

**COMMENTS MADE BY MEMBERS AND OBSERVERS OF THE SCP
ON DOCUMENTS SCP/13/4 (THE CLIENT-ATTORNEY PRIVILEGE)
AND SCP/14/2 (THE CLIENT-PATENT ADVISOR PRIVILEGE)**

**I. 15th session of the SCP, October 11-15, 2010
[Excerpts from the Report (document SCP/15/6)]**

1. Discussions were based on documents SCP/13/4 and SCP/14/2.
2. The Delegation of Belgium, speaking on behalf of the European Union and its 27 Member States, stated that, in the framework of the industrial property system, the freedom of communication between professional representatives and their clients was fundamental in relation to the preparation of an application for a patent, the procedure for obtaining a patent as well as when an opinion was requested regarding infringement or annulment of rights. It considered that the freedom of communication necessarily required the grant of the confidentiality of the communication between the professional representatives and their clients, both with respect to third parties, and particularly, in the event of judicial proceedings. The Delegation expressed its wish to endorse the Secretariat's recommendation for the next steps consisting of a detailed study on the treatment of the confidential information revealed to the professional representatives as granted by the different States. In particular, the Delegation observed that the study in question should also address how confidentiality of communications between professional representatives and their clients in one country was recognized in other jurisdictions, as well as exploring possible options of further recognition of the confidentiality between professional representatives and their clients beyond national borders. In addition, the Delegation noted that a detailed study to be prepared by the Secretariat should also be focused on norm-setting activities in that field. The Delegation considered that prerogative crucial to enable an appropriate communication without reservation between the client and his representative, enabling for the best defense of the client's interest.
3. The Delegation of Switzerland observed that, in order to better understand the issues surrounding the question concerning the client-attorney privilege, it might be ideal to have a summary of all the different national jurisdictions. The Delegation noted that even if it was an issue based on national legislation, solutions could be found within the SCP in order to assist the various legislations to make progress on the topic. The Delegation therefore suggested the possibility of drawing up a potential guide for the members of the Committee and for the responsible officials. It stressed the importance of looking at the practices in different countries as well as their implementation. The Delegation supported the statement made by the Delegation of Belgium on behalf of the European Union and its 27 Member States, i.e., a request to the Secretariat to draw up a detailed study on the issue of the recognition of client-attorney privilege and the confidentiality of communications within and between countries. The Delegation recalled its statement at the previous session of the SCP, and noted that the contents of that statement were still valid in terms of their position. The Delegation informed the Committee that its law on patent advisors would come into force on July 1, 2011, and noted that the privilege to maintain confidentiality was included in Switzerland's Criminal Code and would be taken into consideration in the work carried out by the Council on Patents. The Delegation stressed the importance of the subject for its country and expressed the hope that the work on the issue would make progress in the SCP.
4. The Delegation of Slovenia, speaking on behalf of the Group of Central European and Baltic States, aligned itself with the position expressed by the Delegation of Belgium on behalf of the European Union and its 27 Member States. In particular, the Delegation underlined the importance of in-depth analysis of the situation which arose when advice from professional representatives extended from one jurisdiction to another. The Delegation therefore suggested that a detailed study focusing on the cross-border elements of the client-attorney privilege be prepared by the Secretariat.

5. The Delegation of Nepal noted the importance of a study on the client-attorney privilege for Nepal, given its current process of legal reforms. The Delegation observed that the preliminary study was based on a cross-universal assessment of prevailing systems and drew out interferences between them as well as tried to synchronize theoretical propositions and practical aspects through adequate conceptualism, analysis and review of literature. The Delegation also noted that the preliminary study had clearly illustrated the principal mechanisms for applying and facilitating the client-attorney privilege in the international, regional and national context, and had described four basic approaches concerning international mechanisms. The Delegation expressed its appreciation to the Secretariat for the preparation of the preliminary study because of its neutrality and fairness in the elaboration of its content. The Delegation pointed out that the preliminary study should clearly identify how to effectively implement the said international mechanisms and provide an assessment of pros and cons of such mechanisms. It also noted that the preliminary study should explore the possible risk mitigating measures as well as implications at national, regional and international levels. The Delegation suggested that WIPO commission an independent study providing a comparative analysis of the issue of client-attorney privilege in Member States so as to facilitate its practical implementation at the national level.

6. The Delegation of New Zealand agreed that the lack of cross-border recognition of client-patent advisor privilege was a major problem, and it considered that undertaking a work to identify solutions to the problem in the SCP to be valuable. The Delegation pointed out that, as indicated in the preliminary study, New Zealand's law already had provided for cross-border recognition of client-patent advisor privilege, including privilege in communications with non-lawyer patent attorneys.

7. The Delegation of Australia expressed support for the statements made by the Delegations of Belgium on behalf of the European Union and its 27 Member States, Slovenia on behalf of the Group of Central European and Baltic States and Switzerland, and agreed that the client-attorney privilege was a very important topic. It noted that the international differences that existed in relation to client-attorney privilege had recently received considerable attention within Australia, and that the Australian Government was in the process of considering legislative changes in that area. Consequently, the Delegation supported further work on the client-attorney privilege in the SCP, including a study on the principles and application of privilege afforded at the national level. In addition, the Delegation expressed its support for a study identifying potential guidelines or solutions to the problems related to the client-attorney privilege.

8. The Delegation of the Russian Federation thanked the Secretariat for the preparation of documents SCP/13/4 and SCP/14/2, and inclusion of the practice of the Russian Federation on the issue of client-patent advisor privilege in the latest document. Noting the relevant legislations which governed the issue of secrecy obligation of certain professionals in the Russian Federation, the Delegation underlined that Federal Law on Patent Attorneys prohibited the transmission or any disclosure, without the client's written consent, of information contained in documents obtained and/or produced as part of the performance of their activities, except otherwise provided by the relevant law. Thus, the Delegation explained that in the Russian Federation, patent attorneys had limited privilege, as information which constituted a professional secret may be passed on to third parties in accordance with federal laws and/or on a court decision. Noting that different practice existed on the issue among Member States, the Delegation stated that the issue of minimum standard of privilege applicable to communications with IP advisers deserved further analysis within the SCP.

9. The Delegation of the United States of America aligned itself with the views expressed by the Delegations of Slovenia on behalf of the Group of Central European and the Baltic States and Switzerland, and in particular with the views expressed by the latter concerning the possibility of a summary document to be prepared by the Secretariat. The Delegation pointed out that such a document could be of considerable value not only for legislators, but also for users of patent and legal systems in various countries. The Delegation aligned itself also with the views expressed by the Delegation of Belgium on behalf of the European Union and its 27 Member States, according to which

the document in question would also serve for identifying practical and pragmatic suggestions on the next steps for further work on the topic.

10. The Delegation of El Salvador considered document SCP/14/2 to be a good foundation for the future work on the issue of client-attorney privilege. Recalling that it was an open-ended document that could be improved and fine-tuned, the Delegation expressed its belief that the document should include more examples of experiences in different countries, in particular, cases based on the national experiences of developing countries. As El Salvador had a Roman-law system, the Delegation considered it useful to have access to information related to experiences of countries having also a Roman-law system, taking into account the fact that in El Salvador, the issue was regulated under both the civil law and the criminal law.

