Discussion of the Relevant Issues

Protection against forcible disclosure of communications with patent advisors

Various arguments exist, either in favor of or against providing a legal mechanism to protect confidential communications with a patent advisor against forcible disclosure, particularly in court proceedings. The survey of various literature[1] has shown that, in general, the questions regarding the feasibility of applying such protection can be roughly grouped as follows:

- whether preservation of confidentiality of communications with patent advisors in court proceedings would ensure the quality of advice and administration of justice or impede justice by withholding certain information;

- whether non-lawyer patent advisors[2] merit the same treatment as lawyer patent advisors; and

- whether communications with patent advisors who act as intermediaries between clients and patent Offices and prepare documents for public disclosure deserve such protection.[3]

The following paragraphs will consider these questions in order.

Effects on the administration of justice

One of the arguments supporting protection of communications with patent advisors in court proceedings is that the existence of such privilege could encourage open and frank discussions and communications between patent advisors and clients. Clients and patent advisors may discuss a broad range of issues such as patentability of inventions and the possibility of infringement of existing patents. If privilege is not applied, the client may be discouraged from revealing all related details. Such restricted communications can lead to difficulty in preparing an application and taking other necessary actions in a proper manner.

The role of patent advisors in promoting innovation and supporting dissemination of technical information is acknowledged. They carry out their missions through providing professional advice. If clients cannot fully trust their patent advisors due to a lack of complete confidentiality, it would be almost impossible for the patent advisors to defend and represent their clients, and to ensure that clients meet the requirements and enjoy full rights as prescribed in the patent law and other relevant laws. In short, it is suggested that the overall IP system and the public in general will benefit from privilege granted to communications between patent advisors and their clients, because it would ensure full compliance with the applicable laws.

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[1] For example, see John E. Sexton, Developments in the Law – Privileged Communications, 98 Harv. L. Rev. 1501 (1985); Berta Suchorukovaite, Should the Attorney-Client Privilege Be Applicable to Patent Agents? International Journal of Baltic Law, Vol. 3, No.1, March, 2007; Michael Dowling, Prospects for Improvement, What are the Options? Conference on Client Privilege in Intellectual Property Professional Advice (*CPIPPA*) organized by the World Intellectual Property Organization (WIPO) in collaboration with the International Association for the Protection of Intellectual Property (AIPPI), WIPO Headquarters Geneva, Switzerland May 22 and 23, 2008; Paul R. Rice, Attorney-Client Privilege in the United States, Second Edition, West Group, MN (1999); John M. Romary and Robert D. Wells, The Forced Disclosure of Professional Intellectual Property Advice, A Prelude of International Deliberations, May 2009.

[2] In some countries, a patent attorney has legal qualifications, but this does not apply to all countries.

[3] In some countries, patent advisors may represent their clients before a court in certain cases, but in some other countries, patent advisors can only represent their clients before a patent Office.

On the other hand, there is a view that public interest requires disclosure of information to public tribunals in order to allow justice to be served. This is based on the argument that transparency of information is necessary to allow a tribunal charged with resolving a controversy to reach an impartial and just result. When a tribunal standing in judgment is not given access to all available information, its ability to reach a fair result is limited, if not compromised. In a way, the view therefore questions the concept of "privilege" in court proceedings in general. This contrasts with the practice of a number of countries granting "privilege" with a view to promoting public interest in the observance of the law. Since in many civil law countries, a general "discovery" of documents in the possession of the other party is lacking or exists only in very limited case, the extent to which such protection is considered necessary for the administration of justice might be non-existent or might be limited.

Non-lawyer status of patent advisors

One of the arguments against the grant of common law client-attorney privilege to patent advisors is that in some countries, patent advisors do not have legal qualifications, nor are they admitted to the bar. Therefore, they cannot expect the same treatment with respect to the client-attorney privilege. Attorneys who are entitled to represent their clients before a court have a unique role to play in the administration of justice. Consequently, supporters of the argument consider that confidentiality between attorneys and clients should be treated differently from other confidential professional relationships.

On the other hand, some consider that the above view is formalistic, and differentiate the types of advice patent advisors offer to their clients. While technical knowledge is important in preparing a patent application, patent advisors provide legal advice relating to patentability and other relevant elements of the patent laws. An inventor knows best about his invention from the technical point of view. The major role of a patent advisor is to support the inventor by describing the legal scope of protection that meets all the requirements of the patent law. Therefore, while an understanding of the technical features of inventions is indispensable, the major contribution of patent advisors appears to be more of a legal nature. Further, the advice of a patent advisor may not necessarily be limited to the stage of filing a patent application, as he/she continues to provide advice after that stage in relation to the legal scope of protection throughout the life of the patent.

