

Standing Committee on the Law of Patents

Thirtieth Session
Geneva, June 24 to 27, 2019

CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS: UPDATE

Document prepared by the Secretariat

INTRODUCTION

1. With respect to the agenda item, “Confidentiality of Communications between Clients and Their Patent Advisors”, the Standing Committee on the Law of Patents (SCP), at its twenty-ninth session, held in Geneva from December 3 to 6, 2018, agreed that the Secretariat would continue update the dedicated website on that topic. It was also agreed that the Secretariat would invite Member States to send any additional inputs for the preparation of an updated document based on document SCP/29/5.
2. Pursuant to the above decision, the Secretariat invited Member States and Regional Patent Offices, through its Note C. 8828, dated January 7, 2019, to submit to the International Bureau such inputs.¹
3. Consequently, this document, which contains the additional inputs from the Member States, was prepared by the Secretariat and is submitted to the thirtieth session of the SCP. The updated information is made available on the dedicated website “Confidentiality of Communications between Clients and Their Patent Advisors” at: https://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html. At present, relevant information with respect to 56 member States and three regional systems can be found on the said website.

¹ The submissions by the Member States are available at:
https://www.wipo.int/scp/en/meetings/session_30/comments_received.html.

ADDITIONAL INFORMATION ON LAWS AND PRACTICES

Austria

4. In Austria, Article 17 paragraph 2 of the Law on Patent Attorneys (Patentanwaltsgesetz) contains the following provision regarding confidentiality:

“Art. 1 (1) The patent attorney shall be obliged to act conscientiously in the representations taken over and to safeguard the interests of his party with zeal and loyalty. He is authorized to present openly all that he deems useful under the law for the representation of his party and to use all means of attack and defense in every way that does not contradict his mandate, his conscience and the laws.

“(2) In particular, he shall be bound to secrecy with regard to the matters entrusted to him in his capacity as patent attorney and may also refuse to testify as a witness before the courts and administrative authorities with regard to such matters.”²

“(3) The provision of para. 2 shall apply mutatis mutandis also to patent attorney trainees and other employees of the patent attorney.”³

Colombia

5. Colombian national law on the issue of confidentiality of communications between clients and their patent advisors is complemented by Law No. 1123/2007 establishing the Disciplinary Code for Attorneys:

Law No. 1123/2007 establishing the Disciplinary Code for Attorneys:

“ARTICLE 34. It shall be a breach of loyalty to the client to:

[...]

(f) reveal or use secrets confided by the client, even at the behest of an authority, unless the attorney has received written authorization from the client or must make revelations to avoid the commission of a crime.”

² This provision will be amended and supplemented by the following sentence: “The same applies to the shareholders and members of the supervisory bodies of a patent attorney company provided for by law or the articles of association.” (Amendment is not yet in force as of April 26, 2019).

³ The submission from Austria notes that, for the next amendment of this Law, further alignment of Article 17, paragraph 2 of the Law on Patent Attorneys with the relevant provisions of the Attorneys Act (RAO) on obligation of confidentiality might be considered. Article 9 of the RAO currently reads as follows: “[...] (2) The lawyer shall be obliged to maintain secrecy with regard to the matters entrusted to him and the facts otherwise disclosed to him in his professional capacity, the secrecy of which is in the interest of his party. He has the right to confidentiality in judicial and other official proceedings in accordance with the provisions of procedural law. The same applies to the shareholders and the members of the supervisory bodies of a law firm provided for by law or by the articles of association. (3) The lawyer’s right to secrecy pursuant to para. 2 second sentence may not be circumvented by judicial or other official measures, in particular by questioning auxiliary staff of the lawyer or by ordering the surrender of documents, carriers of image, sound or data or by confiscating them; special provisions on the delimitation of this prohibition shall remain unaffected. (3a) To the extent required by the lawyer’s right to confidentiality in order to ensure the protection of the party or the rights and freedoms of others or the enforcement of civil rights, the person concerned may not rely on the rights set out in Art. 12 to 22 and Art. 34 of Regulation (EU) 2016/679 on the protection of individuals with regard to the processing of personal data, on the free movement of such data and repealing Directive 95/46/EC and Para. 1 DSG.”

