

Standing Committee on the Law of Patents

Sixteenth Session
Geneva, May 16 to 20, 2011

CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS

Document prepared by the Secretariat

I. INTRODUCTION

1. At its fifteenth session held from October 11 to 15, 2010, in Geneva, the Standing Committee on the Law of Patents (SCP) decided that the Secretariat should prepare a study on client-patent advisor privilege, taking into account the comments made by Member States during the SCP sessions. The present document is submitted to the Committee pursuant to the above decision of the Committee. With respect to the same topic, the Secretariat had prepared two preliminary studies (documents SCP/13/4 and SCP/14/2), following the decisions of the SCP at its twelfth and thirteenth sessions, held from June 23 to 27, 2008, and January 25 to 29, 2009, respectively, in Geneva. This document, therefore, should be read together with those two preliminary studies.
2. The present study is intended to assist the Committee to further explore the topic. It first describes the contents of the preliminary studies and summarizes major points discussed at the previous sessions. It then examines those points, adding further analysis. Based on that analysis, the study suggests that the Committee could come to some common understanding that might become the basis for pursuing the topic further. Finally, the study presents a non-exhaustive list of subjects that may be relevant to discussions on this subject at the international level.

3. 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 study the issues further, 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.
4. The term “privilege” in connection with qualified lawyers (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 the client has the power to waive it. It is a concept used predominantly in common law countries.

5. In previous preliminary studies, admittedly, the terms “privilege” and “client-patent advisor privilege” were used in a loose way covering the obligation or duty for a certain professional to keep the information received from her/his client secret. Such a loose manner of using the key terms might cause confusion of fundamental concepts.
6. Therefore, in this document, the term “client-patent advisor privilege” is used in a more narrow sense to describe a similar type of privilege given to a client of a patent advisor (who may be a non-lawyer patent advisor) in common law countries. The notion that is predominantly found in civil law countries – confidentiality obligation imposed on certain professions – is expressed by the representative term “professional secrecy obligation”. 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 cover the issue more generally.

II. BACKGROUND

7. At the international level, the issues relating to forced disclosure of confidential communications between a client and his patent advisor were initially raised by intellectual property practitioners who had been involved in providing intellectual property advice to their clients. Their primary concern was the risk of losing confidentiality of such

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

² Black’s Law Dictionary (sixth edition), ISBN 0-314-76271-X.

intellectual property advice through the discovery procedure before common law courts. While the client-attorney privilege is well established in common law countries, the privilege with respect to communications between a client and his patent advisor on intellectual property advice is recognized in fewer countries. In addition, it has been argued that even if the confidentiality of communications between a client and his patent advisor is respected in one jurisdiction, it could be lost through forced disclosure of such communications in another jurisdiction. Such an inadvertent loss of confidentiality could have a negative impact on the quality of intellectual property 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.

8. Document SCP/13/4, the first preliminary study, summarized the issues surrounding the limited applicability of privilege to confidential intellectual property advice given by patent advisors and described the differences between common law and civil law systems. It also depicted issues that arise in the international context, and portrayed some mechanisms to prevent clients from losing confidentiality of their communications with patent advisors internationally.
9. Document SCP/14/2, the second preliminary study, aimed at enhancing the understanding of some elements described in SCP/13/4. In particular, it provided detailed information concerning client-attorney privilege and, where applicable, client-patent advisor privilege, of selected common law countries and professional secrecy obligations applicable to patent advisors in selected civil law countries. It then summarized convergences and differences found in those countries. Further, the document described opinions found in the literature either in favor of or against the introduction of client-patent advisor privilege at the national level, and addressed the major arguments which underline the rationale for seeking a solution at the international level.
10. During the discussions at the previous sessions of the SCP, in general, the majority of delegations supported the idea of further analysis of the subject matter, although their views varied. In particular, many delegations raised the following issues:
 - (i) Preserving confidentiality of communications with patent advisors in civil law and common law countries:
 - Differences between common law countries and civil law countries and among national laws within the same legal tradition.
 - Desirability and feasibility of applying the same level of protection of confidentiality between communications with lawyers and communications with patent advisors.
 - (ii) Cross-border recognition of confidentiality:
 - Whether and how confidentiality of communications between patent advisors and their clients in one country can be recognized in other jurisdictions.
 - (iii) Disclosure of inventions and disclosure of communications with patent advisors:
 - What is the interplay between the protection of confidential communications with patent advisors and the transparency of the patent system?