In some countries, while a legal qualification is not a requirement to become a patent advisor, he/she may also represent a client before a court with respect to certain IP cases. This could be considered as an indication of the existence of the special legal expertise of patent advisors. Further, in many countries, patent advisors are also bound by professional secrecy obligation, non-compliance with which could result in a severe sanction. Such an obligation is imposed on non-lawyer patent advisors in the same manner as on lawyer patent advisors. Consequently, bearing in mind the legal nature of their activities, some consider that protection against forcible disclosure in court proceedings should be applicable to the same extent to non-lawyer patent advisors.

Intermediary work of patent advisors

In some countries, patent advisors are entitled to represent clients only before a patent office but not before a court. The fact that patent advisors act only as intermediaries or conduits between their clients and the patent office has led to the argument that patent advisors do not deserve to be granted the client-attorney privilege understood as such under the common law system. According to the conduit theory, a patent advisor is simply an intermediary between the patent Office and his or her client (i.e. an inventor or his or her successor in title). Since his or her task is limited to preparing documents for filings, the client should not expect coverage of the client-attorney privilege to communications with patent advisors.

Since one of the objectives of the patent system is to promote the dissemination of technological knowledge, all information disclosed in patent applications prepared by patent advisors will be made available to the public when the patent applications are published or patents are granted. Some consider that since both a patent advisor and his or her client know that the application will be disclosed at some point, such prior knowledge of disclosure defeats the purpose of client-attorney privilege.

On the other hand, the scope of patent advisors' work is not just explaining technologies underpinning the invention in a patent application. Obviously, a patent application should be prepared in such a way that the enabling disclosure requirement and other requirements relating to disclosure of an invention are complied with in accordance with the applicable patent law. A patent advisor should fully and completely describe all features of the invention and explain how the invention works and what the advantages of the invention are. However, drafting a patent application requires additional expertise that is not necessarily needed when writing an article for a technical journal or writing a technical book. While ensuring technical disclosure, a patent advisor also provides advice relating to the legal scope of protection, for example, how the claims should be drafted or how the description should be worded since it may be taken into account when interpreting the scope of the claims. This kind of advice which goes beyond the provision of technical disclosure may be protected from forcible disclosure.

The above discussion supports the argument that the work of patent advisors as intermediaries throughout the procedures before a patent Office has dual characteristics: technical as well as legal.

Disclosure requirement of patent applications and disclosure of communications with patent advisors in court proceedings

There needs to be a clear distinction between the public disclosure of inventions in patent applications and the public forcible disclosure of communications between patent advisors and their clients within the discovery procedure. Since the dissemination of technological information is one of the key objectives of the patent system, many national patent laws require that an applicant describe his/her invention in a patent application in a clear and complete manner so that a person skilled in the art would be able to carry out the claimed invention. In some countries, the applicant must also describe the best mode for carrying out the invention known to the inventor at the filing date (priority date). Further, in some countries, there is a duty of candour to faithfully disclose prior art, and in some countries disclosure statements have to be signed by applicants or patent attorneys to confirm the fulfilment of those requirements. In other countries, less strict requirements are applied, or there is no general obligation to provide a comprehensive list of prior art as part of disclosure.

Those requirements vary from one country to another, and are unrelated to the preservation of confidentiality of communications between patent advisors and their clients, such as privilege or professional secrecy obligation. For example, even if what had been discussed between a patent advisor and an applicant for the preparation of a patent application can be kept confidential, the applicant is obliged to publicly disclose all information necessary to comply with the disclosure requirements under the applicable patent law. Further, each country provides different sanctions for the non-fulfilment of

disclosure requirements in patent law, such as invalidation of the patent and measures related to inequitable conduct. Thus, preservation of confidentiality of communications with a patent advisor in court proceedings does not affect the general obligation of disclosure is fulfilled.

Although the public disclosure of inventions may not be compromised by privilege or professional secrecy, concerns have been expressed that the confidentiality of communications between a patent advisor and his client may hinder courts and patent offices from reviewing evidence relevant to the determination of the case, such as a document relevant to patentability. For example, a case has been cited where a patent agent, who had received from an inventor a draft patent specification containing a reference to a book that could become critical prior art for the determination of the patentability of an invention, had deleted the reference to that book from the patent application as filed, and the patent was granted. As this example suggests, although the deletion of the reference to the prior art book from the patent application does not remove the existence of that book as prior art, the privilege for patent advisors could result in keeping important information away from public inspection.

