communications with patent advisors in countries without privilege will continue to be subject to potential disclosure. A comparable approach can be found with respect to the right of priority under Article 4 of the Paris Convention, where priority can be claimed on the basis of a "regular national filing" under the applicable law. Although the substantive requirement for according a filing date is not necessarily harmonized among the Member States of the Paris Convention (for example, some require the payment of a filing fee and others do not), they accept any filing that is adequate to establish a filing date in the country of first filing as the basis for subsequent priority claims.

154. Similar to the extension of national patent advisor privilege to foreign patent advisors, possible instruments for the recognition of confidentiality in foreign countries may include a binding instrument, a soft law or a unilateral action by each country.

An international framework for mutual recognition of privilege (ICC proposal)

155. The International Chamber of Commerce (ICC) has suggested a framework that extends the recognition of privilege to foreign patent advisors who are designated by the respective foreign authorities.[25] In essence, the suggested framework consists of the following elements:

(i) Each country should specify categories of advisors whose clients benefit from privilege before the State's Courts, intellectual property offices, tribunals, and investigators. These should be all such local general lawyers and local specialist IP advisors as the State considers to be adequately regulated, plus (in the case of EPC members) locally-resident European patent attorneys (both private practice and in-house);

(ii) Within each country, certain communications[26] from or to the specified categories of advisors should be privileged (together with documents, material, and information preparatory to or otherwise related to such communications); and

(iii) Each country shall respect the privilege of the communications under (ii) from or to advisors specified by other countries under (i).

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25 The detailed description of the ICC suggestion is found in paragraphs 41 to 46 of document SCP/16/4 Rev.

26 The ICC defines the term "communications" as follows: "communications as to any matter relating to any invention, design, technical information, trade secret, trade mark, geographical indication, domain name, literary or artistic work, performance, software, plant variety, database, or semiconductor topography, or relating to passing off or unfair competition".

156. The above framework would allow, at least within the countries participating in the framework, seamless cross-border recognition of the privilege of certain foreign patent advisors designated by each country. Each country maintains its autonomy to decide on which group(s) of professions is(are) "considered to be adequately regulated". Further, the substantive law of privilege can be largely defined by each national law, such that each country may decide, for example, on the scope of, and exceptions and limitations to, the privilege.

157. As regards the mechanisms for establishing a possible framework, since it envisages an international mutual recognition of privilege, the most straightforward way to ensure such a legal effect is an international instrument. Another option would be a system under which national laws give effect to an international list of patent advisors administered by an international body listing specific categories of professionals designated by each country and whose clients would benefit from the recognition of privilege in all countries which accept the effect of that international list.

International minimum standards or convergence of the substantive rules on privilege

158. Another way to ensure the recognition of foreign privilege beyond national borders is to seek minimum convergence of substantive national rules on privilege among countries. One may envisage a common set of substantive rules that effectively prevent confidential IP advice from being disclosed to third parties, regardless of the nationality or the place of registration of patent advisors and of the place where the IP advice was given. If a uniform standard for privilege were applied to both national and foreign patent advisors on intellectual property matters in all countries, the confidentiality of IP advice by patent advisors would be recognized beyond their national borders, whatever choice of law rules these countries may adopt.

159. To this end, a Joint Proposal for the establishment of a minimum standard of protection from forcible disclosure of confidential IP advice has been developed by the American Intellectual Property Law Association (AIPLA), the International Association for the Protection of Intellectual Property (AIPPI) and the International Federation of Intellectual Property Attorneys (FICPI).[27]

160. While cross-border legal aspects are not completely absent under the above Joint Proposal, since courts, for example, would have to look into foreign law to determine if a person is officially recognized as eligible to give professional advice, the core question of the scope of the privilege would remain the same in every case.[28]

161. On the one hand, the more uniform the substantive rules on privilege become at the international level, the more predictability potential parties to litigation (clients and their patent advisors on the plaintiff side as well as on the defendant side) may enjoy. On the other hand, considering the current differences with respect to national laws in this area, Member States may need some flexibility, should they implement an international standard.

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27 https://www.aippi.org/?sel=publications&sub=onlinePub&cf=colloquium. The Joint Proposal consists of a preamble part and an agreement part. See footnote 25 for the full text of the Joint Proposal. See also Annex II of this document.

28 See also John T. Cross, Evidentiary Privileges in International Intellectual Property Practice, INTA Annual Meeting 2009.

162. As regards possible mechanisms for international minimum convergence of substantive rules on privilege, in addition to the adoption of a binding instrument, a soft law approach, such as recommendations or model provisions, could be envisaged. Further, international minimum convergence of certain principles through unilateral adoption of similar rules by each country at the national level may be an option, if a sufficient number of countries found benefits in implementing such principles in their national laws.

CHOICE OF LAW RULES

383. The standard applied by the courts of some countries in deciding whether the privilege should apply in relation to communications with foreign patent advisors is to consider whether or not such communications would have been privileged in the foreign law of the country concerned. Such recognition of foreign privileges or secrecy obligations has been applied by courts in the United States.

163. As stated earlier, some civil law countries have amended their national legislation to expressly recognize the privilege in respect of patent advisors, with the aim of achieving foreign recognition through the application of the choice of law rule. While such an approach might provide a remedy in foreign countries where the recognition of patent advisors' privilege in other countries is based on the conflict of law/international private law rule, including the comity rule, it does not have any effect in those foreign countries that apply the *lex fori*.

164. On the one hand, the application of the choice of a law rule does not require amendments of substantive domestic rules on privilege. On the other hand, such a rule has been developed by courts, and even if a common choice of law rule on the recognition of foreign privilege were to be established, the divergent substantive laws on privilege would continue to exist, thus making it impossible to fully avoid forcible disclosure of confidential IP advice by foreign courts.

165. As regards mechanisms to facilitate the recognition of foreign patent advisors' privilege through choice of law rules, various possibilities could be considered, for example, the unilateral adoption of common rules at the national level, a soft law approach or the adoption of an international agreement.

PRACTICAL APPROACHES

166. In the absence of an international legal framework that effectively recognizes confidentiality of IP advice at the global level, a number of practical remedies have been sought by practitioners in order to avoid forcible disclosure of confidential IP advice in their countries as well as in foreign countries. However, certain practical measures such as increased use of oral communications or co-signature of documents with a lawyer and a patent advisor, are not considered as being always efficient, and may increase the cost of providing IP advice.

Cooperation with lawyers

167. In some countries, non-lawyer patent advisors use the services of lawyers in provision of their services to clients. In particular, non-lawyer patent advisors provide their written communications/counseling to clients co-signed by lawyers. Such an approach may, however, complicate and raise the cost of IP legal advice.

Increased use of oral communications

168. Patent advisors often communicate orally instead of in writing, to avoid the disclosure of confidential information in litigation in other countries. This may complicate the counseling process and prevent the establishment of useful documentation.

Contractual confidentiality agreements

169. Patent attorneys who are not bound by confidentiality obligations in foreign jurisdictions could be bound by contractual confidentiality agreements. However, it is not clear whether such agreements would be effective against forcible disclosure in all different pre-trial discovery proceedings. In most jurisdictions, patent attorneys are already bound by domestic secrecy obligations.

[Annexes follow]

BRIEF SUMMARY OF RELATED SCP DOCUMENTS

1. Document SCP/13/4: The Client-Attorney Privilege

Document SCP/13/4 provided some examples of the legal situations in various countries describing the differences between the civil law and common law systems, addressed issues arising in the international context, and contained some of the options for solutions that had been discussed at the international level.

2. Document SCP/14/2: The Client-patent Advisor Privilege

Document SCP/14/2 expanded the information on the legal situation in various jurisdictions in a country study, examined the international dimension as contained in various provisions contained in international instruments such as the Paris Convention, the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement) and the General Agreement on Trade in Services (GATS), provided various arguments in relation to the rationale behind the client-patent advisor privilege, summarized the key findings and illustrated examples of potential areas for future work.

3. Document SCP/16/4 Rev.: Confidentiality of Communications Between Clients and their Patent Advisors

Document SCP/16/4 Rev. brought together those two studies by summarizing the major points discussed at the previous sessions, and providing further analysis. It suggested that the Committee could come to some common understanding that might become the basis for pursuing the topic further and presented a non-exhaustive list of subjects that might be relevant to the discussions on this subject at the international level.

4. Document SCP/17/5: Information on Cross-Border Aspects of Confidentiality of Communications between Clients and Patent Advisors

Document SCP/17/5 gathered information about national and regional practices regarding cross-border aspects of confidentiality of communications between clients and patent advisors, including, *inter alia*: (i) national laws and rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors; (ii) problems in relation to cross-border aspects of confidentiality of communications between clients and patent advisors; and (iii) remedies that are available in countries and regions to solve the problems that remain at the national, bilateral, plurilateral and regional levels.

5. Document SCP/18/6: Approaches and Possible Remedies to Cross-Border Aspects of Confidentiality of Communications between Clients and Patent Advisors

Document SCP/18/6 expanded document SCP/17/5 to explain approaches to cross-border issues and possible remedies identified in the area of confidentiality of communications between clients and patent advisors. It gave an overview of the existing national laws, introduced in the issues in relation to cross-border aspects, analyzed the approaches to cross-border aspects and identified possible remedies with respect to cross-border issues.

6. Document SCP/25/4 (Compilation of Court Cases with Respect to Client-Patent Advisor Privilege)

Document SCP/25/4 compiles national court cases relating to client-patent advisor privilege issues.

[Annex II follows]

WORK UNDERTAKEN BY INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

The issue client-patent advisor privilege was given attention by IP practitioners who have been involved in advising clients. Work has been undertaken by a number of non-governmental organizations, such as the International Federation of Intellectual Property Attorneys (FICPI), the International Association for the Protection of Intellectual Property (AIPPI) and the Asian Patent Attorney Association (APAA), among others.

FICPI

FICPI adopted, at its 2000 World Congress in Vancouver, Canada, from June 12 to 16, the resolution A which urged "appropriate authorities in countries and regions to amend their laws to establish an appropriate system of recognition of qualified intellectual property practitioners."[29]

At its World Congress in Berlin, Germany, from June 2 to 6, 2003, FICPI passed another resolution (Resolution 4) addressing the issue of "qualification of professional representatives and practice across national borders".[30]

AIPPI

A milestone in AIPPI's work was Q163 which was set up to investigate the application of privilege to clients of patent and trade mark attorneys. In its preliminary work, the Committee of Q163 found that there were significant differences between countries in the treatment of privilege.[31] It noted that a number of major factors influenced the type of protection available to patent and trade mark attorneys, including the following:

- The availability of discovery or forced disclosure in the jurisdiction.
- The status of the patent or trade mark professional in the jurisdiction.
- The common law/civil law condition of the jurisdiction.
- The imposition of criminal penalties on patent or trade mark attorneys who reveal their client's confidential information.

In 2003, at its EXCO meeting in Lucerne, AIPPI passed a Resolution arising from the work of Q163 of which the most relevant part is cited below:

> "That 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 trade mark 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 trade mark offices), and their clients regardless of whether the substance of the communication may involve legal or technical subject matter."

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29 http://www.ficpi.org/library/Resolutions/CA2000-RES-1GB.pdf
30 http://www.ficpi.org/library/Resolutions/DE03-RES-4GB.pdf
31 Documents prepared by the Committee of Q163 are available at: https://www.aippi.org/?sel=questions&sub=listingcommittees&viewQ=163#163

The heart of the AIPPI Resolution is that clients of patent and trade mark attorneys should be afforded the same level of protection by privilege as communications between clients and their legal attorneys. AIPPI decided to put more work into raising the attention of governments, among others through WIPO, in order to address the issue. The organization made a decision to explore the avenue of an international instrument as a solution to the perceived problems and approached WIPO in order to explore the possibility to further investigate the matter with WIPO Member States. In that context, AIPPI suggested an international basic standard in 2005[32].

As a result of those contacts, it was decided to hold a WIPO-AIPPI Conference on Privilege, which was held on May 22 and 23, 2008, in Geneva. The Conference was attended by Member States, Intergovernmental Organizations, Non-Governmental Organizations and private persons. It raised much interest and covered a broad range of issues, including an overview of the issues, the presentation of cases in common and civil law systems, the potential and real pitfalls in multiple jurisdictions, developments in various jurisdictions, the point of view of companies, including in respect of in-house counsels and options for improvement.[33]

In 2010, AIPPI passed another Resolution arising from the work of Q199, entitled client Privilege in IP Professional Advice (CPIPPA). It resolved that:

> (i) through WIPO to urge the Member States in the SCP to mandate WIPO to conduct the necessary studies to identify remedies to the problems of the protection and to define a preferred solution from the options for remedies which it so identifies, and that this work should proceed urgently following the closure of the SCP 15 meeting; and
>
> (ii) to make available to WIPO and to its Member States, the AIPPI resources for WIPO to use in relation to its work on remedies as it may be mandated by the SCP to carry out.

APAA

At its 55th Council meeting held in Singapore from October 18 to 21, 2008, APAA put the question of privilege on the agenda and organized a workshop entitled "What Privilege? Whose Privilege?" The event had a considerable success, and APAA adopted a Resolution supporting a solution at the international level.[34] It resolved that:

> "confidential communications between a client and its qualified IP professionals (whether domestic or foreign) should be recognized as privileged communications internationally, so that the client's position can be appropriately protected internationally"; and
>
> "in order to ensure full and frank communications between a client and its qualified IP professionals (whether domestic or foreign) without any risk of disclosure of their confidential communications, an international consensus on setting minimum standards of privilege should be built so that all national legal systems should be harmonized in such a way that such confidential communications can enjoy privilege internationally".

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32 http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_www_100879-related2.pdf. The proposal was updated in 2012 (http://www.ficpi.org/AIPLA-AIPPI-FICPI-Colloquium/Primer.pdf).

33 The full program can be found on WIPO's website at http://www.wipo.int/meetings/en/2008/aippi_ipap_ge/program.html

34 http://wwwapaaonline.org/pdf/APAA_55_council_Meeting/Minutes_of_the Singapore_Council_Meeting_in_2008_AfternoonSession.pdf

COMMUNIQUÉ FROM AIPLA, AIPPI & FICPI

From June 26 to 28, 2013, AIPLA, AIPPI and FICPI jointly organized a colloquium entitled "Protection of Confidentiality in IP Advice (PCIPA or the Protection) – National and International Remedies" in Paris, France.[35] The Colloquium was held to encourage consensus on a framework to protect confidential IP advice given to a client by lawyer and non-lawyer IP advisors. The three organizations issued a joint Communiqué[36] after the Colloquium, in which it is stated that "In both common and civil law systems an agreement could be made that communications relating to IP professional advice with lawyers and/or non-lawyer IP advisors shall be either confidential to the client or subject to professional secrecy and shall, in both cases, be protected from disclosure to third parties unless made public by or with the authority of the client." In addition, at and after the Colloquium, the three organizations drew up a Joint Proposal[37] for the establishment of a minimum standard of protection from forcible disclosure of confidential IP advice. The essential agreement part of the Joint Proposal reads as follows:

> "1. In this Agreement,
>
> 'intellectual property advisor' means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person, where such person is officially recognized as eligible to give professional advice concerning intellectual property rights.
>
> 'intellectual property rights' includes all categories of intellectual property that are the subject of the TRIPS agreement, and any matters relating to such rights.
>
> 'communication' includes any oral, written, or electronic record whether it is transmitted to another person authorized to receive such communication or not.
>
> 'professional advice' means the subjective or analytic views or opinions of an intellectual property advisor and is not meant to include mere statements of fact.
>
> "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.
>
> "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."

[Annex III follows]

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35 https://www.aippi.org/?sel=publications&sub=onlinePub&cf=colloquium.
36 *Ibid.*
37 *Ibid.*

COMPILATION OF LAWS AND PRACTICES

1. ARGENTINA

Article 75 of Law No. 24.481 on Patents and Utility Models and subsequent amendments, consolidated and amended by Decree 260/96, provides that the usurpation of the rights of the inventor shall be deemed to be an offence of counterfeiting punishable by imprisonment of six months to three years and a fine. Further, Article 77 states that "The above sentence shall be increased by one-third in the case of a person who:

(a) was a partner, representative, advisor, employee or worker of the inventor or of his assignees and who misappropriates or discloses the as-yet unprotected invention;
(b) obtains the disclosure of the invention through the corruption of a partner, representative, advisor, employee or worker of the inventor or of his assignees; or
(c) violates the obligation of secrecy imposed by this law".

Likewise, this issue is also addressed by Article 5(B) of the ANNEX of the Ruling No. 101/96 of the National Industrial Property Institute approving the Regulations Governing the Profession of Industrial Property Agent. This ruling is only applicable to industrial property agents.

The relevant parts of the Ruling state the following:

"Buenos Aires, April 18, 2006

The profession of industrial property agent has always been directly linked to the services provided, by legal imperative, by the National Industrial Property Institute.

Article 33 of Decree No. 1141 of November 26, 2003 of the Executive arm of Government, amending Decree No. 558/81 regulating Law No. 22.362 on Trademarks, authorizes the National Industrial Property Institute to regulate the professional responsibilities, rights and obligations, qualification examinations and conditions of registration of the industrial property agents whose licensing it oversees.

The same aim underpinned the delimitation of the powers vested in the disciplinary body, it being understood that to remain a mere observer in the face of certain types of unethical behavior adversely affected the image of industrial property agents, a group of professionals long linked with excellence and specialization. Accordingly, a shortcoming in the relevant legislation in force was remedied.

The system of sanctions is designed to guarantee fully and absolutely the right of defense of agents, allowing related associations to participate and ensuring the impartiality of the judgment through the establishment of the Disciplinary Committee.

Moreover, the interests of the individual and the protection with which the Administration is duty-bound to provide to him in order successfully to safeguard his industrial property rights were the primary reason for incorporating the obligation of assistance for highly technical issues, limited to the processing of trademark applications and administrative appeals, broadening the individual's right to take legal action by providing for free representation.

For these reasons,

THE PRESIDENT OF THE NATIONAL INDUSTRIAL PROPERTY INSTITUTE

DECIDES:

ARTICLE 1
The Regulations governing the Profession of Industrial Property Agent, annexed hereto, form an integral part of this ruling and are hereby approved.

ANNEX
REGULATIONS GOVERNING THE PROFESSION OF INDUSTRIAL PROPERTY AGENT
Definition: Industrial property agents are natural persons enrolled in the Registry of Industrial Property Agents maintained by the National Institute of Industrial Property, in accordance with the provisions of these regulations.

ARTICLE 2. Requirements
Persons wishing to be registered as industrial property agents must meet the following requirements:
[…]
(d) Prove the absence of a criminal record in relation to the crimes mentioned in Article 3(b) and (c) of these regulations, through certification issued by the National Registry of Repeat Offenders.

ARTICLE 3. Impediments
The following may not be registered as industrial property agents:
[…]
(b) persons convicted of breach of confidentiality under Art. 70 of Decree No. 260/96, Annex II regulating Law No. 24.481, Art.156 of the Criminal Code and Law No. 24.766, for the duration of the sentence;
(c) persons convicted of any wrongful act against a national, provincial or municipal administration, for the duration of the sentence;
(d) unrehabilitated bankrupts; and
(e) any person who, for whatever reason, is legally disqualified from practicing a profession, from trade or from industry.

ARTICLE 4. Effects and Powers
(a) The intervention of an industrial property agent or of an attorney shall be mandatory in the following cases: (1) challenge to legal opinions of the National Institute of Industrial Property in trademark applications, corresponding to codes 1, 2 a, b, c, d; 3a, b, c, d, e, f, g, h, i, j; 4, 5, 6, 7, 8, 9, 10, 11 and 12 mentioned in Annex 1 of Decision No. M-545/04; and (2) administrative appeals. In the cases mentioned in this paragraph, the National Institute of Industrial Property shall state in its opinion that it must be challenged with the obligatory assistance of an industrial property agent or a lawyer […].

ARTICLE 5. Duties
Industrial property agents shall at all times conduct themselves professionally in accordance with the importance of the tasks entrusted to them, being especially obliged to perform the following:

(a) Properly advise persons who retain their services.
(b) Maintain confidentiality with respect to all the reserved information received in the practice of their profession, in connection with the matter entrusted to their care.
(c) Observe due diligence in the fulfillment of the formalities under their responsibility.

(d) Take the necessary steps to avoid prejudice to their clients in case of outstanding impediments to the fulfillment of their mandate or in case of abandonment. In such case, the client must be notified of the new development by reliable means within at least 10 days before the effective termination of their action in the case.
(e) Conduct themselves properly at all times in regard to other colleagues, personnel of the National Institute of Industrial Property and the public in general and within the National Institute of Industrial Property, both in performing the professional tasks entrusted to them and in offering their services and in their conduct after the cessation of services.
(f) Represent indigent applicants free of charge, only in cases where such representation is mandatory. To this end, the National Institute of Industrial Property shall designate the industrial property agent that will deal with each case by successive numbers following the order of registration, and the designated industrial property agent selected shall be notified by reliable means. The designated industrial property agent may only be excused for duly substantiated reasons, for which purpose he must file the application to be excused within five business days of his designation, failing which he will be deemed to have accepted the charge. Failure to comply with his or her duty or to perform it with due diligence shall be grounds for application of the disciplinary sanctions provided for in Art. 7. The application for free representation shall suspend the terms of the due diligence, which shall begin to run from the acceptance of the charge by the designated industrial property agent. Persons applying for the benefit of indigence must file a duly legalized certificate of indigence issued by a judicial authority.
(g) When, by express instructions of the owner, an industrial property agent must intervene in ongoing cases in which a colleague is authorized, he must so inform the latter in writing, except in cases of urgency, in which he may effect the notification within 5 working days of his assumption of duty.
(h) Industrial property agents shall refrain from employing means incompatible with professional decorum, probity and dignity in order to procure clients.

ARTICLE 6. Prohibitions

(a) Without prejudice to the stipulations in the substantive rules, the following are set forth as specific cases of conduct from which industrial property agents are prohibited:
(b) Unduly retaining documentation belonging to their clients.
(c) Representing opposing interests within the same case file in any of its instances. This prohibition also extends to industrial property agents working in the same chambers.
(d) Submitting instruments or statements, where the submitting party inexcusably knows or should know that they are totally or partially false, in any case or action brought before the National Institute of Industrial Property.
(e) Removing or extracting without receipt or authorization files, documents or acts submitted to the National Institute of Industrial Property.
(f) Adulterating and/or totally or partially destroying files, documents or acts submitted to the National Institute of Industrial Property.
(g) Intentionally withdrawing instruments or acts submitted to National Institute of Industrial Property, while being aware that there was no representation or authorization on the date of the withdrawal.
(h) Receiving sums to pay fees to the National Institute of Industrial Property, while omitting to deposit the submissions in order to make them effective.
(i) Conducting publicity that may be misleading or that offers or implies solutions that are contrary to law, morality or public order.
(j) Publicizing or offering, either by themselves or through third parties, services that fall within the purview of the National Institute of Industrial Property.

ARTICLE 7. Disciplinary sanctions
Failure of industrial property agents to comply with these regulations may entail the following disciplinary measures after the relevant summary proceedings and a reasoned decision:

(a) Written warning: for those acts that involve a violation of the obligations established in Articles 5(a), 9(b), (c) (d), (e) (f) (h), and (i) and have caused damage to property.
(b) Suspension of the registration for ninety days: this shall apply to acts that violate the prohibitions set forth in Art. 6(a), (b), (g), (h) and (i) and when, within 2 years of a final warning, a person repeats the conduct that led to the sanction.
(c) Cancellation of the registration: this shall apply to those acts that violate the prohibitions set forth in Art. 6(c), (d) and (f) where, following a final suspension ruling, a person repeats the conduct inviting such sanction. After cancellation, a new registration may only be allowed after three years elapse following the effective application of the measure.

ARTICLE 8. Disciplinary process
[…] accepting all means of proof provided for in the Code of Civil and Commercial Procedure that are relevant for reaching a decision.

The President of the National Institute of Industrial Property shall form a Disciplinary Committee within five business days of being seized of the matter and shall make a ruling within 20 business days thereafter. The resolution shall be appealable as established in Article 9 of these regulations. The Disciplinary Committee shall be composed of the President of the National Institute of Industrial Property, who shall be the chair, and by two permanent members of the Advisory Council of the National Institute of Industrial Property representing different entities, as designated by the President of the National Institute of Industrial Property. The Disciplinary Committee shall adopt its decisions by a majority.

ARTICLE 9. Appeals
[…]

ARTICLE 10. Cancellation of the registration
Cancellation shall occur in case of death, resignation, and where the reasons for incompatibility set forth in Article 3 occur. The registration shall be presumed abandoned for lack of payment of the annual fee for 3 consecutive periods, without prejudice to the ability of the National Institute of Industrial Property to initiate debt collection proceedings. In such case, and only where the prescribed time limit has elapsed, the agent's action will cease ex officio in all ongoing proceedings and the agent shall be personally liable for damages caused to his or her clients and/or third parties, except for the assumption of being duly empowered with the limitations of acts provided for in Art. 4(g). The annulment, cancellation and resignation of the registration shall be published for one day in the Official Gazette and in the Trademark and Patents Bulletins.