- What is the interplay between the protection of confidential communications with patent advisors and the transparency of justice, in particular, the ability of judicial authorities and patent offices to investigate the truth and prior art?
- (iv) Public interest and development:
- What are the implications of the client-patent advisor privilege and professional secrecy obligations on the public interest and development?
- (v) International discussions and international solutions:
- Feasibility of discussing at the international level issues generally related to national judicial procedures based on legal tradition.
11. The following Chapters will examine the above issues one by one.

III. ISSUES RAISED BY MEMBER STATES AND FURTHER ANALYSIS

A. Preserving confidentiality of communications with patent advisors

12. Before examining the international dimension of the issue, it is necessary to understand how national laws and practices deal with the confidentiality of communications between clients and their patent advisors, and what kind of legal mechanism is provided for under each national law in order to preserve such confidentiality. In that light, document SCP/14/2 reviewed a number of 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 obligations; (iv) exceptions and limitations of the privilege and secrecy obligations; (v) penalties for breach of secrecy/disclosure; (vi) treatment of foreign patent advisors; and (vii) qualifications of patent advisors. In addition, Q 199 Privilege Task Force of the International Association for the Protection of Intellectual Property (AIPPI) sent a questionnaire to the national Groups of AIPPI and gathered information concerning remedies to protect the right of clients against forcible disclosure of their IP professional advice.³ Since detailed information concerning various national laws and practices can be found in document SCP/14/2 and on the AIPPI website, this part focuses on the mechanisms to preserve confidentiality of communications between patent advisors and their clients under the common law and civil law systems.

Common law approach

13. In many common law countries, a number of professionals, including lawyers in most common law jurisdictions and also non-lawyer patent advisors in some countries, are obligated to keep secret information received through their professional activities. The confidentiality of those professional communications is considered indispensable for clients to have frank, honest and open communications with those professionals and to obtain the best opinion and advice therefrom. Such duty of confidentiality that binds patent advisors is often regulated under a code of conduct set by a professional association or pursuant to governmental regulations. The disclosure of confidential

³ Answers submitted by National Groups of AIPPI are found at:
<https://www.aippi.org/?sel=questions&sub=listingcommittees&viewQ=199#199>.

information without client authorization may result in disbarment, suspension or any other disciplinary measures against improper conduct. The client may be also entitled to a claim against the patent advisor in such circumstances.

14. 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. For example, information that lawyers, doctors or priests received 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.
15. Therefore, in common law countries where no privilege is accepted with respect to communications with non-lawyer patent advisors, if a court orders a party to the proceeding to disclose communications with a non-lawyer professional who is covered by the above professional secrecy, the party (the client) must acquiesce to the order or lose his case. If a professional provides information, it is made as a result of the request of his client who wishes to comply with the court order and, as a consequence, there is no breach of his professional secrecy obligation. As regards a legal professional, however, the court does not have the power to order disclosure of communication between a lawyer and his client if privilege applies to their communications.⁴
16. In some common law countries, a client-patent advisor privilege that closely mirrors the client-attorney privilege has been recognized. Consequently, communications between clients and their patent advisors who are not necessarily lawyers are also privileged. However, in some other common law countries, the privilege does not apply to communications with non-lawyer patent advisors. In Canada, depending on the facts before them, the courts have held that privilege might not be invoked where a lawyer who is also a patent agent who acted in her/his capacity as a patent agent.⁵
17. The reasons justifying the client-patent advisor privilege⁶ 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.

⁴ “Client-attorney privilege in intellectual property matters: additional observation”, ICC document No. 450/1049 - 27 August 2009

⁵ [http://www.wipo.int/export/sites/www/scp/en/meetings/session_14/studies/icc_2.pdf].
Laboratoires Servier v. Apotex Inc., FC 2008.

⁶ Document SCP/14/2, Chapter IV.

18. On the other hand, some argue that the client-attorney privilege was introduced in the common law systems not because of the legal nature of the advice given by lawyers. Instead, 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 requires special consideration. It is argued that this particular difference between lawyers and non-lawyer patent advisors justifies different treatment with respect to the recognition of the privilege.
19. 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.
20. 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. For example, the Australian Patent Act prevents patent attorneys from preparing documents to be filed in court and transacting business or conducting proceedings in court. Nevertheless, non-lawyer patent attorneys registered in Australia are granted patent attorney privilege by the statutes.⁷
21. 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

22. In civil law countries, similar to common law countries, it is widely recognized that confidentiality of communications between certain professionals and their clients needs to be protected for the purpose of ensuring frank and open communications necessary to the accomplishment of their professional tasks. Consequently, they 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 person who received the advice that the information communicated to those professionals could not ultimately be disclosed to third parties. Typically, lawyers are covered by such confidentiality obligation.
23. In general, patent advisors are also covered by the professional secrecy obligation. This is often regulated under a code of conduct set by a professional association and/or under governmental regulations. Any breach of a client's confidential information may result in

⁷ Document SCP/14/2, paragraph 19.

disbarment, suspension or any other disciplinary measures against improper conduct. It often results in criminal sanctions such as a fine or imprisonment as well as civil sanctions for damages. As already stated in document SCP/14/2, compared with common law countries, civil law countries, in general, impose stronger disciplinary measures, including imprisonment.

