

## Summary of National Laws and Practices

### Origin and Scope

#### *Origin of the client-attorney privilege and secrecy obligations*

The need for a client to disclose all facts to his or her legal advisor in order to obtain the best advice to respect the law is common to all countries. To that end, the desirability of the confidentiality of communications between the legal advisor and the client is probably uncontested, unless the maintenance of confidentiality is overridden by a fundamental public policy such as the prevention and punishment of criminal acts.

One of the important points of departure between common law countries and civil law countries is the different approaches taken in protecting confidential communications with certain professions in those countries, which are closely related to the different legal procedures in court for the investigation of the truth.

Civil law countries impose secrecy obligations on the part of professionals in ensuring that clients' confidential information is kept secret from disclosure to third parties. This may be regulated under the laws governing the activities of professionals and/or through the respective national criminal law. In general, the disclosure of such confidential information by legal advisors, such as making documents containing such information public, is subject to severe sanctions.

In civil law countries, the rule of evidence is that a plaintiff needs to substantiate his or her claim, and the fact that a document is in the possession of the defendant does not change this burden of proof. Parties obligation to disclose documents is in general very limited. Consequently, the potential risk of public disclosure of confidential information under the professional secrecy obligation during the legal proceedings is very low. This could be regarded as a reason why the concept of "client attorney privilege" has not developed in civil law countries. Nevertheless, often regulated by civil/criminal procedure law, attorneys may, in principle, refuse to testify any information received from a client during the course of professional duty. Similarly, submission of any document that contains such confidential information may be refused.

Common law privilege originates from the solicitor–client privilege under the common law system which would later be known as legal professional privilege. The main purpose of the legal professional privilege in common law countries is to avoid confidential communications between an attorney and his or her clients from being disclosed to the court during the discovery stage. Privilege in common law countries applies to communications relating to legal advice whether there is litigation or not, subject only to the dominant purpose test and any established common law exceptions (such as for crime/fraud) and any statutory limitations.

#### *Professionals bound by the privilege and secrecy*

Generally, in common law countries, there are two legal bases of privilege: common law privilege and statutory privilege. The former, applies only to communications between qualified lawyers, including in-house lawyers, and the clients. In general, it is not applicable to patent advisors who are not qualified lawyers. The Court of Appeals for Federal Circuit of the United States of America, however, ruled in March 2016 that a client's communication with a non-attorney patent agent is privileged coextensive with the rights granted to patent

agents by the Congress. At the State level, privilege has not been consistently applied to communications with non-attorney patent agents. In February 2018, the Texas Supreme Court reversed the decision of lower courts, and decided that a client's communication with a registered non-attorney patent agent is covered by the attorney-client privilege as defined by the Texas Rule of Evidence.

In some common law countries such as Australia, Canada, New Zealand, Singapore, South Africa and the United Kingdom, the common law privilege has been supplemented by Statute, which extend the client attorney privilege to patent attorneys and patent agents. In the United States of America, privilege applies to communications with US patent agents and with foreign patent agents during the proceedings before its administrative tribunal, i.e., the Patent Trial and Appeal Board (PTAB).

In civil law countries, generally speaking, the professional secrecy obligation is created by statutes governing lawyers and many other professionals. In general, non-lawyer patent attorneys and patent agents are also bound by the professional secrecy obligation.

#### *Scope of the privilege/secrecy obligations*

The client-attorney privilege protects confidential communications between a lawyer and client made for the purpose of obtaining and giving legal advice. In some common law countries, the same scope of privilege is provided for the client with respect to communications between a patent attorney (agent) and client under the relevant statute or case law. The exact types of communications covered by the client-patent attorney (agent) privilege are not the same among countries, since the scope of the professional activities of those professionals (for example, whether copyright matters can be dealt with or not) is different from one country to the next.