6. That said, professional secrecy is premised essentially on the protection of a person's natural privacy and the preservation of the honor, good name and good reputation of the confider of the secret. Presiding Judge Vladimiro Naranjo Mesa ruled in Constitutional Court Judgment T-073A in 1996:

"It is reserved for privacy or exclusivity, for two reasons: firstly, to avoid leaving the person powerless, by depriving him/her of the introspection require to live in dignity with his/her natural privacy; and secondly, to leave the confider's honor, good name and good reputation unblemished, as required. "Reserve" is used to indicate that knowledge is kept for something specific that must be used with the professionally required confidentiality and exclusivity. Confidentiality is breached when a secret is divulged, not necessarily when it is revealed before those who, legally speaking, are also bound by said reserve".⁴

Ecuador

7. Article 20 of the Constitution of Ecuador provides:

"The State shall guarantee the conscience clause for all persons as well as professional secrecy and confidentiality of sources for those who provide information, express their opinions through the media or other forms of communication, or who work in any communication activity". Article 83 of the Constitution also provides that "Ecuadorians have the following duties and responsibilities, without prejudice to others enshrined in the Constitution and in the law, namely: [...] 12. Practice their profession or trade in accordance with the rules of ethics".

8. Regarding patent attorneys, in addition to the provisions of Andean Community law, there are regulations governing confidentiality of communications. For instance:

– Article 335 of the Organic Code of the Judicial Function provides:

"Prohibitions Binding on Attorneys in the Management of Cases – In the management of cases, attorneys shall not: 1. disclose the secrets, documents or instructions of their clients."

– The Comprehensive Penal Code penalizes attorneys who disclose professional secrets by stipulating the following in Article 269:

"Breach of legal duty by attorneys – Any attorney, defense counsel or prosecutor who discloses the secrets of his/her client to the opposing party in the course of trial or who, after representing one party and learning of its defenses, then abandons that party to represent the opposing party, shall be punished with imprisonment of one to three years."

⁴ The submission from Colombia recommends that patent attorneys who offer their services to clients have proper measures in place to avoid the occurrence of any communication crisis and that they design and implement methods and policies to protect their communications, thus obviating inherent risks and potentially costly lawsuits as a result of mismanagement.

Guatemala

9. In Guatemala, pursuant to Articles 200(c) and (d) and 201 of the Law on Judicial Organization (Decree No. 2-89), it is forbidden for lawyers to reveal their client's secrets and to abandon without good reason cases that they have begun to defend, thus failing to comply with the obligations prescribed by the laws and regulations.

10. The client-patent advisor confidentiality is protected as a professional secrecy, in accordance with Article 5 of the Code of Ethics of the College of Attorneys and Notaries of Guatemala, which provides:

“Professional secrecy is one of the attorney's duties and rights. It is a duty to clients that subsists even after the cessation of services to clients. It is an inalienable right before judges and other authorities. The professional secrecy obligation covers all matters confided in connection with a case”.

11. The Code of Civil and Trade Procedure provides for oral hearing in intellectual property law cases. Patent advisors are under a confidentiality obligation not to disclose information relating to the counselling that they provide in their professional capacity.

Republic of Kazakhstan

12. In the Republic of Kazakhstan, a patent attorney conducts clients' affairs in matters of the legal protection of intellectual property. In general, client, if he is not a foreign person, can act himself/herself for an action before the authorized body in the field of intellectual property (the Ministry of Justice) and the Patent Office.⁵

13. Where a patent attorney receives, from a client, information related to the execution of his/her order, such information is considered confidential. The confidentiality shall be maintained when patent attorneys performs:

- (i) advice on the protection or transfer of intellectual property rights;
- (ii) execution of work on the preparation of applications for inventions, utility models and industrial designs on behalf of the customer, principal and employer;
- (iii) interaction with the Ministry of Justice and/or the Patent Office for the protection of inventions, utility models and industrial designs, including correspondence, preparation and submission of objections to expert opinions, taking part in meetings of the expert council at the Patent Office;
- (iv) assistance in drafting, reviewing and subsequent submission for expert examination of contracts of assignment, licensing (sublicensing) contracts and additional agreements.

