Confidentiality of Communication between Clients and their Patent Advisors

Terminology

1. "Patent advisor": the term "patent advisor" is used to describe a person who is a professional representative on patent-related matters. Such a person is called "patent attorney" or "patent agent" in many countries. Often, subject to a qualification examination, she/he is registered with a national authority.[1] The exact scope of professional activities and qualification of patent advisors are defined in the applicable national/regional laws. Since the purpose of this document is to compile the existing information, and not to present draft international norms or an international legal instrument, it appears that the document does not need to contain a concise definition of that term. However, for the purpose of this document, it is important to note that a patent advisor may be a qualified lawyer or, if the applicable law permits, a non-lawyer.

2. "Client-attorney privilege": The term "privilege" in connection with the qualified lawyers and their clients relationship (so called "attorney-client privilege", "solicitor-client privilege", "legal advice privilege" or "client-attorney privilege") is well established in common law countries. One legal dictionary defines the term "attorney-client privilege" as follows:

> "In law of evidence, client's privilege to refuse to disclose and to prevent any other person from disclosing confidential communications between him and his attorney. Such privilege protects communications between attorney and client made for purpose of furnishing or obtaining professional legal advice or assistance."[2]

As clearly stated in the above definition, the privilege belongs to a client, not to an attorney, and hence only the client has the power to waive it. It is a concept used predominantly in common law countries.

3. "Client-patent advisor privilege": the term "client-patent advisor privilege" is used in order to describe a similar type of privilege given to a client of a patent advisor (who may be a non-lawyer patent advisor). While the patent advisor could not be compelled to disclose the communication, nothing prevents the client from doing so. If no privilege exists and it is permitted, the client might be compelled by the court to reveal the confidential communications with the patent advisor as part of court proceedings. The privilege protects only the source of information, i.e., the communication between a client and his/her attorney made for the purposes of professional advice, and not the information itself.[3] In that sense, the information itself could be subject to other obligations, for example, the obligation to fully disclose the invention in a patent application, but the communications as source of that information is protected by the privilege.

4. "Professional secrecy obligation": the term "professional secrecy obligation" of patent advisors, often used in civil law countries, refers generally to the legal obligation, imposed to patent advisors, not to disclose communication with their clients made in their professional capacity.

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1 In many countries, only registered patent advisors are entitled to provide the defined professional services. However, in some countries, persons who are not registered are able to perform all or some functions which are normally performed by patent advisors.

2 Black's Law Dictionary, (6th ed. 1990), ISBN 0-314-76271-X.

3 See Cross, John T., Evidentiary Privileges in International Intellectual Property Practice (December 20, 2008). Available at SSRN: http://ssrn.com/abstract=1328481 or http://dx.doi.org/10.2139/ssrn.1328481.

5. "Preservation of confidentiality" / "maintaining confidentiality of communication with patent advisors": Since the issue under discussion in the SCP is not limited to one legal regime or the other, more general expressions, such as "preservation of confidentiality" and "maintaining confidentiality of communication with patent advisors", are used in this document in order to express the notion that communication between patent advisors, made for the purpose of, or in relation to, providing professional advice, is in principle kept confidential and is not forced to be disclosed.