

## Confidentiality of Communication between Clients and their Patent Advisors

### Germany

#### National aspects

In Germany, both lawyers and patent attorneys advise and represent clients in the patent application procedure and in patent litigation. Patent attorneys may represent their clients not only before administrative authorities such as the German Patent Office, but also before the German Federal Patent Court, the German Federal Supreme Court with regard to patent validity cases and compulsory licenses and any other court where representation by a lawyer is not obligatory.

#### *Origin of the professional secrecy obligation and its coverage*

The lawyers' professional secrecy obligation is based both on the *Strafgesetzbuch (StGB)* – (Criminal Code) and on the *Bundesrechtsanwaltsordnung (BRAO)* – (Federal Code for Lawyers). The patent attorneys' professional secrecy obligation is based on the Criminal Code and on the *Patentanwaltsordnung (PAO)* - (Patent Attorney Code).

#### *Professionals bound by the secrecy obligation*

The secrecy obligation applies to many professionals such as medical doctors, bankers, lawyers and patent attorneys. Section 43a (2) BRAO provides that lawyers are bound by a professional secrecy obligation. Patent attorneys have the duty to observe professional secrecy under Section 39a (2) PAO.

#### *Kind of information/communication covered by secrecy obligation*

Under Section 43a (2) BRAO, the lawyer's secrecy obligation applies to any information that the lawyer became aware of while exercising his or her professional duties. This obligation continues to exist even after the termination of the mandate.

Section 39a (2) PAO is identical with Section 43a (2) BRAO. Accordingly, also the patent attorney's secrecy obligation relates to everything that has become known to him in professional practice.

Lawyers and patent attorneys are entitled to refuse to testify in particular in civil and criminal courts regarding any information provided to them in their professional capacity (Section 383 of the *Zivilprozessordnung [ZPO]* – [Code of Civil Procedure]; Section 53 of the *Strafprozessordnung [StPO]* - [Criminal Procedure Code]). Since the beginning of 2016, the German law has provided for the obligation of in-house attorneys and in-house patent attorneys (*Syndikusrechtsanwälte/Syndikuspatentanwälte*) to keep confidentiality of correspondence with the right to refuse testimony in civil legal procedures.

#### *Exceptions and limitations to the professional secrecy obligation/availability of forced disclosure and how protection operates*

Based on Section 43a (2), 3rd sentence, BRAO, and Section 39a (2), 3rd sentence, PAO, the confidentiality obligation does not apply to facts which are public or which are not so significant as to require secrecy. Lawyers and patent attorneys are entitled to breach secrecy obligations in only very limited circumstances, such as to prevent the commission of a serious crime. In addition, clients are able to waive the privilege, and their waiver is binding on their lawyers and patent attorneys.

### *Consequences of the loss of confidentiality and penalties for unauthorized disclosure*

Any breach of the duty to observe professional secrecy by a lawyer or patent attorney is a criminal offence (Section 203 Criminal Code). Lawyers and patent attorneys who are in breach of the secrecy obligation could also face disciplinary proceedings leading to various possible sanctions such as a fine or disbarment.

### *Treatment of foreign patent advisors*

The secrecy obligation applies to lawyers who are called to the German Bar and to patent attorneys admitted in Germany.

European Lawyers, i.e. lawyers admitted in a European country practicing their profession in Germany are also bound by the secrecy obligation (Sections 6 and 27 of the *Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland (EuRAG)* – (EU Lawyers Code) in conjunction with Section 43a BRAO). A breach constitutes a criminal offence under the same condition valid for lawyers (Section 42 EuRAG). Similar provisions for European patent attorneys are provided in Sections 16 (in conjunction with Section 39a PAO) and 29 of the *Gesetz über die Tätigkeit Europäischer Patentanwälte in Deutschland (EuPAG)* – (EU Patent Attorneys Code).

Foreign Lawyers, i.e. lawyers from non EU-countries who are authorised under the law of their home country to exercise their profession in their home country and have been admitted to the competent German bar association to practice their profession in Germany are also bound by the secrecy obligation (Section 207 (3) BRAO in conjunction with Section 43a BRAO). A breach constitutes a criminal offence under the same condition valid for lawyers (Section 207 (5) BRAO). Parallel provisions for Foreign patent attorneys are provided in Section 158 (3) PAO in conjunction with Section 39a PAO and Section 158 (5) PAO.

### *Requirements/qualifications for patent advisors*

The requirements that have to be fulfilled in order to become admitted as a patent attorney in Germany are governed by Sections 5-12 PAO. One need not be a qualified lawyer but technically qualified. Applicants must have a university degree in engineering or natural sciences and have worked in a practical technical job for at least one year. During the additional 34-month education they receive a 26-month legal training by a qualified patent attorney and have to spend two months at the German Patent and Trademark Office (DPMA) and six months at the German Federal Patent Court. The applicants must also pass registration examinations of high standards relating to legal studies and intellectual property law.

### **Cross-border aspects**

Under German law, the right to refuse testimony before civil and administrative courts depends on the existence of a legal obligation to keep confidentiality. Due to this connection between a patent attorney's/lawyer's legal obligation to keep confidentiality and his corresponding right to refuse testimony, any foreign patent attorney/lawyer who is obliged to keep confidentiality under the applicable jurisdiction of his place of business has the right to refuse testimony in the same manner as recognized for German patent attorneys/lawyers.

With regard to criminal courts, foreign lawyers/patent attorneys have the same rights to refuse testimony as their German colleagues.

### *Summary*

Secrecy obligations in Germany apply to both qualified lawyers and patent attorneys. Both have to ensure that a client's confidential information obtained in the course of professional practice is kept secret. A breach of the secrecy obligation constitutes a criminal offence.

Accordingly, German lawyers and patent attorneys are entitled to refuse to testify before all courts.