ARTICLE 11. Notification to Professional Associations
The final ruling that will determine the application of sanctions to professionals shall be communicated to the respective professional association in Buenos Aires and/or any other jurisdiction.

ARTICLE 12. Re-registration
[…]

All conduct not provided for in the relevant specific legislation shall be governed, by the Basic Codes of the Argentine Republic, that is, the Civil Code, the Commercial Code and the Criminal Code".

2. AUSTRALIA

National aspects

Discovery procedure and how privilege protection operates against discovery

There are two methods of discovery under the Australian High Court rules. One is the normal track discovery and another is the fast track discovery under Federal Court of Australia New Practice Note 30 (fast track) of April 2009, which aims to finalize a proceeding within five to eight months of commencement. On the fast track discovery, the court expects the parties to cooperate with and assist the court in ensuring that the case is conducted in accordance with the fast track. Under the fast track procedure, discovery is only limited to documents on which a party intends to rely and documents that have significant probative value adverse to a party's case.

Under the normal track, discovery may be made on documents on which the party relies, documents that adversely affect the party's own case, documents that affect another party's case and documents that support another party's case. Client-attorney privilege operates to entitle a client, and even an attorney in his or her role as a witness or a party to litigation, to withhold evidence, or in some cases, to prevent others from disclosing privileged information. For example, the privilege allows a client to withhold, from a court, communications that she/he has had with his or her lawyer for the purpose of obtaining legal advice.

Professionals covered by the privilege and secrecy obligation

Professionals covered by the privilege are qualified lawyers, including in-house qualified lawyers and patent attorneys. The term "qualified lawyers" refers to lawyers called to the Bar in each of the States and Territories of Australia. The ultimate decision to admit a person with certain qualifications to the Bar rests with the State or Territory in which one is seeking admission.

Patent attorneys are granted patent attorney privilege by statutes (Section 200 of the Patents Act 1990). The Australian Patents Act restricts patent attorneys from preparing documents to be filed in court, or transacting business or conducting proceedings in court, distinguishing it from that of lawyers who may prepare documents, transact business and conduct proceedings in court.

In comparison, Australia also provides for the same privilege to trademark attorneys as prescribed for their patent attorney counterparts. Australia's Trade Marks Act of 1995, as amended by the Intellectual Property Laws Amendment Act 1998, extends the same rights to Australian patent and trademark attorneys.

In-House Patent Attorney

Based on the strict interpretation of Section 200(2) of the Patents Act and the recent comments in *Telstra Corporation Limited v. Minister for Communications, Information, Technology and the Arts (No 2) [2007] FCA 1445*, regarding client-lawyer privilege, it is expected that patent attorney privilege would apply to communications with in-house patent attorneys subject to certain conditions. Firstly, the attorney would need to be registered under the Patents Act. Secondly, he or she would need to be acting in his or her capacity as a patent attorney rather than in any commercial or technical capacity. In that case, Graham J reiterated the independence required of the in-house lawyer and stated that, for privilege to operate, the lawyer needed to be acting in a legal, rather than a commercial, role. The lawyer, and thus also the patent attorney, would need to be able to give impartial legal (patent attorney) advice not "compromised by virtue of the nature of his employment relationship with his employer".

Scope of privilege

The lawyer-client privilege protects communications between lawyers and clients for the purpose of legal advice. Based on the decision in *DSE (Holdings) Pty Ltd v. Intertan Inc. (2003) 135 FCR 151*, legal advice that is entitled to a privilege must go beyond formal advice as to the law. This means that client-lawyer privilege protects communications (oral or written) and documents which are confidential and pass between or are created by a lawyer and client for the dominant purpose of the lawyer providing, or the client receiving, legal advice. In Australia, client-attorney privilege extends to communications with third parties.

Following the decision of the High Court of Australia in *Daniels Corporation International v. ACCC (2002) 213 CLR 543*, it is now settled that legal professional privilege is a rule of substantive law of which a person may avail himself to resist giving information or the production of documents which would reveal communications between a client and his or her lawyer made for the dominant purpose of giving or obtaining legal advice or the provision of legal services, including representation in legal proceedings. This means that legal professional privilege is not confined to the processes of discovery and inspection and providing evidence in judicial proceedings.

According to Section 200(2) of the Patents Act, the scope of client-patent attorney privilege is narrower than client-lawyer privilege. Privileged communications are limited to those on intellectual property matters. Further, while the privilege granted to clients of solicitors is extended to communications with third parties, communications covered by client-patent attorney privilege are restricted to communications between a registered patent attorney and his or her client.

The scope of client-patent attorney privilege also appears to be narrower than for client-lawyer privilege, which extends to the categories of providing legal advice (Evidence Act 1995 (Cth), s 118), or legal services, including representation in legal proceedings (Evidence Act 1995 (Cth), s 119; *Esso Australia Resources Ltd v Federal Commissioner of Taxation* [1999] HCA 67; (1999) 201 CLR 49). ss 200(2A)-(2B) merely mention "legal advice".

In *Australian Mud Company Pty Ltd v Coretell Pty Ltd* [2014] FCA 200 (at [11]-[12]), referring to the Explanatory Memorandum, it was stated that s 200 of the Patents Act was intended to be consistent with s 118 of the Evidence Act. In *Titan Enterprises (Qld) Pty Ltd v Cross* [2016] FCA 1241, which dealt with an identically worded provision in the Trade Marks Act, it was observed (at [12]-[13]) that the attorney privilege was not intended by parliament to be the same as that for a lawyer, as attorneys "do not have the same rights as lawyers do to initiate proceedings and represent parties in court". It was held that while advice as to whether material could be used in legal proceedings was sufficient, the drafting of such documents did not constitute advice, and was not protected.

The limitations and exceptions to the privilege

Exceptions to the legal professional privilege in Australia take the form of common law exceptions or statutory exceptions. Common law exceptions include the name of the client (*Commissioner of Taxation v. Coombes* (1999) 92 FCR 240), the circumstances in which allowing the claim of legal professional privilege would frustrate legal processes (*R v Bell; Ex parte Lees* (1980) 146 CLR 141.) and where communication between the lawyer and the client is for the purpose of committing a crime or fraud. In *Carter v. Northmore Hale Davy & Lake*, it was held that, in particular circumstances, a court could override the legal professional privilege.

Statutory exceptions to privilege are provided in different legislation. For example, legal professional privilege may be lost where a communication between the lawyer and client concerns "acts attracting the anti-avoidance measures in Pt IV A of the Income Tax Assessment Act 1936" and "in furtherance of a contravention of the Trade Practices Act 1974".

The exceptions and limitations to legal professional privilege may be express or conditional. For example, Section 37(3) of the Administrative Appeals Tribunal Act 1975 provides for an express exception which imposes an obligation on parties to lodge certain documents with the tribunal notwithstanding any rule of law relating to privilege or public interest in relation to the production of documents. On the other hand, Section 157 of the Trade Practices Act 1974 provides for a conditional limitation to the legal professional privilege, according to which a court can order the Australian competition authority to comply with a request for information but such a request may not be complied with if "the court considers it inappropriate to make the order by reason that the disclosure of the contents of the document or part of the document would prejudice any person, or for any other reason." The decision of the High Court of Australia in *Daniels Corporation International Pty Ltd v. ACCC* (2002) 213 CLR 543, suggests that a statute abrogates legal professional privilege in cases where "very clear, indeed unmistakable, provisions of legislation" exist which deny the application of privilege.

Consequences of the loss of confidentiality and penalties for disclosure

The loss of confidentiality or inadvertent disclosure of confidential information subject to the privilege means the confidentiality and also the privilege are lost. A patent attorney who discloses confidential information without authorization may be subject to disciplinary proceedings by the Professional Standards Board in accordance with Disciplinary Guidelines for Registered Patent and Registered Trade Marks Attorneys under Regulation 20.33 of the Patent Regulations 1991. The Guidelines set out the procedures that the Professional Standards Board will follow in investigating a registered patent attorney or a registered trademark attorney and in deciding whether or not to commence disciplinary proceedings. The Board has the power to refer any patent attorney who is in breach of confidentiality for professional misconduct to the Disciplinary Tribunal.

Requirements/qualifications for patent advisors

The registration of patent attorneys and trademark attorneys in Australia is governed by the Professional Standards Board for Patent and Trade Mark Attorneys, a body established under Section 227A of the Patents Act 1990. The Board administers the regulatory and disciplinary regimes for patent and trademark attorneys in Australia.

To register as a Patent and Trademark Attorney in Australia, the following conditions must be met: pass nine prescribed exams; hold a degree in a field of technology that contains potentially patentable subject matter; be ordinarily resident in Australia; have worked for a year as either a technical assistant in a patent attorney's practice, an employee in a company in Australia practicing patent matters on behalf of a company or an examiner of patents at IP Australia; and be of good repute, integrity or character, and not have been convicted within the past five years of offences against patents, trademarks and designs legislation.

Cross-border aspects

Recognition of Foreign Privilege in Australia

The patent attorney privilege was not applicable to communications between clients and foreign patent attorneys who are not registered under the Australian Patents Act 1990 until 2013. In Australia, the requirement for a "registered patent attorney" was established by the Federal Court

of Australia in *Eli Lilly & Co. v. Pfizer Ireland Pharmaceuticals* (2004) 137 F.C.R. 573 (Federal Court of Australia) ["Eli Lilly & Co"]). The privilege for communications with a registered patent attorney was confined to communications with an attorney registered in Australia. The court based its decision on the limitation of the scope of the statutory privilege to registered patent attorneys.

The Australian Government recognized that legislative changes were needed to afford a client of a non-lawyer patent attorney certainty in relation to confidentiality of intellectual property advice both in Australia and overseas. Furthermore, the privilege applicable to clients of non-lawyer patent attorneys should also apply to their communications with suitably accredited overseas non-lawyer patent attorneys. Further, many patent applicants hold global patent portfolios, including a number of patents for the same invention in different jurisdictions. This means that a dispute in relation to a single invention may be prosecuted simultaneously in a number of different jurisdictions. It is not always desirable or practical for parties to such disputes to limit their requests for advice to Australian patent attorneys.

The Intellectual Property Laws Amendment (Raising the Bar) Act extended the existing client-patent attorney privilege to foreign patent attorneys which entered into force on April 15, 2013. This was achieved by expanding the definition of "patent attorney" to include an individual authorized to do patents work under the law of another country or region. No further criteria are mentioned in the Act. However, the privilege applies to the extent that the attorney is authorized to provide intellectual property advice. Consequently, communications with a foreign patent attorney relating to trademarks or other rights will be privileged only if the attorney is authorized to do that work in his home country in addition to patents work. Methodologically, the Act extends the principle of the client-patent attorney privilege to foreign advisors in IP law and not in evidentiary law.

The Intellectual Property Laws Amendment (Raising the Bar) Act revised subsection 200(2) of the Patents Act as follows:

> "(2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.
>
> "(2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.
>
> "(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorized to do patents work under a law of another country or region, to the extent to which the individual is authorized to provide intellectual property advice of the kind provided.
>
> "(2C) Intellectual property advice means advice in relation to:
>
> (a) patents; or
> (b) trademarks; or
> (c) designs; or
> (d) plant breeder's rights; or
> (e) any related matters."

It is noted in relation to those provisions, that patents work is defined as work in relation to patents or patent applications done, on behalf of someone else, for gain. The intention is that the privilege provision captures communications between clients and foreign IP professionals who

are authorized to perform work similar to the work done by their Australian counterparts. This will include not only persons authorized under the law of a nation state, but also persons registered under an international treaty, such as Article 134 of the EPC 1973, which authorizes persons to do patents work before the EPO.

The scope of the privilege is limited to the scope of a person's authority to perform the work in their home country or region. Further, the communication, record or document must be made for the 'dominant' purpose of a patent attorney providing intellectual property advice to a client in order for the communication, record or document to attract the privilege. The definition of 'intellectual property advice' in subsection 200(2) limits the scope of privilege to only those fields in which patent attorneys have specialist qualifications and knowledge.

Summary

The client-attorney privilege accorded to patent attorneys in Australia is part of the statutory privilege and does not originate from the common law legal professional privilege, although the patent attorney privilege closely mirrors the common law legal professional privilege. Thus, before 2013, the patent attorney privilege was only applicable to the intended beneficiary who is a registered patent attorney in Australia and not an unregistered patent attorney which includes a patent attorney registered in a foreign country but not in Australia. Since the entering into force of the Act on April 15, 2013, Australian law extends the patent attorney privilege to foreign to the extent to which the individual is authorized to provide intellectual property advice of the kind provided.

3. BELARUS

National aspects

The Belarus Statute of Patent Attorneys contains rules on the professional secrecy obligations of patent attorneys. According to paragraph 7, chapter 2 of the Statute "the information that a patent attorney receives from the principal in connection with the performance of his/her assignment is acknowledged as confidential, unless otherwise specified by the principal".

According to paragraph 8, chapter 2 "a patent attorney is obliged to comply with the requirements of this Statute, other legislation relating to the activity of a patent attorney, as well as the rules of professional ethics". According to paragraph 9, Chapter 2 of the Statute the breach
of the above mentioned rules will cause the suspension of his/her right to practice as a patent attorney.

Cross-border aspects

The legislation of the Republic of Belarus does not provide rules dealing with cross-border aspects of confidentiality of communications between clients and patent attorneys.

4. BELGIUM

On 28 June 2018 Belgian parliament adopted a law proposal introducing advanced regulation for the access and exercise of the patent attorney profession in Belgium. The law proposal was published in the Belgian State's Gazette on 19 July 2018 as the Law of 8 July 2018 (hereafter - the Law). This Law includes:

1) The creation of an Institute representing the patent attorney profession, which will enforce deontological rules and organise further training;

2) The protection of the professional title of patent attorney; and

3) The right for patent attorneys to be heard in cases involving patent litigation before the Belgian courts.

As one of the main aspects, the Law also provides for an attorney-client privilege applicable to patent attorneys established in Belgium and to foreign patent attorneys temporarily exercising the profession in Belgium under the freedom to provide services. This is accomplished through the introduction of professional secrecy containing specific additional provisions directed towards the patent attorney profession which have been inspired by the attorney-client privilege contained in Rule 153 of the Implementing Regulations of the European Patent Convention.

The provision containing the attorney-client privilege, which is being introduced into the Belgian Code of Economic Law, reads as follows:

Art. XI.75/13.

§ 1er. Lorsqu'un membre de l'Institut des mandataires en brevets est consulté en sa qualité de mandataire en brevets, nul ne peut divulguer ou être contraint de divulguer les communications échangées ou destinées à être échangées à ce propos entre ce mandataire en brevets et son client, dans le cadre de procédures judiciaires ou administratives, à moins que le client n'ait expressément renoncé à ce droit.
L'alinéa 1er s'applique uniquement aux membres de l'Institut, sous réserve des dispositions de traités internationaux.

§ 2. Les communications visées au paragraphe 1er concernent notamment toutes les communications relatives à:

1° l'appréciation de la brevetabilité d'une invention ou de l'opportunité de déposer une demande de brevet;
2° la préparation d'une demande de brevet belge, ou d'une demande internationale désignant la Belgique, ou la procédure y relative;
3° tout avis concernant la validité, l'étendue de la protection ou la contrefaçon de l'objet d'un brevet belge ou d'une demande de brevet belge.

§ 3. L'article 458 du Code pénal s'applique aux membres de l'Institut et à leurs préposés.

Les infractions à l'interdiction visée au paragraphe 1er commises par ces personnes, sont punies de la sanction prévue à l'article 458 du Code pénal.

An equivalent attorney-client privilege applicable to European patent attorneys is also being introduced in Article XI.90/1 of the Belgian Code of Economic Law.

The Belgian attorney-client privilege is thus two-sided:

1. First it gives anyone the right to refuse to make certain communication between the patent attorney and his client public, within the context of judicial or administrative proceedings;

2. Secondly, it forbids anyone to make such communication public without the consent of the client of the patent attorney.

The privilege protects any communication exchanged or destined to be exchanged between a patent attorney and his client in so far as he is consulted in his function of patent attorney. Infractions of the attorney-client privilege committed by the patent attorney can lead to criminal, civil as well as disciplinary proceedings.

The entry into force of the Law, including the provisions on the attorney-client privilege, is subject to further implementing measures. These, together with the Law, are expected to enter into force in the course of 2019.

5. BRAZIL

National aspects

Lawyers and registered Patents & Trademark Agent (API) are bound by professional secrecy obligation. Section 297 of the Brazilian Criminal Procedural Code exempts from the duty of giving testimony anyone who must keep privilege due to his profession. The Brazilian Civil Procedural Code has a similar provision in section 406, II. Criminal acts committed with the assistance of lawyers and APIs, however, are not covered by privilege and the privilege does not apply to documents evidencing such criminal acts.

Origin of the professional secrecy obligation and its coverage

The Brazilian Constitution recognizes the lawyer as an essential profession to the administration of justice. Professional acts and manifestations are protected by the Constitution, in the terms of a federal law. Federal Law n. 8.906/94, known as the Statute of Lawyers, provides for rules applicable to the legal profession. Besides, the Brazilian Bar Association (Ordem dos Advogados do Brasil) enacted a Code of Ethics and Discipline, which establishes the ethical principles of the legal profession. Those legislations impose high standards of professional conduct on Brazilian lawyers, particularly in relation to confidentiality and professional secrecy.

Professionals bound by the secrecy obligation

Many professionals are bound by secrecy obligations. They include practicing lawyers, medical doctors, dentists, and also patent agents and patent attorneys. The confidentiality and secrecy obligation applies to both lawyers and registered patent and trademark agents (Agentes da Propriedade Industrial (APIs)). Lawyers are bound by secrecy due to strict guidelines contained in the Statute of Lawyers. APIs are bound by professional secrecy obligations under the Code of Conduct of APIs enacted by the Brazilian Patent and Trademark Office (BPTO) through Normative Act 142, of August 25, 1998. It is to be noted that the Brazilian Criminal Procedure Code (Section 297) exempts from the duty of giving testimony anyone who must keep privilege due to his or her profession and the Brazilian Civil Procedure Code has a similar provision (Section 406, II).

The relationship between attorney and client is regulated in Brazil by the Statute of Lawyers and the Code of Ethics and Discipline referred to above. These provisions apply to all Brazilian lawyers, including in-house attorneys. There are express and specific provisions in the Statute and in its Regulations about privileged relationship between an attorney and his or her client, which guarantee the attorney the right to protect, and not to disclose, the information received from his or her clients.

Kind of information/communication covered by secrecy obligation

In Brazil, lawyers and APIs are required to respect the confidentiality of all information that becomes known to them in the course of their professional practice. Nevertheless, the scope of the confidentiality obligation is governed by different laws. Section 26 of the Code of Ethics and Discipline, in particular, states that Brazilian lawyers must maintain confidentiality and secrecy in court proceedings vis-à-vis what they have learned from their clients throughout their professional practice. Section 26 further states that lawyers should refuse to testify as witnesses about any facts related to a client, even if authorized or requested by the client. This obligation remains regardless of whether the relationship between lawyer and client continues or has already been terminated by either party.

All the information supplied to the attorney by the client, including written communication, is confidential. As per this privilege, it can only be revealed, unless if used in the defense limits, when authorized by the client. The confidentiality privilege is extended to the attorney's office, files, data, mail and any kind of communication (including telecommunications), which are held inviolable.

Exceptions and limitations to the professional secrecy obligation/availability of forced Disclosure

In a decision of December 5, 1995 (STJ, Resp No. 76.153, Relator: Min. Sálvio de Figueiredo Teixeira, 05.12.1995, D.J.U. 05.02.1996, p. 1,406), the Higher Court of Justice (Superior Tribunal de Justiça) held that a lawyer was allowed to give testimony in court proceedings about facts that the lawyer himself had witnessed, ignoring the language of both the Brazilian Statute of Lawyers (Section 7, XIX) and the Code of Ethics and Discipline (Section 26). In laying down his decision, Justice Teixeira stated that "the prohibition for a lawyer —who counsels or has counseled a party— to testify, under [Brazilian] procedural law, exists by the closeness of both vis-à-vis their contractual relationship, which would lead the testimony of the lawyer to be nothing more than a positive statement of the party with force of testimony. Nothing prevents, however, a lawyer, by himself and not because he has heard from his client, from testifying in court proceedings with respect to facts that he has witnessed". Justice Teixeira further stated that "the barring from a lawyer's testimony is restricted only to the lawsuit in which the lawyer represented or still represents a party."

On October 16, 2003, the Ethics Committee of the São Paulo branch of the Brazilian Bar Association issued an opinion, holding that a lawyer called to give testimony as a fact witness, in court proceedings involving former clients, is unconstrained to do so as long as the lawyer observes the strict interests of his former client.

Criminal acts committed with the assistance of lawyers and APIs are not covered by privilege and the privilege does not apply to documents evidencing such criminal acts. Attorneys and APIs have the right to refuse to make depositions as witnesses (i) in a question in relation to which the attorney has acted or may act, or (ii) about facts qualified as professional secrecy related to a person who is or has been his or her client, even if authorized by the last. The Code of Ethics and Discipline, in Chapter III, also provides that the attorney–client relationship is protected by professional secrecy, which can only be violated in the cases of (i) severe threat to life or honor; or (ii) when the attorney is insulted by his or her own client; and (iii) in self-defense. Violation of professional secrecy must be restricted to the interests of the question under discussion.

Consequences of the loss of confidentiality and penalties for unauthorized disclosure

Any breach of a client's confidential information, under both statutes, can result in administrative, civil and criminal sanctions for the breaching lawyer. The disciplinary proceeding commences either with a petition by the interested party or "ex officio". Once the petition is received, the President of the State Council must appoint a member of the Council to report the case and govern the collection of evidence. Penalties established in the Statute of the Lawyer are: admonition, suspension, disbarment and fines. If lawyers disregard the privilege, without reasonable grounds, they are subject to: (a) professional sanctions imposed by the Bar Association (Law 8906/94, Section 34, paragraph VII); (b) criminal sanctions (Sections 153 and 154 of the Criminal Code), such as a fine or one to 12 months of imprisonment; (c) civil sanctions for damages (Section 159 of the 1916 Brazilian Civil Code).

Requirements/qualifications for patent advisors

In Brazil, API is recognized by law and is entitled to give advice on IP matters as well as to represent clients before the BPTO. Those who are willing to enroll in the BPTO Official Register of APIs need to be successful in an examination given before BPTO. However, lawyers admitted to the Brazilian Bar can be automatically enrolled as APIs, without any additional examination. Lawyers admitted to the Bar in Brazil are also fully qualified to give advice on IP matters as well as to represent clients before BPTO. APIs who are not lawyers have in many cases an engineering degree, although this is not a legal requirement.

Cross-border aspects

There is no evidence to show that the same treatment of confidentiality and privilege applies to foreign patent attorneys.

Summary

Brazilian law imposes confidentiality obligations on the patent attorneys and lawyers not to disclose confidential information obtained in the course of dealing with clients. However, this obligation is not absolute as there are several exceptions to the confidentiality obligation, such as in the case of crime and fraud or where the lawyer is required to testify as a witness in matters that he or she does not represent. Although the confidentiality requirement is applicable to both qualified lawyers and patent attorneys, it is not known whether the same obligation and right to keep information confidential applies to foreign patent advisors.

In Brazil, patent agents are bound by the secrecy obligation flowing from his or her profession. The Brazilian Criminal Procedure Code (Section 297) and the Brazilian Civil Procedure Code (Section 406) exempts anyone who is bound by the professional secrecy obligation from the duty of giving testimony. There is no evidence to show that a different treatment applies to foreign patent advisors.

6. BULGARIA

National aspects

The Ordinance on the Industrial Property Representatives, adopted by the Council of Ministers, provides that patent representatives (lawyers or non-lawyers) are obliged to perform their duties and protect the interests of their clients in good faith by, inter alia, guaranteeing to keep in secret

any information disclosed to them when acting as representatives. However, it fails to specify any sanctions for breach of the professional secrecy obligation. Nationals of EU Member States may also practice their attorney profession. They are deemed equal to Bulgarian attorneys and bound by the same professional confidentiality obligations, when acting before the Bulgarian authorities.

The Code of Civil Procedure stipulates that the courts may order third parties to supply documents in their possession upon written request of a party to the proceedings. Where the third party unduly fails to do so it can be fined by the court and is liable to any damages caused to the requesting party. The same code also specifies that any witness may refuse to answer certain questions, if that may result in immediate damages, disgrace or criminal prosecution for him or his relatives. The professional secrecy obligation could be invoked in such cases to justify any refusal to supply a document or testify in civil proceedings, if that may result in immediate damages to a client.

In criminal proceedings prevails the public interest of ascertaining the truth. Consequently, a witness may refuse to testify only about facts that have been disclosed to him as a defense attorney. Other persons, including patent advisors (lawyers or non-lawyers), cannot rely on this exception. The Code of Criminal Procedure does not contain specific provisions about possibilities to refuse to supply documents.

Cross-border aspects

Bulgarian national law contains no specific provision on the cross-border aspects of confidentiality of communications between clients and patent advisors. The lack of express laws and rules dealing with cross-border aspects of confidentiality brings uncertainty as to whether the courts are bound to accept confidentiality obligations arising under other jurisdictions.