24. 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. 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. Nevertheless, a similar question also arises in civil law countries: to what extent should the professional secrecy obligation imposed to lawyers and patent advisors be maintained in litigation?
25. In general, civil law countries recognize the protection of 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.⁸ 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.⁹ 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.¹⁰ Further, in general, lawyers should refuse to testify as witnesses about any information provided to them in their professional capacity.¹¹ 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.¹²
26. With respect to communications with patent advisors, in some 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

⁸ 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.”

⁹ 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.

¹⁰ Document SCP/14/2, paragraphs 128 to 206. See also Akzo Nobel Chemicals Ltd and Akros 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.”

¹¹ *Ibid.*

¹² “*La profession d’avocat : la déontologie*” [<http://www.barreau-aixenprovence.avocat.fr/fr/profession/deontologie/id-67-le-secret-professionnel-l-avocat-et-l-europe>]; see also document SCP/14/2, paragraphs 131, 145 and 171.

obligation. 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. However, similar to common law countries, the above mechanism that is designed to maintain the confidentiality of communications with patent advisors during litigation does not seem to be applied uniformly in all civil law countries.

27. In Germany, German Patent Attorneys who may represent clients before the Federal Patent Court as well as the Federal High Court with respect to patent revocation proceedings shall refuse testimony on matters covered by the professional secrecy. However, a European Patent Attorney, who has the right to represent clients before the European Patent Office (EPO), but is not entitled to represent clients before these courts, cannot refuse testifying on confidential matters under professional secrecy before the German courts, unless he is registered as a German Patent Attorney.¹³ Similar to common law countries, different criteria are applied among civil law countries to decide whether patent advisors should be treated either in the same way or differently from lawyers.

Privilege and professional secrecy obligation: recognition of confidentiality

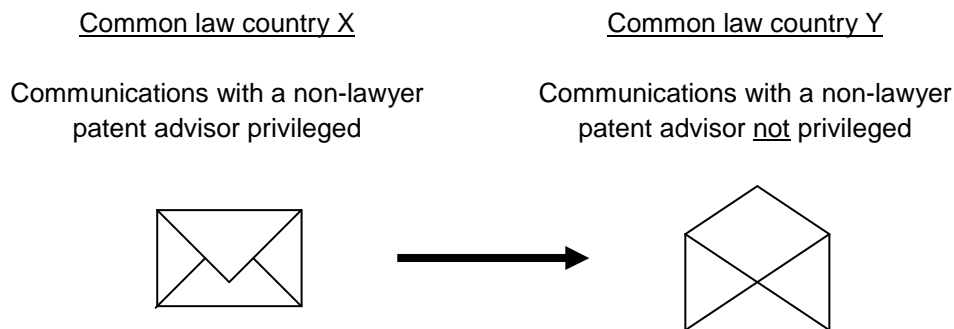
28. Although civil law countries do not have the “privilege” mechanism, this should not be interpreted in a way that the level of confidentiality imposed on lawyers and patent advisors in civil law countries is lower than that in common law countries. In general, the “right” for clients to withhold their confidential communications with lawyers (and in some countries, with patent advisors) does not exist in civil law countries. However, as described above, the professional secrecy obligation demonstrates equally high standards of confidentiality of communications between at least lawyers and their clients within the legal framework of civil law countries.
29. The central question, therefore, seems to be whether and to what extent confidentiality of communications between a client and his patent advisor (who may be a non-lawyer patent advisor) should be protected and how the confidentiality could be preserved beyond the national borders, both under the common law regime and the civil law regime. Both regimes have developed their own mechanisms of protecting confidential communications with lawyers for the sake of ensuring frank and open communications necessary for the accomplishment of their professional tasks. The issue to be looked at is the appropriate level of protection of confidential communications with patent advisors based on the mechanism applied under each regime.
30. Whether under the common law system or under the civil law system, if the protection of confidentiality of communications with patent advisors is not adequate, a client may be inclined to consult a lawyer and not a patent advisor on intellectual property matters. This does not appear to encourage the activities of patent advisors and to promote a better recognition of the important work carried out by patent advisors.

