



Innovation, Science and
Economic Development Canada

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Canada

PATENT AGENT-CLIENT PRIVILEGE

Presentation to the WIPO Standing Committee on the Law of Patents

Background

- Canada already recognizes solicitor-client privilege for communications with lawyers.
- Amendments granting a legislative privilege to communications with IP agents came into force in 2016.
- The legislation is intended to protect communications between patent agents and their clients in the same way as solicitor-client privilege.

Section 16.1 of the *Patent Act*

Privileged communication

16.1 (1) A communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding:

- (a)** it is between an individual whose name is entered on the register of patent agents and that individual's client;
- (b)** it is intended to be confidential; and
- (c)** it is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention.

Exceptions

Waiver

(2) Subsection (1) does not apply if the client expressly or implicitly waives the privilege.

Exceptions

(3) Exceptions to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries apply to a communication that meets the conditions set out in paragraphs (1)(a) to (c).

International Reciprocity

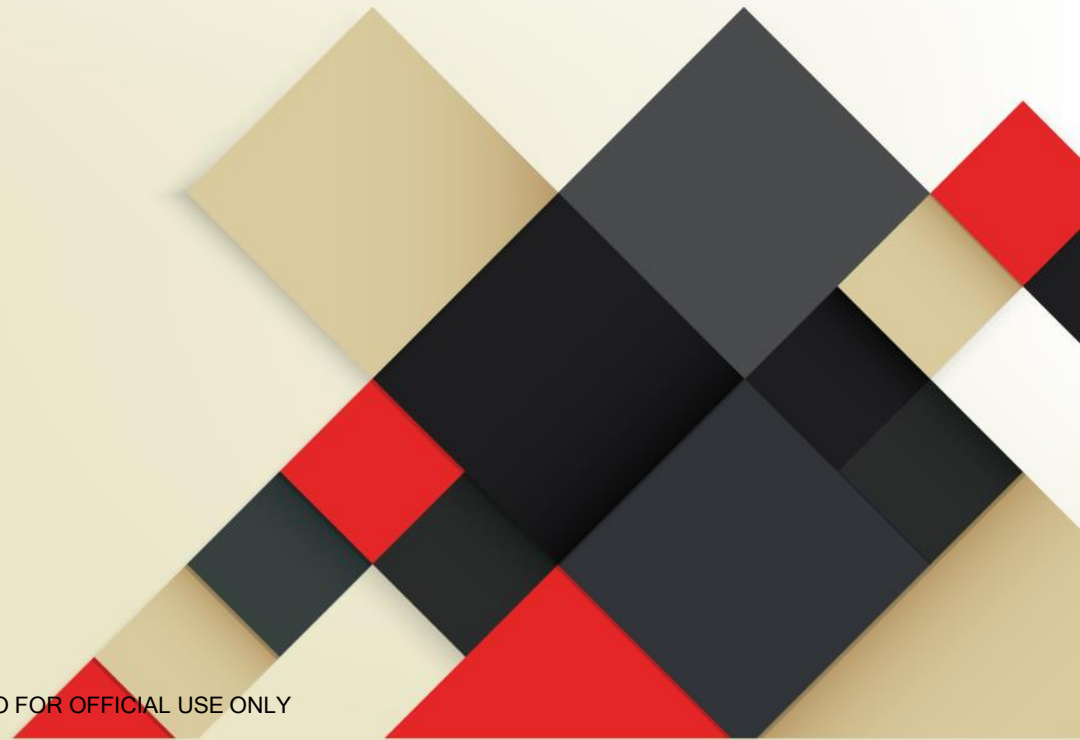
Patent agents — country other than Canada

(4) A communication between an individual who is authorized to act as a patent agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between an individual whose name is entered on the register of patent agents and that individual's client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

International Reciprocity

- **Communications with foreign patent agents will be recognized if:**
 1. The communication is between someone ***authorized to act as a patent agent under the law of a country*** and their client;
 2. The communication is ***intended to be confidential***;
 3. The communication is made for ***the purpose of seeking or giving advice*** with respect to ***any matter relating to the protection of an invention***; and
 4. The communication is ***privileged under the law of the foreign country***.

WHY?



Benefits of Agent-Client Privilege

- Ability to have a full and frank discussion with your patent advisor
- Improves trust between clients and advisors
- More information = Better patent advice
- Improves patent quality
- Reduce the amount of invalid patents

THE COLLEGE OF PATENT AGENTS AND TRADEMARK AGENTS



Background

- In 2018, Canada passed the *College of Patent Agents and Trademark Agents Act*.
- Creates an independent College to regulate patent agents in the public interest. Similar to the legal regulator for lawyers.
- A Board of Directors was appointed to run the College in Summer 2019 consisting of 3 public interest members and 2 IP Agents. 2 more members will be appointed once the College is operational.

Duties of IP Agents

- All Canadian IP agents will be required to follow the rules of the College and meet standards of professional conduct and competence.
- Agents who reveal privileged information can be sanctioned by the College.
- Sanctions can include fines, suspension or loss of agent licence, and more.

Duties of IP Agents

- Canadian IP Agents will be required to follow a Code of Professional Conduct.
- The Code will require agents to act in the best interests of their clients and keep client information confidential.
- Conflict of interest rules will ensure that privileged information will not inadvertently be used to benefit other clients.

Powers of the College

- Similar to the provincial law society for lawyers, the College will have the ability to investigate agents that are suspected of misconduct, and may view privileged information for the limited purpose of regulating the profession.
- Any information provided to the College can only be used for regulating the profession, and is not considered waiving the privilege.

QUESTIONS?