7. CANADA

Previous Canadian case law did not recognise client-patent advisor privilege (Lumonics Research Co. v. Gould, 70 C.P.R. (2d) 11; Whirlpool Corp. v. Camco Inc., 72 C.P.R. (3d) 444; Lilly Icos LLC v. Pfizer Ireland Pharmaceuticals, 2006 FC 1465). However, that case law is no longer valid in light of recent legislative changes creating a privilege for the clients of agents.

On June 24, 2016, Canada enacted amendments to its patent legislation to recognize as privileged confidential communications between patent advisors and their clients. This privilege applies to any communication between a registered patent agent and their client, which is intended to be confidential; and is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention. Canada's new patent law also recognizes as privileged in Canada communications between a client and a patent advisor from another country, provided that the law of the other country also recognizes those communications as privileged.

So far, no court decisions have been issued regarding this new legislation

8. CHINA

The Chinese law does not contain specific provisions on the client-patent attorney privilege. However, there are provisions in the Chinese law concerning the confidentiality obligations and responsibilities of agencies, patent agents and lawyers. Article 19 of the Chinese Patent Law provides that "a patent agency shall comply with laws and administrative regulations, and handle patent applications and other patent affairs as entrusted by a client. The agency

is obliged to keep information regarding the contents of the client's creations and inventions confidential, unless the patent application has been published or announced." Article 25 of the Regulations on Patent Commissioning provides that a patent agent, who discloses the content of a client's invention, shall receive a warning or shall get his "Patent Agent Qualification Certificate" revoked.

Article 38 of the Law on Lawyers provides that "a lawyer shall keep confidential the secrets of the state and commercial secrets that he comes to know during his legal practice and shall not divulge the private affairs of the parties concerned. A lawyer shall keep confidential all things and information that he comes to know during his legal practice and which his client or another person does not want other people to know, with the exception of the facts and information about a crime which his client or another person prepares to commit or is committing endangering the state or public security or seriously endangering another person's personal safety or safety of property."

HONG KONG (CHINA)

There is currently no regulatory regime for provision of patent agent services in Hong Kong, China. Any person, with or without the relevant technical and/or legal expertise, may claim himself or herself to be a patent practitioner.

In Hong Kong, China, it is not uncommon that solicitors are retained as patent agents. In this connection, communications between clients and their patent advisors who are solicitors will qualify as confidential information.

(a) A solicitor owes the duty of confidence to his client during the subsistence of the solicitor–client relationship. This relationship comes to an end with the termination of the retainer. But the duty of confidentiality survives the termination to protect the confidentiality of the information imparted during the subsistence of that solicitor–client relationship: see Prince Jefri Bokjiah and KPMG (a firm) [1997] 2 AC 222 at 235 c-F, per Lord Millett.

(b) Moreover, under paragraph 8.01 of the Hong Kong Solicitors' Guide to Professional Conduct, Vol. 1, it is stated that:

"8.0. A solicitor has a duty to hold in strict confidence all information concerning the business and affairs of his client acquired in the course of the professional relationship, and must not divulge such information unless disclosure is expressly or impliedly authorized by the client or required by law or unless the client has expressly or impliedly waived the duty."

(c) Further, legal professional privilege protects the confidentiality of bona fide communications between a lawyer and a client concerning matters of legal advice or in reference to litigation, be it on-going or in contemplation. The privilege conveys the right to resist the compulsory disclosure of those communications.

Upon endorsing the recommendations made by the Advisory Committee of Review of the Patent System, the government of Hong Kong, China, has decided to develop a fully-fledged regulatory regime on patent agent services in the long run, which has to be achieved in stages, with possible interim measures.

9. CHILE

The Chilean law does not provide for IP professionals as it does for doctors, lawyers etc. IP practitioners are neither the subject of a specific examination nor qualification for practicing. The practice indicates that most of the IP practitioners are lawyers in Chile.

The Professional Code of Ethics of the Bar Association provides certain ethical obligations for lawyers. Lawyers are bound by professional secret obligation, according to which third parties cannot force disclosure of communications between lawyers and their clients, third parties or other attorneys. The Political Constitution of Chile states that professional associations should be empowered to hear complaints against the ethical conduct of their members, and their decisions may be appealed to the respective court of appeals. Lawyers who are not associated will be tried by the ordinary courts. The reserved nature of the documents that are exchanged under the professional secrecy of lawyers is guaranteed by the Supreme Court of Justice in its rulings.

The non-lawyer practitioners will be ruled by the civil mandate, and eventually by the confidentiality clauses of a contract with their clients and/or employers.

10. COLOMBIA

Under Article 74 of the Colombian Constitution, "professional secrecy is inviolable." This imposes the obligation of reserve on the professional to whom a professional secret is entrusted and the effectiveness of that obligation against individuals and authorities. The Constitutional Court has defined professional secrecy as: "reserved or confidential information to which a person becomes privy by practicing a particular profession or engaging in an activity". Thus, professional secrecy is both a right and an obligation of the professional, because "to be compelled to reveal what he knows will lose him the trust of his clients, his reputation and his income."

Professional secrecy arises from a relationship of trust established between a professional and his client regarding the subject matter of their relationship. By virtue of professional secrecy, the user of a professional service transmits pieces of information that are covered by the right to privacy.

Professional secrecy is an autonomous and inviolable guarantee enshrined in Article 74 of the Constitution. It is based on respect for the right to privacy of the user of a professional service and on other guarantees that could be affected by the disclosure of the secret, such as the right to a defense or to a good name.

The Constitutional Court has established some features of professional secrecy. For example, it should be an essential aspect of professions linked to personal services. Another notable feature is that professional secrecy in Colombia is inviolable by express provision of Article 74 of the Constitution. Accordingly, the Constitutional Court has ruled as follows:

> "As with the right to life, in the case of professional secrecy, the Constitution has allowed the legislature no leeway to indicate under what conditions an "inviolable" right might be legitimately violated. The inviolability attributed by the Constitution to professional secrecy means that it is not even optional for a professional bound by secrecy to reveal the secret or to refrain from doing so. He is obliged to keep it."[1]

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[1] Constitutional Court Judgment No. C-264 of 1996, Presiding Judge: Eduardo Cifuentes Muñoz.

Another feature of professional secrecy established by the Constitutional Court is that although it arises from an interpersonal relationship of trust, it is effective against third parties:

> "From the foregoing, it follows that professional secrecy has been codified in keeping with the relationship between the professional and the person requesting and obtaining his services, who must necessarily make him aware of material and information to which he would not otherwise be privy. That protection has effects on people other than the persons involved in the professional relationship, that is, it is something that can be effective against third parties."[2]

Finally, the Constitutional Court has further established that professional secrecy varies in scope with the profession, depending on how it impacts the right to personal and family privacy and State control over them, for example, in legal matters:

> "In legal matters, the Constitutional Court has held that professional secrecy has a special scope because it may also affect the right to defense, which is why the Court has stated that the inviolability of communications is markedly noticeable in client-lawyer communications, so their illegal interception should be severely punished."[3] [4] [5]

11. COSTA RICA

In Costa Rica in practice applicants, who are nationals or residents and those residing outside of Costa Rica, receive assistance from lawyers when filing their patent application. Articles 41, 42 and 43 of the Code of Legal, Moral and Ethical Duties of the Legal Professional are therefore applicable. In particular, Article 41 provides:

> "Confidential information given to an attorney in the course of his or her professional duties by a client, adversarial party, or colleagues, such information resulting from conciliation or trade-related interviews as well as from third parties, shall be subject to client-attorney privilege. Similarly, the knowledge obtained in the course of employment involving private documents, documents received and the content thereof shall be subject to client-attorney privilege. It shall be forbidden to disclose the information obtained subject to client-attorney privilege with the exceptions established in the following article."

Moreover, according to national agents, parties adhere to the principle of good faith and usually sign service agreements or work contracts containing confidentiality clauses. The Criminal Code of Costa Rica (Law № 4573) stipulates that the disclosure of secrets constitutes an offence against privacy. Article 203 states the following:

> "Any person who, owing to their position, occupation, job, profession or art, is aware of a secret which, if disclosed, may be prejudicial, and reveals the secret without just cause, shall be punished with imprisonment of one month to one year or a fine covering 30 to 100 days.

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[2] Constitutional Court Judgment No. T-151 of 1996, Presiding Judge: José Gregorio Hernández Galindo.
[3] Constitutional Court Judgement No. T-708 of 2008, Presiding Judge: Clara Inés Vargas Hernández.
[4] Constitutional Court Judgement No. T-708 of 2008, Presiding Judge: Clara Inés Vargas Hernández.
[5] Information is taken from the submission made by the Superintendency of Industry and Trade of Colombia (Patent Office) to the twenty-six session of the SCP.

If the person is a public official or a professional, he or she shall additionally be barred from performing public functions and duties or an officially recognized profession for six months to two years".

12. CROATIA

National aspects

Croatian legislation provides for confidentiality of any kind of communication between clients and their patent advisors/representatives/attorneys. The provisions under the Croatian legislation concerning duties of patent representatives address the issue with regard to responsibilities of protection of professional confidentiality. These rules are provided for in the Statute of Croatian Association of Patent and Trademark Attorneys (Official gazette 91/2013). Pursuant to the Statute:

- Members of the Associations shall preserve the confidentiality of any information considering service acquired from a client or otherwise while rendering the service, particularly during representation. The representative's secret refers to all the information, documents, recordings, computer data, pictures and similar materials and deposits kept in the representative's office;

- Members of the Associations shall exercise reasonable care to ensure that the confidentiality of such information be preserved by other persons working in his or her law office;

- Confidences or information acquired in the course of rendering service to a client must not be used in the proceedings or otherwise to the client's disadvantage. A representative shall not use such confidences to the disadvantage of either one or more interested members who are in a status relationship with the client, or against them;

- A representative shall preserve the representative's confidentiality permanently;

- In order to preserve the representative's secret, a representative shall not disclose any information about the matters entrusted to him or her, even upon the termination of a case;

- Revelation of the representative's secret is permitted only upon the clear consent of the client or if it is necessary for the defense of the representative.

Based on data available, there are no reported court cases with respect to the client-patent advisor privilege.

Cross-border aspects

The national legislation of the Republic of Croatia does not provide any provisions concerning cross-border aspects of confidentiality of communications between clients and patent advisors.

13. CYPRUS

Cyprus belongs to a mixed legal system combining common law aspects and civil law aspects. The national law of Cyprus does not provide any rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors.

14. CZECH REPUBLIC

According to Act No 417/2004 Coll., on Patent Attorneys, as amended, only registered patent attorneys are authorized to perform services of patent attorneys on the territory of the Czech Republic. The confidentiality of communication between clients and their patent attorneys is regulated in Section 36 of this Act as one of patent attorneys´ duties, namely as follows:

(1) The patent attorney is obliged to maintain confidence on all facts about which he learnt in connection with provision of the services of a patent attorney. He may be relieved from this duty only on the basis of a statement written by the client and after the client's death or dissolution by his legal successor.

(2) The duty of confidentiality applies also to those deleted from the List or those whose performance of activity was suspended.

(3) The patent attorney is not obliged to maintain confidentiality in relation to the person he has authorized to make the individual acts of the services of a patent attorney, in case this person is himself obliged to maintain confidentiality.

(4) The patent attorney is not bound by the duty of confidentiality to the extent necessary for hearing at a court or another body, in case the subject of the hearing is a dispute between the patent attorney and the client or his legal successor; the patent attorney is also not bound by the duty of confidentiality in the disciplinary proceedings.

The patent attorney may not invoke the duty of confidentiality in disciplinary proceedings also against the chairman and members of the supervisory committee who inquire into the disciplinary misconduct of the patent attorney.

(5) The duty of confidentiality similarly applies to a) the persons employed in labour or another similar relation by the patent attorney or the society b) the members of bodies of the Chamber (of Patent Attorneys of the Czech Republic) and its employees, as well as to all persons who participate in the disciplinary proceedings, including the chairman and members of the supervisory committee authorized to prepare the acts for the disciplinary proceedings and for inquiry whether a disciplinary misconduct took place; this does not apply to action at a court in the mentioned cases.

Section 49 of this Act provides for disciplinary sanctions in case of violation of these obligations.

The act does not provide any provisions concerning cross-border aspects of the client patent attorney privilege.

Based on data provided by the Chamber of Patent Attorneys of the Czech Republic, as of April 2017, there are no reported court cases concerning the client-patent attorney privilege.

15. DENMARK

Article 170 of the Danish civil Procedure Act secures confidentiality of communications between clients and certain professionals, such as doctors, lawyers, mediators and priests. As of July 1, 2018, that Article concerning witness exclusion includes patent advisors as defined in Article 134(1) of the European Patent Convention (EPC) on EPO's list of European patent advisors.

It entails that patent advisers are not obliged to provide evidence to the court during legal proceedings of knowledge acquired through their work. The purpose of including patent advisers in the Danish provisions on witness exclusion is to enhance the protection of companies when faced with patent proceedings both nationally and internationally.

The inclusion of patent advisors in the rules on witness exclusion facilitates the confidentiality of communications between clients and their patent advisers in cross-border proceedings and prevents the situation where the patent adviser would be obliged to give evidence to the court because of the lack of protection of patent advisers in the Danish rules.

16. DOMINICAN REPUBLIC

Legal assistance is not a requirement in Dominican Republic legislation, except where the applicant is not domiciled in the Dominican Republic. In such cases, management of all information is strictly the responsibility of the agent, who is responsible for the management and receives communication of all results of formal and technical examinations concerning the pending application.

In general, professional secrecy is covered by Decree № 1290, which ratifies the Code of Ethics of the Bar Association of the Dominican Republic.

CHAPTER II PROFESSIONAL SECRECY

ARTICLE 15.
Professional secrecy is a both a duty from which legal professionals may not be exempt and a right before judges; such professionals may not, therefore, entertain confidential information if they know that they might be compelled to reveal it. A legal professional who is called as a witness must obey the summons, but must, when testifying, proceed with absolute independence of mind and must refuse to answer questions if the answers would, in his/her opinion, breach professional secrecy.

ARTICLE 16.
The secrecy obligation encompasses confidential information provided by third parties to legal professionals by reason of their profession. Such professionals must, therefore, maintain the confidentiality of conversations held for a transaction that has failed and of facts known solely by such means. Professional secrecy also covers unguarded confidential disclosures by colleagues.

ARTICLE 17.
The obligation of secrecy yields to the self-defense requirements of a legal professional who is wrongly accused by a client. The professional may then disclose what is essential to his/her defense and provide for that purpose documents entrusted to him/her by the client.

ARTICLE 18.
The attorney shall maintain the strictest professional secrecy. This fundamental duty remains wholly intact after he/she ceases to provide services to the client. The attorney has the right to refuse to testify against his/her client and may decline to answer any question that would entail the disclosure of a secret or a breach of the confidence that his client has placed in him/her. Nor may the attorney communicate to third parties any information known on account of his/her profession. Professional secrecy shall encompass all of an attorney's dealings with the attorney representing the opposing party.

ARTICLE 19.
The duty to maintain professional secrecy shall cover confidential information imparted by third parties to the attorney professionally, and confidential information derived from conversations necessary for reaching an agreement that has not been implemented. Secrecy shall also cover confidential disclosures by colleagues. The attorney shall not intervene in matters that could lead him/her to divulge a secret or use, either for his/her own or for a client's gain, confidential information received in the exercise of his/her profession, save with the prior express consent of the confidant. The obligation to maintain professional secrecy further covers matters known to the attorney as a result of working together or in association with others or through employees or their dependents.

ARTICLE 20.
An attorney sued by a client shall be discharged from the obligation of maintaining professional secrecy within the limits necessary and indispensable for his/her self-defense. Where a client communicates to the attorney an intention to commit a crime, the attorney may, according to his/her conscience, make the necessary disclosures with a view to preventing the commission of the crime in order to avoid the moral or material damage that might arise from the commission of the crime.

Accordingly, it may be inferred that between the attorney and the client, there is a pre-contractual agreement on the confidential treatment of the information contained in the application, which covers the rights and obligations of each of the parties.

17. ESTONIA

National aspects

Article 6 (2) and (3) of the Estonian Patent Attorneys Act of 2001 provides guarantees of the professional activities of patent attorneys as follows:

> "(2) Information disclosed to a patent attorney shall be confidential. Patent attorneys and the employees of a company of patent attorneys shall not be heard as witnesses with regard to information which became known to them in the provision of legal services nor shall explanations be requested from them with regard to such information.
>
> "(3) Data media received in the course of provision of legal services shall not be confiscated from patent attorneys or the employees of a company of patent attorneys, or from a company of patent attorneys."

Cross-border aspects

No national patent law dealing with cross-border aspects of confidentiality of communications between clients and patent attorneys.

18. FINLAND

The origin of the secrecy obligation

Finland's national IPR strategy of 2009 involves a broad range of proposals for action, including a proposal for drafting new legislation on industrial property attorneys. The Act on Authorized Industrial Property Attorneys (22/2014) came into force on July 1, 2014.

The purpose of the new act is to ensure a high standard of IPR services by introducing an approval procedure for attorneys (agents) handling industrial property assignments. Passing a qualifying examination is one of the qualification requirements laid down in the act. The authorization also requires the applicant to meet other eligibility criteria. The certification is granted for five years at a time and will be renewed if the applicant continues to meet the eligibility criteria and has maintained his or her professional competence.

Professionals bound by the secrecy

While authorization is not a prerequisite for handling industrial property assignments in Finland, the use of the professional Finnish language titles protected by law - "patenttiasiamies" (patent attorney), "tavaramerkkiasiamies" (trade mark attorney), "mallioikeusasiamies" (design attorney) and "teollisoikeusasiamies" (industrial property attorney) - are reserved for authorized attorneys only. Also, the secrecy regulation only concern authorized attorneys.

The scope of the secrecy obligation

Section 9 of the Act on Authorized Industrial Property Attorneys provides for secrecy obligation of patent attorneys: "An authorized attorney or their assistant shall not without permission disclose a private, family, business or professional secret of their clients that has become known to them while performing their duties. Also, an authorized attorney or their assistant shall not without permission disclose any other information about their client that has become known to them while performing their duties."

The secrecy provisions are similar in their factual content to the provisions currently applied to advocates (Section 5c of the Advocates Act, 496/1958). In principle, the obligation of secrecy would apply to all confidential information, both written and oral, exchanged between the client and the attorney.

Penalties for breach of secrecy

Persons guilty of a violation of secrecy, laid down in Section 9 of the Act on Authorized Industrial Property Attorneys, shall be sentenced under the Criminal Code (39/1889).
An unofficial translation of the Act on Authorized Industrial Property Attorneys is available at: http://www.finlex.fi/fi/laki/kaannokset/2014/20140022.

19. FRANCE

Clarification of secrecy obligation in order to facilitate recognition in foreign courts

In France, the Intellectual Property Code R.422-54 (2°) was amended to expressly provide for a professional secrecy obligation of patent advisors. Article L422-11 (inserted by Act No. 2004-130 of 11 February 2004, Article 67, Official Journal of February 12 2004) states:

> "In any matter and for all the services mentioned under Article L. 422-1, the industrial property attorney shall observe professional secrecy. Consultations addressed or intended for customers, professional correspondences exchanged with customers, fellow-members or attorneys-at-law, notes of meetings and, more generally, all documents of the file shall be subject to professional secrecy."

The motivation for passing this legislation was to avoid the forcible disclosure in discovery proceedings of communications with industrial property attorneys in foreign courts, as in the case Bristol-Myers Squibb Co. v. Rhone-Poulenc in 1999 (French Senate, Ordinary Session 2002-2003, Document No : 176, Title 7 (Réforme du statut de certaines professions judiciaires ou juridiques, des experts judiciaires et des conseils en propriété industrielle, N° 176, SÉNAT, SESSION ORDINAIRE DE 2002-2003, Annexe au procès-verbal de la séance du 12 février 2003)).

20. GEORGIA

National aspects

The general rules under the Georgian legislation concerning duties of patent attorneys address the issue in terms of responsibilities and protection of professional secrecy. These rules are provided in the Statute of Patent Attorneys of January, 12, 2011, which was adopted in accordance with the Georgian Patent Law. According to the Article 9 of the statute a patent attorney is obliged: (a) to protect professional secrecy notwithstanding time passed; and (b) to abstain from disseminating information without a consent of the client during execution of his obligations as a patent attorney. According to Article 10 of the present statute, a patent attorney is obliged to refrain from any action which threatens the interests of client, activities of patent attorneys and their independence. According to Article 11 of the statute, the breach of the above-mentioned duties will cause the suspension of his right to practice as a patent attorney.

Cross-border aspects

The Georgian law does not provide rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors.

21. GERMANY

National aspects

In Germany, both lawyers and patent attorneys advise and represent clients in the patent application procedure and in patent litigation. Patent attorneys may represent their clients not only before administrative authorities such as the German Patent Office, but also before the German Federal Patent Court, the German Federal Supreme Court with regard to patent validity cases and compulsory licenses and any other court where representation by a lawyer is not obligatory.

Origin of the professional secrecy obligation and its coverage

The lawyers' professional secrecy obligation is based both on the *Strafgesetzbuch (StGB)* – (Criminal Code) and on the *Bundesrechtsanwaltsordnung (BRAO)* – (Federal Code for Lawyers). The patent attorneys' professional secrecy obligation is based on the Criminal Code and on the *Patentanwaltsordnung (PAO)* - (Patent Attorney Code).

Professionals bound by the secrecy obligation

The secrecy obligation applies to many professionals such as medical doctors, bankers, lawyers and patent attorneys. Section 43a (2) BRAO provides that lawyers are bound by a professional secrecy obligation. Patent attorneys have the duty to observe professional secrecy under Section 39a (2) PAO.

Kind of information/communication covered by secrecy obligation

Under Section 43a (2) BRAO, the lawyer's secrecy obligation applies to any information that the lawyer became aware of while exercising his or her professional duties. This obligation continues to exist even after the termination of the mandate.

Section 39a (2) PAO is identical with Section 43a (2) BRAO. Accordingly, also the patent attorney's secrecy obligation relates to everything that has become known to him in professional practice.

Lawyers and patent attorneys are entitled to refuse to testify in particular in civil and criminal courts regarding any information provided to them in their professional capacity (Section 383 of the *Zivilprozessordnung [ZPO]* – [Code of Civil Procedure]; Section 53 of the *Strafprozessordnung [StPO]* - [Criminal Procedure Code]). Since the beginning of 2016, the German law has provided for the obligation of in-house attorneys and in-house patent attorneys (*Syndikusrechtsanwälte/Syndikuspatentanwälte*) to keep confidentiality of correspondence with the right to refuse testimony in civil legal procedures.

Exceptions and limitations to the professional secrecy obligation/availability of forced disclosure and how protection operates

Based on Section 43a (2), 3rd sentence, BRAO, and Section 39a (2), 3rd sentence, PAO, the confidentiality obligation does not apply to facts which are public or which are not so significant as to require secrecy. Lawyers and patent attorneys are entitled to breach secrecy obligations in only very limited circumstances, such as to prevent the commission of a serious crime. In addition, clients are able to waive the privilege, and their waiver is binding on their lawyers and patent attorneys.

Consequences of the loss of confidentiality and penalties for unauthorized disclosure

Any breach of the duty to observe professional secrecy by a lawyer or patent attorney is a criminal offence (Section 203 Criminal Code). Lawyers and patent attorneys who are in breach of the secrecy obligation could also face disciplinary proceedings leading to various possible sanctions such as a fine or disbarment.

Treatment of foreign patent advisors

The secrecy obligation applies to lawyers who are called to the German Bar and to patent attorneys admitted in Germany.

European Lawyers, i.e. lawyers admitted in a European country practicing their profession in Germany are also bound by the secrecy obligation (Sections 6 and 27 of the *Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland (EuRAG)* – (EU Lawyers Code) in conjunction with Section 43a BRAO). A breach constitutes a criminal offence under the same condition valid for lawyers (Section 42 EuRAG). Similar provisions for European patent attorneys are provided in Sections 16 (in conjunction with Section 39a PAO) and 29 of the *Gesetz über die Tätigkeit Europäischer Patentanwälte in Deutschland (EuPAG)* – (EU Patent Attorneys Code).

Requirements/qualifications for patent advisors

The requirements that have to be fulfilled in order to become admitted as a patent attorney in Germany are governed by Sections 5-12 PAO. One need not be a qualified lawyer but technically qualified. Applicants must have a university degree in engineering or natural sciences and have worked in a practical technical job for at least one year. During the additional 34-month education they receive a 26-month legal training by a qualified patent attorney and have to spend two months at the German Patent and Trademark Office (DPMA) and six months at the German Federal Patent Court. The applicants must also pass registration examinations of high standards relating to legal studies and intellectual property law.

Cross-border aspects

Under German law, the right to refuse testimony before civil and administrative courts depends on the existence of a legal obligation to keep confidentiality. Due to this connection between a patent attorney's/lawyer's legal obligation to keep confidentiality and his corresponding right to refuse testimony, any foreign patent attorney/lawyer who is obliged to keep confidentiality under the applicable jurisdiction of his place of business has the right to refuse testimony in the same manner as recognized for German patent attorneys/lawyers.

