

Work undertaken by International Non-governmental Organizations

The issue client-patent advisor privilege was given attention by IP practitioners who have been involved in advising clients. Work has been undertaken by a number of non-governmental organizations, such as the International Federation of Intellectual Property Attorneys (FICPI), the International Association for the Protection of Intellectual Property (AIPPI) and the Asian Patent Attorney Association (APAA), among others.

FICPI

FICPI adopted, at its 2000 World Congress in Vancouver, Canada, from June 12 to 16, the resolution A which urged “appropriate authorities in countries and regions to amend their laws to establish an appropriate system of recognition of qualified intellectual property practitioners.”¹

At its World Congress in Berlin, Germany, from June 2 to 6, 2003, FICPI passed another resolution (Resolution 4) addressing the issue of “qualification of professional representatives and practice across national borders”.²

AIPPI

A milestone in AIPPI’s work was Q163 which was set up to investigate the application of privilege to clients of patent and trade mark attorneys. In its preliminary work, the Committee of Q163 found that there were significant differences between countries in the treatment of privilege.³ It noted that a number of major factors influenced the type of protection available to patent and trade mark attorneys, including the following:

- The availability of discovery or forced disclosure in the jurisdiction.
- The status of the patent or trade mark professional in the jurisdiction.
- The common law/civil law condition of the jurisdiction.
- The imposition of criminal penalties on patent or trade mark attorneys who reveal their client’s confidential information.

In 2003, at its EXCO meeting in Lucerne, AIPPI passed a Resolution arising from the work of Q163 of which the most relevant part is cited below:

“That AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize (that) the protections and obligations of the attorney client privilege should apply with the same force and effect to confidential communications between patent and trade mark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trade mark offices), and their clients regardless of whether the substance of the communication may involve legal or technical subject matter.”

¹ <http://www.ficpi.org/library/Resolutions/CA2000-RES-1GB.pdf>

² <http://www.ficpi.org/library/Resolutions/DE03-RES-4GB.pdf>

³ Documents prepared by the Committee of Q163 are available at:
<https://www.aippi.org/?sel=questions&sub=listingcommittees&viewQ=163#163>

The heart of the AIPPI Resolution is that clients of patent and trade mark attorneys should be afforded the same level of protection by privilege as communications between clients and their legal attorneys. AIPPI decided to put more work into raising the attention of governments, among others through WIPO, in order to address the issue. The organization made a decision to explore the avenue of an international instrument as a solution to the perceived problems and approached WIPO in order to explore the possibility to further investigate the matter with WIPO Member States. In that context, AIPPI suggested an international basic standard in 2005⁴.

As a result of those contacts, it was decided to hold a WIPO-AIPPI Conference on Privilege, which was held on May 22 and 23, 2008, in Geneva. The Conference was attended by Member States, Intergovernmental Organizations, Non-Governmental Organizations and private persons. It raised much interest and covered a broad range of issues, including an overview of the issues, the presentation of cases in common and civil law systems, the potential and real pitfalls in multiple jurisdictions, developments in various jurisdictions, the point of view of companies, including in respect of in-house counsels and options for improvement.⁵

In 2010, AIPPI passed another Resolution arising from the work of Q199, entitled client Privilege in IP Professional Advice (CPIPPA). It resolved that:

- (i) through WIPO to urge the Member States in the SCP to mandate WIPO to conduct the necessary studies to identify remedies to the problems of the protection and to define a preferred solution from the options for remedies which it so identifies, and that this work should proceed urgently following the closure of the SCP 15 meeting; and
- (ii) to make available to WIPO and to its Member States, the AIPPI resources for WIPO to use in relation to its work on remedies as it may be mandated by the SCP to carry out.

APAA

At its 55th Council meeting held in Singapore from October 18 to 21, 2008, APAA put the question of privilege on the agenda and organized a workshop entitled “What Privilege? Whose Privilege?” The event had a considerable success, and APAA adopted a Resolution supporting a solution at the international level.⁶ It resolved that:

“confidential communications between a client and its qualified IP professionals (whether domestic or foreign) should be recognized as privileged communications internationally, so that the client’s position can be appropriately protected internationally”; and

“in order to ensure full and frank communications between a client and its qualified IP professionals (whether domestic or foreign) without any risk of disclosure of their confidential communications, an international consensus on setting minimum standards of privilege should be built so that all national legal systems should be harmonized in such a way that such confidential communications can enjoy privilege internationally”.

⁴ http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_www_100879-related2.pdf. The proposal was updated in 2012 (<http://www.ficpi.org/AIPLA-AIPPI-FICPI-Colloquium/Primer.pdf>).

⁵ The full program can be found on WIPO’s website at http://www.wipo.int/meetings/en/2008/aippi_ipap_ge/program.html

⁶ http://www.apaaonline.org/pdf/APAA_55_council_Meeting/Minutes_of_the_Singapore_Council_Meeting_in_2008_AfternoonSession.pdf

COMMUNIQUÉ FROM AIPLA, AIPPI & FICPI

From June 26 to 28, 2013, AIPLA, AIPPI and FICPI jointly organized a colloquium entitled “Protection of Confidentiality in IP Advice (PCIPA or the Protection) – National and International Remedies” in Paris, France.⁷ The Colloquium was held to encourage consensus on a framework to protect confidential IP advice given to a client by lawyer and non-lawyer IP advisors. The three organizations issued a joint Communiqué⁸ after the Colloquium, in which it is stated that “In both common and civil law systems an agreement could be made that communications relating to IP professional advice with lawyers and/or non-lawyer IP advisors shall be either confidential to the client or subject to professional secrecy and shall, in both cases, be protected from disclosure to third parties unless made public by or with the authority of the client.” In addition, at and after the Colloquium, the three organizations drew up a Joint Proposal⁹ for the establishment of a minimum standard of protection from forcible disclosure of confidential IP advice. The essential agreement part of the Joint Proposal reads as follows:

“1. In this Agreement,

‘intellectual property advisor’ means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person, where such person is officially recognized as eligible to give professional advice concerning intellectual property rights.

‘intellectual property rights’ includes all categories of intellectual property that are the subject of the TRIPS agreement, and any matters relating to such rights.

‘communication’ includes any oral, written, or electronic record whether it is transmitted to another person authorized to receive such communication or not.

‘professional advice’ means the subjective or analytic views or opinions of an intellectual property advisor and is not meant to include mere statements of fact.

“2. Subject to the following clause, a communication made for the purpose of, or in relation to, an intellectual property advisor providing professional advice on or relating to intellectual property rights to a client, shall be confidential to the client and shall be protected from disclosure to third parties, unless it is or has been made public with the authority of that client.

“3. Jurisdictions may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in clause 2 provided that such limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of clause 2 having due regard to the need to support the public and private interests described in the recitals to this Agreement which the effect of the provision in clause 2 is intended to support, and the need which clients have for the protection to apply with certainty.”

⁷ <https://www.aippi.org/?sel=publications&sub=onlinePub&cf=colloquium>.

⁸ *Ibid.*

⁹ *Ibid.*