14. The patent attorney shall be registered and certified by the authorised body as a patent attorney upon successful qualification examination.⁶ It is important to note that legislation resolves conflicts of interest. Thus, the patent attorney is obliged not to accept instructions if they can jeopardize the interests of the person to whom the patent attorney has previously rendered services.

⁵ Article 36-1 of the Patent Law of the Republic of Kazakhstan.

⁶ *Ibid.*

15. Confidentiality in the activities of a patent attorney must also comply with the requirements of the legislation of the Republic of Kazakhstan in the field of confidential information and other secrets protected by law.

Kyrgyz Republic

16. In accordance with Article 14 of the Law of the Kyrgyz Republic “On patent attorneys”⁷, information that the patent attorney receives from his/her client in connection with the execution of his/her order is considered confidential, unless otherwise specifically indicated by the client or should not be obvious from his/her actions.

17. The patent attorney is obliged to provide safety of documents which he/she receives and/or draws up in connection with his/her obligation as a patent attorney. The patent attorney is not entitled to transfer these documents or copies thereof to third parties or disclose orally the information contained therein without the written consent of the person whose interests he/she represents.

18. Article 13 of the Law defines responsibility of the patent attorney for non-qualified and poor quality performance of the contract obligation with the client. The patent attorney bears legal responsibility in accordance with the legislation of the Kyrgyz Republic. Appellation Commission of authorized state body in the field of Intellectual Property shall consider all complaints against unsatisfactory implementation of a patent attorney’s profession duties and infringement of legal acts of the Kyrgyz Republic.

Republic of Moldova

19. According to the Government Decision No.541 approving the Regulations on the Activity of the Authorized Intellectual Property Attorneys of the Republic of Moldova of July 18, 2011, which entered into force on July 22, 2012, patent attorneys shall exercise their powers according to the principles of good faith, honesty, trust and confidentiality. According to Article 1852, paragraph 1 of the Criminal Code of the Republic of Moldova, prior to the official publication of data from the registration request, disclosure of information on IP by a person to whom such information was entrusted shall be punished.

20. In the relationship between the customer and the attorney, according to p.10, 13-17 of the Government Decision No. 541 from July 18, 2011 approving the Regulations on the Activity of the Authorized Intellectual Property Attorneys:

- The authorized attorney must demonstrate honesty, probity, fairness, correctness, sincerity and confidentiality in the relationship with his/her customer, characteristics that motivate the customer’s decision to engage him/her.
- The authorized attorney is bound to keep the confidentiality of any data, including personal data, and information that becomes known to him/her directly or indirectly from his/her customer, whether directly linked to or not by the assumed commitment. He/she cannot disclose this information both during the commitment and after its termination, except with the express consent of his/her customer.
- The right and obligation to maintain confidentiality apply to all information acquired during the exercise of the profession and will have to be respected even after the settlement of the commitment, except in cases expressly provided for by the law.

⁷ Law of the Kyrgyz Republic “On patent attorneys” of February 28, 2001.

- The authorized attorney cannot pass on to any third party any document received from his/her customer, such as documents, printed or electronic files, samples and models, without the consent of the customer.
- The obligation of confidentiality implies an active role of the authorized attorney in ensuring that such confidentiality is preserved, including by the persons he or she employs in order to fulfil a particular commitment or to carry out his/her professional activity in general.
- Among the customers represented jointly, the confidentiality rule does not apply unless the parties decide otherwise.

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