



Client Attorney Privilege

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Overview

- What is Client Attorney Privilege?
- Professional Secrecy Obligation
- What about Patent Attorneys?
- International Aspects
- An Example
- How can the position be improved?



Client Attorney Privilege



What is it?

- A feature of common law systems
- “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*.”

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



What is it?

- Belongs to the client
- Protects communication between client and their attorney
- Does not prevent client disclosing the communication
- Means attorney cannot be compelled to disclose the communication



When does it matter?

- In litigation, a key part of pre-trial phase is “discovery”
- Each party is required to disclose relevant documents and other evidence in their possession
- Privilege protects the communications between client and their lawyer



Why does it exist?

- Encouraging a client to frankly and fully communicate with his lawyer assists the administration of justice
 - privilege ensures the human right to privacy
- BUT**
- Need to investigate the truth for the sake of justice, so all relevant information needs to be laid down before the court.



Professional Secrecy Obligation



Professional Secrecy Obligation

- No discovery in Civil Law
 - Therefore, Privilege not necessary
- Need to protect confidentiality between certain professionals and clients
- ‘Professional Secrecy Obligation’ requires professionals to keep information received secret



What about Patent Attorneys?



Patent Attorneys

- In many countries, Patent Attorneys are not lawyers
- Not all Common Law countries give Privilege to Patent Attorneys
- Patent Attorneys in most countries are subject to Professional Secrecy Obligations
- Diversity of National Laws leads to issues



Issues

- Protection to 'local' patent attorneys?
- Protection to 'overseas' patent attorneys?
- Types of communication covered?
- Protection of privileged advice overseas?
- Complex web of laws and provisions



International Legal Framework



Any help?

- Paris Convention
 - Likely not covered
 - Article 2(3) – excludes judicial proceedings
- TRIPS Agreement
 - Refers to Paris Convention
- GATS
 - Allows for national regulation of privilege



IT'S ALL ABOUT

MIE

An Example



United Kingdom



- s. 280 CDPA 1988
 - Where a patent attorney acts for a client in ... any communication, document, material or information to which this section applies is privileged from disclosure in like manner as if the patent attorney had at all material times been acting as the client's solicitor.



EPC



- r. 153 EPC
 - Where advice is sought from a professional representative in his capacity as such, all communications ... are permanently privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client.



UPC



- r. 287 UPC
 - Where a client seeks advice from a lawyer ... any confidential communication ... is permanently privileged from disclosure ...
 - This privilege applies to communications between ... a client and a patent attorney or agent



But what about abroad?

- Variety of approaches
 - Recognition of Foreign Law (comity)
 - Application of domestic *lex fori*
 - Extension of principles of substantive law
 - Facilitating recognition of foreign law



But what about abroad?

- Australia



- 2004 case – only for local patent attorneys (statutory)
- 2013 – law amended to extend to foreign patent attorneys

- Canada



- 2019 – law amended to grant privilege to patent attorneys (no privilege before)
- Same law provides reciprocal privilege



But what about abroad?

- India

- Old UK case – no general privilege to patent attorneys



- Malaysia

- No privilege to patent attorneys



- New Zealand

- Statutory privilege extends to patent attorneys
- Foreign patent attorneys covered
 - Due to an Order in Council





But what about abroad?

- South Africa



- Law provides privilege to local patent attorneys
- No case law regarding privilege for foreign attorneys

- United Kingdom



- No case law regarding privilege for foreign attorneys



But what about abroad?



- USA

- Patent attorneys are lawyers, so are protected
- Patent agents are not lawyers, but are *now* protected

- CAFC - In re Queen's University at Kingston, No. 2015-145
- Texas - in In re Silver, Case No. 16-0682
- PTAB – by statute



But what about abroad?



- USA
 - Privilege for foreign patent attorneys likely to be recognised if they have privilege in their own country
 - Varying approach taken by different courts
 - PTAB – statutory privilege for foreign patent advisors
 - This is an example of why there is ‘privilege’ under the EPC



But what about abroad?

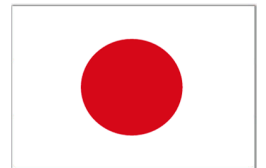
- China

- Professional Secrecy Obligation for Patent Attorneys (Article 19(3) Patent Law)
- Protection for foreign patent attorneys?



- Japan

- Professional Secrecy Obligation extends to Patent Attorneys (Article 197 Code of Civil Procedure)
- No cases on protection for foreign patent attorneys





How can the position be improved?



Can it get better?

- Work by International Organisations, including FICPI
- FICPI resolutions in 2000 and 2003
- AIPPI resolution in 2003
- APAA resolution in 2008





Can it get better?

- FICPI, AIPPI and AIPLA Colloquium on Privilege in June 2013
- Joint Proposal
 - A minimum international standard
 - a communication [by] ... an intellectual property advisor ... shall be confidential to the client and shall be protected from disclosure to third parties
 - ...



Can it get better?

- Under consideration at WIPO (SCP), and in particular by Group B+ nations
 - User associations, including FICPI, have presented on this topic at the Group B+ meeting in 2014-2019
 - Follows Paris Colloquium in 2013
- The latest proposal for a multi-lateral treaty was presented in October 2019
 - We will continue to work on this



Thank you for your attention!

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