With regard to criminal courts, foreign lawyers/patent attorneys have the same rights to refuse testimony as their German colleagues.

Summary

Secrecy obligations in Germany apply to both qualified lawyers and patent attorneys. Both have to ensure that a client's confidential information obtained in the course of professional practice is kept secret. A breach of the secrecy obligation constitutes a criminal offence. Accordingly, German lawyers and patent attorneys are entitled to refuse to testify before all courts.

22. GUATEMALA

In Guatemala, there has been no litigation concerning cases on professional secrecy in client -patent advisor relations and the challenges encountered, at least as far as the Intellectual Property Registry is aware.

The law of Guatemala comprises the principle on professional secrecy. The Code of Professional Ethics holds the maintenance of professional secrecy to be both an obligation and a duty incumbent on attorneys in respect of their clients. This duty survives even after the attorney has finished providing his services and it is contingent on good faith. It is an inalienable right before the courts and other authorities. The professional secrecy obligation includes all confidential information, in particular patents.

23. HUNGARY

Hungarian Law expressly provides for confidentiality of communications between clients and their patent advisors including explicitly documents. Article 15 of the provisions of Act XXXII of 1995 on patent attorneys, which came into force April 1, 2013, concerning confidentiality of communications between clients and their patent advisors provides that:

> "(1) A patent attorney – in the absence of a provision of law to the contrary – shall be under secrecy obligation with respect to all facts and data that come to his knowledge in connection with his activity as patent attorney; this obligation shall remain even after the termination of his activity as patent attorney.
>
> "(2) The secrecy obligation shall extend to those documents of patent attorney that contain facts and data subject to patent attorney secrecy. In the course of the administrative examination at the patent attorney, the patent attorney shall not disclose the documents and data concerning his client, but he cannot obstruct the procedure of the authority.
>
> "(3) The client and his successor in title may grant exemption from the secrecy Obligation.
>
> "(4) The secrecy obligation shall extend to individual patent attorneys and their employees, patent attorneys' office and their employees, patent attorneys' partnership and their employees, Hungarian Chamber of Patent Attorneys and its officers and employees.

Article 22 of the same Act contains disciplinary sanctions for violation of these obligations.

24. INDIA

Section 126 of the Indian Evidence Act 1872 provides that no barrister, attorney, pleader or vakil shall be permitted to disclose communications made by his client or advice given by him in the course of his employment except if there is an illegal purpose or showing a crime or fraud after commencement of his employment. Further, section 129 states that no one shall be compelled to disclose to a court any confidential communication between him and his legal professional adviser except when he offers himself as a witness, to the extent necessary to explain evidence given. According to Wilden Pump Engineering Co. v. Fusfield, a patent agent was not regarded as a variety of lawyer and was held to be outside the common law privilege under English law.

25. ISRAEL

In Israel, there are no statutory provisions in the law regarding the confidentiality of communications between clients and their patent advisors, though private organizations might have best practices recommendations. Courts may rule in favor of confidentiality in view of there being a fiduciary relationship between the client and its patent advisor.

26. JAPAN

National aspects

Origin of the professional secrecy obligation and its coverage

Many professions in Japan, including lawyers (Bengoshi) and patent attorneys (Benrishi), are covered by professional secrecy obligations. For example, Article 23 of the Attorney Act and Article 30 of the Patent Attorney Act provide such obligations.

In connection with civil court proceedings, Article 197 of the Code of Civil Procedure provides the cases where a witness may refuse to testify. One such case is where certain professionals, including lawyers and patent attorneys, are examined with regard to any fact that they have learned in the course of their professional duties and which shall remain confidential (Article 197(1)(ii)). In addition, where a witness is examined with regard to matters concerning technical or professional secrets, he or she may refuse to testify (Article 197(1)(iii)).

Further, Article 220 provides rules concerning the production of evidential documents. In 1998, the revised Code of Civil Procedure expanded the scope of duty to produce documents by including Article 220(iv) which made such a duty a general rule with the prescribed limited exceptional cases where an owner of certain documents may refuse the submission of such documents. One of those exceptional cases applies to documents that detail facts prescribed in Article 197(1)(ii). Another exceptional case where the person in possession of the document may refuse the submission of documents is when the document details a particular prescribed in Article 197(1)(iii). Accordingly, the secrecy obligation of lawyers and patent attorneys is supported in terms of legal procedures.

Professionals bound by the secrecy obligation

Article 30 of the Patent Attorney Act provides that a patent attorney or a person who was a patent attorney must not disclose or appropriate, without any justifiable grounds, secrets learned in the course of conducting business. Article 23 of the Attorney Act provides that non-disclosure constitutes a professional right as well as a professional obligation, unless otherwise prescribed in statutes.

According to Article 197(1)(ii) of the Code of Civil Procedure, professionals who have a right to refuse to testify on any fact learned in the course of duty that shall remain confidential, are medical doctors, dentists, pharmacists, pharmaceuticals distributors, birthing assistants, attorneys at law (including foreign lawyers registered in Japan), patent attorneys, defense counsels, notaries or persons engaged in a religious occupation, or persons who were in any of these professions in the past.

In addition, in accordance with Article 220(iv) of the Code of Civil Procedure, the person in possession of the document that details facts prescribed in Article 197(1)(ii) or the document detailing a particular that involves technical or professional secrets may refuse to produce such a document. The person in possession of the document may be the professional covered by the secrecy obligation, a client of such a professional or any third party.

Kind of information/communication covered by the secrecy obligation in general and in relation to patent law

With regard to a lawyer, he or she has a right and an obligation to maintain the confidentiality of any facts which he or she may have learned in the course of performing his or her duties. As regards patent attorneys, he or she must not disclose or appropriate, without any justifiable grounds, secrets learned in the course of conducting business. Lawyers and patent attorneys have a right to refuse to testify on any fact learned in the course of duty that shall remain confidential. In addition, any witness may refuse to testify on matters that involves technical or professional secrets, such as technological know-how and trade secrets. However, if the witness including the lawyer and patent attorney has been exempted from their duty to keep information confidential, they cannot refuse the testimony. With respect to documentary evidence, any document that details a fact learned in the course of professional duty that shall remain confidential or a particular that involves technical or professional secrets may be withheld from the production of evidence. However, if the fact or the particular mentioned above has been exempted from the duty to keep information confidential, the person in possession of the document cannot refuse to produce the document.

Article 221 of the Code of Civil Procedure requires that, if a party requests a court to order the person in possession of the document to produce such document, the party must show the court the facts to be proven by the document.

Further, Article 223(6) of the Code of Civil Procedure provides so-called in camera inspection of a document. The court is entitled to examine whether the document may be withheld from the production of evidence in a proceeding where only court is allowed to access the document.

Exceptions and limitations to the professional secrecy obligation/availability of forced Disclosure

The Court may compel attorneys and patent attorneys to produce evidential documents subject to secrecy obligations. The Code of Civil Procedure, Article 220(1) provides that the person in possession of the document shall not refuse the production of the document where the party itself is in possession of the document that the party has cited in the litigation.

Consequences of the loss of confidentiality and penalties for unauthorized disclosure

Any breach of confidentiality is subject to professional sanctions, where applicable. Any disclosure of secrets is subject to disciplinary measures under the Attorney Act. Article 80 of the Patent Attorney Act provides a specific punishment of imprisonment for a period not more than six months or a monetary penalty not more than 500,000 yen for violation of nondisclosure duty. In addition, Article 134 of the Penal Code provides for an offence for divulging clients' secrets. Clients may also seek compensation for general wrongful acts under Article 709 of the Civil Code. In addition, the Japan Patent Attorneys Association has a code of conduct concerning confidentiality, which also includes penalty provisions.

Requirements/qualifications for patent advisors

In general, a person who intends to become a patent attorney must pass the government examination conducted by the Japan Patent Office, complete the practical training and be registered in the roll of patent attorneys held by the Japan Patent Attorneys Association.

Cross-border aspects

Treatment of foreign patent advisors

The application of Articles 197(1)(ii) and 220(iv) of the Code of Civil Procedure to patent attorneys who are registered in other countries is not clear at this point, due to a lack of case law and established legal opinions.

Clarification of secrecy obligation in order to facilitate recognition in foreign courts

In Japan, following the amendment of the Code of Civil Procedure (Code of Civil Procedure (Act No.109 of June 26, 1996, as last amended by Act No. 30 of May 8,2012)) in 1996, where a patent attorney is examined, as a witness, with regard to any fact that he/she has learned in the course of his/her professional duties and which shall remain confidential, he/she can refuse to testify, in accordance with Article 197(1)(ii) of the Code of Civil Procedure as follows:

> Article 197
> "(1) In the following cases, a witness may refuse to testify:
>
> (i) a case as referred to in Article 191, paragraph (1);
>
> (ii) a person who is or was a doctor, dentist, pharmacist, pharmaceuticals distributor, birthing assistant, attorney at law (this includes registered foreign lawyers), patent attorney, defense counsel, notary, or person engaged in a religious occupation is examined with regard to any fact learned in the course of duty that shall remain confidential;
>
> (iii) the witness is examined with regard to a matter that involves a technical or professional secret.
>
> "(2) The provisions of the preceding paragraph do not apply if the witness has been released from the duty of silence."

Further, in accordance with Article 220(iv) which provides exceptions to the general duty to produce documents, the person in possession of the document that details facts prescribed in Article 197(1)(ii), which includes documents that contain fact learned in the course of duty that shall remain confidential, may refuse the submission of such documents, as follows:

> Article 220
> "In the following cases, the person in possession of the document in question may not refuse to submit that document:
>
> "(iv) in cases other than those listed in the preceding three items, if the document does not fall under any of the following categories:
>
> (a) a document detailing the particulars prescribed in Article 196 with regard to the person in possession of the document or a person who is related to the person in possession of the document in any of the ways set forth in the items of that Article;

(b) a document concerning confidential information in connection with a public officer's duties, which, if submitted, would likely harm the public interest or substantially hinder the performance of a public duty;

(c) a document detailing a fact prescribed in Article 197, paragraph (1), item (ii) or a particular prescribed in Article 197, paragraph (1), item (iii), neither or which are exempt from the duty of silence;

(d) a document prepared exclusively for the use of the person in possession (excluding a document held by the State or a local public entity, which is used by a public officer for an organizational purpose);

(e) documents related to the litigation of a criminal case, the case record in a juvenile protective case, or a document seized in these cases."

Summary

A patent attorney is subject to the secrecy obligations, and has the same right with respect to refusal of testimony and a production of evidential documents. The Patent Attorney Act also provides for penalties for breach of such a secrecy obligation. As the law provides for specific secrecy obligations and certain rights of non-disclosure in relation to Japanese patent attorneys, it is not clear to what extent the law applies to patent attorneys registered in foreign countries. Following and amendment of the respective legal provision, it was clarified that a patent attorney has the right to refuse testimony if examined, as a witness, with regard to any fact that he/she has learned in the course of his/her professional duties and which shall remain confidential, and may be excepted from the general duty to produce documents in courts.

27. KENYA

In Kenya a client-patent advisor privilege applies to lawyers but not to Intellectual Property (IP) advisors unless the IP advisors are also lawyers and provide legal advice. This is stipulated in the Kenyan law as Legal Professional Privilege (LPP). The LPP is a privilege against disclosure, ensuring clients know that certain documents and information provided to lawyers cannot be disclosed at all. It recognizes the client's fundamental human right to be candid with his legal adviser, without fear of later disclosure to his prejudice. It is an absolute right and cannot be overridden by any other interest. However, the LPP only extends to such confidential communications falling under either advice privilege or litigation privilege.

28. KYRGYZSTAN

In accordance with Article 14 of the law of the Kyrgyz Republic "On patent attorneys" information that the patent attorney receives from the principal in connection with the execution of his order is considered confidential, unless otherwise specifically indicated by the principal or should not be obvious from his actions.

The patent attorney must provide safe-keeping of a document, receivable and (or) containing within a process of patent attorney activity. The patent attorney is not entitled to transfer these documents or copies thereof to third parties or discloses orally the information contained therein without the written consent of the person whose interests he/she represents.

Article 13 of indicated law defines responsibility of the patent attorney for non- qualified and poor quality performance of the contract obligation with a principal the patent attorney bears property and other responsibility in accordance with the legislation of the Kyrgyz Republic. Complaints of anyone, related with improper performance of professional duty by the patent attorney, and as well as commissioning actions by him, violating requirements of regulatory legal acts of the Kyrgyz Republic is considered by the Appeal Committee of authorized stated body in the field of Intellectual Property.

29. LATVIA

The Latvian "Law on Industrial Property Institutions and Procedures" (unofficial translation) contains a provision relating to the client-attorney privilege. Section 128 of the "Law on Industrial Property Institutions and Procedures" regulates relations between clients, patent advisors and other persons. The full text of the "Law on Industrial Property Institutions and Procedures" is available here: http://likumi.lv/ta/id/2750 49-rupnieciska-ipasumainstituciju-un-proceduru-likums (Latvian version).

30. LITHUANIA

National aspects

Article 17 of the Law on Patent Attorneys of the Republic of Lithuania (No. XIII-546 of June 29 2017) regulates the protection of the confidential information. It states that such information includes the fact of client referring to a patent attorney, terms of contract, information and data provided by the client, nature of the consultation and data collected by the patent attorney on behalf of the client; it does not include information and data that the client has himself made public, or has clearly indicated his consent to make it public.

Cross-border aspects

The relevant government authorities have no information regarding problems in relation to cross-border aspects of confidentiality of communications between clients and patent advisors, but note that in some cases there might be problems with confidentiality of communications when an exaction of documents is addressed to foreign country and question of application of foreign law arises.

31. MALAYSIA

National aspects

In Malaysia, the law on privilege is a subject matter of legislation supplemented with common law principles where applicable. Generally, then law of privilege only covers communications between a lawyer and his client. However, the Malaysian law on privilege does not protect communications between a registered IP agent and his client.

Discovery procedure and how privilege protection operates against discovery

Under pre-trial case management, the Rules of the High Court 1980 set out a non-exhaustive list of directions which the Judge may make. Where discovery by a party is considered inadequate, application for further or more specific discovery may be made to the court. Failure to comply with an order for discovery can ultimately result in dismissal of the action or striking out of the

defense. It is the legal duty of each party and its solicitor to make full disclosure of those documents in his or her possession or control and relevant to the issues in the action, if the party making disclosure relies on those documents or such documents would lead the opponent to a relevant course of inquiry. The disclosure shall be made even if it is helpful to the opponent's case.

Privileged documents are exempt from disclosure. In Malaysia, the law on privilege is generally the subject of legislation supplemented with common law principles where applicable.

Section 126 of the Evidence Act 1950 prohibits advocates from disclosing any communication with his or her clients for the purpose of his or her professional activities unless express consent is given by the client. Section 126 reads as follows:

> "(1) No [advocate] shall at any time be permitted, unless with his client's express consent, to disclose any communication made to him in the course and for the purpose of his employment as such [advocate] by or on behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment: Provided that nothing in this section shall protect from disclosure – (a) any such communication made in furtherance of any illegal purpose; (b) any fact observed by any [advocate] in the course of his employment as such showing that any crime or fraud has been committed since the commencement of his employment.
>
> "(2) It is immaterial whether the attention of the [advocate] was or was not directed to the fact by or on behalf of his client."

In addition, the client is also protected by privilege under the Evidence Act as provided in Section 129 as follows:

> "No one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional advisor unless he offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others."

For example, communications with legal advisors for the purpose of obtaining legal advice are privileged. Documents tending to incriminate a party are also privileged. Documents containing matters confidential to a party and not otherwise privileged must be disclosed, but the Court may order a controlled method of disclosure to protect confidentiality.

Professionals covered by the privilege and secrecy obligation

Under Section 126 of the Evidence Act 1950 and the Interpretation Act which defines "advocate" to mean a lawyer qualified to practice law in any part of Malaysia, the duty to keep communications with clients secret only applies to qualified practicing lawyers and does not apply to IP professionals in Malaysia (patent and trademark agents) who are not qualified lawyers. A qualified lawyer means a person who has been admitted to the Malayan Bar or the Sabah and Sarawak Bar under the Legal Professional Act 1976 and the respective law in Sabah and Sarawak.

On the other hand, under Section 129 of the Evidence Act, the term "legal professional advisor", and not "advocate", is used. Consequently, clients' privilege to keep communications secret does not apply to communications with patent or trademark agents, but may also be extended to in-house lawyers (VL Kandan, Malaysia's Position on IP Advisor-Client Privilege, WIPO AIPPI Conference on Client Privilege in IP Professional Advice, May 22-23, 2008). Communications with patent agents who are also lawyers are covered by privilege.

Scope of privilege

Generally, the law of privilege in Malaysia only covers communications between a lawyer and his or her client. The scope of privilege is wide and covers all communications in the course and for the purpose of his or her services as a lawyer. It continues even after cessation of his or her employment as a lawyer of the client. Communications protected by privilege would also include communications between the lawyer and third parties (such as independent expert witnesses) during the course of his or her engagement as a lawyer.

The limitations and exceptions to privilege

The limitations and exceptions to privilege have been discussed by the Malaysian Federal Court in a recent case of Anthony See Teow Guan v. See Teow Chuan and See Teow Koon (Civil Appeal 02-50-2006, judgment delivered on February 23, 2009). In this case, the Federal Court upheld the common law maxim that "once privileged, always privileged." The Court held that the client could waive the privilege recognizing the position of the client as the holder of the privilege and the lawyer as the holder of the confidentiality. The waiver must be made with the express consent of the client and as such Malaysian law does not recognize the common law waiver of implication or by imputation. It is also held that the disclosure of any legal opinion did not remove the privilege attached to the legal opinion.

Apart from express waiver, there are statutory provisions that provide for exceptions to privilege. For example, Section 14 of the Anti-Money Laundering and Anti-Terrorism Financial Act 2001 ("AMLATF") imposes on a reporting institution an obligation to "promptly report to the competent authority any transaction: Exceeding such amount as the competent authority may specify; and where the identity of the persons involved, the transaction itself or any other circumstances concerning that transaction gives any officer or employee of the reporting institution reason to suspect that the transaction involves proceeds of an unlawful activity."

With effect from September 30, 2004, advocates and solicitors are included as one of the 'Reporting Institutions' in the First Schedule of AMLATF. Lawyers thus have the same obligations as that of financial institutions to report to the competent authority any transaction which falls within Section 14 of AMLATF.

Further, Section 47 of AMLATF is a provision specific to advocates and solicitors which empowers a High Court judge to make an order, in relation to an investigation into a money laundering offence or a terrorism financing offence, requiring an advocate and solicitor to disclose information in respect of any transaction or dealing relating to any property which is liable to seizure under AMLATF.

The legal professional privilege between the advocate and solicitor and his or her client is overridden by Section 20 of AMLATF for the purposes of the reporting obligation. It will not excuse the advocate or solicitor from any failure to report a suspicious transaction.

Any lawyer who discloses confidential documents and privileged documents without the express consent of his or her client will be subject to professional penalties and professional disciplinary proceedings. The discipline of patent agents is not fully provided for under the Patent

Regulations 1986. Regulation 45E(3) of the Patent Regulations 1986 only provides that "the Registrar may refuse to renew the registration of any person who has been convicted of an offence involving fraud or dishonesty." This may mean that a registered patent agent who has dishonestly disclosed the client's information may be classified as dishonest, and the renewal of the registration may be refused.

Requirements/qualifications for patent advisors

To be a registered patent agent in Malaysia, one has to pass the patent agent examination set by the Malaysian Intellectual Property Corporation and has to hold an engineering or science degree or be a practicing lawyer. Under the Patents Act and the Patent Regulations 1986, a legal education is not required in order to qualify for a patent agent A candidate for the patent agent examination has to sit for several subjects, namely, Technology, Malaysian Patent Law and Practice, Malaysian Trademark and Design Law and Practice and Foreign Intellectual Property Law.

Cross-border aspects

Treatment of foreign lawyers and patent advisors

According to Section 126, the duty of confidentiality applies to domestic lawyers. Due to a lack of case law regarding the interpretation of the term "legal professional advisor" in Section 129 of the Evidence Act, it is not clear whether privilege under Section 129 extends to communications with foreign lawyers. One expert assumes that communications with a client and his or her foreign patent attorney who is also qualified as a lawyer are also covered by Section 129 (VL Kandan, Malaysia's Position on IP Advisor-Client Privilege, WIPO AIPPI Conference on Client Privilege in IP Professional Advice, May 22-23, 2008). Since there is no statutory provision establishing privilege for communications between a client and his or her patent agent who is not a lawyer, it is likely that privilege does not extend to foreign patent attorneys who are not lawyers.

Summary

Malaysia provides for statutory client-attorney privilege to qualified lawyers, including in-house lawyers, only. Therefore, patent agents in Malaysia need to be qualified lawyers in order to be able to be covered by privilege. Whether a foreign based lawyer or a foreign based patent attorney who is also a qualified lawyer is also covered by the client-attorney privilege in Malaysia has not been clarified.

According to Section 129 of the Evidence Act, no one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional advisor. Due to the lack of case law regarding the interpretation of the term "legal professional advisor" in the above provision, it is not clear whether privilege extends to communications with foreign lawyers or to foreign patent advisors.

32. MEXICO

National aspects

The Mexican law provides for a legal privilege for professionals without distinguishing between professionals, attorneys or patent advisors. The Law regulating Article 5 of the Mexican Constitution concerning the discharge of professions in the Federal District, which is published in the Federation Official Gazette on May 26, 1945, states in Article 36:

> "Article 36.- Any professional person shall be obliged to remain strict confidentiality regarding the subjects entrusted to him or her by his or her clients, with the exception of the reports stipulated by the respective laws."

Title Nine, Chapter I, Article 210-211 of the Federal Penal Code states the type of crimes relating to the disclosure of secrets criminalizes the disclosure of professional secrets. It is important to highlight that Article 210 of the above Code establishes the offense of disclosure of a secret or reserved communication that has been made known or received for the purposes of employment, work or post, without establishing a specific capacity in the active subject of the offense, i.e., there is no requirement for the person who discloses the secret to be an attorney. However, Article 211 provides for aggravating circumstances in the case of the disclosure of a secret by a person providing professional services or where the secret or published material is industrial in nature, a legal assumption that may cover the advice of an attorney or lawyer, with respect to subjects such as patent applications or registration of industrial designs, which, as may be appreciated, are industrial elements. Additionally, there is specific regulation for each state of the country.

Each federative entity has powers to legislate on professions issues, which in most cases reproduce article 36 of the Law of Professions of the capital; also, in criminal matters they reproduce the Federal Penal Law.

Cross-border aspects

As regards regional practice, there is no bi- or multilateral treaty to which Mexico is party, which would incorporate the scenario of client-attorney privilege. For that reason the legislation of each country in which a relationship exists between clients and their patent advisors shall apply

33. MONACO

National aspects

Article 308 of the Criminal Code of Monaco punishes any violation of a professional secrecy obligation, including that of a patent attorney providing advice to his client. According to Article 329 of the Code of Civil Procedure, any person bound by a professional secrecy or confidentiality obligation can refuse testimony in court proceedings.

Cross-border aspects

There is no legal provision in Monaco which could lead to the conclusion that foreign patent attorneys would be treated in a different way.

34. MOROCCO

The profession of Industrial Property Adviser (IPA) was first regulated in Morocco by Law № 23/13 amending and supplementing Law № 17/97, which entered into force on December 18, 2014.

Articles 4(1) to 4(11) of that law lay down the conditions for serving as an IPA.

Article 4(7) establishes a commission to examine IPA applications. Pursuant to article 4(10), the commission may impose disciplinary measures on persons who infringe the regulations or code of ethics of the profession (including confidentiality).

35. NEW ZEALAND

National Aspects

Under Section 54 of New Zealand's Evidence Act 2006, communications between "legal advisers" and their clients are privileged. The definition of "legal adviser" refers to lawyers, registered patent attorneys and "overseas practitioners" whose functions wholly or partly correspond to those of New Zealand registered patent attorneys. Such "overseas practitioners" include Australian barristers, solicitors and registered patent attorneys and practitioners who are equivalent to New Zealand's lawyer or patent attorney and are in a country specified by an Order in Council. The privilege covers communications relating to the obtaining or giving of information or advice concerning intellectual property, which includes copyright and protection against unfair competition.

Discovery procedure and how privilege protection operates against discovery

New Zealand court trials closely resemble those of the United Kingdom and Australia. Pre-trial discovery is limited to document discovery (which is based on similar concepts of relevance to the United Kingdom) and interrogations answered on affidavit. In New Zealand, legal professional privilege is a term that applies to the protection of confidential communications between a lawyer and his or her client. Legal advice protected by legal professional privilege will not need to be produced for inspection during discovery in legal proceedings. Consequently, the opponent in the case will not be able to have access to the privileged document.

Professionals covered by the privilege and secrecy obligation

Amongst the various reforms brought about by the New Zealand Evidence Act 2006, which came into force on August 1, 2007, was a strengthening of the statutory privilege which protects communications between registered patent attorneys and their clients (also known as "patent attorney privilege"). The privilege also covers in-house lawyers.

