

International Legal Framework

TRIPS Agreement

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) does not directly refer to the issue of client-patent advisor privilege. However, the following provisions could be relevant to the issue at stake.

First, as far as patents are concerned, Article 2 of the TRIPS Agreement provides that members shall comply with Articles 1 to 12 and 19 of the Paris Convention in respect of Parts II, III and IV of the TRIPS Agreement. Consequently, obligations arising from the above Articles of the Paris Convention became obligations of WTO Members, and are enforceable under the Dispute Settlement Understanding.

Further, Article 3 of the TRIPS Agreement provides rules on national treatment obliging Members to accord to the nationals of other Members treatment no less favorable than that it accords to its own nationals with regard to protection of intellectual property. The same provision stipulates that the national treatment principle of the TRIPS Agreement is subject to the exceptions provided in the Paris Convention (Article 3 of the TRIPS Agreement. In addition, the provision refers to exceptions allowed under the Berne and Rome Conventions).

In relation to those exceptions, Article 3(2) of the TRIPS Agreement, albeit indirectly, refers to Article 2(3) of the Paris Convention allowing exceptions to be made with respect to the appointment of agents, designation of an address for service and other special rules applicable to foreigners in judicial and administrative proceedings. The use of those exceptions under the TRIPS Agreement is limited to cases that are necessary to secure compliance with laws and regulations which are consistent with the provisions of the TRIPS Agreement and where such practices are not applied in a manner which would constitute a disguised restriction on trade (Article 3(2) of the TRIPS Agreement).

Accordingly, with respect to national treatment issues, Members of WTO seem to have a free hand in their treatment of the client-patent advisor privilege issue, provided that their policies are not inconsistent with other provisions of the Agreement and are not applied in a manner that would constitute a disguised restriction on trade. Naturally, such freedom for a WTO Member also includes freedom to treat nationals and non-nationals equally in judicial and administrative procedures with respect to client-patent advisor privilege.

Most-favored nation treatment

Article 4 of the TRIPS Agreement provides that “With regard to the protection of intellectual property, any advantage, favor, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members [...]” Further, the same provision stipulates four exceptions to the most-favored nation (MFN) rule. The relevant exception for the purpose of this paper is provided under paragraph (a) which exempts from the MFN obligation international agreements on judicial assistance or law enforcement in general, which are not particularly confined to the protection of intellectual property of the client-patent advisor issue. The main question which arises in the context of the client-patent advisor privilege issue is whether the MFN principle could suggest that any recognition of client-patent advisor privilege in a foreign jurisdiction (of a WTO Member) be extended to all other jurisdictions of WTO Members. In the light of the MFN

principle, any obligation of extension may depend on the specific criteria and factual circumstances for the recognition of the foreign client-patent advisor privilege.

Enforcement of IP

Article 43 on “Evidence” concerning civil and administrative procedures and remedies provides that:

“The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.”

While this provision has not been analyzed in WTO dispute settlement proceedings, and no interpretation is proposed in this document, the last part of the provision “subject in appropriate cases to conditions which ensure the protection of confidential information” may have some relevance to the issue of client-patent advisor privilege. In particular, this provision is relevant to the scenario in which one party in litigation holds evidence relevant to the substantiation of the claims of the other litigant.