¹³ AIPPI Q199 Questionnaire – Answers from Germany
[<https://www.aippi.org/?sel=questions&sub=listingcommittees&viewQ=199#199>].

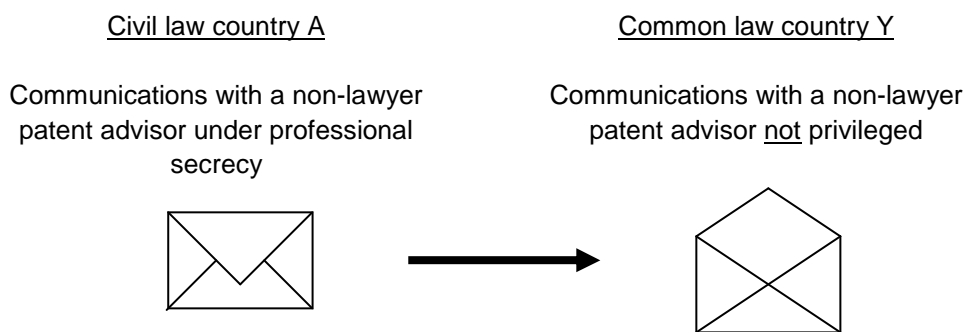
B. Cross-border recognition of confidentiality

The international dimension

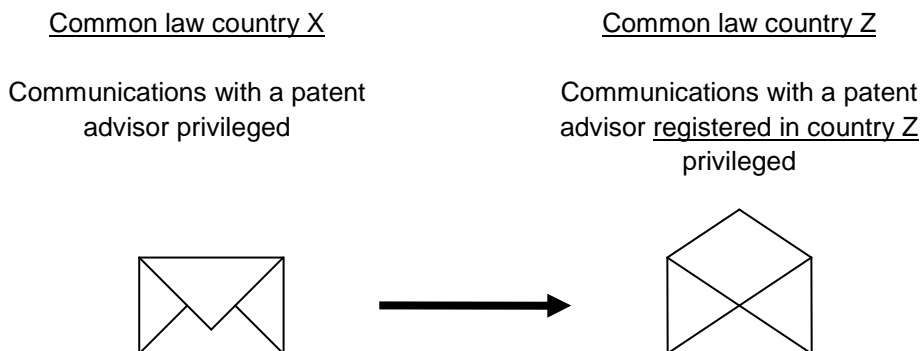
31. Because of the territoriality of patents, where business activities remain confined to a national territory, the question of patent protection and advice from patent advisors has to be answered only in respect of that territory. Consequently, the main issue for a client is whether his/her communication with patent advisors will remain confidential in accordance with the applicable national law.
32. 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 intellectual property specialist in his country and, in addition, will seek advice from an intellectual property advisor in the second country.
33. 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 vary, at least any confidential information that patent advisors receive from their clients in the course of their professional activity shall be kept secret.
34. 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.
35. As described in documents SCP/13/4 and SCP14/2, 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. The following examples illustrate some situations that could arise due to differences in national rules:
 - (a) A client obtained advice from a non-lawyer patent advisor registered in common law country X which provides client-patent advisor privilege. The client was involved in litigation in common law country Y where no client-patent advisor privilege is recognized with respect to communications with non-lawyers. Consequently, the advice received in country X must be disclosed during the discovery process in country Y.



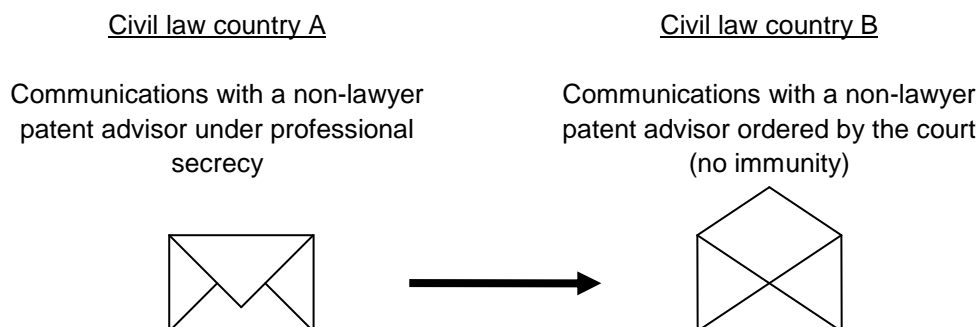
- (b) A client obtained advice from a non-lawyer patent advisor registered in civil law country A who is bound by professional secrecy obligation. The client was involved in litigation in common law country Y where no client-patent advisor privilege is recognized with respect to communications with non-lawyers. Consequently, the advice received in country A must be disclosed during the discovery process in country Y.