11. The Delegation of Brazil, speaking on behalf of the DAG, noted that, according to document SCP/14/2, the difference in the regulation of the client-attorney privilege existed not only between common law and civil law countries, but a variety of approaches existed also between countries having the same legal tradition, and that such difference of approaches among different systems and inside the same legal systems was reflected also in relation to the confidential information between a client and his or her patent advisor. In particular, the Delegation observed that the document stressed the fact that the treatment of confidential information between a client and his or her non-lawyer patent advisor in foreign courts was an issue far from being settled, and the evidence rule, the scope of protection of confidentiality, the professions covered by confidentiality and the treatment of foreign registered patent advisors and their qualifications were different from country to country. The Delegation considered that many of the mentioned issues went beyond patent protection or patent litigation because, they were more generally related to national judicial procedures that reflected the fundamental legal structure and tradition of each country. For that reason, the Delegation was of the view that it was neither practical nor realistic to seek a uniform rule that could involve fundamental changes in national judicial systems. The Delegation considered that privileged communications between a lawyer and his or her client was not based on the legal nature of the lawyer's work *per se* but on the judicial relationship that existed between the lawyer and the court. In addition, the Delegation pointed out that privileged communications such as those that took place between a client and his or her lawyer did not fall within the domain of the law of patents.

12. The Delegation of India reiterated its position expressed during the previous session of the SCP. The Delegation pointed out that, under the Indian Patent Act, there was no provision concerning the client-attorney privilege, and observed that such provision was neither included in the Paris Convention nor the TRIPS Agreement. For that reason, the Delegation considered that each country should be allowed to set its own level of privileges and extent of disclosure depending upon the social and economic circumstances and level of development of each country. In its view, the harmonization of the client-attorney privilege would imply the harmonization of exceptions to the disclosure which would then bring great secrecy and tie the hands of patent offices and judiciary to find out the relevant information which might be very critical to determine the issue of patentability. Since the disclosure of not only technical information but other relevant information relating to patent applications was a substantial element of the patent system, the Delegation was of the view that one of the important duties of the patent attorney was to promote dissemination of information about the patent application and therefore, any effort of harmonization of the client-attorney privilege would ultimately lead to a defective and unenforceable grant of patent. In its opinion, any confidentiality of the information between a client and his or her attorney could be protected through a non-disclosure agreement. The Delegation concluded that the protection of important information through client-attorney privilege would lead to a situation where vital information would be suppressed and kept out of the public access, and therefore, it could be detrimental to public interest, particularly in developing countries.

13. The Delegation of the Islamic Republic of Iran aligned itself with the statement made by the Delegation of Brazil on behalf of the DAG. The Delegation observed that no definition of the concept of client-attorney privilege had been provided in the preliminary study. The Delegation observed that the legislation of several countries, especially civil law countries, did not contain such concept of

privilege, and that although there was an overall common practice on the issue of confidentiality of communication between a client and his attorney in both common law and civil law countries, the confidentiality in civil law countries stemmed from professional secrecy obligation, while in common law countries, privilege was intended to have different meaning. The Delegation therefore observed that the client-attorney privilege was a matter of private law which belonged to national jurisdictions of different countries, and consequently, harmonization of that topic would not be easy. The Delegation invited the Secretariat to further elaborate the interplay between the extension of the concept of the client-attorney privilege and the transparency of the patent system, whether such an extension would affect the transparency in patent law, as well as the possible results of an eventual harmonization of the existing procedures in the countries on the enforcement of IP. Finally, the Delegation underscored the need to assess the possible implications of such privilege for development. Referring to the statement made by the Delegation of India, it observed that the privilege would allow more information to be kept out of the public domain, and adversely affect the quality of patents and access to information and innovation especially in developing countries.

14. The Delegation of Brazil stated that, with respect to paragraph 138 of document SCP/14/2, there was no evidence to show that a different treatment of confidentiality and privilege applied to foreign patent attorneys in Brazil.

15. The Delegation of Japan aligned itself with the statements made by the Delegations of Belgium on behalf of the European Union and its 27 Member States, Switzerland and the United States of America.

16. The Representative of the EPO supported the statement made by the Delegation of Belgium on behalf of the European Union and its 27 Member States.

17. Referring to his statement on the client-attorney privilege made during the previous session of the SCP, the Representative of the ICC urged the Committee to consider detailed possible solutions to the problem related to the privilege, and WIPO to evaluate the advantages and disadvantages of the different solutions.

18. The Representative of AIPPI stated that, notwithstanding the two preliminary studies prepared by the Secretariat on the issue of client-attorney privilege, there was still a misunderstanding in relation to what privilege was, given that the issue was often considered as a tool for blocking the disclosure, a fundamental part of the patent system. The Representative explained that since the privilege related only to the instructions for and the advice which was given by an attorney to a client, it was not related to the fundamental fact of prior publication, and for that reason, the privilege could not be used as an instrument for concealing frauds (e.g., a fraud on the patent office). The Representative stressed the need for clarifying the issue, since the fears that the privilege could be an obstacle to disclosure were caused by the lack of informed debate. The Representative illustrated the outcome of the work carried out by AIPPI in that area, and stated that among the 48 countries that responded to their questionnaire, 96 per cent provided the client-attorney protection (i.e., from forcible disclosure) and 76 per cent of them considered that kind of protection to be inadequate. In his view, that outcome manifested the existence of a serious problem in the system. The Representative further noted that 78 per cent of the countries interrogated did not recognize the overseas non-lawyer intellectual property advisors, and that 52 per cent of them recognized neither the lawyers of other countries. In his view, the statistics elaborated by AIPPI, which dealt also with the issue of the qualifications of the IP professionals and limitations and exceptions, provided a good basis for further investigation of the issue. In addition to a study addressing the need for the recognition of protection from forcible disclosure in each country, the Representative stressed the need for a study on the inadequacies and anomalies of the current protection in the context of potential remedies. It observed that there would be no point, for example, in harmonizing around a topic which showed to be faulty itself. In relation to limitations, exceptions and waivers, the Representative stressed the need of investigating to what extent they should be part of a general principle. The Representative further stressed the importance of the certainty of protection, because the client and his or her advisor could

not have confidence in the process of advising in an atmosphere without such certainty. Finally, in relation to further studies, the Representative recommended WIPO and Member States to use the work carried out by AIPPI.

