Possible Remedies Identified on the Cross-Border Aspects

In the context of the cross-border aspects of preserving the confidentiality of communications between patent advisors and their clients, the issues described above arise, in principle, where the following two conditions are simultaneously met:

(i) the national procedural law provides a mechanism (discovery proceedings or any other similar proceedings) that obliges the production of information with respect to confidential IP advice by patent advisors to a court; and

(ii) the national law does not fully recognize the privilege or confidentiality of IP advice given by foreign patent advisors.

In those circumstances, confidential IP advice given by a patent advisor may be kept secret in some jurisdictions, but risks forcible disclosure in others. In order to remedy this situation, a mechanism could be envisaged under which the confidentiality of IP advice by patent advisors is recognized beyond the national border.

In order to achieve seamless cross-border recognition of confidentiality, it may be useful to consider two aspects, i.e., the standards regulating the substantive law of the privilege of patent advisors, and the standards for the recognition of foreign law on privilege. These two aspects are reflected in the possible remedies identified below. In addition, even if they are not perfect solutions, practical approaches to remedy the problems have been applied by practitioners in the absence of legal rules. The following paragraphs will describe those different approaches.

In preserving the confidentiality of IP advice beyond national borders, none of the approaches identified above oblige civil law countries to introduce, in their national procedural laws, an evidentiary privilege akin to that of common law countries, as long as their procedural laws do not provide any proceedings that would require a party to produce communications containing confidential IP advice to a court.