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Seminar on the Confidentiality of Advice from Patent Advisors
Patent Advisors' Perspectives

AIPPI, AIPLA, FICPI

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Professional Secrecy in civil law countries

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Civil law approach

- **Professional secrecy – IP advisor obligation**
 - Obligation to keep information relating to clients confidential
 - Primarily an obligation of the IP advisor (lawyer, patent attorney)
 - Advisor cannot be forced to disclose such information in court
 - Also, normally no or limited disclosure
 - It's an obligation of the advisor, not his right
- **It is an obligation of the advisor, not a right of the client**
 - It is not a property right
 - It does not add any intellectual property
 - It does not extend the scope of existing intellectual property
 - It does not create a trade secret for the client
 - It is merely a procedural issue
 - It exists for all lawyers, not merely IP lawyers
 - Patent attorneys provide legal advice, similar to lawyers

Is the client protected?

- **Professional secrecy is primarily an obligation of the advisor**
 - The advisor cannot be forced to disclose communications with his client
 - This would not work if the client could be forced to do so
 - Therefore the client cannot be forced to disclose that same information
 - However, this is not always as clear
 - Communications by advisor with third party (expert) also unclear
- **Professional secrecy is limited to client-attorney communications**
 - It relates to the advice given to the client
 - But to be able to give advice, the advisor needs relevant documents
 - Client cannot be forced to disclose such advice and communications
 - Otherwise the advisor's privilege would be pointless
 - But the client cannot refuse to disclose those facts
 - If there are means to obtain such disclosure

Legal basis for professional secrecy

- **Professional regulatory law - secrecy**
 - Laws governing the professional statute of lawyers and patent attorneys
- **Procedural law – right to refuse testimony**
 - Lawyers and patent attorneys may refuse testimony
 - They cannot be forced to produce documents themselves
 - Documents in their possession are not subject to seizure
 - But of course the client may be forced to produce documents (facts)
- **Waiver of protection**
 - The client can always waive protection and disclose the advice
 - The advisor needs the client's consent to disclose
 - But even then he still has a responsibility to protect his client
- **Exceptions**
 - No protection in case of abuse
 - No protection in case of criminal offence

Other issues

- **Limited disclosure introduced in civil law countries**
 - 2006: EU Enforcement Directive introduces some disclosure
 - 2016: Unified Patent Court can issue orders for limited disclosure
 - Further disclosure may be developed under national law
- **Position of in-house lawyers**
 - Weaker in many countries, or unclear
 - In EU competition law: CJEU denied protection, lack of independency
- **International position**
 - Often unclear
 - May be weak in common law countries for advisors from civil law countries due to difference in concept
 - Especially if common law country has disclosure



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