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EPLIT ANNUAL MEETING

ACTIVITIES in the PRIVILEGE WG

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Amsterdam

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Basis of our work

Questionnaire regarding cross-border aspects of client/ patent attorney privilege (CAP)

- Issued by the Swiss Federal Institute of Intellectual Property (IPI)

- However, the discussion was initiated by the USPTO

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Frame of the work: Group B+ consultation

EPO website: „The Group B+ was established to promote and facilitate progress on key issues under consideration at the World Intellectual Property Organization (WIPO) and in particular to **move forward on substantive patent law harmonisation**.

Composition

all members of WIPO's Group B (embracing quite a lot developing countires),
EU member states, the European Commission,
EPOrg member states, the EPO, South Korea." (USA is in the subgroup B+)

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Introductory remark:

The objective of the survey is a complete set of answers to the questions below. Each delegation is free to decide which stakeholders should be questioned (e.g. users of the system i.e. industry; IP professionals: lawyers, patent attorneys etc.; courts; administration branches etc.) and/or which questions should be submitted to which group of stakeholders.

Result: many national chambers of patent attorneys were asked by their national IP Offices (which are delegates in Group B+)

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QUESTIONS – Part A / General aspects

1. In your opinion, is there a need to protect communications between IP professionals (nonlawyer/lawyer) and clients in cases having cross-border aspects?

Response: Yes, there is definitely a need to protect communications between IP professionals (in the following: representatives, including patent attorneys and lawyers/attorneys at law) and clients in cases having cross-border aspects.

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Further details in response 1

-The same rules are to be applied equally to all types of the above IP professionals since they are acting in this sub-area of law and there is no difference between these professions with regards to the necessity of safeguards of CAP

- Moreover, the above approach is also in line with the decision of the US CAFC in re: Queen's University at Kingston, Parteq Research and Development Innovations (2015-145, decided: March 7, 2016) where an independent patent agent privilege was recognized.

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Question 2

2. Have you been confronted with situations where the client attorney privilege was an issue?

Response: EPLIT does not have direct contact with clients (only the members thereof), so most of the above questions are not applicable for EPLIT. **However, it is known fact that the question of CAP arises very frequently in everyday communication**, especially in each case relating to infringement and clearance opinions. There are also several reported cases, such as …

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Question 3

3. **Is your interaction with your clients (e.g. communication, decision making process) influenced by the differences in national approaches to client attorney privilege issues?**

Response: The danger of non-intended discovery of confidential information (e.g. in a court procedure) obviously influences the way of communication. If no privilege is ensured then the communication is much more reserved and this lesser freedom of discussion may have negative impact on the quality of representation and may cause complications with some waste of time and costs.

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QUESTIONS 4 and 5:

4. In connection with the cross-border client attorney privilege, what do you think is essential to be regulated by a multilateral agreement?

Response: reference to our reponse in Part B.

5. In your opinion, what are possible reasons against adopting a multilateral agreement?

Response: There are no such meritorious reasons.

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PART B - Specific aspects of the agreement

1. **What professionals should be covered by the agreement?**
2. What advice should be covered by the agreement?

Response: We think that the approach applied in the Rules of Procedure of the Agreement on a Unified Patent Court (RoP) can be the starting point in this discussion (see Rules 286 and 287). Please note that during the elaboration of the CAP part of the RoP all the national differences were intended to be taken into consideration.

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NEW WORDING FOR RULES 286 to 288

However, in our proposal we simplified the wording of the cited Rules and broadened the scope of the related persons (see in point 4 below).

The suggested wording was adapted to the present situation, i.e. it is did not refer to the special legal instruments of the UPC system.

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Point 1 of the new version

1. The attorney-client privilege prevents the representative instructed in a professional capacity and his client from being questioned or examined about the contents or nature of their communication, accordingly the communication is privileged from disclosure in any proceedings before any Court or Authority, including arbitration or mediation proceedings.

/based on Rules 288 and 287/

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Point 2 of the new version

2. The communication of point 1 comprises especially the followings:
- seeking advice by the client from representative, in connection with proceedings before the Court or Authority, including arbitration or mediation proceedings, or otherwise;
- any confidential written or oral communication between the client and the representative**;**
- any work product or record made in connection with the communication**.**

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Points 3 and 4 of the new version

3. This privilege applies also to communication between a client and a representative employed by the client and to communication between representatives employed in the same firm or entity.

4. This privilege extends to any patent attorney, lawyer ***and other employee of the representative's entity*** involved by the representative into the procedure before the Court or Authority, including arbitration or mediation proceedings**.**

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REASONS for this „broadening”

Our note to the highlighted part relating to employees:

It broadens the privilege to other employees who are involved into the work. We think that it has a real practical importance. Please note that examples can be found for this approach in Europe at national level.

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FINAL QUESTION

3. Should there be a provision in the agreement that stipulates a certain flexibility for the participating countries?

Response:

If possible, not. Equal treatment would be advisable.

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Last year: Public consultion by the USPTO

EPLIT Comments:

i) some information about EPLIT;

ii) some information about the UPP/UPC system [in general];

iii) citation the relating Rules 286 to 288;

iv) short comment concerning the content [the privilege is world-wide (the state of the practice is not limited to EU countries)]

v) Final statement: we were happy to see a similar treatment (reciprocity) for European IP lawyers and PAs.

OUR PRESENT RESPONSES ARE CONSISTENT WITH OUR EARLIER PAPER

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THANK YOU
for the attention