However, it could be argued that the patent advisor's advice to delete a relevant reference from the patent application was not in conformity with his professional ethics and code of conduct. He was in fact advising the applicant to seek the grant of a patent which was not valid or at least at risk to be invalidated if the prior art contained in the book was found and the patent challenged. In order to prevent such misuse, high standards of codes of conduct, disciplinary measures and sanctions are common mechanisms contained in national laws. It has to be noted that the objective of discovery in civil proceedings is not to monitor or sanction such misuse, but to provide the other party and the court with relevant evidence.

A similar criticism in respect of the confidentiality of legal advice from lawyers, and the necessity for judges to access all relevant evidence has also been expressed with respect to the privilege for lawyers. In the end, the issue comes down to a global policy consideration on balancing the various interests involved, and many countries have made conscious policy choices with a view to promoting the public interest in having the law respected.

In general, administrative *inter partes* procedures before patent offices apply, *mutatis mutandis*, to many aspects of the general civil procedural law. Therefore, the way in which the preservation of confidential communications with patent advisors affects administrative procedures before patent offices may be another element that could be examined. Since patent advisors, including non-lawyer patent advisors, represent their clients in such administrative procedures in many countries, Member States may be interested in looking into the experiences of national/regional administrative bodies that provide privilege for patent advisors or that allow patent advisors to refuse to testify or submit documents relating to confidential communications with clients.

Public interest and development

As discussed previously, there are both public and private interests behind the regulation of the confidentiality of communications with patent advisors, including non-lawyer patent advisors. In relation to the public interest, an environment that encourages a client to frankly communicate with his patent advisors would ensure a high quality of advice given by patent advisors and would overall benefit the patent system and the public in general through full compliance with applicable laws. However, there is another public interest aspect, namely, to investigate the truth for the sake of justice, which may require tabling all relevant information before a tribunal. Both at the national level and, where the international dimension is considered, at the international level, there is a need to balance these competing interests. At the national level, many countries appear to be inclined to provide a mechanism

allowing a limited scope of protection of confidential patent advice, which would not compromise the exercise of justice.

Although their qualifications and competence vary among national and regional applicable laws, in general, patent advisors play an important role in the "checks and balances" mechanism of the patent system. In particular, in many countries, technically qualified patent advisors, who are specialists in IP laws and technology, are essential players in a functional patent system. This has become more important in recent years, as the technology becomes more complex and the application of IP laws to cutting-edge technology becomes more challenging. Further, in addition to the preparation and prosecution of patent applications before a patent office, some patent advisors provide comprehensive business and IP advice, including general IP consulting, licensing strategies, and dispute resolution. A good understanding of technology and IP laws certainly helps giving such business-oriented IP advice. If a client is not able to frankly communicate with his patent advisors due to the fear of potential loss of confidentiality, this could have a direct impact on the quality of services provided by patent advisors. In view of the functions that patent advisors can assume for the promotion of innovation and transfer of technology, in general, high-quality services by patent advisors support the public interest.

Fewer options of professional IP services or the absence of patent advisors in developing countries does not mean that the issue under consideration is irrelevant to those countries. It is believed that, in those countries, lawyers carry out the tasks entrusted to patent advisors elsewhere and, therefore, the confidentiality of communications between an inventor and his lawyer providing advice on patent prosecution, litigation and other patent related questions needs to be respected both in the national and international contexts. Therefore, the information contained in this document may provide a good opportunity for these countries to consider the usefulness of establishing or strengthening a regulatory mechanism for a special IP profession in their countries.

The obligation for patent advisors to respect the confidentiality of information that becomes known to them in the course of their professional practice is a prerequisite to any kind of protection of such information. In this regard, high standards of professional codes of conduct and their binding effect, disciplinary measures as well as high standards of professional training may facilitate the recognition of protection of confidentiality of communications with patent advisors in court proceedings.

According to the information contained in this document and the result of the AIPPI Questionnaire[4], the current laws regarding preservation of confidentiality of communications with patent advisors seem to be deeply rooted in the legal tradition of each country, and the level of economic or technological development does not seem to be a determinant factor. Thus, while consideration of particular situations of countries in respect of their development may be important, on this particular topic, the different legal traditions may be more pertinent to the consideration of flexibility in the international system.

[4] https://www.aippi.org/download/onlinePublications/AIPPISubmissionto WIPOonConfidentialityof CommunicationsBetweenClients andtheirPatentAdvisiorsSeptember6-FINAL.pdf