

Confidentiality of Communication between Clients and their Patent Advisors

Japan

National aspects

Origin of the professional secrecy obligation and its coverage

Many professions in Japan, including lawyers (Bengoshi) and patent attorneys (Benrishi), are covered by professional secrecy obligations. For example, Article 23 of the Attorney Act and Article 30 of the Patent Attorney Act provide such obligations.

In connection with civil court proceedings, Article 197 of the Code of Civil Procedure provides the cases where a witness may refuse to testify. One such case is where certain professionals, including lawyers and patent attorneys, are examined with regard to any fact that they have learned in the course of their professional duties and which shall remain confidential (Article 197(1)(ii)). In addition, where a witness is examined with regard to matters concerning technical or professional secrets, he or she may refuse to testify (Article 197(1)(iii)).

Further, Article 220 provides rules concerning the production of evidential documents. In 1998, the revised Code of Civil Procedure expanded the scope of duty to produce documents by including Article 220(iv) which made such a duty a general rule with the prescribed limited exceptional cases where an owner of certain documents may refuse the submission of such documents. One of those exceptional cases applies to documents that detail facts prescribed in Article 197(1)(ii). Another exceptional case where the person in possession of the document may refuse the submission of documents is when the document details a particular prescribed in Article 197(1)(iii). Accordingly, the secrecy obligation of lawyers and patent attorneys is supported in terms of legal procedures.

Professionals bound by the secrecy obligation

Article 30 of the Patent Attorney Act provides that a patent attorney or a person who was a patent attorney must not disclose or appropriate, without any justifiable grounds, secrets learned in the course of conducting business. Article 23 of the Attorney Act provides that non-disclosure constitutes a professional right as well as a professional obligation, unless otherwise prescribed in statutes.

According to Article 197(1)(ii) of the Code of Civil Procedure, professionals who have a right to refuse to testify on any fact learned in the course of duty that shall remain confidential, are medical doctors, dentists, pharmacists, pharmaceutical distributors, birthing assistants, attorneys at law (including foreign lawyers registered in Japan), patent attorneys, defense counsels, notaries or persons engaged in a religious occupation, or persons who were in any of these professions in the past.

In addition, in accordance with Article 220(iv) of the Code of Civil Procedure, the person in possession of the document that details facts prescribed in Article 197(1)(ii) or the document detailing a particular that involves technical or professional secrets may refuse to produce such a document. The person in possession of the document may be the professional covered by the secrecy obligation, a client of such a professional or any third party.

Kind of information/communication covered by the secrecy obligation in general and in relation to patent law

With regard to a lawyer, he or she has a right and an obligation to maintain the confidentiality of any facts which he or she may have learned in the course of performing his or her duties. As regards patent attorneys, he or she must not disclose or appropriate, without any justifiable grounds, secrets learned in the course of conducting business.

Lawyers and patent attorneys have a right to refuse to testify on any fact learned in the course of duty that shall remain confidential. In addition, any witness may refuse to testify on matters that involves technical or professional secrets, such as technological know-how and trade secrets. However, if the witness including the lawyer and patent attorney has been exempted from their duty to keep information confidential, they cannot refuse the testimony. With respect to documentary evidence, any document that details a fact learned in the course of professional duty that shall remain confidential or a particular that involves technical or professional secrets may be withheld from the production of evidence. However, if the fact or the particular mentioned above has been exempted from the duty to keep information confidential, the person in possession of the document cannot refuse to produce the document.

Article 221 of the Code of Civil Procedure requires that, if a party requests a court to order the person in possession of the document to produce such document, the party must show the court the facts to be proven by the document.

Further, Article 223(6) of the Code of Civil Procedure provides so-called in camera inspection of a document. The court is entitled to examine whether the document may be withheld from the production of evidence in a proceeding where only court is allowed to access the document.

Exceptions and limitations to the professional secrecy obligation/availability of forced disclosure

The Court may compel attorneys and patent attorneys to produce evidential documents subject to secrecy obligations. The Code of Civil Procedure, Article 220(1) provides that the person in possession of the document shall not refuse the production of the document where the party itself is in possession of the document that the party has cited in the litigation.