19. The Representative of GRUR supported the position stated by the Representatives of AIPPI, FICPI, and ICC. The Representative expressed the belief that the legal status and privilege of lawyers and attorneys-at-law in respect of confidential information should be accorded or extended without discrimination also to patent attorneys and other intellectual property law advisors, and it should be fully recognized by all Contracting Parties through a possible international legally binding instrument without the requirement of reciprocity. The Representative stated that the protection of privilege generally available to lawyers or attorneys was in essence a human right issue. He pointed out that it was closely interrelated with the right of any party to court proceeding to have fair proceedings under the rule of law. The Representative observed that such approach was respected not only under European regional law, but also by the Universal Declaration of Human Rights administered by the United Nations. The Representative noted that, as regards the European law, it had been recently confirmed by the European Court of Justice in respect of competition proceedings, although it had limited the protection to legal advice given by the attorneys in private practice and excluded in-house counsel from the scope of the privilege. In relation to the principle of non-discrimination, which was also a fundamental value under the Declaration of Human Rights, the Representative noted that patent attorneys, having a similar qualification and training as those of lawyers and giving legal advice of the same nature in the specific field of IP law, were excluded from the protection of the privilege for confidential information without justification, which constituted, in his view, discriminatory treatment. Concerning the issue of disclosure and the international legal framework, the Representative stated that it was based on a misunderstanding of the concept of enabling disclosure as contained in the international, regional and national legal instruments. The Representative stated that according to Article 29.1 of the TRIPS Agreement, a patent applicant had the obligation to disclose the invention for which patent protection was sought in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art, and according to Article 29.2 of the TRIPS Agreement, the competent authorities of a Member may require an applicant to provide information concerning the applicant's corresponding foreign applications and grants. The Representative noted that there was no obligation under international law, neither on the applicant nor the patentee nor the opponents in opposition, revocation or infringement proceedings, to lay open to the public or a competent authority or court, each and every element of the information in their possession or in possession of their attorneys or other legal advisors. Nevertheless, the Representative clarified that that did not allow the applicant or his attorney to willfully conceal knowledge about the state of the art available to them, which could be considered as a fraud against the patent office. The Representative further explained that the privilege could be considered an abuse when it was invoked to shield the patent attorneys from giving legal advice to a gang of organized crime, or from schemes to undermine or infringe patents, trademarks and other IP titles. The Representative observed that the above mentioned behavior of the attorney was not only a matter of criminal law or professional personal liability, but also an issue of professional honesty, sanctioned by the rules of professional moral and behavior. The Representative noted that disclosure or discovery was an element of the rules of procedure of the courts in common law countries such as the United Kingdom or the United States of America, in particular in enforcement proceedings, where confidentiality of information came into play, as clearly indicated in the national laws of those countries, as well as in Article 43 of the TRIPS Agreement in relation to the rules of evidence. Otherwise, in his view, there would exist a gross conflict between disclosure and the right to a fair and equitable procedure under the rule of law. The Representative stated that the national law approach to or for the privilege was also not tenable in view of the international character of patent protection as clearly demonstrated by the very existence of WIPO as a specialized agency in the field of intellectual property, and in particular, by the PCT system with its distribution of responsibilities between receiving offices and the international PCT authorities. The Representative further observed that the whole system could only properly function if it was complemented by a network of patent attorneys representing their clients before the various national, regional and international authorities which closely cooperated with each other. In his opinion, the constant flow of information between those attorneys and their clients around the world, including also

clients and attorneys from developing countries, should be protected, to the extent that such flow of information qualified for confidentiality.

20. The Representative of FICPI referred to his general statement and, in particular, to the three Resolutions passed by his Federation.

21. The Representative of AIPLA stressed the importance of the client-attorney privilege issue, and supported the continuation of discussion in the SCP, as well as the preparation of further studies, including studies of possible solutions to the problems.

22. The Representative of TWN stated that the extension of privilege would create a layer of secrecy around patents and compromise transparency in the patent prosecution. The Representative observed that even if there was a reason underpinning the difference between the concept of disclosure and confidentiality, in practice, a particular privileged communication could not be considered as an evidence in front of a Court, which then came into conflict with disclosure. The Representative stated that the issue of professional privilege played out only where there was a judicial or quasi-judicial body asked for the discovery of documents by requesting the advisor or client to submit the relevant documents. The Representative considered that it would eventually affect the quality of patents, and stated that the extension would be a backward step in an effort to improve the quality of patents. The Representative further stated that even if it had substantial law implications, it was not a substantive patent law issue. In his view, the SCP had little to offer to build the confidence of an IP applicant towards a patent attorney, and therefore, the Representative deemed it more appropriate to keep the issue in national legislation. The Representative further observed that since there was no legal recognition of patent attorneys in many developing countries, it would be impossible to grant privilege to foreign attorneys. Therefore, in his view, the discussion at the SCP had no relevance to those developing countries. In addition, the Representative noted that, given that the client-attorney privilege fell in the domain of trade in services, and in view of the ongoing WTO negotiations on domestic regulations, the Representative considered that the SCP was not the right forum to discuss the issue. The Representative observed that there were different opinions among AIPPI members, given that the Philippines, the Czech Republic, Argentina and Poland did not share the dominant view within AIPPI and considered that the issue should be left to each country to implement under their own national law. The Representative considered that the preliminary study needed further improvement in four concrete areas. First, he stated that the study did not provide enough clarity in relation to the concept of the terms of patent advisor and patent attorney. Second, in his view, the study did not examine the adverse implications of the privilege on the quality of examination of the patent office or deduce the freedom to discover relevant documents. Third, he observed that while the study showed that the client-attorney privilege existed in many countries, it did not clarify the legal position with regard to the patent advisor privilege and did not provide the tabular representation on how many countries had extended the client-attorney privilege to patent advisors. Lastly, the Representative noted that the case law cited in the study, with the exception of the case of the United States of America, was not directly linked to the IP or patent law, and therefore, did not provide adequate information with regard to the issue.

23. The Representative of JPAA referred to his statement made during the previous session of the SCP, and supported the statement made by the Representative of AIPPI. He stated that the Committee needed to move forward in the investigation of the issue, in particular, in relation to exploring potential remedies offered by any effective means, led by either the Secretariat, a working group or external experts.

24. The Representative of CIPA and EPI supported the continuation of work on the client-attorney privilege in the SCP. The Representative drew the attention of the Committee to the word "client", which made it clear that the privilege was not an attorney privilege, but a client privilege. He echoed the words of the Representative of AIPLA in relation to the future work of the Committee.

II. 14th session of the SCP, January 25-29, 2010
[Excerpts from the Report (document SCP/14/10)]

25. Discussions were based on documents SCP/13/4 and SCP/14/2.

26. The Delegation of Morocco noted that its country was modifying the current legislation in order to standardize the patent profession in its country, taking into account the professional privilege. It further noted that national and regional patent offices were bound by professional secrecy, and explained that the Moroccan Industrial and Intellectual Property Office was bound by provisions requiring secrecy. The relevant statute prohibited disseminating, using or publishing documents that the Office received through its services. The Delegation clarified that such a treatment gave reassurance to patent applicants while the Office was examining their applications.

27. The Delegation of Argentina was of the view that the client-patent advisor privilege was a matter of private law which belonged to national jurisdiction. As a result, the Delegation considered it appropriate to continue relying on Article 2(3) of the Paris Convention and Article 1.1 of the TRIPS Agreement.

28. The Delegation of Australia stated that the topic of the client-patent advisor privilege had recently received considerable attention in its country, and legislative changes in that area were currently considered. The Delegation, however, believed that international development was necessary to adequately address the issue. For that reason, it supported further discussion about the client-attorney privilege and professional secrecy in the Committee with the view to identifying common objectives and potential solutions.

