

AIPPI - Question 163

Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

ANSWERS OF THE BRAZILIAN GROUP

1. The domestic situation in relation to any privilege protecting disclosure of communications between attorneys at law and their clients

The groups should explain the current situation in their jurisdiction in respect of the attorney-client privilege. Items to be addressed include the following:

A. Is an attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

1.A) Yes, the attorney-client privilege is protected by:

a) section 7, paragraph XIX, of Law 8906/94, which sets forth that lawyers have the right to refuse testifying on facts referred to their current or former clients (even if asked by them) and on any fact which is a professional secrecy; and

b) section III, letter "a", of the Lawyers' Ethical Code of Behavior, which declares that lawyers are obliged to keep the secrecy of any information disclosed to them due to their activities.

B. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

1.B) Yes, the privilege may be invoked to prevent disclosure, as mentioned above.

C. What are the limits of the privilege? Does the privilege extend to non-legal matters? What exceptions are recognized to this privilege? Under what circumstances can or will the privilege be "vitiating" or overcome?

1.C) The Law makes no distinction: the privilege applies both to legal or non-legal matters. Its only limit is the extension of the secret. There are some extensions: lawyers are not punished if the disclosure has a reasonable ground. A reasonable ground is an open concept, to be assessed on a case by case basis. The Agents' Ethical Code of Behavior (Decree 142/98, enacted by the BPTO) provides for some guidelines: disclosure is accepted whenever there is: a) a serious menace to life or honor; or b) litigation between client and agent.

D. In what types of cases can the privilege be asserted?

1.D) The privilege may be asserted in all kinds of cases.

E. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the attorney at law violates the privilege?

1.E) Yes, if lawyers disregard the privilege, without any reasonable ground, they are subject to:

- a) professional sanctions imposed by the Bar Association (Law 8906/94, section 34, paragraph VII);
- b) criminal sanctions (sections 153 and 154 of the Criminal Code), such as a fine or 1-12 months of imprisonment;
- c) civil sanctions (section 159 of Brazilian 1916 Civil Code), for damages.

2. The domestic situation in relation to any privilege protecting disclosure of communications between patent or trademark attorneys and their clients

The groups should explain the current situation in their jurisdiction in respect of any privilege protecting communications between patent attorneys, patent agents or trademark attorneys and their clients. Items to be addressed include the following:

A. By way of background, please first explain the qualifications for patent or trademark attorney or patent agent in the Group's jurisdiction, the extent of the representation allowed by this qualification and the differences if any between the representations allowed in the jurisdiction as between patent attorneys and patent agents.

2.A) Both lawyers and registered agents are allowed to act before the BPTO. The BPTO's registration is not mandatory for lawyers. Non-lawyers must take a qualifying exam held at the BPTO. Any citizen, 21 or older, with a clean moral record is allowed to apply. Lawyers and registered agents are entitled to practice all acts aimed at the acquisition, maintenance or extinction of their clients' patent and trademark rights. However, only lawyers are allowed to file lawsuits or defenses before the Courts.

B. Is a patent or trademark attorney-client privilege recognized in your jurisdiction? If so, please define the privilege, explain how it arises, and explain how it is protected (for example, by statute or case law.)

2.B) Yes, the patent or trademark agent-client privilege is recognized in Brazil. Such privilege is protected by:

- a) sections 153 and 154 of Brazilian Criminal Code (see topic 1.E above); and

b) sections 10 to 14 of the Agents' Ethical Code of Behavior, enacted by BPTO's Decree 142/98.

C. What are the limits of this privilege? Does the privilege extend to issues beyond questions of patent or trademark law and practice? Does the privilege extend to technical disclosures? Under what circumstances will the privilege be lost or "vitiating"?

2.C) The privilege extends to all issues. According to section 12 of the Agents' Ethical Code of Behavior, the privilege may be disregarded in case of serious menace to life or honor, and as self-defense in litigation between client and agent.

D. Explain the practical significance of the privilege. For example, does some form of discovery or disclosure obligation exist generally in court proceedings in the jurisdiction during which the privilege may be invoked to prevent disclosure?

2.D) Yes, the privilege may be invoked to prevent disclosure.

E. In what types of cases can the privilege be asserted?

2.E) The privilege may be asserted in all types of cases.

F. Are there criminal laws, civil laws or professional obligations which exist which can come into play if the patent or trademark attorney at law violates the privilege?

2.F) Yes. See topics 2.B for agents and 1.E for lawyers.

### 3. Proposal for General Rules

Would the group support a proposal for a general rule respecting the existence of a privilege protecting communications between patent attorneys and their clients?

A. Should the AIPPI support the existence in each member country of a privilege protecting from forced disclosure to a court or a third party communications between patent or trademark attorneys or their clients?

3.A) Yes.

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?

3.A.1) By both statute and professional obligation.

2. Whose communications would qualify for such protection?

3.A.2) All communications between clients and agents must earn protection against disclosure (section 14, sole paragraph of Agents' Ethical Code of Behavior, enacted by BPTO's Decree 142/98).

3. Should there be a limit on the scope of the protection? Should the privilege extend to purely technical communications as well as to communications mixing legal and technical matters?

3.A.3) The protection should not be limited only to purely technical matters. It must extend to all communications.

4. Should communications involving responses to patent and trademark office actions be covered by such a privilege?

3.A.4) Yes. All communications between clients and agents must be covered by the privilege.

5. Should the privilege extend to patent agents who do not make court appearances as well as to patent or trademark attorneys who are authorized to appear in court with attorneys-at-law?

3.A.5) Yes, no distinction should be made between agents or lawyers, in so far as the maintenance of the secrets revealed to them is concerned.

B. Should the AIPPI not take a position on the question of the patent attorney-client privilege except to say that the organization believes that if a jurisdiction recognizes a privilege protecting communications between attorneys at law and their clients, they should also recognize a privilege protecting communications between registered patent or trademark attorneys and their clients?

3.B) No, AIPPI should not take such position. The construction of internal rules is a matter for the Courts of each country, not for the AIPPI. In countries, such as Brazil, in which the activities, rights and obligations of the lawyers are different from the agents', the rules applicable to the first do not automatically apply to the latter.

1. Is there any practical difference in the professions which would justify a different treatment for communications with their respective clients?

3.B.1) In their contacts with the clients, lawyers and agents must abide by the same rules, as stated in topic 3.A.5. However, such equal treatment must be expressed by Law.

C. Is the matter of purely national concern such that the AIPPI should not take a position?

1. As many jurisdictions do not allow any form of discovery or forced disclosure in litigation or other court proceedings, the practical impact of the existence of the privilege on

a local level would seem to vary considerably as among the member groups. Would it thus be inappropriate for AIPPI to adopt a provision which would have uneven impact throughout the membership

3.C.1) Yes, such provision would be inappropriate. See topic 3.B above.

2. Please comment on whether foreign applicants could be disadvantaged by the lack of an internationally or generally recognized privilege and how AIPPI might serve to minimize such a disadvantage by another means.

3.C.2) Foreign applicants must have the same protection given to national applicants, regarding the agent-client privilege, and this is so in many countries, like Brazil, which prohibits any difference of treatment between nationals and foreigners according to article 5 of the Federal Constitution. To ensure that such privilege is recognized as a standard worldwide, the AIPPI should propose the amendment of international treaties.

D. Are there other issues which should be taken into account in considering this question?

3.D) No.

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