Discussion of the Relevant Issues

Civil Law Approach to the Client-Patent Advisor Privilege

In general, civil law countries protect the confidentiality of communications between lawyers and their clients in both criminal and civil procedures. Although they may be invoked less frequently in civil law countries than in common law countries, mechanisms exist that allow courts in civil law countries to issue an injunction order to the defendant, upon the admissible request of the plaintiff, to disclose a document which the plaintiff knows to be in the possession of the defendant.[1] There are also the so-called "*saisie contrefaçon*" procedure under French law or the possibility of a court ordering provisional measures to preserve relevant evidence, including seizure of documents.[2]

It appears that, in those circumstances, it is a well-established principle that confidential communications exchanged between lawyers and their clients would not be forced to be disclosed, recognizing the necessity of protecting the confidentiality of legal advice.[3] Further, in general, lawyers should refuse to testify as witnesses about any information provided to them in their professional capacity. The nature of the professional secrecy obligation, however, seems to be considered differently in different jurisdictions. In some, it is an absolute obligation derived from public order, and therefore, a client is not entitled to allow his lawyer to disclose the protected confidential communications. In others, it is a relative obligation where a client remains a custodian of the secret information. Therefore, they provide the possibility for a client to allow his lawyer to disclose the confidential communications.

With respect to communications with patent advisors, patent advisors are, in general, bound by the obligation not to disclose the communications made with his/her clients in their professional capacity. In an increasing number of countries, non-lawyer patent advisors are entitled to refuse to testify in court on any matter falling under the professional secrecy obligation. In some countries, they are also entitled to refuse to produce documents that contain information covered by the professional secrecy obligation. The right given to patent advisors to refuse production of the documents, however, does not fully avoid forcible disclosure of confidential information in court proceedings, since a client, who is often a party to the litigation, may be ordered to submit the document that contains such confidential information. In some countries, therefore, any party may, in principle, withhold in court proceedings documents containing confidential information under the professional secrecy obligation.

Therefore, communications with patent advisors (including non-lawyer patent advisors) are withheld from forced disclosure in litigation in some civil law countries in a manner similar to confidential communications with lawyers. Here again, taking into account the need to keep certain information confidential from public inspection, the broader public interest has been the key consideration of policy makers. Similar to common law countries, the above

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[1] Article 6.1 of the EU Directive on the Enforcement of IP Rights (Directive 2004/48/EC) provides the following: "Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information."

[2] The provisional measures, however, may be less relevant to the issue of confidentiality, since these procedures do not automatically lead to the disclosure of the seized documents.

[3] See Akzo Nobel Chemicals Ltd and Akcros Chemicals Ltd v European Commission (Case C-550/07 P), Opinion of Advocate General Kokott, delivered on April 19, 2010 ("legal professional privilege is currently recognized in all 27 Member States of the European Union, in some of which its protection is enshrined in case-law alone, but in most of which it is provided for at least by statute if not by the constitution itself."

mechanism that is designed to maintain the confidentiality of communications with patent advisors during litigation does not seem to be applied uniformly in all civil law countries. This may be due to the various reasons, for example, the differences among national laws with respect to the evidence gathering rule in civil procedure, significance of the professional secrecy obligation, seriousness of sanctions in case of breach of confidentiality, professional duties and a code of conducts of patent advisors etc.