29. The Delegation of India stated that the client-attorney privilege was regulated neither under the Paris Convention nor in the TRIPS Agreement. Therefore, it considered that each country should be allowed to set its level of privilege and extent of disclosure that suited its social or economic circumstances and its particular level of development. The Delegation was of the opinion that harmonizing the client-attorney privilege implied harmonizing the exceptions to the disclosure. It observed that, since the disclosure was a substantive element of the patent system, harmonization of the client-attorney privilege could have substantive implications and involve elements regarding substantive harmonization. It concluded that such harmonization would also keep more information out of the public domain, adversely affecting the quality of patents and access to information and innovation, especially for developing countries.

30. The Delegation of Spain, speaking on behalf of the European Union and its 27 Member States, stated that, in the framework of industrial property, freedom of communication between professional representatives and their clients was needed to apply for patent rights, prosecute patent applications to grant and when an opinion was requested regarding infringement or annulment of rights. In its view, the freedom of communication required necessarily that confidentiality of the communications was granted to them both with respect to third parties and particularly in the event of judicial proceedings. As a conclusion, the Delegation endorsed the recommendation for the next steps consisting of a detailed study on the treatment of the confidential information revealed to the professional representatives as granted by the different States. It noted that the questions that could be addressed were how confidentiality of communications between professional representatives and their clients in one country was recognized in other jurisdictions and what were possible options for a better recognition of the confidentiality of communications between the representatives and their clients beyond national borders. In addition, the Delegation was of the view that the detailed study to be prepared by the Secretariat should also be focused on the feasibility of international regulations in that field. The Delegation considered that such prerogative was crucial to enable an appropriate communication, without reservation, between the client and his representative, enabling for the best defense of the client's interests.

31. The Delegation of France stressed the importance of the subject of the client-attorney privilege, and recalling the interest of users, renewed its commitment to continue working on that subject. The Delegation associated itself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. In order to move forward, the Delegation requested the Secretariat to further study the treatment of confidential information across borders. In view of the importance of the issue for companies, the Delegation suggested that the Secretariat work on the possibility of setting up international rules in the patent-advisor privilege area.

32. The Delegation of Nigeria stressed the importance of clarifying the practices relating to the client-attorney privilege in different countries and their implications. Noting the differences between common law countries and civil law countries, the Delegation wondered whether the countries that had introduced such privilege with respect to legal professionals had based themselves on their own legal system or judicial system. Due to the territorial nature of patents, the Delegation was of the view that the privilege issue regarding patents was a matter to be addressed at the national level. He was of the opinion that possible actions at the international level were to bring ideas and institute a dialogue so that national activities could be strengthened. In that light, the Delegation supported the idea that the Secretariat engage in further studies that would provide more analysis on the issue.

33. The Delegation of the United Kingdom associated itself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States, and reiterated the importance of the issue for the users of the patent system. The Delegation informed the Committee that, in relation to paragraph 91 of document SCP/14/2, as of January 1, 2010, responsibility for the register of patent attorneys in the United Kingdom had been transferred from the Intellectual Property Office (IPO) to a separate regulating body, known as IPReg.

34. The Delegation of the Islamic Republic of Iran noted that, although there was an overall common practice on the issue of confidentiality of communication between a client and an attorney in both common law and civil law countries, the concept in civil law countries stemmed from professional secrecy obligation and there was no privilege in the common law sense in a number of countries. Therefore, the Delegation felt that the use of the term "privilege" in the preliminary study was problematic, and wondered why a word which was used for the exceptional situation in common law was selected for describing the concept in all countries. The Delegation suggested that the Secretariat elaborate further on the interplay between the extension of the concept and the transparency of the patent system, in particular, whether it would affect the transparency in patent law, and what would be the possible result of harmonizing the existing procedures on the enforcement of IP as well as the legal procedures of Member States. In addition, the Delegation requested the Secretariat to add existing case law regarding the acceptance and denial of that concept in different Member States, which would provide an invaluable means for understanding the real and ongoing status of such concept.

35. The Delegation of Pakistan considered that privilege in respect of communications between a lawyer and a client was not based on the legal nature of a lawyer's work as such, but on the relationship between the lawyer and the code. It explained that the privilege was extended to lawyers in some jurisdictions because they had a strict duty to the code enforced by strong professional codes of conduct. Abusing such privilege had serious consequences for the lawyers, and therefore, in its view, extending such a privilege to other actors, such as patent attorneys and patent agents, who were not lawyers and did not have such duty to the code was more likely to be abused. The Delegation noted that, in many countries, lawyers could no longer be at the bar once when they joined a firm as in-house legal advisers, hence they lost the privilege. The Delegation further stated that the preliminary study did not sufficiently analyze what could be the possible adverse implications of having uniform legal standards on client-attorney privilege. It considered that there were already problems with the current level of privilege despite strong professional codes of conduct in industrialized countries. As the client-attorney privilege was an exception to the general duty to disclose, the Delegation observed that broadening the scope of privilege might conceal information crucial to the discovery of truth, which could have adverse implications with regard to ensuring patent quality in the

examination process, particularly for developing countries where patent offices were burdened with a gigantic backlog of patent applications. The Delegation reiterated that the client-attorney privilege should be treated as an exception to the law of disclosure, and hence harmonizing the standards on client-attorney privilege would have substantive implications as it harmonized the law of exceptions to disclosure. The Delegation, therefore, was of the opinion that countries should be left free to set their own level of privilege and the issue, which was a private law matter, should be left to be dealt with under the national legislation in accordance with Article 2(3) of the Paris Convention. Moreover, the Delegation expressed the wish to focus on the balance between public and private rights, as well as on the implication of the client-attorney privilege on public interest, including its impact on patent quality, competition and other aspects of development.

36. The Delegation of Switzerland informed the Committee that the Swiss law provided for strong protection of confidential information because of the high value attributed to the constitutional right of privacy. Nevertheless, the professional secrecy guaranteed in the Swiss Criminal Code referred to clergymen, attorneys, defense counsels, notaries, and medical professionals only. Owing to the fact that there was no recognition of a separate patent attorney profession in Switzerland at the moment, patent attorneys were not bound by such obligation yet. The Delegation, however, noted that the situation would change in a few months. In March 2009, the Swiss Parliament adopted the Swiss Patent Attorney Act, which would come into force in January 2011. Under the new Act, only persons with proven expertise would be allowed to carry the professional title of patent attorney in Switzerland. It would enable inventors and patent holders to choose a professional and competent advisor in patent-related matters. The Delegation further noted that the new Act also aimed at meeting the non-disclosure concerns of the person being advised by imposing an obligation of secrecy on the patent attorney. The person advised must be able to rely on the non-disclosure of his or her confidential information in all patent related matters in order to communicate freely with his/her patent attorney. According to the Delegation, the newly imposed secrecy obligation for patent attorneys would be guaranteed in two ways: first, the secrecy obligation for patent attorneys in Switzerland would be imposed in the new Swiss Patent Attorney Act and violations would be prosecuted by criminal law. In addition, the professional secrecy guaranteed in the Swiss Criminal Code would be extended explicitly to patent attorneys. The secrecy obligation would apply to any information that a patent attorney had become aware of while exercising his or her professional duties. The obligation would continue even after the patent attorney and his or her client had terminated their contractual relationship. Second, as a procedural counterpart, patent attorneys would enjoy the right to refuse to provide evidence that was subject to professional secrecy in both criminal and civil cases. As for exceptions, the Delegation explained that clients would be able to waive the privilege and the waiver would bind patent attorneys. The Delegation considered that, although such regulations could not guarantee an equal privilege being conferred to Swiss patent attorneys in foreign jurisdictions, it would still improve the situation for patent attorneys in Switzerland by adapting the professional secrecy obligation, as was already the case in most European countries. The Delegation stated that the above complementary information to document SCP/14/2 regarding the forthcoming changes in its national legislation could explain the importance of the topic to the Delegation. Concerning future work, the Delegation supported continuing the work in potential areas mentioned in document SCP/14/2 for further consideration by the SCP. In its view, additional information on the question of how confidentiality of communication between a patent advisor and his client in one country was recognized in different jurisdictions would be of strong interest for all SCP Member States. The Delegation therefore suggested that the Secretariat prepare a questionnaire for Member States in order to collect information on that important subject for the following session of the Committee.