Section 54 of the Evidence Act 2006 provides that:

> "Privilege for communications with legal advisors
> (1) A person who obtains professional legal services from a legal advisor has a privilege in respect of any communication between the person and the legal advisor if the communication was-
> (a) intended to be confidential; and
> (b) made in the course of and for the purpose of-
> (i) the person obtaining professional legal services from the legal advisor; or
> (ii) the legal advisor giving such services to the person.
>
> "(2) In this section, professional legal services means, in the case of a registered patent attorney or an overseas practitioner whose functions wholly or partly correspond to those of a registered patent attorney, obtaining or giving information or advice concerning intellectual property.
>
> "(3) In subsection (2), intellectual property means 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 endeavor;
> (d) scientific discoveries;
> (e) geographical indications;

(f) patents, plant varieties, registered designs, registered and unregistered trademarks, 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."

Thus, under Section 54 of the Evidence Act 2006, privilege may be claimed for communications between "legal advisors" and their clients. The definition of "legal advisor" refers to lawyers, registered patent attorneys and overseas practitioners whose functions wholly or partly correspond to those of a New Zealand registered patent attorney.

Scope of privilege

In accordance with the Evidence Act 2006, privilege applies to communications between a legal advisor and his or her client, where the legal advisor is acting in his or her professional capacity, the communication is intended to be confidential, and the communication is for the purpose of obtaining legal advice.

Under the former Evidence Act 1980, registered patent attorneys and their clients could claim privilege only in relation to information or advice relating to any patent, design, or trademark, or to any application in respect of a patent, design, or trademark, whether or not the information or advice related to a question of law. However, the Evidence Act 2006, under Section 54(2), has extended the scope of legal professional privilege relating to registered patent attorneys and overseas practitioners so as to cover communications relating to obtaining or giving information or advice concerning "intellectual property", as defined under Section 54(3) above.

The statutory intent of the above amendment is to provide all-encompassing protection against discovery during legal proceedings of communications between patent attorneys and their clients concerning the protection, enforcement or use of intellectual property rights. The scope of the privilege is not limited simply to the types of communications listed, but may protect any other communications concerning rights resulting from intellectual activity in the industry, scientific, literary or artistic fields.

The limitations and exceptions to privilege

The protection of legal professional privilege may be lost in two circumstances, express waiver and implied waiver. Express waiver exists when a client chooses to waive privilege in the legal advice and release it. Implied waiver exists when a client refers to the legal advice in a way that would make it unfair to allow the privilege to be maintained.

Consequences of the loss of confidentiality and penalties for disclosure

As in any other common law countries, loss of confidentiality means that the relevant document and communication has to be disclosed and communicated to the party requesting such information. Professionals who make unauthorized disclosure may have to face disciplinary proceedings. The Patent Regulations do not provide for any disciplinary procedure for breach of confidentiality. Patent attorneys who are members of the New Zealand Institute of Patent

Attorneys may be subject to the Code of Conduct set by the Institute. Under the Code of Conduct, paragraph 1.3 states that it is the duty of the patent attorney to keep his or her knowledge of each client's affairs confidential unless otherwise expressly authorized by clients to disclose it.

Upon a breach of Code of Conduct, the Institute may impose the following penalties: admonishment and/or reprimand delivered in writing; suspension from membership of the Institute for such a period and on such terms as the Council deems appropriate, with such suspension and the terms or conditions thereof to be notified to the member in writing, or expulsion from the Institute.

Treatment of foreign lawyers and patent advisors

New Zealand now extends the legal professional privilege to communications between a client and his or her foreign legal advisor including foreign patent attorneys from more than 80 countries. This is due to the Order in Council of August 2008 issued under the Evidence Act 2006.

Requirements/qualifications for patent attorneys

In New Zealand, a patent attorney is a person that has specialized qualifications to act as a professional intermediary between clients and the Intellectual Property Office of New Zealand. Patent attorneys deal with intellectual property, specifically, patents, trademarks, and designs. In practice, patent attorneys also deal with other aspects of intellectual property law, such as copyright, trade secrets and plant variety rights.

The Patent Regulations 1954 provide the regulations on how to register as a patent attorney in New Zealand. Section 154 of the Patent Regulations 1954 provide that any person who wishes to be registered as a patent attorney in New Zealand must be a British subject or a citizen of the Republic of Ireland, of good character, and have passed the patent attorneys' examination. If an applicant is not a solicitor of the Supreme Court of New Zealand, or a patent agent or patent attorney registered in the United Kingdom or in Australia, such a person must have been employed for a period totaling not less than three years by a patent attorney in New Zealand; or in the Patent Office; or in some other employment which, in any particular case in the opinion of the Commissioner and the Council of the New Zealand Institute of Patent Attorneys Incorporated, affords substantially similar practical experience to that given by either of the last two mentioned forms of employment.

Candidates wishing to apply to be registered as a patent attorney must pass an examination, consisting of the following subjects: New Zealand Law and Practice relating to patents and designs; New Zealand Law and Practice relating to trademarks; Foreign Patent Law; the preparation of specifications for New Zealand patents; and patent attorney practice in New Zealand, including the interpretation of patent specification.

Cross-border aspects

Due to the Order in Council of August 2008 issued under the Evidence Act 2006, New Zealand extends the legal professional privilege to communications between a client and his or her foreign legal advisor including foreign patent advisors from 87 countries.

Section 54 of the Evidence Act 2006 provides that the privilege applies to an "overseas practitioner whose functions wholly or partly correspond to those of a registered patent attorney, obtaining or giving information or advice concerning intellectual property."

36. NORWAY

National aspects

There are no authorization nor attorney–client evidentiary privilege for patent advisors in Norway. However, authorized lawyers have the right to keep the communications with their client confidential according to the Dispute Act, Article 22-5, the Criminal Procedure Act, Article 119 and the Criminal Code Article 144.

Cross-border aspects

Due to international development on this matter, the Norwegian Government has recently indicated to consider whether to implement regulations on authorization of patent advisors in order to provide attorney–client evidentiary privilege for patent advisors in Norway.

37. PERU

The Constitution of Peru protects in Article 2, Section 18 the professional secrets.

With regard to legislation on the scope of professional client/lawyer confidentiality Article 165 of the Criminal Code of Peru provides that:

> "CHAPTER V. BREACH OF PROFESSIONAL CONFIDENTIALITY
>
> Article 165.- Breach of professional confidentiality
>
> Persons who are privy to information, by virtue of their status, occupation, employment, profession or ministry, about secrets whose disclosure can cause harm and who reveal them without the consent of the interested party shall be sentenced to a maximum of two years' imprisonment and 60 to 120 day fines."

38. PHILIPPINES

Scope of Client-Attorney Privilege

There exists some national legislation that relate to the scope of protection in client-attorney relationships. Those most applicable to patent advisors are as follows:

- If the patent advisor is a lawyer:

  1) the "attorney cannot, without the consent of his client, be examined as to any communication made by the client to him, or his advice given thereon in the course of, or with a view to, professional employment." In addition, "an attorney's secretary, stenographer, or clerk" may not testify as to "any fact the knowledge of which has been acquired in such capacity" without first securing the consent of the attorney and the client. (Rule 130 of the Rules of Court, Section 24(b));

  2) It is likewise prohibited for any attorney-at-law or any person duly authorized to represent and/or assist a party to a case, who, "by any malicious breach of professional duty or of inexcusable negligence or ignorance, shall prejudice his client, or reveal any of the secrets of the latter learned by him in his professional capacity". The penalty for such revelation of secrets is *prisión mayor* in its medium period, or imprisonment from

between 2 years, 4 months and 1 day to 4 years and 2 months, or a fine ranging from PhP40,000-PhP200,000, or both. (Revised Penal Code, Article 209, as amended by Republic Act № 10951).

- If the patent advisor is not a lawyer, the client may take in the provisions of the Civil Code of the Philippines, which pertinent provision states:

Article 21. Any person who willfully causes loss or injury to another that is contrary to morals, good customs, or public policy shall compensate the latter for the damage.

39. POLAND

In Poland, there is a general rule in the industrial property law which provides that in proceedings before the patent office in matters related to the filing of applications and maintenance of the protection of inventions, utility model, industrial designs, trademarks, geographical information and topographical information, parties can be represented by a patent or trademark agent or by a person rendering cross-border services. In proceedings before administrative and civil courts, including before the Supreme Court, in cases involving intellectual property matters, parties can be represented by barristers, attorneys at law or patent and trademark agents.

Pursuant to Article 14 (1) of the Polish Act on Patent Attorneys of 2001, patent attorneys admitted to the bar are obliged to keep the confidentiality of any information acquired in the course of practicing the profession. Accordingly, Polish patent attorneys are entitled to refuse to testify before the courts, since the applicable provision of the civil procedure code granted such a right. The patent attorney's obligation to keep the professional confidentiality of the facts obtained during provision of assistance in IP matters cannot be waived.

As regards persons rendering cross-border services, there is a general principle provided in the legal provisions regulating various professions, including in the Act on Patent and Trademark Agents. According to that principle, such persons are entitled to perform any duties of barristers and attorneys at law or patent trademark agents, if they are qualified to perform such duties in their mother countries, but only within the limits of rights provided in respect of that profession in the laws of their own countries. This means that foreign advisors in Poland enjoy confidentiality privilege only to the extent they enjoy it in their home countries. In order to be able to enjoy those rights, such persons have to meet some formal requirements stipulated by the Polish law, such as submitting a certificate confirming that they are qualified to practice their profession in their country of origin, a document indicating his or her citizenship, and a copy of the civil liability insurance. It is advisable that such persons have communication skills in the Polish language. That general rule applies to citizens of the EU Member States, while the principle of reciprocity applies to persons of non-EU Member States rendering cross-border services.

A European patent attorney, who is not registered as a Polish patent attorney, is not entitled to represent clients before the Polish courts and is not admitted to the Polish bar. Therefore, in general, he cannot refuse testifying on confidential matters under professional secrecy before the Polish courts.

40. PORTUGAL

National aspects

There is no specific legislation on confidentiality of communications between clients and their patent advisors in Portugal. However, patent attorneys who are members of ACPI (Portuguese Association of Industrial Property Consultants) are bound by ethical rules of the association and of the relevant technical international federation (FICPI). The patent attorneys who are also attorneys at law are as well subject to the rules established by their own professional bar that recognizes the obligation of confidentiality in communications with customers. Although there are no legally prescribed penalties in such cases, the duties of confidentiality are generally safeguarded in the national territory.

Cross-border aspects

At the international level, the disparities within the various jurisdiction and the lack of international regulation on the issue of confidentiality is considered disturbing since the information contained in patent documents usually takes a cross-border character which would require that non-disclosure rules should have a transverse nature among several countries.

41. REPUBLIC OF KOREA

The law in the Republic of Korea protects the confidentiality of communications between clients and their patent advisors by civil and criminal law. Article 26 (Duty to Maintain Confidentiality) provides that "no attorney-at-law or former attorney-at-law shall disclose any confidential matter that he/she has learned in the course of performing his/her duties: provided, that the same shall not apply to cases where such disclosure of confidential matters is especially prescribed otherwise by Acts." Article 23 (Crime as to Use by Stealth and Divulgence) provides that a "patent attorney or a person who was a patent attorney divulges or uses by stealth without any justifiable reason the secret of an invention or design of an inventor, a designer, or an applicant for patent or registration, which he has learned in the course of performing his duty, he shall be punished by imprisonment for not more than five years or a fine not exceeding ten million won."

The obligation also applies to the forced disclosure of documents. Article 112 (Professional Secrets and Seizure) states that a "person who is or was a licensed advocate, patent attorney, notary public, certified public accountant, licensed tax accountant, public scrivener, doctor, herb doctor, dentist, pharmacist, druggist, midwife, nurse, or a religious functionary may resist seizure of articles held in his custody or possession in consequence of mandate he has received in the course of his profession and which relates to secrets of other persons: provided, that this shall not apply if the principal has consented to such seizure, or if it is necessary for important public interests." Article 149 provides the same privilege to refuse to testify in respect to facts of which he has obtained knowledge in consequence of a mandate he has received in the course of his profession.

However, Article 315 (Right to Refuse Testimony) provides that the right to refuse testimony shall "not apply to the case where the witness has been exempted from a liability for keeping secret" and Article 344 (Obligation to Submit Document) provides for the case of forcible disclosure:

> "(1) When the party holds the document quoted in a lawsuit;
>
> (2) When the applicant holds a judicial right to ask the holder of the document to transfer or show it to him; and
>
> (3) When the document has been prepared for the benefit of the applicant, or prepared as to a legal relationship between the applicant and the holder of document: Provided, that the same shall not apply to the case falling under any one of the following causes".

42. REPUBLIC OF MOLDOVA

According to the Rule 45 of the Regulations on the Activity of Patent Attorneys of the Republic of Moldova of July 22, 2011, which entered into force from July 22, 2012, patent attorneys shall exercise their powers according to the principles of good faith, honesty, trust and confidentiality. According to Article 1852, par. 1 of the Penal Code of the Republic of Moldova, the disclosure of information on IP prior to the official publication of data from the registration request, by a person to whom such information was entrusted is sanctioned.

43. ROMANIA

In Romania the "confidentiality" is not specifically regulated for the IP domain but it is based on the provisions of the Code of Ethics for Lawyers. More precisely, as most of the patent advisors are also lawyers, the principle of professional secrecy and the principle of professionalism and loyalty to the client is applicable (Article 8 (2) (c) and (h) of the Code of Ethics).

44. RUSSIAN FEDERATION

National aspects

Origin of the professional secrecy obligation and its coverage

Article 23 of the Constitution of the Russian Federation guarantees that each person shall have the right to inviolability of private life, and personal and family secrecy. This right may be restricted only on the basis of a court decision (Article 23, Chapter 2 "Rights and Freedoms of Human Beings and Citizens" of the Constitution of the Russian Federation, December 12, 1993). Presidential Decree No. 188 of March 6, 1997, defines a list of confidential information. The list includes inter alia: information linked to professional activities, access to which is restricted in accordance with the Constitution of the Russian Federation and Federal Laws (medical and notarial secrecy, and attorney privilege, confidentiality of correspondence, telephone conversations, postal dispatches, telegraph or other communications etc.); information linked to commercial activities, access to which is restricted in accordance with the Civil Code of the Russian Federation and Federal Laws (commercial secrecy); information on the essential features of an invention, utility model or industrial design prior to official publication of information thereon.

Federal Law No. 149-FZ of July 27, 2006, on Information, Information Technologies and Protection of Information (Article 9(5) of the Federal Law No. 149 FZ of July 27, 2006 on Information, Information Technologies and Protection of Information. (Further "Federal Law on Information")) states that information obtained by citizens when carrying out professional obligations, or by organizations in their performance of specific types of activities (professional secrecy) shall be protected in cases where obligations are placed on these persons by federal laws to observe the confidentiality of such information.

Thus, it can be said that the institution of "professional secrecy" is based on the constitutional right of citizens to the inviolability of their private life, and personal and family secrecy. The laws regulating one or other specific activity may contain provisions obliging confidentiality of the information obtained in the performance of such activities to be observed. The sphere of validity of this institution covers the activities of natural persons in their performance of professional obligations or of organizations in their performance of specific forms of activities.

Professionals bound by the secrecy obligation

The requirement to observe professional secrecy is established by the laws in various spheres of activity: for doctors (medical secrecy), lawyers (attorney privilege) (Article 4(5) of the Federal Law on Advocatory Activity and Advocacy in the Russian Federation, May 31, 2002, N63-FZ), notaries and other persons carrying out notarial activities (notarial secrecy), courts of arbitration (secrecy of arbitration proceedings), for persons registering acts of civil status (secrecy of child adoption), for telecommunications operators and their employees (secrecy of communication), tax authorities and their employees (fiscal secrecy), banks and their employees (banking secrecy), pawn brokers and their employees, internal affairs authorities and their employees etc.

Federal Law No. 316-FZ of December 30, 2008, on Patent Attorneys (which came into force on April 1, 2009) establishes, in relation to patent attorneys, a prohibition "to transmit or otherwise disclose", without the client's written consent, information contained in "documents obtained and/or produced as part of the performance of their activities" (Article 4(3)(6) of the Federal Law on Patent Attorneys, No. 316-FZ of December 30, 2008 (Further: Federal Law on Patent Attorneys)). In addition, an employer of a patent attorney, who has concluded a civil law agreement with a client providing for the patent attorney's services, shall not disclose confidential information obtained as part of the implementation of this agreement (Article 3(2)(4) of the Federal Law on Patent Attorneys).

Kind of information/communication covered by secrecy obligation

There is no general description in legislation of the types of information/ communications which may be protected by professional secrecy. In each specific profession, the relevant law establishes the type of information/communication relating to confidential issues, not subject to disclosure without the consent of the client.

As far as attorneys are concerned, the following types of information and documents, inter alia, are covered by a secrecy obligation: any documents and evidence prepared by an attorney in preparation of litigation; information received from the clients; information about clients which became known to the attorney in the course of provision of legal advice; the content of legal advice provided and any other type of information related to the provision of legal assistance by the attorney to the client. The attorneys' secrecy obligation in relation to the above listed commutations/documents is not time-bound and can only be waived by the client.
In relation to a patent attorney, the restriction contained in Presidential Decree No. 188 of March 6, 1997, which defines as confidential information the essential features of an invention, utility model or industrial design prior to publication of official information thereon, is

applicable. The Law on Patent Attorneys identifies as protectable by professional secrecy the content of documents obtained and/or produced as part of the activities of a patent attorney, and also confidential information obtained as part of the implementation of an agreement with a client.

As a general rule, the Federal Law on Information establishes that "information which constitutes a professional secret may be passed on to third parties in accordance with federal laws and/or on a court decision" (Article 9(6) of the Federal Law on Information). Nevertheless, an exception to this rule is established for attorneys. In particular, the Federal Law on Advocatory Activity and Advocacy in the Russian Federation provides that "an attorney cannot be called or questioned as a witness in relation to circumstances made known to him as a result of a request for legal assistance made to him or in connection with its provision" (Article 8(2) of the Federal Law No. 63-FZ of May 31, 2002 on Advocatory Activity and Advocacy in the Russian Federation, amended on October 28, 2003, and August 22 and December 20, 2004). A similar provision, in relation to attorneys, exists under the Code of Criminal Procedure of the Russian Federation (Article 56(3) of the Code of Criminal Procedure of the Russian Federation of December 18, 2001, No.174 FZ).

Such an exception to the general rule of disclosure for attorneys is granted as a realization of the provisions of the Constitution of the Russian Federation on the right of each person to qualified legal assistance (Article 48, Chapter 2 "Rights and Freedoms of Human Beings and Citizens" of the Constitution of the Russian Federation) and the right to inviolability of private life, and personal and family secrecy (Article 23, Chapter 2 "Rights and Freedoms of Human Beings and Citizens" of the Constitution of the Russian Federation), as well as universally recognized principles and norms of international law.

A patent attorney who is obliged to observe professional secrecy does not enjoy "immunity" against requests from a court to disclose confidential information. The "immunity" does not also apply to the activities of other professions listed above under "Professionals bound by the secrecy obligation". This is because the activity of a patent attorney is not regarded as advocatory activity, except in cases where it is the attorney who fulfils the function of a patent attorney (Article 1(3) of the Federal Law No. 63-FZ of May 31, 2002 on Advocatory Activity and Advocacy in the Russian Federation, amended on October 28, 2003, and August 22 and December 20, 2004). Thus, it is mainly an attorney ("адвокат"), a person who has a graduate or post-graduate legal degree, and has successfully passed the examination and obtained the status of attorney according to the applicable law in the Russian Federation, who is covered by such "immunity". It is to be noted that the Code of Criminal Procedure of the Russian Federation provides that a churchman and a member of the State Duma cannot be questioned as witnesses in relation to circumstances made known to them as a result of their profession (Article 56(3)).

Exceptions and limitations to the professional secrecy obligation/availability of forced disclosure

As provided by the Federal Law on Advocatory Activity and Advocacy, in the Russian Federation, an attorney cannot be called or questioned as a witness in relation to circumstances made known to him in the course of provision of legal assistance. However, this rule neither applies to means of committing the crime nor to things, the circulation of which is prohibited or restricted by the Law of the Russian Federation (Article 8(3) of the Federal Law No. 63-FZ of May 31, 2002 on Advocatory Activity and Advocacy in the Russian Federation, amended on October 28, 2003, and August 22 and December 20, 2004).

Consequences of the loss of confidentiality and penalties for unauthorized disclosure
Penalties for disclosure of confidential information are established by law. Penalties may be civil, administrative or criminal.

One of the civil penalties, established by the Civil Code, is the obligation to provide compensation for losses caused by the unlawful disclosure of confidential information (Articles 15 and 1472 of the Civil Code of the Russian Federation). Other civil penalty measures may be established by agreement between the holder of confidential information and the person to whom this information was transmitted.

The patent attorney who has allowed disclosure of confidential information may be subject to special measures provided for under the Law on Patent Attorneys: an administrative caution; suspension of activity of the patent attorney for a period of up to one year or exclusion from the Register of Patent Attorneys for a period of up to three years according to a court decision, taken at the request of the Patent Office (Articles 9 and 10 of the Federal Law on Patent Attorneys).

The Code of the Russian Federation on Administrative Infringements provides for administrative penalties for the deliberate disclosure of information with limited access: an administrative fine ranging from 500 to 1,000 rubles for citizens and from four to five thousand rubles for officials (Articles 13 and 14 of the Code of the Russian Federation on Administrative Infringements, December 30, 2001).

The disclosure of information on the essential features of an invention, utility model or industrial design prior to its official publication, where these acts have caused major harm, shall incur criminal penalties in accordance with Article 147 of the Criminal Code of the Russian Federation: a fine of up to 200,000 rubles or the salary or other income of the convicted person, for a period of up to 18 months, or compulsory labor for a period ranging from 180 to 240 hours, or a prison sentence of up to two years (Article 147 of the Criminal Code of the Russian Federation, June 13, 1996, No.63 FZ).

Requirements/qualifications for patent advisors

A citizen of the Russian Federation may be registered as a patent attorney of the Russian Federation if he or she resides permanently on its territory, has attained the age of 18, completed higher education, and has not less than four years' experience working in the sphere of activity of a patent attorney in accordance with his or her chosen specialization, has successfully passed the qualifying examination, at which knowledge of legislation on intellectual property is tested, and has the practical skills to work as a patent attorney in his or her chosen specialization (specialization: inventions and utility models; industrial designs; trademarks and service marks; appellations of origin; computer programs, databases and topographies of integrated circuits) (Article 2 of the Federal Law on Patent Attorneys).

Cross-border aspects

Treatment of foreign patent advisors

The Federal Law on Advocatory Activity and Advocacy applies to foreign attorneys who obtained the status of attorney according to the applicable law in the Russian Federation (Article 2(6) of the Federal Law No. 63-FZ of May 31, 2002 on Advocatory Activity and Advocacy in the Russian Federation, amended on October 28, 2003, and August 22 and December 20, 2004). According to the wording of the statute, it appears that such foreign attorneys cannot be called or questioned as a witness in relation to circumstances made known to them in connection with provision of legal assistance.

Foreign patent attorneys do not enjoy immunity in relation to the legal requirements of a Russian court to disclose confidential information entrusted to them by their clients. As part of civil, administrative and criminal liability for disclosure of confidential information, where the

disclosure has occurred in the territory of the Russian Federation, foreign persons are treated on the same conditions as Russian citizens. There is no case law developed on the issue of treatment of foreign patent attorneys as far as the issue of secrecy obligation is concerned.

Summary

Patent attorneys have an obligation to keep the contents of documents obtained and/or produced as part of the activities of a patent attorney, as well as confidential information obtained as part of the implementation of an agreement with a client, undisclosed to third parties without the consent of the client. However, unlike general attorneys at law, patent attorneys do not enjoy "immunity" and have to provide confidential information upon court request. Similarly, foreign patent attorneys do not enjoy immunity in relation to the legal requirements of a Russian court to disclose such confidential information.

The Federal Law on Advocatory Activity and Advocacy and the Code of Criminal Procedure of the Russian Federation provides that an attorney in law cannot be called or questioned as a witness in relation to circumstances made known to him as a result of a request for legal assistance made to him or in connection with its provision. However, foreign patent attorneys do not have protection in relation to the legal requirements of a Russian court to disclose confidential information entrusted to them by their clients.

45. SINGAPORE

Introduction

In Singapore, the sources of law on the issue of privilege against disclosure are the Evidence Act, the Patents Act, and the common law.

As background, Singapore law recognizes a form of privilege known as "Legal Advice Privilege". Under Legal Advice Privilege, communications for the purposes of obtaining legal advice are protected from disclosure. The main sources of Singapore law for Legal Advice Privilege are several provisions in the Evidence Act. Legal Advice Privilege is the first of the two components of Legal Professional Privilege that is recognized in Singapore.

The second of the two components of Legal Professional Privilege that is recognized in Singapore is "Litigation Privilege". This form of privilege is intended to maintain the confidentiality of the strategy in litigation and preparation of the case. The main source of Singapore law for Litigation Privilege is the common law (Litigation Privilege has been explicitly recognized in past Singapore Supreme Court cases). Litigation Privilege overlaps with Legal Advice Privilege in respect of communications between a client and a lawyer concerning litigation. Therefore, advice given by the advocate and solicitor to his client in relation to court proceedings would be protected by both Legal Advice Privilege and Litigation Privilege.

