Question 163
Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

This is a new question for AIPPI which is of great practical importance.

Many if not most member countries recognize that confidential communications between attorneys at law and their clients, aimed at providing the client with legal advice, are privileged and need not and indeed should not be revealed to third parties or even a court except in extraordinary circumstances. The purpose for such a privilege is in the recognition that in order for the client to obtain the best legal advice, he or she should feel that their communications with their attorney should be full and complete and without fear that their communications would be revealed to third parties or the public.

This “attorney-client privilege” seems to be widely recognized in both common law and civil law countries, has been codified into the law of a great many countries, and has been recognized in court decisions throughout the world.

The question of the attorney-client privilege frequently arises in jurisdictions where parties to a litigation or other form of dispute resolution are compelled to produce relevant documentation or testimony to the adversary or the court. Even in jurisdictions where discovery procedures are available, the parties can usually refuse to produce documentation or testimony which consists of communications between clients and their attorneys by asserting the protection of the attorney-client privilege. Some countries in fact make it a crime for an attorney at law to reveal client confidences to third parties.

It should be recognized that other classes of communications are also widely recognized as being protected by such privileges, including those between clergy and penitent, husband and wife, and doctor and patient. The policy reasons protecting such communications are similar to the attorney-client privilege, i.e. society widely recognizes that parties to these unique and trusted relationships should feel free to engage in complete and open discussions without worry that their communications will be forced to be revealed in a court or other public proceeding.

However, notwithstanding the widespread recognition of the attorney-client privilege and the other mentioned types of privileges, there appears to be a high degree of variability throughout the world’s jurisdictions in terms of protection of communications between “patent attorneys” (including “patent agents”) or trademark attorneys who are not also attorneys at law and their clients. (Hereinafter, except where expressly noted, the Question uses the expressions “patent attorney” and “patent agent” synonymously to refer to those professionals who are not attorneys at law but who nevertheless meet and have passed local governmental qualifications for representing clients before their local patent offices.)

The reasons expressed by some in support of a different treatment as to privileges protecting communications between patent or trademark attorneys and their clients include that: (1) the training and experience of the non-attorney at law patent or trademark attorney is different from that of the attorney at law and does not involve representation before the courts; (2) the subject matter involved in such patent attorney communications can be of a purely technical and non-legal nature; and (3) that the communications involve directly or indirectly representations made to government agencies, not courts.

In more practical terms, it also seems that in some jurisdictions, the lack of recognition of a privilege protecting communications between patent attorneys and their clients may not be representative of a decision to maintain such a distinction, but instead might be an oversight in the development of the law, or even may be the result of a professional rivalry between local attorneys at law and patent attorneys having the effect of delaying the adoption of rules or laws respecting such a privilege.

Regardless of the reasons, the fact remains that there is some non-uniformity throughout the member countries respecting the existence of a "patent (or trademark) attorney-client privilege." And this non-uniformity may result in a kind of unsuspected trap for clients using patent attorneys in foreign jurisdictions, as the client may believe its communications with its patent attorney are privileged when in fact they are not. Thus, the question has international as well as national significance and may be ripe for a resolution of the AIPPI in support of the international recognition of a privilege protecting communications between patent attorneys and their clients at least on par with the local recognition in each member country of a privilege protecting from disclosure communications between attorneys at law and their clients.

Prior to commencing debate on the desirability of such a resolution, the question raises the following specific issues of national effect on which each of the member countries are invited to comment.

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.)

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?

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 "vitiated" or overcome?

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

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?

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.

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.)

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 "vitiated"?

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?

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

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?

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?

1. If so, would it be preferable to suggest implementation by statute, common law recognition, professional obligation, etc?
2. Whose communications would qualify for such protection?
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?
4. Should communications involving responses to patent and trademark office actions be covered by such a 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?

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?

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

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

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.

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