37. The Delegation of Japan was of the view that the issue should be examined from a technical and legal standpoint. Noting that the treatment of client-patent advisor privilege varied considerably from country to country, the Delegation considered it useful to conduct further studies and clarify those issues that needed further in-depth examination. The Delegation noted that comments with regard to the description of its domestic legislation in document SCP/14/2 would be submitted to the Secretariat in writing.

38. The Delegation of China stated that, while it fully understood that many international non-governmental organizations in the patent area had a special interest in the client-attorney privilege, because it was important in ensuring the quality of the law and in safeguarding public interest, the privilege was not unique to the patent area. The Delegation considered that the problems might not be solved by amending patent laws, as they actually touched upon the essential litigation system and even the legal culture of different countries. Since there was no disclosure system or corresponding privilege system under the legal system in some countries, the Delegation was of the opinion that it was not the right time to formulate internationally uniform standards, and that the discussion of the issue should take full account of the intrinsic differences between legal cultures or systems. The Delegation observed that extensive surveys and studies, without rushing to draw any conclusion, would be beneficial for the Committee.

39. The Delegation of Guatemala expressed its reservation as far as the convenience of discussing the issue at the international level was concerned. Nevertheless, the Delegation believed that a constructive way to move forward would be to find out more about national legislations and practices. To that end, delegations would have to submit more information to the Committee and complement the work of the Secretariat. The Delegation informed the Committee that the professional secrecy in Guatemala was protected both legally and ethically. From the ethical perspective, the Delegation explained that the professionals in Guatemala had to meet a certain level of moral duties. For example, the Bar Association was submitted to rules requiring loyalty. A lawyer must remain faithful to the justice of his client, which included the rigorous observance of professional secrecy. The Delegation further explained that Article 5 of such rules stated that maintaining professional secrecy was a duty and a right of lawyers, which extended beyond the time when the lawyer had stopped providing services before the judges. Furthermore, Guatemala criminalized the violation of professional secrecy. According to Article 23, anyone who revealed a secret that they had learned as a result of their professional function, and that revelation consequently caused damage, would be sanctioned under the criminal law. The Delegation expressed its preference for a general provision relating to certain professional function which could be extended to patent advisors. At the same time, the Delegation expressed its willingness to know more about the practices and experiences of other countries.

40. The Delegation of the Bolivarian Republic of Venezuela stated that the professional secrecy obligation had a serious ethical component in its country in a more general sense. It noted that the privacy between a lawyer and his client was recognized in the law and the lawyer's code of ethics. The Delegation considered that that obligation did not exist for economic reasons, but for protecting the interests of the client. The Delegation further noted that similar professional secrecy applied to journalists who had to protect the source of their information, as well as religious leaders, such as catholic priests. The Delegation stated that professional secrecy was further extended to certain professional positions related to the ethical and personal behavior of people and not the economic subject, as in the case of patents. Therefore, the Delegation supported the view that the issue should remain a subject to be dealt with under national laws.

41. The Delegation of Germany associated itself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. The Delegation supported those delegations who had requested further study on the issue, especially with respect to the recognition of professional secrecy and privilege in foreign jurisdictions.

42. The Representative of the EPO associated herself with the statement made by the Delegation of Spain on behalf of the European Union and its 27 Member States. The Representative noted that, as mentioned on page 19 of document SCP/14/2, the EPC 2000 contained a mechanism in Rule 153 aiming to safeguard the obligation of confidentiality and the privilege from disclosure of communications between professional representatives and their clients.

43. The Delegation of Argentina reiterated that the client-patent advisor privilege or professional secrecy was a private law matter which was to be left to national legislation. Therefore, the Delegation

did not understand the inclusion of the issue in the discussion in the SCP, particularly given the competencies of WIPO. The Delegation stated that it would not therefore support any future work on the subject.

44. The Representative of AIPPI stated that, in relation to the argument that the issue of client-attorney privilege should not be debated in the SCP because it was a private law matter, national laws were inadequate to solve international problems. AIPPI was very interested in solving the international problems with minimal intervention in national laws, and it considered that national laws needed to be protected and individual countries should look after their own interest. The Representative noted, however, that national laws did not contribute to solving the international problem of the loss of their own nationals' advice privilege in another territory. The Representative stated that AIPPI was starting the process of studying those and related matters in parallel with the SCP, and would share its findings and recommendations at the following session of the SCP.

45. The Representative of FICPI was of the opinion that the client-attorney privilege was a very important aspect in the cooperation between a counsel and a client. In his view, the client should be free to discuss IP related matters with his IP advisor without running the risk that such communication would later become public against the client's will. The Representative considered that that should be true for both legal counsels and other IP advisors. FICPI was of the opinion that a secrecy obligation for IP advisors was insufficient, since that did not protect the client against disclosure in litigation. Furthermore, he observed that parties in litigation should have the same rights irrespective of the country they resided in, the country in which they litigated and the IP advisors they had consulted, which was not necessarily the case at present. According to a recent survey conducted by FICPI, only a limited number of countries accepted a client-attorney privilege between the client and a non-lawyer IP advisor. The Representative considered that, since privilege for clients of IP advisors would enable clients to seek advice on, for example, technical aspects of circumventing or invalidating IP rights without running the risk of the advice becoming public, it was not only relevant for IP right holders, but also for third parties. As patents were generally not easy to understand, clients should be able to freely seek advice about, for example, the scope of protection provided by those patents in their country or other countries and the possibility of protecting their own inventions. The Representative observed that understanding the scope of patents would promote technical progress and transfer of technology, and IP advisors, especially patent and trademark attorneys, were trained to give such technical and legal advice. In addition, the Representative stated that client-attorney privilege for IP advisors might further reduce costs for clients in seeking technical advice, because a lawyer would no longer needed to be involved. In his view, that was important especially for developing countries and small- and medium-sized enterprises. In summary, FICPI was of the opinion that the client-attorney privilege for communications between clients and their IP advisors was essential in international practice involving IP rights. He considered that it would facilitate the understanding of inventions disclosed in patents and of transfer of technology, and increase cost effectiveness of IP advice essential to a proper working of the IP system, both for right holders and for third parties.

