

EPLIT

EUROPEAN PATENT LITIGATORS ASSOCIATION



*EPLIT – c/o Multiburo Paris Chatelet 52,
Boulevard Sébastopol, F- 75 003 Paris*

To the United States Patent and Trademark Office

25 February 2015

Re: Comments on Domestic and International Issues Related to Privileged Communications Between Patent Practitioners and Their Clients

Dear Sirs,

As you probably know, the patent system in Europe is before a great change since after a long negotiating within the European Union (EU) the creation of a European patent with unitary effect („unitary patent protection”, UPP) and a unified European Patent Court (UPC) seem to turn into reality in the near future. As it can be read on the homepage of the European Patent Office: „in 2012 the representatives of the EU member states achieved a breakthrough agreement: the European unitary patent will soon guarantee supranational protection for inventions in 25 countries across Europe. Meanwhile, the agreement to install a European patent court is currently being ratified by EU member states.”

EPLIT, the European Patent Litigators Association, was founded in 2013 in view of the fact that the UPC Agreement provides for representation of parties by European Patent Attorneys having an appropriate qualification in patent litigation. Thus it is one of the main objectives of our association to promote the participation of European Patent Attorneys in proceedings before the UPC.

Studying the aims of the above inquiry we found that the USPTO is interested in „how foreign courts treat communications between U.S. patent agents or attorneys and their clients”. **EPLIT** is of the opinion that the relating regulations of the planned European system should be interesting to the USPTO since this framework will be applied to US patent agents and patent attorneys in the planned system with a start in 2016, as it is currently envisaged.

The issue of privilege is discussed in the Rules of Procedure as follows (it is cited from the 17th draft version of it issued on October 31, 2014):

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Rule 287 – Attorney-client privilege

1. *Where a client seeks advice from a lawyer or a patent attorney he has instructed in a professional capacity, whether in connection with proceedings before the Court or otherwise, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is privileged from disclosure, whilst it remains confidential, in any proceedings before the Court or in arbitration or mediation proceedings before the Centre.*

2. *This privilege applies also to communications between a client and a lawyer or patent attorney employed by the client and instructed to act in a professional capacity, whether in connection with proceedings before the Court or otherwise.*

3. *This privilege extends to the work product of the lawyer or patent attorney (including communications between lawyers and/or patent attorneys employed in the same firm or entity or between lawyers and/or patent attorneys employed by the same client) and to any record of a privileged communication.*

4. *This privilege prevents the lawyer or patent attorney and his client from being questioned or examined about the contents or nature of their communications.*

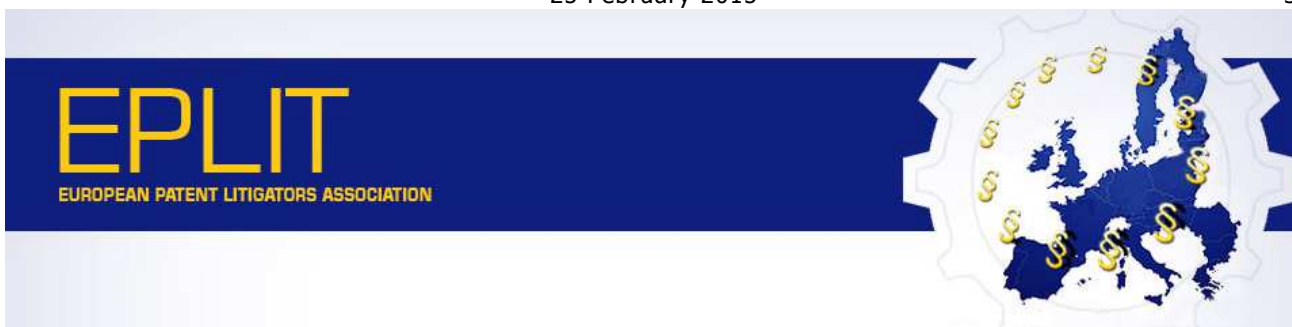
5. *This privilege may be expressly waived by the client.*

6. *For the purpose of Rules 287 and 288*

a) *The expressions "lawyer" shall mean a person as defined in Rule 286.1 and any other person who is qualified to practice as a lawyer and to give legal advice **under the law of the state where he practices** and who is professionally instructed to give such advice.*

b) *The expression "patent attorney" shall include a person who is recognized as eligible to give advice under the **law of the state where he practices** in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice. /emphasis added/*

7. *The expression "patent attorney" shall also include a professional representative before the European Patent Office pursuant to Article 134 (1) European Patent Convention.*

**Rule 288 – Litigation privilege**

Where a client, or a lawyer or patent attorney as specified in Rules 287.1, 287.2, 287.6 and 287.7 instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings, including proceedings before the European Patent Office, such communications shall be privileged from disclosure in the same way and to the same extent as provided for in Rule 287.

As you can see from this text, the European member states intend to provide a world-wide privilege for lawyers and patent attorneys before UPC since *the state of the practice* is not limited to EU countries. We hope that the final result of the present consultation will ensure a similar treatment for qualified European patent lawyers and attorneys in the USA, i.e. we shall enjoy a reciprocity in this respect.

If you have any questions in connection with the planned European system, please do not hesitate to contact us.

Sincerely yours,

A handwritten signature in black ink, appearing to be 'K. Bijvank', written in a cursive style.

on behalf of EPLIT
Koen Bijvank, President