- (c) A client obtained advice from a patent advisor registered in common law country X which provides client-patent advisor privilege. The client was involved in litigation in common law country Z where client-patent advisor privilege was provided for communications with patent advisors (including non-lawyer patent advisors) registered in country Z only. Consequently, the advice received in country X must be disclosed during the discovery process in country Z.



- (d) A client obtained an advice from a non-lawyer patent advisor registered in civil law country A. The patent advisor is bound by professional secrecy obligation. The client (defendant) was involved in litigation in civil law country B where a court issued an injunction order to the client, upon an admissible request of the plaintiff, to disclose a document containing that advice. The court did not recognize the immunity of non-lawyer patent advisors. Consequently, the advice received in country A must be disclosed in country B.



36. The above scenarios describe cases where the national rules regarding the preservation of confidential communication with foreign patent advisors are clearly regulated. In reality, there is much uncertainty in many countries in this area for two reasons: first, the issue has never been addressed; and second, varied decisions have been rendered by courts depending on how they treat the issue.¹⁴ 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.

International mechanisms

37. In document SCP/13/4, paragraphs 62 to 67, four types of mechanisms that may facilitate the recognition of the confidentiality in another jurisdiction are described. They are: (i) reciprocity; (ii) recognition of the confidentiality of communication protected in other countries (to the extent it is protected in other countries); (iii) national treatment; and (iv) minimum convergence of laws. With respect to reciprocity, as highlighted in document SCP/13/4, it may not be an effective mechanism to facilitate international recognition. Further, concerning recognition of foreign protection under (ii), according to national practices found in document SCP/14/2,¹⁵ where a national law does not recognize privilege with respect to communication with national patent advisors, most likely that law also does not recognize the privilege with respect to communication with foreign patent advisors. Therefore, a country which does not protect the confidentiality of communication with its own national patent advisors cannot be expected to automatically recognize the confidentiality of communication with foreign patent advisors protected in foreign countries. If this assumption is correct, a country which does not protect the confidentiality of communications with national patent advisors may only recognize the confidentiality protected in foreign countries under certain conditions that may need to be built into such a mechanism.

¹⁴ Document SCP/14/2, paragraphs 115 to 121, with respect to the United States of America.
¹⁵ Document SCP/14/2, Chapter II.

38. Accordingly, in this document, four types of international mechanisms that may improve the recognition of the confidentiality of communications with patent advisors in foreign countries are described. They are: (i) national treatment; (ii) recognition of confidentiality of communications with foreign patent advisors designated by the respective foreign authority; (iii) minimum convergence of laws; and (iv) minimum convergence of laws with national treatment.
39. National treatment. National treatment requires a country to apply the same rules to its nationals and non-nationals. In the context of this document, this means that, where the confidentiality of communications with national patent advisors is protected, the confidentiality of communications with equivalent foreign patent advisors must be protected in the same manner as in the case of national patent advisors. In other words, if national patent advisors are subject to the privilege, the equivalent foreign patent advisors must also be covered by the privilege. In civil law countries, where no privilege mechanism exists, if a country allows national patent advisors to refuse to testify or to submit documents containing a matter under the professional secrecy obligation, equivalent foreign patent advisors shall also be entitled to such refusal.
40. On the one hand, national treatment guarantees the same treatment for national patent advisors and equivalent non-national patent advisors within each jurisdiction. On the other hand, if a country does not provide, for example, privilege with respect to communications with national non-lawyer patent advisors, that country is not obliged to recognize privilege in relation to communications with foreign non-lawyer patent advisors. Consequently, at the international level, the treatment of confidential communications with patent advisors will continue to be different in various jurisdictions. Accordingly, on the basis of national treatment alone, the risk of losing the confidentiality of communications with patent advisors in foreign countries will persist.
41. Recognition of the confidentiality of communications with foreign patent advisors designated by the respective foreign authority. The principle of this mechanism is found in the proposal made by the International Chamber of Commerce (ICC).¹⁶ Although the ICC's proposal covers only "privilege" before the State's courts, intellectual property offices, tribunals and investigators, the principle of such a mechanism can be easily extended to both countries applying privilege and countries applying a professional secrecy obligation. This mechanism¹⁷ consists of the following elements:
- (i) Each country specifies a category (or categories) of patent advisors;
 - (ii) Within each country, confidentiality of communication with the category (categories) of patent advisors specified by that country shall be protected;
 - (iii) Each country shall protect the confidentiality of communication with the category (categories) of patent advisors specified by other countries.