46. The Representative of APAA stated that it had adopted Resolutions in 2008 and in 2009, expressing an international consensus on setting minimum international standards for a client privilege against the forcible disclosure of confidential communications between clients and intellectual property professionals. He explained that the Resolutions were adopted in consideration of the fact that, due to the international character of intellectual property, a client needed to have a full and frank communication not only with domestic IP professionals, but also with IP professionals in other countries. However, confidential communications between clients and IP professionals which were protected in their own country were sometimes forced to be disclosed in another country during litigation. In his view, an increasing number of international litigations had exposed the clients to a higher risk of forcible disclosure, thereby undermining the clients' ability to obtain professional legal advice on intellectual property related matters. The Representative further stated that, for example, in one discovery motion before a United States judicial court, the US judge had reviewed the communication between the plaintiff and the foreign patent professionals in relation to the filing and prosecution of a patent in 47 patent offices around the world. The US judge found that

communications relating to some of the jurisdictions were privileged, but the others were not. The document would have been protected against such a forcible disclosure if the IP professionals involved in the communications were United States lawyers. The Representative was of the view that, as noted in paragraph 256 of document SCP/14/2, the client-attorney privilege in common law countries and the professional secrecy obligation in civil law countries aimed at a very similar practical result, i.e., non-disclosure of confidential information exchanged between a client and an attorney. Nevertheless in reality, the Representative observed that the privilege in one country was not properly respected by courts in other countries. The Representative believed that the SCP was the right forum to address such a rapidly growing and complicated international concern involving intellectual property, in particular, patents. The Representative noted that the two WIPO documents, namely SCP/13/4 and SCP/14/2, were excellent summaries of the current status in the area and of the related international concerns. In view of the increasing international concerns, he suggested that the issue be studied within a WIPO working group dedicated to client-attorney privilege issues concerning confidential communications between clients and IP professionals. The Representative further stated that the working group should assess current and future problems under the various legal systems, and study the feasibility of setting minimum international standards for the mutual recognition of the client privilege in an accelerated manner.

47. The Representative of CEIPI recognized the importance of the problem of secrecy of communications among clients and patent advisors. He noted that the problem, due to the international nature of the issue, was part of the competences of WIPO. The Representative considered that the discussion taking place in the Committee well demonstrated the need to delve into certain aspects of the problem. For example, it would be useful that the Secretariat clarified the scope of Article 2(3) of the Paris Convention and the TRIPS Agreement, which referred to that provision. In his view, that provision did not prevent the Paris Union to agree on issues which were reserved for national law, and created neither obligation nor obstacles in that respect. The Representative further noted that the disclosure of communications between the client and his advisor and the disclosure of an invention in a patent application were two different issues, and all they had in common was the word "disclosure". In conclusion, the Representative supported the follow-up of the studies by the Secretariat.

48. The Representative of ICC noted that, in most countries, communications between clients and their legal advisors were withheld from the other party when the clients were in litigation locally. In his view, this was good for trade because it encouraged clients to seek full legal advice, which, in general, meant that they were more likely to act lawfully and to avoid litigation. On the international scale, however, the Representative was of the view that such situation did not exist, specifically in the area of intellectual property. He explained that, at present, judges in common law countries were required to apply complex and expensive rules on whether communications with foreign advisers were privileged. Repeatedly, they had ordered disclosure of communications with foreign advisers which would not have been disclosed in the local courts of those advisers, for example, of advisers in Australia, France, Japan, the Netherlands, Pakistan, South Africa and the United Kingdom. The Representative observed that, even between two common law countries, there was remarkably little mutual respect. He said that the above problem had occurred in intellectual property litigation, because, for instance, patent owners might have taken advice on patentability in many countries, and trade mark owners and those launching new products and brands might have taken advice on infringement risks in many countries. The Representative therefore believed that an international framework for mutual respect of communications with legal advisers on intellectual property matters was needed. He believed that achievement of such mutual respect was supportive of businesses engaging in international trade, regardless of the state of development of their home country, and was also consistent with the mission of WIPO. The Representative suggested a workable framework as described in paragraphs 22 and 23 of its position paper dated October 9, 2008. Moreover, after careful consideration, as articulated in its position paper dated August 27, 2009, the ICC had concluded that its proposed framework would work notwithstanding potential difficulties raised by the delegations at the SCP in March 2009. In addition, the ICC believed that its proposal did not need further research or study of existing national laws on privilege or professional secrecy. The Representative urged the Committee

to start considering possible solutions to the privilege problem, along the lines of its proposal. He also urged WIPO to evaluate the advantages and disadvantages of possible solutions, and to do only such further research or study as was necessary for such evaluation.

49. The Representative of IPIC stated that the issue of client privilege for IP advisors was an issue of great interest and importance to IPIC. The Representative considered that mutual recognition would be of great benefit to users of the IP system in Canada, particularly as its courts had failed to recognize privilege for non-lawyer agents, be they Canadian or foreign agents. Since there had also been a Canadian court decision which did not recognize the common law privilege of lawyers when acting as patent agents, she was of the view that mutual recognition might lead the Canadian Government to take steps to provide for privilege for agents regardless of their legal qualification so that their Canadian clients would benefit from mutual recognition when obtaining and enforcing rights outside of Canada. The Representative urged WIPO to begin devising suitable solutions for the problem, such as those that had been proposed by the ICC, and conduct the required research and study for their evaluation.

50. The Representative of JPAA noted that his organization had submitted its position paper recognizing the necessity of establishing solutions to the issue of client-patent attorney privilege at the international level. In his view, due to the lack of international or mutual recognition of privilege for a client, be it an IP owner or a third party, in each and every country, the client still faced a risk of losing confidentiality in communications with IP advisors. The Representative observed that that would be significantly detrimental to the interests of clients, the quality of IP rights and any associated cost. Acknowledging the fruitful work that had been conducted in the SCP, the Representative considered it necessary to move to the next stage for further elaboration of possible remedies and solutions from a practical standpoint. For that purpose, he encouraged the SCP to continue studying and discussing the issue as suggested in Section 5 of document SCP/14/2, especially in paragraph 263. In parallel, the Representative strongly encouraged the establishment of a working group for investigating and analyzing the experiences of various countries, thereby seeking the best solution that would be beneficial to the stakeholders of all Member States. The Representative expressed his organization's willingness to assist the SCP and the Secretariat in any possible way, based on its experience as a body of legal professionals.

