

Possible Remedies Identified on the Cross-Border Aspects

Choice of Law Rules

The standard applied by the courts of some countries in deciding whether the privilege should apply in relation to communications with foreign patent advisors is to consider whether or not such communications would have been privileged in the foreign law of the country concerned. Such recognition of foreign privileges or secrecy obligations has been applied by courts in the United States.

As stated earlier, some civil law countries have amended their national legislation to expressly recognize the privilege in respect of patent advisors, with the aim of achieving foreign recognition through the application of the choice of law rule. While such an approach might provide a remedy in foreign countries where the recognition of patent advisors' privilege in other countries is based on the conflict of law/international private law rule, including the comity rule, it does not have any effect in those foreign countries that apply the *lex fori*.

On the one hand, the application of the choice of a law rule does not require amendments of substantive domestic rules on privilege. On the other hand, such a rule has been developed by courts, and even if a common choice of law rule on the recognition of foreign privilege were to be established, the divergent substantive laws on privilege would continue to exist, thus making it impossible to fully avoid forcible disclosure of confidential IP advice by foreign courts.

As regards mechanisms to facilitate the recognition of foreign patent advisors' privilege through choice of law rules, various possibilities could be considered, for example, the unilateral adoption of common rules at the national level, a soft law approach or the adoption of an international agreement.