According to the information gathered in Annex III, the professional obligation to keep secrets in civil law countries attaches to information and documents obtained from clients in the course of the professional relationship as between an attorney or a patent attorney and a client. It does not apply in other situations, for example, where attorneys act in their non-professional capacity such as that of a director, business advisor or business partner to the client.

In civil law countries, due to no or very limited disclosure proceedings in civil litigations, strong imposition of professional secrecy obligation for lawyers coupled with their right to refuse to testify in court any matter falling under the professional secrecy obligation is regarded as a sufficient mechanism to preserve the confidentiality of professional advice. In many countries, a similar mechanism applies to patent advisors: Strong obligation of professional secrecy with severe sanction in case of breach, coupled with the right to refuse testify such confidential matters. In some other countries, while patent advisors are under the professional secrecy obligation, no immunity in respect of testimony in court is granted to non-lawyer patent advisors. With respect to documents that contain information covered by the professional secrecy obligation, in some countries, a patent advisor may refuse to produce such document. In some other countries, the owners of such documents, who may be patent attorneys, their client or any third party, may refuse to produce such documents in court.

The obligation of confidentiality extends beyond the life of the attorney–client relationship. It is typically the result of rules of professional conduct that are put in place by the appropriate body responsible for regulating the legal profession in any given jurisdiction or of the statutory rules.

As regards in-house attorneys, in common law countries, privilege attaches if counsel is acting in his/her capacity as a lawyer. In many civil law countries, there is generally no protection,<sup>1</sup> although in some countries, the professional secrecy obligation and the right to refuse testimony apply to in-house attorneys as well.

In general communications with patent advisors that are protected from forcible disclosure are those for the purpose of or in relation to professional advice sought from a patent advisor. More precise scope of the protected communications may be nuanced. They may be communications made for the predominant purposes of giving legal advice or all communications given in relation to patent matters under the duty of the patent advisor.

Furthermore, the question of whether the privilege does extend to communications by lawyers and clients with third parties is dealt with differently among the countries.<sup>2</sup>

With respect to the communications with overseas patent advisors, the situation is largely uncertain. In general much depends on, for example: (i) the formal as well as substantive qualification of a foreign patent advisor; (ii) nature of advice given; (iii) doctrine of comity; or (iv) status of communication in foreign jurisdiction.

#### *Exemptions and limitations of the privilege and secrecy obligations*

The privilege that prevents the disclosure of communications concerning legal advice belongs to the client. Therefore, one of the limitations of the legal professional privilege under the common law system is the fact that clients may decide to waive the privilege and thus allow the privileged communication to be disclosed to the court. Express and implied waivers are available under the common law systems of the United Kingdom, Australia and New Zealand. Malaysia only recognizes express waiver by the client. In general, there is an exception to the privilege, if such confidential communications involve fraud or criminal acts.

Exception to the professional secrecy obligation, if such confidential communications involve fraud or criminal acts. Consequently, cannot refuse testimony etc. in court.

#### *Penalties for breach of secrecy/disclosure*

Among the countries in the compilation, a breach of the secrecy obligation in civil law countries may lead to criminal prosecution. In both civil law and common law jurisdictions, a breach of secrecy and disclosure of privileged information may lead to professional disciplinary actions.

#### *Qualifications of patent advisors*

Qualifications to become a patent attorney or patent agent vary from one country to another. Many countries such as Germany and the United Kingdom require patent agents and patent attorneys to be technically qualified. The United States of America allows non-lawyers who are technically and scientifically qualified to become patent agents, although patent attorneys must have legal qualifications. In some countries such as Brazil, Malaysia and South Africa, both lawyers who are not technically qualified and non-lawyers who are technically qualified may become patent agents.

---

<sup>1</sup> Steve Garland, Seminar on the Confidentiality of Advice from Patent Advisors, 21<sup>st</sup> Session of the SCP, November 4, 2014.

<sup>2</sup> For Australia, see *Pratt Holdings Pty Ltd and Another v. Commissioner of Taxation* [2004] FCAFC 122.