

International Legal Framework

Paris Convention

The Paris Convention for the Protection of Industrial Property (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 is not regulated in the Paris Convention. Each Contracting Party, therefore, may regulate the client-attorney privilege 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 of client attorney privilege 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. 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.”

Nationals of non-Contracting States are also entitled to national treatment under Article 3 of the Convention if they are domiciled or have a real and effective industrial or commercial establishment in a Contracting State.

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.”

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.

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 (discussed in G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIPRI 1969, WIPO Publication). Another example of permissible discrimination as to procedure could be a requirement for foreigners to deposit a

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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.

The issue of client-patent advisor privilege 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 of client-patent advisor privilege between its nationals and nationals of other countries.