

Discussion of the Relevant Issues

Common Law Approach to the Client-Patent Advisor Privilege

One general characteristic of civil procedure in common law countries is “discovery” (or disclosure) in a pre-trial phase. There, each party to litigation may request disclosure of relevant documents and other evidence in the possession of other parties. The discovery system was developed with a view to bringing all evidence to the attention of the court so that the truth can be ascertained. On the other hand, there is also a competing public need to keep certain information confidential from public inspection.

The reasons justifying the client-patent advisor privilege are similar to the justifications put forward in respect of the client-attorney privilege, i.e. the client’s need for frank, honest and open communications with patent advisors to obtain the best intellectual property advice, and the competing public interest to use all rational means for ascertaining truth during an *inter partes* procedure. Another argument supporting the client-patent advisor privilege is that, even if not all patent advisors are qualified lawyers, patent advisors provide legal advice relating to patent law, such as the patentability of inventions or the legal scope of patent protection.

On the other hand, it could be noted that the client-attorney privilege was introduced in the common law systems not with the sole reason of the legal nature of the advice given by lawyers. The lawyers’ strict adherence to a code of ethics plays an important role. In addition, the lawyers’ ability to professionally represent their clients before the courts may require special consideration. Therefore, this particular difference between lawyers and non-lawyer patent advisors could be one of the factors that may justify different treatment with respect to the recognition of the privilege.

It appears that the common law countries, where the client-patent advisor privilege exists, provide a vigorous regulatory environment for patent advisors. Patent advisors must be registered with the competent authority, are required to pass an official examination to obtain the relevant professional title under the applicable national/regional law (for example, “patent attorney” or “patent agent”), and only those who have been registered with the competent authority can use such professional title and conduct professional services. They are also bound by high standards of professional codes of conduct. Therefore, it is assumed that a high professional qualification of patent advisors is an important consideration in those countries. However, in some other common law countries, the client-patent advisor privilege is not recognized even if patent advisors in these countries adhere to similar high standards. Further, some common law countries provide the client-patent advisor privilege even if non-lawyer patent advisors are not allowed to represent their clients before the courts.

The above differences suggest that, at least for some common law countries, the full legal qualification of patent advisors or the entitlement to act before courts is not a decisive factor to establish the privilege. Considering the above, are there any common factors applicable to all common law countries for the determination of either applying or not applying the client-patent advisor privilege? From the information gathered to date, no such common factor emerged.