¹⁶ "Client Privilege in Intellectual Property Advice", ICC Document No. 450/1040, 9 October 2008 [http://www.wipo.int/export/sites/www/scp/en/meetings/session_14/studies/icc_1.pdf].

¹⁷ The ICC proposal specifies the applicable scope of communications and the categories of professions. However, those specific elements of the proposal are not indicated in this paragraph, but are mentioned in paragraphs 44 and 45.

42. For example, in a common law country that has a privilege system, the privilege applicable in that country's legal framework shall be recognized with respect to the group of national patent advisors defined by its own authority as well as to each group of foreign patent advisors defined by each foreign authority. Similarly, in a civil law country that has a professional secrecy obligation system, confidential communications with national patent advisors specified by the authority of that country as well as with foreign patent advisors specified by each foreign country shall be protected from forcible disclosure under the applicable civil law framework.
43. On the one hand, this mechanism allows, at the international level, the protection of the confidentiality of communications with at least patent advisors who are designated by each Member State. Each country has the discretion to define the category (categories) of patent advisors whose advice should be covered by this arrangement. Therefore, each country may take into account the particular characteristics and qualifications of national patent advisors, and thus determine the professional group which would qualify for international recognition.
44. On the other hand, if each country is entirely free to determine the professional groups to be covered and the applicable scope of the communications the confidentiality of which shall be preserved, this could result in different rules being applied in different countries. For example, one country may designate only lawyer patent advisors, while another may designate both lawyer and non-lawyer patent advisors. As another example, in one country, all IP-related communications with the defined group of patent advisors may be kept confidential, while in another country, only those communications which were made for the dominant purpose of receiving or providing legal advice may be covered. In consequence, at the international level, the treatment of confidential communications with patent advisors may continue to be different in various jurisdictions.
45. One way of minimizing such disparities is to define certain criteria for the types of professional groups and communication to be covered.¹⁸ However, finding common objective criteria that take into account the different regulatory frameworks is a challenge.
46. Depending on the level of flexibility that Member States may wish to maintain, this mechanism may also be designed so as to accommodate a gradual development of national laws in this area. For example, a country may initially designate lawyers as well as lawyer patent advisors as the category of professions to be recognized internationally and, gradually, expand the category of patent advisors to include non-lawyer patent advisors.
47. Minimum convergence of laws. Another mechanism that may be explored is to seek minimum convergence of laws that could facilitate the recognition of confidentiality of communications with patent advisors at the international level. Countries could establish the principle that confidentiality of at least certain communications with patent advisors who meet certain criteria, regardless of whether they are nationals or non-nationals, should be preserved under the applicable national legal system. For example, in common law countries, privilege could be applicable with respect to certain types of communications with national and foreign patent advisors having certain defined qualifications.

¹⁸ For example, the ICC suggests that specific categories of advisors who are covered by such arrangement be: (i) local general lawyers; (ii) local specialist IP advisors as the State considers to be adequately regulated; and (iii) locally-resident European Patent Attorneys.

48. Due to different legal systems that exist today, it is improbable that uniform rules would be established in this area in the near future. Currently, the confidentiality of communications with a patent advisor in one country may be lost in another country. If countries could agree on minimum conditions under which the confidentiality of communications with national and foreign patent advisors, particularly non-lawyer patent advisors, must be recognized in all countries, this would certainly improve the current international situation. The core part of this mechanism is designing such minimum conditions. The minimum requirements regarding the nature, type and scope of communications to be protected, and the type or qualifications of patent advisors whose communications should be protected, would need to be agreed upon by Member States.
49. An agreement on these minimum conditions would establish clear international rules applicable to the countries that embrace them, and would contribute to legal certainty.
50. Minimum convergence of laws with national treatment. Another mechanism that may be considered is to seek minimum convergence of laws with national treatment. Noting that the national treatment principle provided for in existing international treaties probably does not apply to privilege or professional secrecy obligations, under the mechanism of the minimum convergence of laws as described above, a country may provide protection higher than the minimum standard only to national patent advisors. Through combining the minimum convergence of laws with national treatment, if a country provides protection for national patent advisors that goes beyond the minimum standard, that higher standard will also be applicable to foreign patent advisors.
51. The feasibility of such a mechanism, however, may need to be carefully analyzed. For example, since national patent advisors' qualifications and the scope of professional activities are different from one country to another, a country may consider it justified to provide to national patent advisors a higher level of protection that goes beyond the minimum level of protection granted to foreign patent advisors.