In addition to the above, the Patents Act contains statutory provisions which accord privilege for proceedings before the Registrar of Patents, and which also accord privilege from disclosure for communications with registered patent agents and registered foreign patent agents.

Origin of privilege and its coverage

Singapore Evidence Act

The Evidence Act is the main source of law for Legal Advice Privilege.

Section 128(1) of the Evidence Act prohibits advocates and solicitors from doing any of the following except with the client's express consent: (a) disclosing any communication made to him in the course and for the purpose of his employment as such advocate or solicitor by or on behalf of his client; (b) stating the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment; (c) disclosing any advice given by him to his client in the course and for the purpose of such employment.

Section 128A(1) of the Evidence Act prohibits legal counsel in entities (i.e. in-house counsel) from doing any of the following except with their entity's express consent (a) disclosing any communication made to him in the course and for the purpose of his employment as such legal counsel; (b) stating the contents or condition of any document with which he has become acquainted in the course and for the purpose of his employment as such legal counsel; (c) disclosing any legal advice given by him to the entity, or to any officer or employee of the entity, in the course and for the purpose of such employment. Under Section 128A(4) of the Evidence Act, where the legal counsel is employed by one of a number of corporations that are related to each other under section 6 of the Singapore Companies Act, Section 128A(1) of the Evidence Act applies in relation to the legal counsel and every corporation so related as if the legal counsel were also employed by each of the related corporations.

Under Section 129A of the Evidence Act, Sections 128 and 128A apply to interpreters and other persons who work under the supervision of legal professional advisors. Section 131(2) of the Evidence Act, discussed below, defines what a "legal professional advisor" is for Section 129A.

Section 131(1) of the Evidence Act provides that "[n]o one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional adviser unless he offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others." Section 131(2) of the Singapore Evidence Act defines "legal professional adviser" as an advocate or solicitor; or in the case of any communication which has taken place between any officer or employee of an entity and a legal counsel employed, or deemed to be employed (under Section 128A(4) or (5)), by the entity in the course and for the purpose of seeking his legal advice as such legal counsel, that legal counsel.

Common law

The common law is the main source of law for Litigation Privilege.

Singapore Supreme Court cases which have recognized Litigation Privilege include the following: the Singapore High Court case of Gelatissimo Ventures (S) Pte Ltd & Ors v Singapore Flyer Pte Ltd [2010] 1 SLR 833 ("Gelatissimo"); and the Singapore Court of Appeal case of Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Brewries (Singapore) Pte Ltd and Other Appeals [2007] 2 SLR (R) 367 ("Skandinaviska"). Litigation Privilege covers not only communications between the lawyer and the client concerning litigation, it also covers information provided by a third party to the lawyer or client predominantly for the purposes of pending or anticipated court proceedings.

Singapore Patents Act

Section 94 of the Singapore Patents Act extends the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an advocate and solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to an advocate and solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in Singapore, to communications so made for the purpose of any pending or contemplated proceedings before the Registrar of Patents under the Singapore Patents Act.
Section 95(1) of the Singapore Patents Act provides that communications (with respect to any matter relating to patents) between a person and a registered patent agent or a registered foreign patent agent, for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent or a registered foreign patent agent, is privileged from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

Professionals covered by privilege

The professionals covered by privilege, as seen from the Singapore Evidence Act provisions, the common law cases, and the Singapore Patents Act provisions described above, are advocates and solicitors, in-house counsel, interpreters and other persons who work under the supervision of legal professional advisors, Singapore registered patent agents and Singapore registered foreign patent agents.

Kind of information/communication covered by privilege

The kinds of information/communications that are covered by privilege can be seen in the explanation given above on the Singapore Evidence Act provisions, the common law cases and the Singapore Patents Act provisions.

Exceptions and limitations /availability of forced disclosure

Singapore Evidence Act Exceptions to Legal Advice Privilege

The following disclosures are not protected under Section 128 of the Evidence Act:
(a) any communication made in furtherance of any illegal purpose; (b) any fact observed by any advocate or solicitor in the course of his employment showing that any crime or fraud has been committed since the commencement of his employment (Section 128(2) of the Evidence Act).

The following disclosures are not protected under Section 128A of the Evidence Act:
(a) any communication made in furtherance of any illegal purpose; (b) any fact observed by any legal counsel in an entity in the course of his employment as such legal counsel showing that any crime or fraud has been committed since the commencement of his employment as such legal counsel; (c) any communication made to the legal counsel which was not made for the purpose of seeking his legal advice; and (d) any document which the legal counsel was made acquainted with otherwise than in the course of and for the purpose of seeking his legal advice (Section 128A(2) Evidence Act).

Section 131(1) of the Evidence Act does not apply when the client offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others (Section 131(1) of the Singapore Evidence Act).

Common law exceptions to Litigation Privilege

There is academic argument that there should be an exception in Singapore to Litigation Privilege for communications made in furtherance of any illegal purpose. However, there is no Singapore case on this issue yet.

Singapore Patents Act

There are no statutory exclusions to Sections 94 and 95 of the Patents Act. Requirements/qualifications for registered patent agents and registered foreign patent agents.

Under Rule 6 of the Patents (Patent Agents) Rules, an individual is entitled to be registered as a patent agent in Singapore if he fulfills the following requirements:

(a) is resident in Singapore;
(b) holds a university degree or equivalent qualification approved by the Registrar;
(c) has passed the course specified in Part I of the Third Schedule;
(d) has passed the examination specified in Part II of the Third Schedule; and
(e) has completed internship in patent agency work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule, for - (i) a continuous period of at least 12 months; or (ii) a total period of at least 12 months within a continuous period of 24 months.

Under Rule 10A of the Patents (Patent Agents) Rules, an individual is eligible to apply for registration as a foreign patent agent in Singapore if –

(a) he is resident in Singapore; and
(b) he is registered as a patent agent or patent attorney with —
(i) any patent office (other than the Singapore Registry of Patents); or
(ii) any professional accreditation or regulatory body for patent agents or patent attorneys in any country or jurisdiction other than Singapore.

Summary

In Singapore, the sources of law on the issue of privilege against disclosure are the Evidence Act, the Patents Act, and the common law.

Legal Professional Privilege has two components – Legal Advice Privilege and Litigation Privilege.

The Evidence Act is the main source of law for Legal Advice Privilege. Under the Evidence Act, advocates and solicitors, and in-house counsel, are prohibited from disclosing communications made to them in the course of, and for the purpose of their employment, stating the contents of or condition of any document which they have become acquainted in the course of and for the purpose of their employment, and disclosing any legal advice given in the course of and for the purpose of such employment. These prohibitions also apply to interpreters as well as other persons who work under the supervision of such advocates and solicitors and in-house legal

counsel. The common law is the main source of law for Litigation Privilege. Singapore Supreme Court cases that have recognized Litigation privilege are the cases of Gelatissimo and Skandinaviska, both of which have been cited above.

The Patents Act extends the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an advocate and solicitor, to communications so made for the purpose of any pending or contemplated proceedings before the Registrar of Patents under the Singapore Patents Act. It also provides that communications (with respect to any matter relating to patents) between a person and a registered patent agent or a registered foreign patent agent, for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent or a registered foreign patent agent, is privileged from disclosure in legal proceedings in Singapore.

46. SOUTH AFRICA

National Aspects

Discovery procedure and how privilege protection operates against discovery

According to the South African Law of Evidence, legal professional privilege in South Africa is based on the Anglo-American evidentiary system. It is based on the fundamental principle that every person has the right of access to the courts, and thus the right of access to a legal advisor, which includes the right to consult with such an advisor privately and confidentially. Generally, as in any other common law country, a privileged document will not be subject to disclosure in any litigation or to the court. However, it should be borne in mind that the question of privilege has not yet been scrutinized by the South African Courts in view of the South African Constitution which came into effect in 1997 (Constitution of the Republic of South Africa No. 108 of 1996). Although the Constitution contains no express recognition of a right to privilege, the Constitution appears to suggest the implicit creation of such a right. Section 34 mentions the right to access to the courts. Section 35 recognizes the right to assistance of counsel and the right not to be compelled to give self-incriminating evidence. Section 14 creates the general right to privacy, which includes the right not to have the privacy of communications infringed.

Professionals covered by the privilege and secrecy obligation

In terms of common law privilege, South African and foreign attorneys, which include in-house attorneys, but exclude patent agents or attorneys acting in their capacity as patent agents, may enjoy client-attorney privilege.

In 1997, the South African Patents Act No. 57 of 1978 was amended to include a new Section 24(9) which provides that:

> "(9) Any communication made by or to a patent agent in his or her capacity as such shall be privileged from disclosure in legal proceedings in the same manner as is any communication made by or to an attorney in his or her capacity as such."

Consequently, communications between a client and a South African patent agent or patent attorney acting in the capacity of a patent agent (e.g. advising on the patentability of an invention or drafting, filing and prosecuting a patent application) are privileged. It is important to note, however, that this provision expressly applies only to South African patent agents.

Scope of privilege

Under the common law, communications made between a client and a legal advisor may obtain privilege if the following requirements are met:

(i) the legal advisor must have been acting in his or her professional capacity;
(ii) the legal advisor must have been consulted in confidence;
(iii) the communication must have been made for the purpose of obtaining legal advice; and
(iv) the advice must not facilitate the commission of a crime or fraud.

The South African Appeal Court decision of S v. Safatsa and Others (1988 (1) SA 868 (A)), extended privilege to all communications with a legal advisor made for the purpose of giving or receiving legal advice, going beyond communications made for the purpose of litigation. Prior to Safatsa, in the case of MJ Snyman v. Alert-O-Drive (Pty) Ltd (1981 BP 215 (CP)) in an opposition to the grant of a patent on patent application 74/2501, it appeared that certain documents came into existence in respect of consultations between the applicant and his or her patent agents and attorneys, for the purposes of filing and prosecuting the patent application.

During the course of the opposition proceedings, the objector sought to use the documents for the purposes of cross-examining the applicant but the applicant objected to the admission of any such document on the grounds that it was clothed in professional privilege. The Commissioner of Patents held that the documents were all communications between the applicant and their counsel, in their capacity as patent agents and in connection with the application for a patent, and at a time when there was no question of any litigation. The fact that the counsel was also an attorney was therefore purely coincidental. This issue was also raised in the case of Kirin-Amgen v. Bioclones (1993 BP 420 (CP)) and the Commissioner of Patents refused to depart from this precedent set in the MJ Snyman case.

However, as described earlier, the Patents Act No. 57 of 1978 now provides that communications made by or to a patent agent shall enjoy the same scope of privilege as that given to communications made by or to an attorney.

The limitations and exceptions to privilege

Where a communication facilitated the commission of a crime or fraud, it would not be privileged and thus should be disclosed if required by the court.

Consequences of the loss of confidentiality and penalties for disclosure

Patent attorneys and agents are subject to rules of professional confidentiality and must maintain the confidentiality of confidential communications with a client. A legal advisor who discloses privileged information without authorization from the client may be struck off the roll for improper conduct. The client may also have a claim against the advisor in such circumstances.

Requirements/qualifications for patent advisors

There are two types of patent-related professionals in South Africa, one is patent agents and the other is patent attorneys. A patent agent does not need to be legally qualified whereas a patent attorney does. A patent attorney may also act as a patent agent. A patent attorney must be admitted as an attorney in South Africa, must be a member of the South African Law Society,

and be in possession of a technical or scientific diploma or degree or have adequate practical experience in a technical or scientific field. In addition, the patent attorney must have passed the examinations held by the patent examination board.

Cross-border aspects

Treatment of foreign patent advisors

In terms of the common law, communications between a client and a foreign patent agent or a foreign patent attorney acting in the capacity of a patent agent (e.g. advising on the patentability of an invention or drafting, filing and prosecuting a patent application) might be privileged in practice if the foreign advisor is either (i) a legal advisor being contacted for the purpose of obtaining legal advice or (ii) if such communications are privileged under the law of the foreign country concerned. Under the statute, only South African patent agents and South African patent attorneys acting in the capacity of patent agents are covered by the client-attorney privilege.

The potential problems in practice are that a non-qualified client may choose to communicate with a foreign patent agent in relation to the prosecution of a patent application in that country only to find that the communication may not be privileged in South Africa since it did not pass between a legal advisor and the client and/or it does not enjoy privilege in the particular country concerned. However, the comments that privilege may still be claimed locally by applying the foreign standard as set out above should be kept in mind if such foreign privilege exists. However, such communications would be considered to be privileged in South Africa if the employee of the client acting on the client's behalf is a legal advisor and the communications were made for the purpose of obtaining legal advice from the foreign IP professional.

Summary

South Africa has a comprehensive legal professional privilege under the common law system that also extends, under the statute, to patent agents and patent attorneys acting in their professional capacity as patent agents. In order to qualify as a patent agent or a patent attorney, one needs to be legally or technically and scientifically qualified and pass certain examinations. Nevertheless, South African law only extends privilege to local-based patent attorneys and patent agents and not to foreign patent agents or foreign patent attorneys. However, the privilege of foreign patent attorneys might be recognized by courts, if such foreign privilege exists in the foreign law of the country.

47. SPAIN

The duty of the Spanish Industrial Property Agents to keep confidential the communications with their clients and the right to refuse to disclose said communications is recognized in Article 176(5) of the Spanish Patent Law 24/2015 (entry into force on April 1, 2017): "Industrial Property Agents are required to keep the confidentiality on the issues they are involved in and have the right to refuse to disclose communications with customers or third parties relating to proceedings before the Spanish Patent and Trademark Office."

Origin of the professional secrecy obligation and privilege and its coverage

Spanish lawyers have always enjoyed the right to refuse testimony concerning their communications with clients. The Spanish legal system admits the existence of a duty of confidentiality regarding certain professions or when agreed in a contract. Professions with a duty

of confidentiality, as noted by case law, would be those in which the author is a professional who performs a public and legally regulated activity with a specific legal provision regarding the duty of professional secrecy.

Spanish Industrial Property Agents (a category that includes both Patent and Trade Mark Attorneys) are professionals that perform a public and legally regulated activity but whose professional secrecy obligation was, prior to the introduction of Article 176 of Law 24/2015, only regulated in the Code of Ethics of the Spanish Association of Industrial Property Agents (without normative nature), which provides that "collegiate members shall be obliged to not disclose the confidential information received during the exercise of their profession" (General Provision 1c).

Therefore, until the adoption of Article 176, the professional secrecy obligation and the consequent right to refuse testimony could not be awarded to those Industrial Property Agents who were not lawyers.

Professionals covered by the secrecy obligation and privilege

Article 176(1) of Law 24/2015 defines Spanish Industrial Property Agents as "professionals that regularly offer and provide their services to advise, assist and represent third parties in obtaining the different categories of Industrial Property and in defending their subsequent rights before the Spanish Patent and Trademark Office." Article 176(2) further provides that the "Agents may exercise the activity individually or through juridical persons validly incorporated under the law of a Member State of the European Union and whose headquarters or principal activity is in the Community. The Agents as well as the juridical persons through which they exercise their activity may enroll in the Special Register of Agents of the Spanish Patent and Trademark Office."

With regard to the execution of the activities of Industrial Property Agents through juridical persons, Articles 176(3) and (4) of Law 24/2015 clarify that "[i]n order for a juridical person to obtain registration in the Special Register of Agents of the Spanish Patent and Trademark Office, at least one partner or associate members of the entity shall certify the condition of Agent as provided in the following article. The juridical person registered will lose the authorization for the exercise of this professional activity at any time if such a requirement is no longer met." Furthermore, "[t]he juridical person as well as the Agent that acts through it shall be liable for the professional management that is developed under the partnership or association form."

Finally, Article 176(6) of Law 24/2015 states that Article 176(5) also applies to the representatives referred to in Article 175(1) that are not Industrial Property Agents." Article 75(1) of Law 24/2015, in relation to capacity and representation, provides that in addition to Industrial Property Agents, interested parties with capacity to act pursuant to Title III of Law 30/1992, of November 26 on the Legal Regime of Public Administration and Administrative Procedure may also act before the Spanish Patent and Trademark Office. In other words, such interested parties who are entitled to represent their clients before the Office also have the right to refuse to disclose certain communications with their customers or third parties.

Kind of information/communication covered by the secrecy obligation and privilege

Pursuant to Article 176(5) of Law 24/2015, among others, any communication or any document relating to the following shall be subject to the secrecy obligation and confidentiality privilege:

> "a) Assessing the patentability of an invention, the registrability of the industrial design, trademark or trade name;

b) Preparation or processing of a patent application, utility model, industrial design, trademark or trade name;

c) Any opinions regarding the validity, scope of protection or infringement of the object of a patent, utility model, industrial design, trademark or trade name, as well as an application for any of these modalities of Industrial Property protection."

Requirements/qualifications for industrial property agents

Pursuant to Article 177 of Law 24/2015, all Industrial Property Agents must: (i) have a professional office in a Member State of the European Union (EU); (ii) possess the official titles of degree, graduate, architect or engineer issued by the university dean, or other equivalent official titles; and (iii) pass the government examination. Further, the execution of activities in Spain by agents who acquired their professional qualification of Industrial Property Agent in another Member State of the EU shall be regulated by Community law as well as by the internal provisions on implementation of those norms under Royal Decree 1837/2008 of November 8, 2008.

In order to be able to act as an Industrial Property Agent, directly or through a juridical person, a Responsible Declaration shall previously be presented to the Spanish Patent and Trademark Office in which, according to the Implementing Regulation of Law 24/2015, the party concerned declares under its responsibility that it meets all requirements of Articles 176 and 177, is not subject to the incompatibilities referred to in Article 178, possesses the relevant documentation to prove it and commits to maintain compliance with those provisions. The Industrial Property Agent shall then be registered in the Special Register of Industrial Property Agents of the Spanish Patent and Trademark Office (Article 179 of Law 24/2015).

Summary

Following the introduction of Article 176 of Law 24/2015, an Industrial Property Agent could be regarded as one of the professions that perform a public and legally regulated activity, and could, to a certain extent, enjoy secrecy privilege with respect to the communications in relation to certain information/advice relating to proceedings before the Spanish Patent and Trademark Office between an Industrial Property Agent and his/her clients/third parties. There is a view that, lex ferenda, secrecy obligation of Industrial Property Agents should be regulated in a Code of ethics with normative nature. The Spanish Patent Act 24/2015 does not provide for penalties for breach of such a secrecy obligation. Further, as the Patent Act provides for specific secrecy obligations and privileges of non-disclosure in relation to Industrial Property Agents of Spain and other Member States of the EU if the relevant conditions are met, and, in certain cases, Spanish or EU interested parties with capacity to act, it is not clear to what extent the law would apply to industrial property agents registered in non-EU countries.

48. SWEDEN

Under the system introduced in 2010 in Swedish law, a patent agent authorized by the Patent Agents Board (a governmental agency), and his or her assistants are obliged to keep any information gathered within their professional activity confidential, and are correspondingly exempted from the duty to give evidence in court proceedings as far as the information in question concerns "patent affairs". This scheme, set out in the Patent Agents Authorization Act and the Code of Judicial Procedure, constitutes the basis of the legal privilege system for patent agents in Sweden.

An unauthorized patent agent is not bound by this scheme and can therefore not be exempted from duty of giving evidence. However, such a patent agent may be subject to confidentiality based on contractual liability. On a national level, an authorized patent agent who does not adhere to the principle of confidentiality may be warned, or even have his or her authorization revoked.

49. SWITZERLAND

National aspects

Introduction

The professional secrecy obligation of the legal profession in Switzerland relates to the confidentiality between client-lawyer communications which covers all information that an attorney receives from his or her client or of which he or she learns in the course of his or her activity as an attorney. Swiss law provides for a strong protection of confidentiality, in part because of the very high value placed on the constitutional right to privacy (Federal Constitution of the Swiss Confederation of 18 April 1999, RS 101, art 13). Switzerland's highest court has emphasized that the legal professional secrecy assists the administration of justice by allowing clients to confide frankly in their lawyers: if the client does not unreservedly trust him or her, and if he or she is not aware of all the material circumstances, then it is difficult, even impossible, for the lawyer properly to represent the client in either advisory work or in a lawsuit (BGE 112 Ib 606, 606–7). In S v. Switzerland ((1992) 14 E.H.R.R 6770), the European Court of Human Rights held that: "[A]n accused's right to communicate with his advocate out of the hearing of a third person is one of the basic requirements of a fair trial in a democratic society. If a lawyer were unable to confer with his client and receive confidential instructions from him without such surveillance, his assistance would lose much of its usefulness".

Professionals bound by secrecy obligation

The professional secrecy includes, among others, attorneys, medical doctors, notaries, dentists and bankers. Pursuant to the article 321 of Swiss Criminal Code (RS 311), cited professionals who divulge secrets entrusted to them or which they come to know in their professional capacity may be punished by imprisonment or a fine. Banking secrecy falls under Article 47 of the Swiss Federal Law on Banks and Savings Banks (RS 952). Corporate in-house counsels are not protected by confidentiality because of their perceived lack of independence.

- Patent Attorneys and Patent Attorneys Associations in Switzerland

The Swiss Parliament adopted the Patent Attorney Act (RS 935.62) in March 2009. Pursuant to Art. 2, Swiss patent attorneys must possess a recognized higher education qualification in natural sciences or engineering; have passed the Swiss Federal Patent Attorney Examination or a recognized foreign patent attorney examination; have completed practical training; possess an address for service in Switzerland and be registered in the Patent Attorney Register.

In Article 10 of the Patent Attorney Act, the Swiss legislator introduced professional secrecy obligations for patent attorneys (see Art. 10 in the appendices). In addition, the professional secrecy guaranteed by the Swiss Criminal Code was also extended to patent attorneys. According to the Federal Act on the Federal Patent Court (Art. 29, RS 173.41, see appendices), a registered patent attorney can represent a party before the Federal Patent Court provided that they engage in independent practice. As a procedural counterpart, the Code of Civil Procedure (Art. 160 par. 1 lit. b, RS 272) provides that patent attorneys may refuse the production of evidence that is subject to professional secrecy.

In Switzerland, there are three patent attorney associations, namely the Association of Swiss Patent and Trademark Attorneys (ASPTA), the Association of Swiss and European Patent Attorneys in the Private Practice (VESPA) and the Association of Patent Attorneys in Swiss Industry (VIPS). The members of all those associations are bound by the Code of Conduct of the Institute of Professional Representatives before the European Patent Office (epi Code of Conduct), as well by the Regulation on discipline for professional representatives (epi Disciplinary Regulation), which obliges its members to keep the information received from their clients undisclosed (See Article 2 of epi Disciplinary Regulation). In addition, ASPTA represents the national association of the Fédération Internationale des Conseils en Propriété Industrielle (FICPI) in Switzerland. Therefore the patent attorneys of ASPTA are also bound by FICPI rules and more particularly the Lugano Code of Conduct (See Rule 5 of the Lugano Code of Conduct).

Scope of secrecy obligation

- Secrecy confined in the course of the profession

Under Article 321 of the Swiss Criminal Code, the secrecy obligation covers all information that an attorney at law has received from his or her client, or of which he or she has learned in the course of professional activity as an attorney at law. However, the professional secrecy is only limited to such material which is confided for the purpose of the mandate and the exercise of the lawyer's profession (BGE 112 Ib 606). In addition, professional secrecy extends only to facts which the client entrusts to his or her lawyer in order to carry out the mandate, or which the lawyer notices in the practice of his or her profession (BGE 112 Ib 606 at 607).

The lawyer is not bound by secrecy concerning such facts which he noticed as a private person, or which are generally known (BGE 112 Ib 606 at 607).

- Release of the professional secrecy

Pursuant Art. 321 par. 2 of the Swiss Criminal Code no offence is committed if the attorney at law discloses the information with the consent of its client. However, even in such case the attorney has no obligation to release the secrecy (see Art. 13 of the Federal Law on the Free Circulation of Lawyers of 23 June 2000, RS 935.61; Art. 166 par. 1 lit. b of the Swiss Civil Procedure Code of the 19 December 2008, RS 272; Art. 171 par. 4 of the Swiss Penal Procedure Code of the 5 October 2007, RS 312). Furthermore, an attorney at law can disclose information if he or she is authorized (but in no way obliged) by a supervisory authority (e.g. the Cantonal authority in charge of supervising attorneys at law). An attorney at law may request the authorization to disclose privileged information if his or her professional honor is at stake; or if he or she can only defend himself by disclosing such information (e.g. in a malpractice case); or if it is in the public interest to do so, e.g. in the event of a crime or fraud (Canton of Zurich, Anwaltsgesetz vom 17 November 2003 (OS Zürich Bd 59 S 144) arts 33–5; Canton of Geneva, Loi sur la profession d'avocat du 26 avril 2002 (RSG E 6 10) art 12).

Patent attorneys who are bound by the epi Code of Conduct are obliged to keep information received in the course of the exercise of their duties undisclosed, unless they are released from this obligation (Article 1b of the epi Code of Conduct in relation to Article 2 of the epi Disciplinary Regulation). Moreover, patent attorneys are automatically released from their secrecy obligation if the secret information is published (Rule 4(g) of epi Code of Conduct).