51. The Representative of GRUR stated that GRUR was always ready to defend and improve the international recognition of the legal status of the patent attorneys' profession. He further informed the Committee that, in Germany, the status of patent attorneys were in many respects identical with that of lawyers, with a few exceptions as contained in document SCP/14/2. German patent attorneys could represent their clients directly before the German Patent and Trademark Office, the German Patents Court and, in nullity proceedings, even before the Federal Supreme Court. In proceedings before the ordinary courts, for example in infringement litigation, they might appear before courts of ordinary jurisdiction together with an attorney-at-law only, but they had an important role in the preparation and control of such litigation, not to speak about the preparation and prosecution of patent applications. Referring to paragraph 148 of document SCP/14/2, the Representative questioned the clarity of the text. In particular, the Representative clarified that the professional training period of approximately three years comprised also eight months of training at the German Patent and Trademark Office and the German Federal Patents Court. The Representative stressed the high quality standards of the final qualifying examination that the candidates had to pass. The Representative observed that the confidentiality from professional communications and the professional advice given by attorneys protected under Article 6 of the European Human Rights Convention were an essential element of fair proceedings, due process of law and the right of the defense. The Representative expressed the view that that protection should also be applicable to patent attorneys having qualifications similar to those of lawyers and other professional advisors. The Representative considered that the view referred to in paragraph 244 of the document was irreconcilable with that approach. From that point of view, the Representative stated that there was a justified interest for the profession to enjoy in the United States of America, or in other common law countries, the same privilege for their confidential communication as was accorded to lawyers of the general legal profession. While noting that no acute problems had

been reported affecting German patent attorneys by that time, the Representative raised the question of how judges in common law countries would decide in the future. The more transnational litigation was expected in globalized markets, the more acute the question would become for patent attorneys and agents in foreign countries who had close commercial relations with the United States of America or other common law countries that applied the legal privilege approach in pre-trial discovery proceedings. Therefore, the Representative supported the efforts by AIPPI and the ICC to resolve problems caused by the legal uncertainties which were created by the case law of, for instance, the US courts. The Representative suggested that the work forward should be guided by making a distinction between the professional secrecy obligation and the evidentiary privilege for legal advisors. Referring to a matter of international comity, where the court looked at the national law of the home country of the foreign patent attorney concerned, the Representative stated that the result was sometimes a matter of good luck. In that regard, the Representative referred to paragraph 233 of document SCP/14/2 which made a reference to Article 43 of the TRIPS Agreement, and agreed with the statement of the Secretariat that that reference might be relevant to the issue of the client-attorney privilege. While observing that the language of the provision was very vague, and therefore, the Members of WTO might have a wide discretion to set the conditions of such protection, the Representative noted that further analysis of the potential of the provision would be worthwhile and interesting. Against that background, the Representative believed that the legal certainty for patent owners and their patent attorneys could only be achieved through some sort of a legally binding international instrument obliging the Contracting Parties to protect the confidentiality of written or oral communications between patent or trademark attorneys and their clients made in the context of, or dealing with, actual or future proceedings in the field of intellectual property rights before national or regional courts and authorities, in particular in trans-border actions. In conclusion, the Representative urged the Committee to maintain the issue on the agenda.

52. The Delegation of Indonesia reiterated that the issue of the client-attorney privilege needed sufficient analysis particularly on the possible adverse implications of having uniform legal standards internationally. While noting that under the legal system of Indonesia, the term "privilege" was not recognized, the Delegation stated that that was one of the predicted adverse impacts in further going with the subject matter. The Delegation noticed from the study that there were no uniform laws on the application of privilege to communications between IP advisors and their clients even within the same legal system. The Delegation was pleased that the study acknowledged that absolute privilege for client-attorney communications might be detrimental to the public interest of ensuring that all relevant information was made available to the responsible authorities for investigating truth for the sake of justice. The Delegation stated that more information and clarification on the subject matter was needed, in particular concerning the adverse implications of having such uniform legal standards.

53. The Representative of EPI and CIPA stated that both organizations were strongly supportive of a worldwide unified client-IP advisor privilege, which should include advice given by patent attorneys qualified to act before regional offices, such as European patent attorneys entitled to represent before the European Patent Office, and suitably qualified in-house patent advisors. The Representative urged the Committee to continue working on the subject matter and to allow the Secretariat to progress matters as was suggested in the last chapter of document SCP/14/2.

54. The Representative of AIPPI clarified two points which came up in the discussion. In relation to the first point, the Representative stated that "privilege" meant to be protection against forcible disclosure. Referring to concerns raised by some delegations that the protection might be used to disguise information and thus be detrimental to public information, the Representative noted that one should be aware of the fact that privilege, in the sense of protection against forcible disclosure, had been globally accepted for lawyers a long time ago. The Representative observed that there had been no dispute over the problem of disguising information which might arise in the context of privilege for lawyers. He noted that there was a sufficient regulatory framework around that protection, which guaranteed that the privilege was balanced with all the public interest that was raised in that context. In relation to IP advisors, the Representative stated that legal advice was no longer a pure domain for lawyers. The complexity of technical and legal advice in connection with IP and, in particular, with

patents, made it necessary to spread the work from lawyers to other IP advisors, and it had been globally accepted that IP advisors also gave legal advice in the context of their work. The legal advice was necessarily intertwined with technical advice. In this situation, the question arose whether the application of protection against forcible disclosure to non-lawyer patent advisors was an expansion of the privilege. The Representative was of the view that the answer to that question was negative for countries which already had protection for lawyers, because the patent attorneys were offering in effect the same legal advice which formerly came from lawyers only. The Representative stated that in modern economies, the profession of patent attorneys had been developed to provide the best legal and technical advice to clients, which had been formerly given by lawyers in cooperation with technical experts. The Representative stated that thus one could not speak of an expansion of privilege, since it was simply the application of the same matter done by other people. The Representative believed that the studies being discussed were not aiming at creating new, but accepting the same matter which had been accepted for lawyers and was undisputed for other advisors who were allowed to give legal advice. The second point was in relation to the Paris Convention and to the TRIPS Agreement, in particular on the issue whether those Agreements would support the view that the issue of privilege and protection belonged to national law only. In that regard, while noting that the TRIPS Agreement as well as the Paris Convention did not affect national laws relating to judicial and administrative procedures and jurisdiction, the Representative, however, observed that the issue at stake was not raising or questioning the right of national jurisdictions or national legislations to make their laws nationally. What it did raise, according to his view, was the question of how the effect of national laws regarding the existing protection against forcible disclosure could be maintained internationally. That was a purely international dimension, which national solutions could not sufficiently cover. The Representative therefore believed that the SCP was the right forum for dealing with the matter. He further stated that the problem of loss of the existing protection could not be resolved purely by national law and that the need for the discussion about the issue had become evident in the studies prepared by the Secretariat. He further informed the Committee that AIPPI was conducting studies by looking at various aspects of the issue, such as remedies, limitations, exceptions and effects that the privilege on IP advisors might have on the entire system.

55. The Representative of TWN stated that one of the fundamental principles of patent law was the disclosure of information on technology, and non-disclosure or partial disclosure was a ground for refusing to grant, or revocation of, a patent. In his view, the extension of client-attorney privilege to patent advisors went against that fundamental principle of disclosure. Patent specifications were public documents and therefore any related records which were used in the preparation of the patent specification should also be made available to public scrutiny in order to find or verify the truth about the claims made in the specification. The Representative underlined that considering the public policy concerns associated with patent law, it was important to maintain absolute transparency around the granting of patents and litigation around patents. Society could not afford any kind of opaque layer around the patent specifications. He further stated that extension of privilege to patent advisors would compromise the transparency requirement in the administration of patents which included both patent prosecution procedures as well as litigation of patents. The Representative was of the view that there was enough documentation regarding the misuse of attorney-client privilege by corporate clients. As one of the most distinct examples of such misuse, the Representative mentioned the case of tobacco companies where they had commissioned studies to attorneys on disputes against the tobacco industry. Another cited example of such misuse was the Novelpharma case where the inventors gave their Swedish patent agent a draft patent specification which included a citation to a book written by the inventors describing the use of the invention more than two years earlier. That book was eventually held to anticipate the patent, although the patent agent had deleted all references to the 1977 book from the patent application, which was ultimately filed in Sweden and the USA. The Representative further continued that the court had found that the evidence of actual deletion by the patent agent had given the jury reasonable ground to find intent to fraud by the patentee. The Representative noted that if that communication with the patent agent had been privileged, the patent office and court would never have known about it. In his opinion, the example clearly showed that extension of privilege would legitimize withholding of information to obtain patents, including facilitation of evergreening of patents. Extension of the attorney privilege to cover patent advisors would

incapacitate patent offices and courts in developing countries from safeguarding public interest following the grant of patents. The Representative expressed his deep concern about the extension of privilege to patent advisors due to the unintended consequences of such extension and its effect on patent applications, on the TRIPS flexibilities, on patent opposition systems, and on the transparency of patent procedures.