C. Disclosure of inventions and disclosure of communications with patent advisors

52. There needs to be a clear distinction between the public disclosure of inventions in patent applications and the public disclosure of communications between patent advisors and their clients. Since the dissemination of technological information is one of the key objectives of the patent system, many national patent laws require that an applicant describes 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 shall also describe the best mode for carrying out the invention known to the inventor at the filing date (priority date). Those requirements are independent and different from the rules regarding 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.
53. 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.¹⁹ 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 or the professional secrecy obligation for patent advisors might be misused and could result in keeping critical information for the determination of the case away from public inspection. 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.²⁰

54. 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.²¹ 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. Perhaps experiences of countries that provide the privilege for patent advisors (including non-lawyer patent advisors) or that allow patent advisors to refuse the testimony or submission of documents relating to confidential communications with clients could be shared within the SCP.
55. Although it has not been discussed by the Committee, the way in which the preservation of confidential communications with patent advisors affects administrative procedures before patent offices may be also considered. In general, administrative *inter partes* procedures before patent offices apply, *mutatis mutandis*, many aspects of the general civil procedural law.²² Since patent advisors, including non-lawyer patent advisors, represent their clients in such administrative procedures in many countries, Member States may be interested to hear the experiences of national/regional administrative bodies that provide privilege for patent advisors or that allow patent advisors to refuse the testimony or submission of documents relating to confidential communications with clients.

D. Public interest and development

56. As discussed in documents SCP/13/4 and SCP/14/2, there are both public and private interests behind the regulation of the confidentiality of communications with patent advisors, including non-lawyer patent advisors. Paragraphs 240 to 255 of document SCP/14/2 provide some consideration about rationales and policies behind the confidentiality of communications with patent advisors. In relation to the public interest, the document states that 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

¹⁹ Nobelpharma Ab Usa v. Implant Innovations Inc (141 F.3d 1059 1998-1 Trade Cases P 72100, 46 U.S.P.Q.2d 1097).

²⁰ Document SCP/14/2, Chapter II.

²¹ Document SCP/14/2, paragraphs 242 to 244.

²² For example, the ICC proposal specifies that privilege applies to the State's courts, intellectual property offices, tribunals and investigators.

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.

57. 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.²³ 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, the lack of high-level services by patent advisors does not support the public interest.
58. 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, discussions in the SCP 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.²⁴
59. It goes without saying that 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 confidentiality. 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.²⁵

²³ Document SCP/12/3 Rev.2, paragraphs 256 to 258.

²⁴ “Resolution 4: Qualification of professional representatives, and practice across national borders”, passed by the International Federation of Intellectual Property Attorneys (FICPI) at the World Congress in Berlin in 2003 addresses the issues relating to qualifications of professional representatives.

²⁵ The experience of the Intellectual Property Institute of Canada (IPIC) with respect to a linkage between the regulatory scheme of Canadian patent agents and privilege is found in a paper presented at the Conference on Client Privilege in Intellectual Property Advice (May 22 and 23, 2008, Geneva) by Ms. Joan van Zant [http://www.wipo.int/meetings/en/2008/aippi_ipap_ge/program.html].

60. According to the information contained in document SCP/14/2²⁶ and the result of the AIPPI Questionnaire, the current laws regarding privilege and the professional secrecy obligation 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. The Committee should certainly be mindful of particular situations of countries at different stages of development, as indicated in the previous paragraph. However, on this particular topic, the different legal traditions may be more pertinent to the consideration of flexibility in the international system, as described in item (e) below.

E. International discussions and international solutions

61. As illustrated in the previous preliminary studies, 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 into consideration.
62. 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.²⁷ 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. Since in many countries, the preservation of confidentiality of communications with patent advisors is an issue that may be an integral part of civil and criminal procedural rules, 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.

IV. SHARING A COMMON UNDERSTANDING

63. The two preliminary studies and the discussions at the 13th, 14th and 15th sessions of the SCP indicated the shortcomings with respect to the treatment of the confidentiality of communications with patent advisors at the international level, as well as the challenges that may need to be overcome. Those challenges include the diversity of national legal systems and laws surrounding this subject and the public interest considerations that need to take into account different stakeholders' interests. In order to shape the future direction of the discussions on this topic, it may be useful for the Committee to share a common understanding that would support future exploration of the subject.