Consequences of unauthorized disclosure

The violation of the professional confidentiality obligation is a criminal offense that can lead to a custodial sentence or to a monetary penalty (Art. 321 Swiss Criminal Code). An attorney at law, including a patent attorney, can be held liable for any damages caused by the violation. He or she can be subject to administrative sanctions, warned, fined, suspended or disbarred in the event he or she violated the privilege.

Article 9 par. 1 lit. a of the FICPI statutes provides that an individual member may face expulsion from the Organization if he or she has been deficient in their professional conduct. It is assumed that deficiency in professional conduct includes breach of professional client confidentiality. In addition, a professional representative who fails to comply with the epi Disciplinary Regulation may face disciplinary measures, such as a warning, reprimand, a fine, removal from the list of professional representatives for not more than six months and deletion from the list of professional representatives for an indefinite period of time (Art. 4 par. 1 of epi Disciplinary Regulation).

Cross-border aspects

Treatment of foreign patent advisors

The question whether the relevant provisions and practices in Switzerland related to professional confidentiality could be invoked by foreign patent attorneys (not registered in Switzerland) is not yet resolved by the Swiss legislation and jurisprudence.

Summary

Patent attorneys are bound by professional secrecy. In general, they cannot be compelled to testify on confidential matters arising out of their profession, nor can documents covered by privilege be seized. Members of Patent Attorney Associations, such as ASPTA, VESPA and VIPS are required to observe the rules and the code of conduct of those associations which oblige members to keep the information received from their clients undisclosed. Whether patent attorneys registered in foreign countries are also entitled to enjoy such privilege is not regulated or decided by court.

Appendices

Section 3, Article 10 of the Patent Attorney Act (RS 935.62) states:

> "Section 3: Professional Confidentiality
>
> Article 10
>
> (1) Patent attorneys are obliged to maintain confidentiality concerning all secrets that are entrusted to them in their professional capacity or which come to their knowledge in the course of their professional activities, this obligation being unlimited in time.
>
> (2) They must ensure that persons assisting them maintain professional confidentiality."

The Federal Act on the Federal Patent Court (RS 173.41) states:

"Section 3: Representation of Parties

Article 29

(1) In proceedings concerning the validity of a patent, patent attorneys may also represent parties before the Federal Patent Court as provided for in Article 2 of the Patent Attorney Act of 20 March 2009, provided that they engage in independent practice.

(2) Proof of independent practice as a patent attorney shall be furnished by way of suitable documentation at the request of the Federal Patent Court.

[...]"

50. THAILAND

Origin of the professional secrecy obligation, its coverage

The Lawyers Act B.E. 2528 (A.D. 1985) defines a lawyer as "a person who has been registered as a lawyer, and a license has been issued to him or her by the Law Society of Thailand." As a member of the Law Society of Thailand, a lawyer (member) must abide by the code of ethics, called the Regulations of the Law Society of Thailand on Lawyer's Ethics B.E. 2529 (A.D. 1986), which is overseen and supervised by the Committee on Professional Ethics. The types of professional and ethical conduct described include a prohibition from revealing client's secrets.

Professionals bound by the secrecy obligation

In relation to this paper, registered lawyers are bound by the secrecy obligation but this may also include medical doctors and notaries, patent attorneys and patent agents. The Criminal Code of Thailand prescribes that whoever knows or acquires a private secret of another person by reason of his or her functions as a competent official or his or her profession, including an advocate or lawyer, or by reason of being an assistant in such a profession, and who discloses such a private secret, shall be punished with imprisonment or with a fine, or with both. This provision would therefore require that both patent attorneys and patent agents have an obligation to maintain the secrecy of confidential client information and confidential communications with their clients.

Kind of information/communication covered by secrecy obligation

The scope of the secrecy obligation is broad and covers all communications between an attorney and his or her client (or an assistant to the attorney and his or her client) that contain a private secret disclosed in conjunction with the execution of professional duties. Similarly, such communications made between a patent agent and his or her clients are also covered by the secrecy obligation. Whether the professional secrecy obligation could prevent communications containing such secret information from being disclosed to the court is not known.

Exceptions and limitations to the professional secrecy obligation/availability of forced disclosure

Exceptions may apply in the event of fraud or criminal activities.

Consequences of the loss of confidentiality and penalties for unauthorized disclosure

A breach of confidentiality constitutes professional misconduct. If any lawyer violates any of the regulations, it may result in any of three types of penalties: probation, suspension of practice not exceeding three years, or deletion of the name from the register. This applies to patent attorneys who are also registered lawyers.

The Council of the Law Society under Section 28 of the Lawyers Act B.E. 2528 (A.D. 1985), has issued the Rules on Lawyer Ethics as follows:

> "Article 4: Any lawyer who violates or does not comply with any of the Rules hereinafter shall be deemed guilty of misbehavior.
>
> "Article 11: Disclosure of a client secret obtained while a lawyer acts on behalf of a client is prohibited unless the client consents or a [Thai] court orders the disclosure."

The Criminal Code of Thailand prescribes that whoever knows or acquires a private secret of another person by reason of his or her functions as a competent official or his or her profession, including an advocate, or lawyer, or by reason of being an assistant in such profession, and who discloses such private secret, shall be punished with imprisonment or with a fine, or with both. The same provision would apply in relation to both patent attorneys and patent agents.

Requirements/qualifications for patent advisors

In Thailand, there are two types of professionals who can represent clients before the patent office: patent attorneys and patent agents. A patent attorney must be a qualified lawyer, must hold a bachelor's degree, must have attended a training program arranged by the Department of Intellectual Property, and must have completed a course on intellectual property laws, arranged by an institution or any other agency which has been approved by the Department of Intellectual Property. Under the Patents Act, a patent agent does not have to have a law degree, but must meet all of the other requirements of a patent attorney.

Cross-border aspects

Treatment of foreign patent advisors

It is not clear whether attorneys registered in foreign countries may be able to prevent professional secrecy information from being disclosed to Thai courts.

Summary

Thailand's Criminal Code imposes broad secrecy obligations on professionals and this applies equally to patent attorneys and to patent agents. Any breach of the secrecy obligations may cause the professional to face criminal prosecution and compensation claims from clients. At the same time, it is not clear whether professionals who are not registered in Thailand can also prevent disclosure of secret information obtained through their professional duties in court proceedings.

Thailand's Criminal Code imposes secrecy obligations on various professionals which apply inter alia to patent attorneys and to patent agents. At the same time, it is not clear whether professionals who are not registered in Thailand can also prevent disclosure of secret information obtained through their professional duties in court proceedings.

51. TURKEY

A new IP Code, which amended the previous law 5000/2003 in respect of the patent attorney profession, and the *ad hoc* regulation provided by the Code of Conduct and Discipline of Patent and Trademark Attorneys, entered into force in January 2017. Those provisions are set to have a major impact on the profession of patent attorneys, as they established new rules regarding responsibilities of patent and trademark attorneys, especially from a disciplinary point of view.

Under the new IP Code, all patent and trademark attorneys, irrespective of whether they were attorneys at law, are subject to, and punishable by, uniform rules of conduct in exercising their professional activity with peers, clients and the Turkish Patent and Trademark Office. Article 5 of the Code of Conduct introduced the obligation of confidentiality of communication, according to which those patent attorneys are not allowed to disclose information and secrets received from their clients. Such obligation does not in any way involve a right benefitting the clients in the sense of attorney-client privilege.

52. UKRAINE

According to the Paragraph 16 of the Regulations on Intellectual Property Representatives (Patent Attorneys) (as approved by the Order of the Cabinet of Ministers of Ukraine of August 10, 1994, № 545 (as amended by Decree of the Cabinet of Ministers of Ukraine of August 27, 1997, № 938)) (hereinafter – the Regulations)) a patent attorney must keep confidential
information which he has obtained in the course of his professional duties, in particular, matters raised by the person he represents, content of consultations, advice, explanations, etc. secret. In accordance with Paragraph 9 of the Article 23 of the Law of Ukraine "On Advocacy and Legal Practice" of July 05, 2012, № 5076-VI, any intrusion in private communication of lawyer with his client is prohibited.

According to Article 23 of the Criminal Code of Ukraine, any intentional disclosure of trade secrets without the owner's consent by a person who knows this secret due to his professional or official duties, if it is committed for mercenary or other personal reasons and causes substantial damage to an entity of economic activities, shall be punished by fine from one thousand to three thousand untaxed minimum incomes with deprivation of the right to occupy certain positions or be engaged in certain activities for a term up to three years.

53. UNITED KINGDOM

Pursuant to section 280 of the Copyright, Designs and Patents Act 1988 ("the 1988 Act"), which has UK extent, communications between a person and his/her patent attorney are "privileged from disclosure in like manner as if the patent attorney had at all material times being acting as the client's solicitor…" (s. 280(2)).[6]

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[6] Section 280 applies to "communications as to any matter relating to the protection of any invention, design, technical information, or trade mark, or as to any matter involving passing off".

Disclosure procedure and how privilege protection operates against discovery

Under English law (which applies in England and Wales), parties to a civil action are under the duty of disclosure to enable the other party to obtain information as to the existence, and also to the contents, of the relevant documents relating to the matters in question. It is an important duty, where strict timetables have to be followed. The concept of "disclosure" is broadly similar to the concept of "discovery" in many other common law jurisdictions. In other parts of the UK, there may be differences in discovery/disclosure procedures.[7]

In most cases, each party must make "standard disclosure" after an action starts. It is done by way of a list which sets out, describes and identifies documents relating to any matters in question between them. In general, a party is only required to disclose documents (i) on which he/she relies; (ii) which adversely affect his or her case; (iii) which adversely affect the other party's case; (iv) which support the other party's case; or (v) which are required to be disclosed by a relevant practice direction. In compiling the list, a party has the duty to make reasonable searches proportionate to the issues of the case, and to make a "disclosure statement" verifying that searches have been carried out. The legal representative must endeavor to ensure that the person making the statement understands the duty of disclosure.

If a party believes that the other party has any specific documents which he/she has failed to disclose, he/she may make an application for "specific disclosure". In both "standard disclosure" and "specific disclosure", the duty of disclosure is limited to documents that are, or have been, within a party's control.

Generally, a party enjoys the right to inspection of the documents disclosed, subject to exceptions such as where the documents are no longer within the other party' control, or where the other party has a right or duty to withhold inspection (privilege). If a party claims a right/duty to withhold, it must state this in the "disclosure statement" with the grounds provided. Pre-trial depositions or oral examination of opposition witnesses for the purpose of disclosure of information are not available as a matter of English Law Court procedure.

Solicitor–client privilege is the legal protection provided by common law to certain communications between solicitors and their clients. Solicitors have a legal and professional obligation to refuse to make disclosure of privileged communications, except where the client has waived the privilege or disclosure is required by law. In the United Kingdom, solicitor–client privilege, once established, has been found to be absolute. It was deemed too crucial to the administration of justice to interfere with (R. v. Derby Magistrates' Court, [1995] 4 All E.R. 526).

The common law courts first recognized privilege for communications in relation to litigation, based upon the oath and honour of a lawyer who was duty-bound to guard his or her client's secrets (Berd v. Lovelace (1577) 21 ER 33 (Ch.) and Dennis v. Codrington (1580) 21 ER 53 are examples).

Originally, privilege was restricted to an exemption only from testimonial compulsion, a right belonging to the lawyer, protecting him/her against the forced disclosure of his or her clients' secrets. Since then, the definition of privilege has been extended, such that it now applies to the receipt of legal advice in general, even if provided outside the context of litigation, and is considered to be a right belonging to the client. Privilege in Scotland has developed along very similar lines as in England and Wales, but began from a different starting point. In Scotland, the courts initially protected legal advice and then later conduct relating to litigation.

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[7] For example, there is no discovery procedure in Scotland, but a recovery process, which isn't mandatory. Applications can be made to the court for recovery of evidence in Scotland following Scottish rules. Chapter 35 of the Ordinary Cause rules in the Court of Session sets down the procedure.

While the scope of solicitor–client privilege has evolved and expanded with time, the rationale for the privilege has not significantly changed since its inception. Once a document is classified as privileged, the document will not be disclosed to the other party to the litigation, and the relevant legal advisor cannot be compelled to testify in court on the privileged information or communication.

Professionals covered by the privilege and secrecy obligation

In general, privilege in the United Kingdom extends to solicitors and barristers (known as "advocates" in Scotland), as well as in-house lawyers in most circumstances.[8] [9] Section 280 of the 1988 Act extends the same privilege to patent attorneys, with the definition of "patent attorney" given by section 280(3) (see below).

Scope of privilege

Before the Civil Evidence Act 1968, there was no provision for a patent attorney privilege in England and Wales. At that time, patent agents were not considered to be professional legal advisors and communications with them were not privileged.

However, with section 15 (now repealed) of that Act, the legislature provided for a patent agent privilege which put a patent agent in the same position as a solicitor would have been if he/she had been acting in the place of the patent agent. That provision later appeared in section 104 of the Patents Act 1977 (also repealed) and is now found in section 280 of the Copyright, Designs and Patents Act 1988 (which has UK extent as mentioned above). The substantive wording of the current provision is:

> "(1) This section applies to –
> (a) communications as to any matter relating to the protection of any invention, design, technical information or trademark, or as to any matter involving passing off, and
> (b) documents, materials or information relating to any matter mentioned in paragraph (a)
>
> "(2) Where a patent attorney acts for a client in relation to a matter mentioned in subsection (1), any communication, document, material or information to which this section applies is privileged from disclosure in like manner as if the patent attorney had at all times been acting as the client's solicitor.
>
> "(3) In subsection (2) "patent attorneys" means: (a) a registered patent attorney or a person who is on the European list, (b) a partnership entitled to describe itself as a firm of patent attorneys or as a firm carrying on the business of a European patent attorney, (ba) an unincorporated body (other than a partnership) entitled to describe itself as a patent attorney, or (c) a body corporate entitled to describe itself as a patent attorney or as a company carrying on the business of a
> European patent attorney."

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[8] In England and Wales, s.190 of the Legal Services Act extends privilege to other types of lawyer.
[9] However, in Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd v Commission (Case C-550/07 P) [2010], the Court of Justice of the European Union confirmed that privilege does not apply to communications between a company and its in-house lawyers in the context of EU antitrust investigations.

In the United Kingdom, legal advice privilege protects communications between a solicitor and his or her client where the communications are both confidential and made for the purpose of obtaining and giving advice. Litigation privilege, which is wider than advice privilege, protects confidential communications made between the solicitor and a client or third parties, where the communications are for the sole or dominant purpose of existing or contemplated litigation.

In Three Rivers District Council v. Governor and Company of the Bank of England (no. 5), [2002] EWHC 2730, a restrictive interpretation of "client" in the context of advice privilege was adopted. The court held that other than those employees specifically responsible for instructing and receiving legal advice (in that case, a unit established to deal with all communications between the Bank and an independent inquiry into the collapse of the Bank of Credit and Commerce International SA), employees of the Bank of England were not the "client" for the purposes of the privilege. Rather, they were third parties and as such, not covered by the advice privilege.

In Three Rivers District Council and Others v The Governor and Company of the Bank of England, [2004] UKHL 48, the court confirmed the absolute nature of legal advice privilege and reaffirmed the Court of Appeal's view in Balabel v Air India that "legal advice is not confined to telling the client the law; it must include advice as to what should prudently and sensibly be done in the relevant legal context" ([1988] Ch
317, per Lord Taylor at 330).

The limitations and exceptions to privilege

Privilege may be lost by waivers, implied or express, and by the failure to apply for privilege during the disclosure stage. Apart from the waivers, common law rules also place further limitations on the application of privilege. In England and Wales, privilege cannot be claimed if it relates to the name of the client (R (on the application of Howe) v. South Durham Magistrates Court [2004] EWHC (Admin) 362), but there is no equivalent rule in Scotland.

Privilege also cannot be claimed if the legal professional communication involved crime and fraud. In Crescent Farm (Sidcup) Sports Ltd v. Sterling Offices Ltd [1972] 1 Ch 553, Goff LJ held that fraud included tort of deceit, dishonesty, fraudulent breach of trust, fraudulent conspiracy, trickery and sham contrivances. In Barclays Bank plc v. Eustace, [1995] 4 All ER 511, CA, it was held that "where legal advice is given to further a purpose that is 'sufficiently iniquitous,' then legal professional privilege will not attach to such communications whether or not the client was aware
of the wrongdoing thereby facilitated." The position for legal professional communication involving fraud is similar in Scotland.

Apart from common law limitations, there are also statutory limitations. For example, the Limitation Act 1980 (which extends to England and Wales) provides for the power to compel a partial waiver of privilege.

In the Police and Criminal Evidence Act 1984 (which extends to England and Wales), it is provided that prosecuting authorities may obtain orders for the production of "special procedure material." There are other statutory limitations in England and Wales, as well as in other parts of the UK.

Consequences of the loss of confidentiality and penalties for disclosure

The loss of confidentiality results in the loss of privilege and will lead to full disclosure of documents. Unauthorized disclosure may lead to disciplinary action by the professional bodies/relevant regulators. Those authorised by the Chartered Institute of Patent Attorneys (CIPA) are regulated by the Intellectual Property Regulation Board (IPReg). IPReg deals with

complaints of professional misconduct and breaches of the Rules of Conduct against patent attorneys and trade mark attorneys. IPReg can issue notices, reprimands and fines. It can also remove an attorney or a practice from its registers either for a specified period or permanently. Many members of CIPA also belong to the Institute of Professional Representatives since membership of this institute is required in order to appear before the European Patent Office.

Requirements/qualifications for patent advisors

IPReg sets the education and training requirements for qualification as a patent attorney. There is a combination of examinations and practical training courses.

Alternatively, patent attorneys registered anywhere else in the EEA can apply to be included on the UK patent register, under EU legislation concerning mutual recognition of professional qualifications.

Almost all patent attorneys in the United Kingdom also qualify as European patent attorneys. This also entails the need to pass examinations and obtain practical experience.

Cross-border aspects

Treatment of foreign patent advisors

R (on the application of Prudential Plc) v Special Commissioners of Income Tax [2013] UKSC 1 confirmed that legal advice privilege applies only to communications between clients and their solicitors and not to other advisors, such as accountants offering advice on tax law5. It also confirmed that communications with foreign lawyers are entitled to the same legal professional privilege as communications with English lawyers. Communications with patent practitioners who are neither registered in the UK nor on the European patent attorney list are excluded from the protection afforded by patent agent privilege. This is based on the wording of section 280 of the 1988 Act which confines patent attorney privilege to communications with registered patent attorneys or persons on the European List. There is no recent case law regarding the possible application of privilege for foreign patent attorneys.

Summary

The wording of section 280 of the 1988 Act means that patent attorney privilege is confined to communications with patent attorneys registered in the United Kingdom or persons on the European List (i.e. European patent attorneys) only. Privilege is not extended to other foreign attorneys but attorneys who are qualified lawyers may also be covered by solicitor-client privilege. There is no recent case law regarding the possible application of privilege to foreign patent attorneys.

54. UNITED REPUBLIC OF TANZANIA

In the case of judicial proceedings by either party, Courts in the United Republic of Tanzania shall take judicial notice to the effect that the client's representative has and is by duty bound to maintain communications confidential which are produced as a cause of the client-patent advisor relationship. However, there are no specific provisions in the United Republic of Tanzania in respect of cross-border aspects of confidentiality of communications between clients and their patent advisors.

55. UNITED STATES OF AMERICA

National aspects

Discovery procedure and how privilege protection operates against discovery

The discovery procedure in the United States of America depends on whether a case is filed and heard in a state or a federal court. After a suit is filed, both parties exchange certain information, namely all material "regarding any non-privileged matter that is relevant to any party's claim or defense" (Fed. R. Civ. P. 26(b)(1)). Discovery begins with certain mandatory disclosures, including witness lists, lists of documents to be used to prove one's case, and certain other preliminary documents. The two limits on discovery are the attorney–client privilege and the attorney work product doctrine. In other words, during the discovery stage a party may refuse to supply any documents requested by the other party to litigation on the grounds that the documents are subject to attorney–client privilege or subject to attorney work doctrine or both.

The attorney–client privilege is the oldest privilege recognized in America (Upjohn Co. v. United States, 449 U.S. 383, 389 (1981)). Wigmore states that the privilege exists only: (i) where legal advice of any kind is sought; (ii) from a professional legal advisor in his or her capacity as such; (iii) for the communication relating to that purpose; (iv) when made in confidence; (v) by the client; (vi) at his or her instance permanently protected; (vii) from disclosure by himself or by the legal advisor; and (viii) except the protection be waived (John Henry Wigmore, Evidence in Trials at Common Law 2290 (McNaughton rev. ed. 1961)).

On the other hand, Judge Wyzanski states that to be able to claim attorney–client privilege, one has to show that (1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication was made (a) is a member of the bar of a court, or his or her subordinate and (b) in connection with this communication is acting as a lawyer; (3) the communication relates to a fact of which the attorney was informed (a) by his or her client, (b) without the presence of strangers, (c) for the purpose of securing primarily either (i) an opinion of law or (ii) legal services or (iii) assistance in some legal proceeding, and not (d) for the purpose of committing a crime or tort; and (4) the privilege has been (a) claimed and (b) not waived by the client (United States v. United Shoe Mach. Corp., 89 F. Supp. 357, 358 (D. Mass. 1950)).

Professionals covered by the privilege and secrecy obligation

Qualified lawyers are covered by the privilege and many professionals such as medical doctors are required to keep client information secret. The attorney–client privilege also extends to U.S. patent attorneys, but courts have not uniformly extended the same privilege to communications with U.S. patent agents, who are registered to practice before the USPTO but are not admitted to a state bar. This is because of the U.S. Supreme Court decision that the only legal services patent agents may render are those "necessary and incident" to patent prosecution, including patentability opinions and the preparation and filing of patent applications (Sperry v. Florida, 373 U.S. 379, 386 (1963)). Unlike patent attorneys, patent agents are not authorized to render infringement opinions, because the issue of patent infringement is not "incident to patent prosecution" (Shashank Upadhye, Understanding Willfullness in Patent Infringement: An Analysis of the "Advice of Counsel" Defense, 8 Tex. Intell. Prop. L.J. 39, 53 (1999)).

However, there are cases where federal courts recognize that the privilege operates fully in respect of patent agents, giving consideration to the function they perform rather than their title (Vernitron Medical Products Inc v. Baxter Laboratories Inc. 186 USPQ (BNA) 324 (DNJ 1975) and In re Ampicillin Antitrust Litigation 81 FRD 377 (D.D.C. 1978): Willi (2005), 303-307).

The same applies to trademark attorneys who are recognized and trademark agents who are not and do not have the privilege. The privilege also applies to in-house lawyers who do work of a legal rather than a commercial nature.

More recently, in In re Queen's University at Kingston, No. 2015-145, March 2016, the United States Court of Appeals for the Federal Circuit recognized that client communications with non-attorney patent agents are privileged coextensive with the rights granted to patent agents by the Congress. The Court reasoned that an independent patent-agent privilege should be recognized because of "[...] the unique roles of patent agents, the congressional recognition of their authority to act, the Supreme Court's characterization of their activities as the practice of law, and the current realities of patent litigation [...]" that support the privilege. In finding that the privilege exists, the Federal Circuit relied on the Supreme Court's decision in Sperry v. State of Florida which had confirmed that patent agents were not simply engaging in law-like activity, they were engaging in practice of law itself.

At the State level, in In re Silver, Case No. 16-0682 (Tex. February 23, 2018), the Supreme Court of Texas reversed the lower court's decision, and ruled that a client's communications with his registered non-attorney patent agent are covered by the attorney-client privilege as defined by the State's evidence rule. The case concerned a breach of contract dispute between an inventor (original patentee) and a company that bought a patent from him. During discovery, a trial court ordered the inventor to compel production of over 300 emails between the inventor and his non-attorney patent agent. Following a writ of mandamus request filed by the inventor, the Texas Court of Appeal denied the motion, stating that no patent agent privilege exists in Texas, and neither the trial court nor the Court of Appeal is empowered to establish patent agent-client privilege. The Supreme Court reversed the decision of the Court of Appeal, finding that patent agents are "lawyers" for the purposes of attorney-client privilege governed by Rule 503 of the Texas Rule of Evidence. Rule 503 defines "lawyer" as a "person authorized, or who the client reasonably believes is authorized, to practice law in any state or nation." The Texas Supreme Court found that although patent agents are not "licensed" to practice law, they are "authorized" to practice law before the United States Patent and Trademark Office (USPTO). Accordingly, it ruled that clients of patent agents may invoke the attorney-client privilege in relation to communications with patent agents, which fall within the scope of the privilege.

As to attorney-client privilege for trials before the Patent Trial and Appeal Board (PTAB) in the USPTO, the amendments to 37 CFR 43 entered into force on December 7, 2017. The amended rule clarifies situations where privilege is recognized for communications between clients and their domestic or foreign patent attorneys and patent agents. Accordingly, a communication between a client and a USPTO patent practitioner or a foreign jurisdiction patent practitioner that is reasonably necessary and incident to the scope of the practitioner's authority shall receive the same protections of privilege under Federal law as if that communication were between a client and an attorney authorized to practice in the United States, including all limitations and exceptions. The rule also clarifies that USPTO patent practitioners and foreign jurisdiction patent practitioners shall receive the same treatment as attorneys on all issues affecting privilege or waiver, such as communications with employees or assistants of the practitioner and communications between multiple practitioners.

