

## South Africa

### National Aspects

#### *Discovery procedure and how privilege protection operates against discovery*

According to the South African Law of Evidence, legal professional privilege in South Africa is based on the Anglo-American evidentiary system. It is based on the fundamental principle that every person has the right of access to the courts, and thus the right of access to a legal advisor, which includes the right to consult with such an advisor privately and confidentially.

Generally, as in any other common law country, a privileged document will not be subject to disclosure in any litigation or to the court. However, it should be borne in mind that the question of privilege has not yet been scrutinized by the South African Courts in view of the South African Constitution which came into effect in 1997 (Constitution of the Republic of South Africa No. 108 of 1996). Although the Constitution contains no express recognition of a right to privilege, the Constitution appears to suggest the implicit creation of such a right. Section 34 mentions the right to access to the courts. Section 35 recognizes the right to assistance of counsel and the right not to be compelled to give self-incriminating evidence. Section 14 creates the general right to privacy, which includes the right not to have the privacy of communications infringed.

#### *Professionals covered by the privilege and secrecy obligation*

In terms of common law privilege, South African and foreign attorneys, which include in-house attorneys, but exclude patent agents or attorneys acting in their capacity as patent agents, may enjoy client-attorney privilege.

In 1997, the South African Patents Act No. 57 of 1978 was amended to include a new Section 24 (9) which provides that:

- “(9) Any communication made by or to a patent agent in his or her capacity as such shall be privileged from disclosure in legal proceedings in the same manner as is any communication made by or to an attorney in his or her capacity as such.”

Consequently, communications between a client and a South African patent agent or patent attorney acting in the capacity of a patent agent (e.g. advising on the patentability of an invention or drafting, filing and prosecuting a patent application) are privileged. It is important to note, however, that this provision expressly applies only to South African patent agents.

#### *Scope of privilege*

Under the common law, communications made between a client and a legal advisor may obtain privilege if the following requirements are met:

- (i) the legal advisor must have been acting in his or her professional capacity;
- (ii) the legal advisor must have been consulted in confidence;
- (iii) the communication must have been made for the purpose of obtaining legal advice;
- and
- (iv) the advice must not facilitate the commission of a crime or fraud.

The South African Appeal Court decision of *S v. Safatsa and Others* (1988 (1) SA 868 (A)), extended privilege to all communications with a legal advisor made for the purpose of giving or receiving legal advice, going beyond communications made for the purpose of litigation.

Prior to *Safatsa*, in the case of *MJ Snyman v. Alert-O-Drive (Pty) Ltd* (1981 BP 215 (CP)) in an opposition to the grant of a patent on patent application 74/2501, it appeared that certain documents came into existence in respect of consultations between the applicant and his or her patent agents and attorneys, for the purposes of filing and prosecuting the patent application. During the course of the opposition proceedings, the objector sought to use the documents for the purposes of cross-examining the applicant but the applicant objected to the admission of any such document on the grounds that it was clothed in professional privilege. The Commissioner of Patents held that the documents were all communications between the applicant and their counsel, in their capacity as patent agents and in connection with the application for a patent, and at a time when there was no question of any litigation. The fact that the counsel was also an attorney was therefore purely coincidental. This issue was also raised in the case of *Kirin-Amgen v. Bioclones* (1993 BP 420 (CP)) and the Commissioner of Patents refused to depart from this precedent set in the *MJ Snyman* case.

However, as described earlier, the Patents Act No. 57 of 1978 now provides that communications made by or to a patent agent shall enjoy the same scope of privilege as that given to communications made by or to an attorney.

#### *The limitations and exceptions to privilege*

Where a communication facilitated the commission of a crime or fraud, it would not be privileged and thus should be disclosed if required by the court.

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

Patent attorneys and agents are subject to rules of professional confidentiality and must maintain the confidentiality of confidential communications with a client. A legal advisor who discloses privileged information without authorization from the client may be struck off the roll for improper conduct. The client may also have a claim against the advisor in such circumstances.

#### *Requirements/qualifications for patent advisors*

There are two types of patent-related professionals in South Africa, one is patent agents and the other is patent attorneys. A patent agent does not need to be legally qualified whereas a patent attorney does. A patent attorney may also act as a patent agent. A patent attorney must be admitted as an attorney in South Africa, must be a member of the South African Law Society, and be in possession of a technical or scientific diploma or degree or have adequate practical experience in a technical or scientific field. In addition, the patent attorney must have passed the examinations held by the patent examination board.

## **Cross-border aspects**

### *Treatment of foreign patent advisors*

In terms of the common law, communications between a client and a foreign patent agent or a foreign patent attorney acting in the capacity of a patent agent (e.g. advising on the patentability of an invention or drafting, filing and prosecuting a patent application) might be privileged in practice if the foreign advisor is either (i) a legal advisor being contacted for the purpose of obtaining legal advice or (ii) if such communications are privileged under the law of the foreign country concerned. Under the statute, only South African patent agents and South African patent attorneys acting in the capacity of patent agents are covered by the client-attorney privilege.

The potential problems in practice are that a non-qualified client may choose to communicate with a foreign patent agent in relation to the prosecution of a patent application in that country only to find that the communication may not be privileged in South Africa since it did not pass between a legal advisor and the client and/or it does not enjoy privilege in the particular country concerned. However, the comments that privilege may still be claimed locally by applying the foreign standard as set out above should be kept in mind if such foreign privilege exists. However, such communications would be considered to be privileged in South Africa if the employee 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 IP professional.

### *Summary*

South Africa has a comprehensive legal professional privilege under the common law system that also extends, under the statute, to patent agents and patent attorneys acting in their professional capacity as patent agents. In order to qualify as a patent agent or a patent attorney, one needs to be legally or technically and scientifically qualified and pass certain examinations. Nevertheless, South African law only extends privilege to local-based patent attorneys and patent agents and not to foreign patent agents or foreign patent attorneys. However, the privilege of foreign patent attorneys might be recognized by courts, if such foreign privilege exists in the foreign law of the country.