Consequences of the loss of confidentiality and penalties for unauthorized disclosure

Any breach of confidentiality is subject to professional sanctions, where applicable. Any disclosure of secrets is subject to disciplinary measures under the Attorney Act. Article 80 of the Patent Attorney Act provides a specific punishment of imprisonment for a period not more than six months or a monetary penalty not more than 500,000 yen for violation of non-disclosure duty. In addition, Article 134 of the Penal Code provides for an offence for divulging clients' secrets. Clients may also seek compensation for general wrongful acts under Article 709 of the Civil Code. In addition, the Japan Patent Attorneys Association has a code of conduct concerning confidentiality, which also includes penalty provisions.

Requirements/qualifications for patent advisors

In general, a person who intends to become a patent attorney must pass the government examination conducted by the Japan Patent Office, complete the practical training and be registered in the roll of patent attorneys held by the Japan Patent Attorneys Association.

Cross-border aspects

Treatment of foreign patent advisors

The application of Articles 197(1)(ii) and 220(iv) of the Code of Civil Procedure to patent attorneys who are registered in other countries is not clear at this point, due to a lack of case law and established legal opinions.

Clarification of secrecy obligation in order to facilitate recognition in foreign courts

In Japan, following the amendment of the Code of Civil Procedure (Code of Civil Procedure (Act No.109 of June 26, 1996, as last amended by Act No. 48 of May 18,2022)) in 1996, where a patent attorney is examined, as a witness, with regard to any fact that he/she has learned in the course of his/her professional duties and which shall remain confidential, he/she can refuse to testify, in accordance with Article 197(1)(ii) of the Code of Civil Procedure as follows:

Article 197

“(1) In the following cases, a witness may refuse to testify:

- (i) a case as referred to in Article 191, paragraph (1) ;
- (ii) a person who is or was a doctor, dentist, pharmacist, pharmaceuticals distributor, birthing assistant, attorney at law (this includes registered foreign lawyers), patent attorney, defense counsel, notary, or person engaged in a religious occupation is examined with regard to any fact learned in the course of duty that shall remain confidential
- (iii) the witness is examined with regard to a matter that involves a technical or professional secret.

“(2) The provisions of the preceding paragraph do not apply if the witness has been released from the duty of silence.”

Further, in accordance with Article 220(iv) which provides exceptions to the general duty to produce documents, the person in possession of the document that details facts prescribed in Article 197(1)(ii), which includes documents that contain fact learned in the course of duty that shall remain confidential, may refuse the submission of such documents, as follows:

Article 220

“In the following cases, the person in possession of the document in question may not refuse to submit that document:

“ [...]

“(iv) in cases other than those listed in the preceding three items, if the document does not fall under any of the following categories: (a) a document detailing the particulars prescribed in Article 196 with regard to the person in possession of the document or a person who is related to the person in possession of the document in any of the ways set forth in the items of that Article;

(b) a document concerning confidential information in connection with a public officer's duties, which, if submitted, would likely harm the public interest or substantially hinder the performance of a public duty;

(c) a document detailing a fact prescribed in Article 197, paragraph (1), item (ii) or a particular prescribed in Article 197, paragraph (1), item (iii), neither or which are exempt from the duty of silence;

(d) a document prepared exclusively for the use of the person in possession (excluding a document held by the State or a local public entity, which is used by a public officer for an organizational purpose);

(e) documents related to the litigation of a criminal case, the case record in a juvenile protective case, or a document seized in these cases.”.

Summary

A patent attorney is subject to the secrecy obligations, and has the same right with respect to refusal of testimony and a production of evidential documents. The Patent Attorney Act also provides for penalties for breach of such a secrecy obligation. As the law provides for specific secrecy obligations and certain rights of non-disclosure in relation to Japanese patent attorneys, it is not clear to what extent the law applies to patent attorneys registered in foreign countries. Following the amendment of the respective legal provision, it was clarified that a patent attorney has the right to refuse testimony if examined, as a witness, with regard to any fact that he/she has learned in the course of his/her professional duties and which shall remain confidential, and may be excepted from the general duty to produce documents in courts.