Scope of privilege

In the U.S. Supreme Court decision in Sperry v. Florida 373 US 379 (1963), it was ruled that patent practice was the practice of law thus rendering the extension on attorney–client privilege to patent attorneys. In re Spalding 203 F.3d 800 (Fed Cir. 2000), the Court of Appeals for the Federal Circuit was required to decide the privilege of an invention record submitted to Spalding's corporate legal department by two inventors. The court stated that the client legal privilege "exists to protect not only the giving of professional advice to those who can act on it,

but also the giving of information to the lawyer to enable him to give sound and informed advice". Citing Sperry v. Florida 373 US 379 (1963) and Knogo Corp v. United States (1980) 213 USPQ (BNA) 936, the Court of Appeals went on to hold that a communication to a patent attorney will be privileged "as long as it is …for the purposes of securing primarily legal opinion, or legal services, or assistance in a legal proceeding" (203 F.3d 800 (Fed Cir. 2000), 806 quoting Knogo Corp v. United States 1980 213 USPQ (BNA) 936. Co. 50 FRD 225, 228 (N. D. Cal 1970)), and that an invention record prepared primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application was privileged".

In United Shoe 89 F. Supp. at 358-59, the Court states that privilege arises when a communication is made between a client and an attorney, that the communication is made in private, and that it be made in order to obtain legal advice. The tests also require that the privilege be asserted; that is, clients may waive the privilege at any time should they so choose. As for communications from the attorney to the client, courts are split on what should be privileged and what should not. Some courts have held that only when the attorney's communication would itself reveal a confidential communication from the client to the attorney is the communication protected (United States v. Ramirez, 608 F.2d 1261, 1268 n.12 (9th Cir 1979); GFL Advantage Fund, Ltd. v. Colkitt, 216 F.R.D. 189 (D.D.C. 2003)). Other courts have held that virtually any communication from the lawyer conveying legal advice should be protected (In re LTV Securities Litigation, 89 F.R.D. 595, 602 (N.D. Tex. 1981); Restatement (Third) of the Law Governing Lawyers § 69 cmt. I (2000)).

The Courts in Jack Winter, Inc. v. Koratron Company, Inc. (Jack Winter I) 50 F.R.D. 225 (N.D. Cal. 1970) and Jack Winter, Inc. v. Koratron Company, Inc. (Jack Winter II) 54 F.R.D. 44 (N.D. Cal. 1971) held that the preparation of patents does constitute the practice of law. However, the Court held that the privilege should not fully apply. The Court held that a patent attorney's practice involved relaying to the USPTO all relevant material concerning the patentability of the invention without exercising any discretion as to what portion of the information to be related to the Patent Office. As such it was held that all technical information provided by a client could not be expected to be held in confidence by the attorney.
In recognizing that communications with non-attorney patent agents are privileged, the Court of Appeals for Federal Circuit held that the privilege extends only to those communications that are in furtherance of the performance of tasks of patent agents as listed in 37 C.F.R. § 11.5(b)(1), or to communications which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the USPTO.

The extension of client-attorney privilege to communications involving third parties is limited to the situation where those third parties are acting as agents for either the client or the legal practitioner and only if their presence is necessary to secure and facilitate communication between the attorney and client (Fin Tech Int'l Inc v. Smith 49 Fed R. Serv. 3d 961, 967 (S.D. N.Y. 2000)).

For the client-attorney privilege, the form of the communication does not matter in most instances in the determination of whether privilege applies (Haines v. Liggett Group, Inc., 975 F.2d 81, 90 (3d Cir. 1992)). The communication may even be non-documented so long as it actually pertains to advising the client (Restatement (Third) of the Law Governing Lawyers § 69 cmt. E (2000)). What does matter is whether the document reflects an actual substantive communication between the attorney and the client regarding legal advice: simply giving a document to a lawyer will not protect the communication (Fisher v. United States, 425 U.S. 391, 404 (1976)). The privilege will only protect the actual communication between the lawyer and the client: it will not protect the facts underlying the communication (Upjohn Co. v. United States, 449 U.S. 383, 395-96 (1981)). Even if the facts were included in a communication with the lawyer, the party may still be required to disclose them to the opposing party (re Six Grand Jury Witnesses, 979 F.2d 939, 943 (2d Cir. 1992)).

The limitations and exceptions to privilege

There are several limitations and exceptions to the attorney-client privilege in the United States, such as the crime-fraud exception and testamentary exception, in order to safeguard the proper functioning of the adversary system (United States v. Zolin (1989) 491 US 554, 562-563, quoted in Swidler & Berlin v. United States (1998) 524 US 399). In United States v. Zolin (1989) 491 US 554, 562-563, it was held that the purpose of the crime-fraud exception to the attorney–client privilege is to ensure that the "seal of secrecy" between lawyer and client does not extend to communications "made for the purpose of getting advice for the commission of a fraud or crime." Testamentary exception relates to disputes on estates of a deceased between the heirs of the clients (Swidler & Berlin v. United States (1998) 524 US 399).

The most common way of destroying privilege is its voluntary waiver by the client. This can happen in a number of settings and for a variety of motives. In the patent context, voluntary waivers tend to take two forms. The first concerns disclosures made by an inventor of attorney communications to "a third party who lacks a common legal interest" (Ferko v. NASCAR, 218 F.R.D. 125, 134 (E.D. Tex. 2003). See also, United States v. Ackert, 169 F.3d 136, 139 (2d Cir. 1999); In re Auclair, 961 F.2d 65, 69 (5th Cir. 1992)). Any such disclosure will render the communication unprivileged by destroying the confidentiality of the document.

The second, and more common, type of voluntary waiver in the patent setting is that connected with an advice-of-counsel defense to a willful infringement claim. A defendant raising such a defense will argue that she could not have been willful in her infringement because she sought the advice of a lawyer who returned an opinion that the allegedly infringing activity was not in fact covered by the plaintiff's patent, or that the plaintiff's patent was likely to be invalid (Westvaco Corp. v. International Paper Co., 991 F.2d 735, 743 (Fed. Cir. 1993)). Such a defense will, by necessity, require that the attorney opinion letter be disclosed to the fact-finder in the case, as well as those documents underlying the advice in the letter (See, e.g., Micron Separations, Inc. v. Pall Corp., 159 F.R.D. 361, 363-65 (D. Mass. 1995)).

Another form of the voluntary waiver of attorney–client privilege occurs when a client decides to waive privilege in response to prosecutorial incentives. Courts have so far been split on what the effect is of a voluntary waiver to a government agency on third party access to disclosed material. Most favor an approach which respects the absolute nature of the attorney–client privilege, and so will find that any disclosure to an agency is a complete waiver of the privilege.

The Eighth Circuit has endorsed the concept of selective waiver (Diversified Industries, Inc. v. Meredith, 572 F.2d 596 (8th Cir. 1977)). Selective waiver would permit a party to waive the attorney–client privilege with respect to certain third parties but not to others. A disclosure to one government agency would then not have destroyed the privilege with respect to the disclosed material.

The final method of waiving privilege occurs when material meant to be kept confidential is inadvertently disclosed. The most common scenario for inadvertent disclosure occurs as parties answer document requests during discovery, and material meant to be excluded is accidentally supplied to opposing counsel. Courts have adopted three primary means of addressing this situation, perhaps best thought of as points along a continuum. At one extreme are the courts which have held that any disclosure is sufficient to destroy confidentiality and therefore no privilege can exist. These courts will argue that the purpose of privilege is to preserve confidentiality: without such confidentiality then there is no sense left in preserving the privilege (See, e.g., Hamilton v. Hamilton Steel Corp., 409 So. 2d 1111, 1114 (Fla. Dist. Ct. App. 1982)). For these courts, the reason for the disclosure does not matter, only that the disclosure happened.

The other extreme sees courts which rule that waiver is a voluntary action and therefore cannot happen inadvertently. For these courts the fact that a disclosure happened is not enough to waive privilege, and so even when an opposing party obtains documents meant to remain confidential that party may not use them (See, e.g., Stratagem Dev. Corp. v. Heron Int'l N.V., 153 F.R.D. 535, 543 (S.D.N.Y 1994)).

There are also statutory limitations to the attorney–client privilege in the United States. For example, in major and important corporate cases such as the Enron World fraud case, the Department of Justice issued guidelines to encourage federal prosecutors to seek waivers by corporations of the attorney–client privilege in a sort of quid pro quo for favorable treatment by the prosecutor in considering whether to indict the corporation. Prosecutors then use a corporation's refusal to provide privilege waivers as an aggravating factor in support of charging a corporation with a crime (R J Anello, "Preserving the Corporate Attorney-Client Privilege: Here and Abroad" (2008) 27 Pennsylvania State International Law Review 291, 293).

Consequences of the loss of confidentiality and penalties for disclosure

As privilege is premised on the idea that certain communications were meant to be kept private by the client, once a communication is disclosed to the public the need for confidentiality is removed and the privilege may be destroyed. Such a disclosure may be voluntary or inadvertent, and the consequences of the disclosure can vary depending on what type of disclosure was made.

The consequences for the attorney responsible for a disclosure may be severe, depending on the nature of the disclosure. The Model Rules of Professional Conduct require that attorneys preserve client confidentiality (Model Rules of Prof'l Conduct R. 1.6 (2008)). The rule requires lawyers not to disclose intentionally confidential information, as well as taking reasonable precautionary steps to guard against any disclosure by employees. Should the lawyer fail to do the above, she may become the subject of disciplinary action by the relevant bar association, leading to a punishment ranging from warnings to suspension to disbarment (Model Rules of Prof'l Conduct R. 8.5 (2008)). A lawyer disclosing information may also be sued by her client for malpractice, which could bring with it far more severe pecuniary punishments.

The law gives the United States Patent and Trademark Office (USPTO) the power to make rules and regulations governing conduct and recognition of patent attorneys and agents to practice before the USPTO. The USPTO has the power to disbar, or suspend from practicing before it, persons guilty of gross misconduct, etc., but this can only be done after a full hearing with the presentation of clear and convincing evidence concerning the misconduct.

Requirements/qualifications for patent advisors

The USPTO maintains a register of patent attorneys, who are attorneys at law, and patent agents, who are not attorneys at law. According to the USPTO, to be admitted to this register, a person must comply with the regulations prescribed by the Office, which require proof that the person is of good moral character and of good repute and that he/she has the legal, and scientific and technical qualifications necessary to render applicants for patents a valuable service. Some of these qualifications must be demonstrated by passing an examination. Those admitted to the examination must have a college degree in engineering or physical science or the equivalent of such a degree.

Cross-border aspects

Treatment of foreign patent advisors

In terms of the recognition of foreign patent attorney/agent privilege, there are two main approaches adopted across the federal district circuit courts either based on the non-choice of law or choice of law approach.

Under the non-choice of law approach, no privilege for a foreign patent practitioner is recognized, because he or she is neither a US attorney nor the agent or immediate subordinate of an attorney (examples of this approach can be found in decisions of the Federal District Courts in Maryland and Wisconsin). For example, in Status Times Corp. v. Sharp Electronics Corp., 95 F.R.D. 27 (S.D.N.Y. 1983), privilege for a foreign patent practitioner was denied due to the fact that he/she is not a member of the American Bar Association.

Most courts, however, use the choice of law approach, which is based on either the "touching base" approach, the "comity plus function approach" or the "most direct and compelling interest approach". Under the touching base approach, communications with foreign patent agents regarding assistance in prosecuting foreign patent applications may be privileged if the privilege would apply under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States (See Duplan Corp. v. Deering Milliken, Inc., 397 F. Supp. 1146, 1169-71 (D.S.C. 1975)).

Under the comity plus function approach, the court will abide by the outcome dictated by comity when the foreign patent agent renders independent legal services. In Mendenhall v. Barber-Greene Co. 531 F. Supp. 951, 952 (N.D. Ill. 1982), the Court held that where a U.S. client seeks a foreign patent through her U.S. attorney the U.S. attorney operates only as a conduit for information between the client and the foreign agent, and therefore communication is effectively between a U.S. client and a foreign agent, and communication is then privileged only if the foreign law would recognize such a privilege.

Another situation is where a US client retains a US attorney to secure a foreign patent, and the US attorney hires a foreign agent in order to prosecute the application before the foreign office. If the foreign attorney does nothing other than filing documents with the foreign office, then, again, the agent is nothing more than a conduit and the privilege exists only if the foreign law would grant such a privilege to communications between the US attorney and the foreign office directly.

Under the "most direct and compelling interest" approach, the court will weigh the competing interests of all involved states and decides which one has the greatest interest in seeing its own law applied. This may involve the application of the Restatement (Second) Conflict of Laws (VLT Corp. v. Unitrode Corp., 194 F.R.D. 8, 16 (D. Mass. 2000); Restatement (Second) of Conflict of Laws § 139(2) (1988)). Section 139(2) of the Restatement (Second) of Conflict of Laws § 139(2) provides for several factors to be taken into consideration when deciding on the law to be applied including the real ties between the parties and the various nations involved and in the overall equities in the situation. In Aktiebolag v. Andrx Pharmaceuticals, Inc. 208 F.R.D. 92, 104-105 (S.D.N.Y. 2002), the district court suggested that the doctrine could be used in a more expansive way to protect more communications. The court found that the equities of a situation may require that the law of a state without the strongest interest but with greater privilege protections may require that these laws be applied. The court also suggested that for the purposes of federal common law privilege doctrine there was no difference between U.S. and foreign patent attorneys for the purpose of deciding protection for communications with U.S. clients by arguing that a German, a Korean, and a U.S. patent attorney were all alike for the analysis of attorney–client privilege.

In the Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer Inc., 52 U.S.P.Q 2d 1897, 188 F.R.D. 189 (S.D.N.Y. 1999), the District Court did not recognize the client-patent attorney privilege of a professional representative who was a qualified French patent agent and a European patent attorney. The Court ruled that French patent agents were not entitled under French law to an evidentiary privilege comparable to the attorney-client privilege as it was enjoyed by patent attorneys under United States law. As a result, the Court held that unless the French patent agent was acting under the authority of an American attorney, the French patent agents' communications were not privileged. It also ruled that although the Institute of Professional Representatives before the European Patent Office (epi) Disciplinary Rule contained a disciplinary rule of secrecy, the said rule of secrecy did not confer the equivalent of the United States attorney-client privilege on EPO representatives.

Similarly, privilege for IP advice made by Japanese patent attorneys had been denied by U.S. courts in the 1980s and early 1990s, as in the case of Honeywell, Inc. v. Minolta Camera Co., Ltd., 1990 U.S. Dist. LEXIS 5954 (D.N.J. 1990). Other such cases include: (i) Status Time Corp. v. Sharp Electronics Corp., 95 F.R.D. 27 (S.D.N.Y. 1982); (ii) Detection Systems Inc. v. Pittway Corp., 96 F.R.D. 152, 156 (W.D.N.Y. 1982); (iii) Burroughs Wellcome Co. v. Barr Labs. Inc., 143 F.R.D. 611, 616-17 (E.D.N.C. 1992); and (iv) Santrade v. General Electric, 27 USPQ 1446 (E.D.N.C. 1993).

The amendment to the Japanese Code of Civil Procedures in 1996, however, gave patent attorneys the right to refuse to testify with regard to any facts that were under the professional secrecy obligation and to produce documents containing those facts. After such amendment, in the decision Eisai Ltd. V. Dr. Reddy's Laboratories Inc., 77 U.S.P.Q. 2d 1854, 406 F. Supp. 2d 341 (S.D.N.Y. 2005), the Court recognized the confidentiality of communications between a client and a Japanese non-lawyer patent agent as privileged according to the principle of judicial comity. Still, it was considered that the comity was subject to overriding U.S. policy considerations. Another case involving the Japanese patent agent after the amendment is VLT Corp. v. Unitrode Corp., 194 F.R.D. 8, 16 (D. Mass. 2000).

Similar rulings by US courts are also found with respect advice from Swiss patent attorneys. In the earlier case, Burroughs Wellcome Co. v. Barr Labs. Inc., 143 F.R.D. 611, 616-17 (E.D.N.C. 1992), the Court found that a letter from a Swiss patent attorney to an European patent attorney was privileged on the basis of an unopposed declaration stating that the Swiss privilege law covered communications between clients and patent agents. However, in In re Rivastigmine (239 F.R.D. 351, 359, S.D.N.Y. 2005), in applying its interpretation of Swiss law, the District Court found that communications between a Swiss patent agent, his client, and a Swiss in-house counsel were not protected by a professional privilege.

The court noted that where communication with a foreign patent agent or attorney involved a foreign patent application, U.S. courts looked to the law of the country where the patent application was pending to examine whether that country's law provided a privilege comparable to the U.S. attorney-client-privilege. According to the judge, the Swiss regulations referred only to a professional secrecy obligation and not to an absolute evidentiary privilege. The court was asked to consider the effects of these rules within the context of the Swiss discovery procedures. The Swiss plaintiff argued that the mandatory disclosure of documents would be quite limited in civil litigation in Switzerland, and that a Swiss court would not order disclosure of the documents at issue. A professional secrecy obligation would, therefore, be sufficient to protect the privilege between patent agents and their clients. Although the judge noted that "special problems [may] arise when evaluating the attorney-client privilege of foreign jurisdictions whose discovery systems are not comparable to our own", it decided that it would not imply privilege from discovery procedures if a special evidentiary privilege, comparable to the American attorney-client privilege, had not been recognized in Swiss law. Similarly, in Schindler v. Otis (District

Court New Jersey; 2:09-cv-00560), the Court found that the privilege did not apply to communications made with a non-lawyer European patent attorney, as communications with a patent agent were not entitled to attorney-client privilege under Swiss law.[10]

Since then, the Swiss Federal Act on Patent Attorneys, which introduced professional secrecy obligation for patent attorneys, entered into force in July 2011. Professional secrecy guaranteed by the Swiss Criminal Code was also extended to patent attorneys. As a procedural counterpart, the Code of Civil Procedure entitled patent attorneys to refuse the production of evidence that is subject to professional secrecy. In applying the amended Swiss law (Art. 10 of the Patent Attorneys Act and Art. 160 of the Swiss Code of Civil Procedure), in In re Zoledronic acid (District Court New Jersey; 2:12-cv-03967), the Court found that the privilege applied to a Swiss patent attorney.

This approach of recognizing foreign law based on conflict of laws/international private law could be seen as generating certain results, leaving sufficient flexibility to each national jurisdiction concerning the substantive law of evidence or IP law. In the absence of international standards, it provides for a remedy which takes into account national realities. However, it might trigger additional costs for the examination of foreign law and increases legal uncertainty. As the case Rhone-Poulenc based its decision on the non-existence of patent advisor privilege in the statute, it provided for some incentives, in civil law countries, to set national statutory standards as a necessary element for foreign recognition by countries following such an approach (for example, the amendments made in national laws of France, as well as the Implementing Regulations to the European Patent Convention).

As the above makes clear, the state of the law regarding foreign patent agents is anything but settled. However, what ultimately separates courts is more a question about how expansive the attorney–client privilege is meant to be rather than any doubts about the value of foreign agents.

In relation to the proceedings before the PTAB, privilege is recognized with respect to communications with eligible practitioners acting within the authorized scope of their duties, whether domestic or foreign. The term "foreign jurisdiction patent practitioner" means a person who is authorized to provide legal advice on patent matters in a foreign jurisdiction, provided that the jurisdiction establishes professional qualifications and the practitioner satisfies them. For foreign jurisdiction patent practitioners, the privilege rule applies regardless of whether that jurisdiction provides privilege or an equivalent under its laws.

Summary

The above discussion shows how complicated the situation is in the United States in dealing with attorney-client privilege, especially in relation to patent attorneys and patent agents. Attorney-client privilege is generally extended to patent attorneys and in limited circumstances to patent agents who provide legal advice to clients. The law is not settled on the treatment of patent agents as decisions are rendered on a case-by-case basis and depends on the treatment of such a request for privilege by the court. In more recent cases, the Court of Appeals for Federal Circuit recognized the privilege of communication with non-attorney patent agents. At the State level, the Texas Supreme Court ruled that a client's communications with a registered non-attorney patent agent are protected under the attorney-client privilege as defined by the Texas Rules of Evidence. Furthermore, in relation to the proceedings before the PTAB, privilege for all domestic and foreign practitioners who met professional qualifications to practice patent matters in at least one jurisdiction is recognized. Attorney-client privilege may exist in normal circumstances, that is, in legal communications between an attorney and his or her client in the attorney's legal professional capacity. The patent attorney privilege may be lost where there the

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10 http://www.wipo.int/edocs/mdocs/scp/en/scp_21/scp_21_ref_bloechle.pdf.

legal advice is sought for the purpose of committing crime and fraud. The privilege may also be lost by clients' waiver. Any breach of the privilege will cause patent attorneys to be subject to disciplinary proceedings by the relevant Bar and/or by the USPTO.

United States case law provides several legal rules in allowing the privilege to be extended to foreign patent attorneys under different doctrines. It appears that most courts use the "touching base" approach (communications with foreign patent agents regarding assistance in prosecuting foreign patent applications may be privileged if the privilege would apply under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States) and the "comity plus function approach" (the court will abide by the outcome dictated by comity when the foreign patent agent renders independent legal services). Privilege is recognized with respect to communications with foreign patent practitioners, regardless of whether the jurisdiction in which a foreign patent practitioner is authorized to practice provides privilege or an equivalent under its laws.

56. ZAMBIA

Zambia provides in Chapter 30 of the Legal Practitioners Act for the client-attorney privileges and rights. To practice in Zambia as an attorney that person must be a resident and registered in accordance with the Legal Practitioners Act. The functions, qualifications and privileges of patent agents are regulated in Part X of the Patent Act of Zambia. According to Section 67 Patent Act, a patent agent may draw and sign all documents and make all communications between an applicant and the patent Office and may represent an applicant at all attendances before the Office. According to Section 68 Patent Act, patent agents have to be registered. Only persons ordinarily resident in Zambia could register as patent agent after having passed certain prescribed examinations and fulfilling other qualifications. No other persons than registered patent agents are allowed to practice as patent agents, with the exception of legal practitioners registered in Zambia. There are no information on cross-border aspects of the confidentiality of communications between clients and their patent attorneys.

57. European Patent Convention (EPC)

Cross-border aspects

Clarification to facilitate the recognition by foreign courts

At the regional level, the case Bristol-Myers Squibb Co. v. Rhone-Poulenc motivated the EPO to amend the EPC to which the US domestic law refers to decide whether attorney–client privilege applies to communications between a European patent attorney and his client. With a view to protecting – in the course of US proceedings – the confidentiality of communications between European patent attorneys and their clients, a new provision, Rule 153, was introduced in the Implementing Regulations to the European Patent Convention (EPC) (Basic Proposal for the Revision of the European Patent Convention (MR/2/00), October 13, 2000, Munich, page 191), as follows:

> "Rule 153: Attorney evidentiary privilege
>
> "(1) Where advice is sought from a professional representative in his capacity as such, all communications between the professional representative and his client or any other person, relating to that purpose and falling under Article 2 of the Regulation on discipline for professional representatives, are permanently privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client.

(2) Such privilege from disclosure shall apply, in particular, to any communication or document relating to:

(a) the assessment of the patentability of an invention;

(b) the preparation or prosecution of a European patent application;

(c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application."

The new rule created a European patent attorney–client privilege applicable in EPO proceedings, modeled after the evidentiary privilege existing in the United States (Basic Proposal for the Revision of the European Patent Convention (MR/2/00), October 13, 2000, Munich, page 191). However, it is unclear whether and how the privilege will be recognized under national laws of the EPC Member States, if the disclosure of the relevant privileged communication becomes an issue in national court proceedings.

58. Unitary Patent Court (UPC) Agreement

The Agreement on the Unified Patent Court (UPC) signed by 25 Member States of the European Union (EU) on February 19, 2013 provides for creating a specialized patent court with exclusive jurisdiction for litigation relating to European patents and European patents with unitary effect. It will need to be ratified by at least 13 Member States, including France, Germany and the United Kingdom to enter into force.

The Agreement on the UPC and its proposed Rules of Procedure provide for a protection of confidentiality of communications between clients and their patent advisors. While Article 53 UPC Agreement provides for "discovery" proceedings with regard to requests for information, production of documents and inspection, Article 48 UPC Agreement states that the communication with representatives of clients, namely lawyers or European Patent Attorneys (see Article 134 EPC), are privileged. Rules 287 and 288 of the Preliminary Rules of Procedure for the UPC in its version of May 31, 2013 provide for an attorney–client and a litigation privilege for communications between a client and a lawyer and a client and a patent attorney in a professional capacity to advice on patent matters (15th draft of May 31, 2013 Preliminary set of provisions for the Rules of Procedure ("Rules") of the Unified Patent Court, Document - Ref. Ares(2013)2443291 - 21/06/2013).

59. Eurasian Patent Convention (EAPC)

The issue of confidentiality of communications between clients and their patent attorneys is beyond the scope of the EAPC and a matter of the applicable law of the Contracting States.

[End of Annex III and of document]