²⁶ Document SCP/14/2, Chapter II (country studies).

²⁷ However, for example, Australia, South Africa and the United Kingdom provide provisions concerning patent advisor privilege in their Patent Acts (document SCP/14/2, paragraphs 18, 66 and 85).

64. In this regard, taking into account the comments made by members of the SCP during the previous sessions, the following non-exhaustive list of principles has been identified by the International Bureau for consideration by the Committee.

- (i) SCP's further work will focus on matters where cooperation among Member States and collective actions are needed and appropriate.

The protection of the confidentiality of communications with patent advisors involves national and international aspects. Although these two are intertwined, SCP's efforts may focus on problems at the international level and solutions that could improve the current situation through international cooperation.

- (ii) Future exploration of the issues should take into account differences in the procedural laws of common and civil law countries.

Since the recognition of national protection of confidential communications with patent advisors affects both civil and common law countries, differences in the legal mechanisms regarding the protection of confidentiality should be taken into account so that any international cooperation would neither disturb legal systems nor interfere with existing well-functioning mechanisms. In this sense, such international cooperation should be based on the principle of flexibility, and would not establish a uniform solution that would determine all aspects relating to the national protection of confidential communications with patent advisors.

- (iii) International cooperation should not foreclose the possibility for Member States to adopt national measures which they deem appropriate to improve the current national framework relating to the protection of confidentiality of communications with patent advisors.

- (iv) International cooperation should not weaken the level of disclosure of inventions in patent applications as required by the applicable national/regional law.

The sufficient disclosure of inventions in patent applications is one of the fundamental requirements of the patent system. International cooperation should in no way alter the level of disclosure of inventions required under the applicable national/regional law.

- (v) International cooperation should ensure the administration of justice and safeguard the public interest.

International cooperation should contribute to ensuring the quality of advice given by patent advisors and the administration of justice, and promote the public interest in the observance of the law, balancing the interests of the various stake holders.

- (vi) Discussions in the SCP should encourage capacity building of patent advisors and promote their better recognition in Member States, in particular, in developing countries.

Discussions in the SCP should contribute to the higher quality of services provided by patent advisors, and promote a better recognition of their important role in supporting local innovation and knowledge creation, and in facilitating access to knowledge and technology.

V. SUBJECTS FOR INTERNATIONAL COOPERATION

65. In view of the previous studies and the present document, Member States may wish to consider some or all of the following questions with respect to future work.

A. Extent of the preservation of the confidentiality of communications with patent advisors

- Scope of non-disclosure:
 - *Could confidential communications with patent advisors be disclosed to third parties (outside the judicial, quasi-judicial or administrative (patent office) procedures)?*
 - *Could confidential communications with patent advisors be disclosed to third parties during the judicial, quasi-judicial or administrative (patent office) procedures?*
 - *May a patent advisor/client refuse testifying matters under the confidentiality?*
 - *May a patent advisor/client refuse submission of documents containing matters under the confidentiality?*
 - *In a particular jurisdiction, should the scope of non-disclosure of communication with patent advisors be the same with that of communication with lawyers?*
- Exceptions and limitations to the privilege or secrecy obligation:
 - *What are exceptional cases where the confidentiality of communications with patent advisors will not be maintained?*
 - *Can privilege or professional secrecy obligation be waived by a client?*
- Term of non-disclosure:
 - *Is the confidentiality of communications maintained indefinitely, as long as they remain confidential?*

B. Nature and scope of communications between patent advisors and their clients

- *Which forms of communications are covered by the confidentiality (written, oral)?*
- *What type of communications is covered? All advice in relation to patents that a patent advisor is competent according to the applicable law (for example, patent prosecution, litigation-related, licensing matters etc.)?*
- *Are there any conditions to be attached to the nature of the advice given, for example, communication was made for the dominant purpose of obtaining or giving patent advice?*

C. Types and qualifications of patent advisors

- *Is advice given by a lawyer patent advisor protected?*
- *Is advice given by a non-lawyer patent advisor protected? Are there any conditions to be fulfilled (for example, registration before a competent authority, high standards of codes of conduct or provision of legal advice)?*
- *Is advice given by an in-house patent advisor (lawyer or non-lawyer) protected?*

D. Cross-border recognition

- *How to facilitate the cross-border recognition of confidentiality of communications with patent advisors? For example, through the recognition of confidentiality of communications with foreign patent advisors designated by the respective foreign authority (paragraphs 40 to 45) or through minimum convergence of laws (paragraphs 46 to 50)?*

[End of document]