Summary of National Laws and Practices

Approaches to Cross-Border Aspects

Cross-border aspects concern whether the confidentiality of communications between clients and patent attorneys could be recognized and respected across national borders, in particular by courts in another jurisdiction. Cross-border aspects are not necessarily related to providing professional legal services abroad. The applicable laws of the different countries take different approaches to the cross-border aspects of the client-patent advisor privilege. In some countries, the patent law or evidentiary law expressly provides that communications with foreign patent advisors are protected from forcible disclosure. In the absence of such statutory provision, some common law countries courts recognize the legal mechanisms regarding the confidentiality of communications between clients and patent attorneys established in another jurisdiction as foreign privilege, in accordance with choice of law rules. Other common law courts apply the domestic *lex fori* and therefore deny foreign privileges.

Recognition of foreign law: The standard applied by the courts of some countries in deciding whether the privilege should apply in relation to communications with foreign patent advisors is to consider whether or not such communications would have enjoyed privilege in the foreign law of the country concerned. Although it is an essential element, confidentiality of communication in itself is not sufficient to render the communication privileged. Therefore, the confidential nature of the advice given by patent advisors in the foreign law alone is most likely not considered as privileged advice.

The recognition of foreign law is practiced in some States of the United States as part of the choice of law/international private law rules. In terms of the recognition of foreign law with respect to confidentiality of communications with patent advisors, two main approaches have been adopted across the Federal District Courts based on either the non-choice of law or the choice of law approach. Under the non-choice of law approach, no privilege for a foreign patent practitioner is recognized, because he or she is neither a United States' attorney nor the agent or immediate subordinate of an attorney. Most courts, however, use the choice of law approach, which is based on either the "Touching Base" approach, the "Comity Plus Function approach" or the "Most Direct and Compelling Interest approach". Under the Touching Base approach, communications with foreign patent agents regarding assistance in prosecuting foreign patent applications may be privileged, if the privilege applies under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States.

A similar approach has been chosen by other common law countries, such as South Africa. The communications between a local and a foreign patent advisor are considered to be privileged in South Africa, if the communications were made for the purpose of giving or receiving legal advice to, or from, a particular client. The communications between clients and a foreign patent advisor are considered to be privileged if the representative of the client acting on the client's behalf is a legal advisor and the communications were made for the purpose of obtaining legal advice from the foreign patent advisor. If the representative of the client is not a legal advisor, the issue has not been settled by the courts.

Extension of principles of substantive law: In some common law countries, for example, Australia, Canada and New Zealand, the domestic patent law (Australia and Canada) or law of evidence (New Zealand) provides an extension of the substantive principle of privilege to foreign patent advisors. In recognizing the foreign client-patent advisor privilege, the courts of those countries must review either: (i) whether the functions of overseas patent advisors "correspond" to those of a registered patent

attorney (New Zealand); (ii) whether a foreign patent advisor is "authorized" to do patents work under the law of his/her country (Australia); or (iii) whether the law of a foreign patent advisor also recognizes those communications as privileged (Canada). In the United Kingdom, the Copyright, Designs and Patents Act 1988 stipulates that privilege applies to a more limited scope of foreign patent advisors, i.e., it applies to patent agents who are either registered in the United Kingdom or on the European patent attorney list.

Facilitating recognition of foreign law: In civil law countries, the confidentiality of communications with patent advisors is underpinned by the professional secrecy obligation imposed to patent advisors. However, some non-lawyer patent advisors of those civil law countries have faced a loss of confidentiality of communications with their clients in foreign countries, in particular, in common law countries, because the foreign courts could not identify a corresponding privilege in those civil law countries.

In order to alleviate the problem, some of those countries, such as France, Japan and Switzerland, expressly regulate the secrecy obligation of both lawyer and non-lawyer patent advisors, and correspondingly provide exemptions from the duty to give evidence in court proceedings as far as the information in question is covered by the professional secrecy obligation, with the aim of obtaining the foreign recognition of confidentiality in common law countries. These exemptions may include refusing testimony and withholding documents that contain information subject to secrecy obligation. The number of such countries has been increasing, in particular, in recent years. Such an approach, however, is not effective in common law countries which categorically deny the foreign privilege to non-lawyer patent advisors.