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[Excerpts from the Report (document SCP/13/8)]

56. The Secretariat introduced document SCP/13/4.

57. The Delegation of El Salvador referred to the Germanic Romanic law, which its country applied, and the Anglo-Saxon law under which the client-attorney privilege conflicts could usually occur. The Delegation observed that, in its country, lawyers had the obligation to observe professional secrecy and violation of such obligation was subject to the criminal code. The Delegation was of the view that the Romanic law tradition could have been more reflected in the document. The Delegation explained that its national office offered a free assistance services for users, to which, in its view, the professional secrecy was not necessarily applicable, and requested that such cases be reflected in the document. The Delegation further suggested that the inclusion of best practices of national offices in Latin America would enrich the document with added-value.

58. The Delegation of China shared the concerns of many international attorney associations on the issue of attorney privilege in the area of patents: given that different countries in the area of attorney privilege had different systems and practices, patent attorneys' work could meet with difficulties. The Delegation was of the view that it was necessary to discuss the issue in the SCP in order for patent attorneys to provide better services to their clients. The Delegation observed that, since the attorney privilege issue was a general legal issue not limited to the area of patents, it was difficult for a country to establish a provision of the client-attorney privilege in the patent area only. On the contrary, an overall consideration was needed. The Delegation noted that, for example, in China, the civil procedure law and the criminal law stipulated that anyone in possession of knowledge related to a case had the obligation to provide witness. A few years ago, its country revised the law of attorneys to the effect that attorneys should keep the information obtained during the professional practice secret if his or her client did not wish to disclose the information. The exceptions provided were any criminal facts or information that concerned the national security, public security or any information that threatened people's life and the safety on property. The Delegation therefore concluded that China had a professional secrecy obligation provision, but not a special attorney privilege system. Given the above, the Delegation considered that a focus should be given to different national legal systems, and further investigation, analysis and studies should be made. The Delegation took a cautious view toward the minimum standards, and considered that forming bilateral or multilateral arrangements was more practical. The Delegation further noted that, in the area of patents, various professionals, such as patent attorneys, patent agents or patent advisors, were involved in the services. Consequently, the Delegation observed that the questions as to whether the client-attorney privilege should cover those different professionals needed to be also considered.

59. The Delegation of Germany, speaking on behalf of Group B, stated that the preliminary study was important to both civil and common law countries of which the Group consisted. The Delegation agreed that the lack of uniform legal framework caused clients to risk losing confidentiality in advice they had obtained from IP advisors. On the other hand, in its view, the study showed how closely the aspect of confidentiality was linked with the scope of a party's duty to disclose information in legal proceedings. Further, the Delegation was of the view that the recognition of the client-attorney privilege in a foreign legal system had to be taken into account to safeguard comprehensive international protection of confidentiality. In the opinion of the Delegation, although an IP law might not be the only context in which such problems could arise, a global nature of trade and IPR made it the focal point. Group B therefore considered that the issue remained high on the agenda of the

Committee. The Delegation supported further investigation of the issue, and believed that harmonization in that context would help creating a level playing field in international legal IP advise for the benefit of all stakeholders.

60. The Delegation of the Czech Republic, speaking on behalf of the European Community and its 27 Member States, stated that since the client-attorney relationship was not regulated in any international IP treaty, national laws and practices relating to the application of the privilege lacked uniformity. In the context of the European Union, the issue was left to its Member States to regulate it under the laws regulating this profession. Rule 153(1) of the Implementing Regulations under the revised EPC also provided for privileged communications between the professional representatives and their clients, effective from April 1, 2009. The European Community and its 27 Member States considered such privilege as a basis for the guarantee of free and confidential communications between clients and their representatives. The Delegation welcomed further investigation of all the options for addressing the issue, in particular, the feasibility of setting up minimum standards.

61. The Delegation of the Russian Federation stated that a Federal law of December 30, 2008, governing the activities of the patent attorneys, their registration, attestation and obligations and rights of those attorneys would enter into force on April 1, 2009. He explained that, according to that law, a patent attorney was authorized to implement his professional activity independently, but also based on the agreement between the patent attorney and its employer (legal entity). The employer of the patent attorney who had concluded a commercial contract with a client, for instance, with an applicant or a patent holder, had to ensure the security of the documents received from a guarantor or contractor and to ensure that the information would not be disclosed. The Delegation further noted that the Federal law also established that an independent attorney had to ensure the security of the documents made and received in the course of performance of his professional activity. He was not authorized to disclose or to submit information without any agreement with the person whom he was representing. The violation of those provisions was serious. A party whose rights and the legal interest had been infringed was authorized to file a complaint with the Patent Agency of the Russian Federation, which could adopt one of the following decisions: warning the patent attorney, or the Agency could go to court to bring an action against the patent attorney with remedies such as stopping the activities of the attorney for a period of one year or an exclusion from the list of attorneys for a period of three years. If a patent attorney had caused damages to the person he was representing, the patent attorney was liable under the legislation of the Russian Federation. In other words, the employer of the patent attorney as well as the independent patent attorneys were under an obligation not to disclose or transfer to third parties the confidential information he had received in the course of his work in order to provide services based on commercial contract. The Delegation further explained that the Russian legislation provided a restricted privilege, since confidential information could be submitted to third parties by the decision of a court or if it was established by the Federal law. The Federal law on the trade secrets stated that the holder of information, which was a trade secret, had to submit that information when it was requested by the government authorities. In its turn, the government authorities who received the confidential information were obliged to submit that information upon Court's request, or request of the law enforcement bodies, according to the rules as provided by the legislation of the Russian Federation. In that case, it would be the government who guaranteed the confidentiality of such information. In conclusion, the Delegation stated that taking into account the differences existed in legislation of various countries on the subject, the Russian Federation supported further studies on exploring a minimum standard of privilege applicable to communications with patent attorneys.

62. The Delegation of Sri Lanka, speaking on behalf of the Asian Group, stated that the members of its Group were of different levels of development and followed different judicial and legal practices regarding patent attorneys and patent attorney privileges. The Delegation stated that the following issues should be further analyzed in order to provide Member States sufficient information from different stakeholders' perspectives: (i) the impact of patent quality and costs; (ii) cost and benefit analysis for developing countries' judicial and administrative systems; (iii) impact on competition; and (iv) other impacts on development and public policy objectives.

63. The Delegation of the Republic of Serbia, speaking on behalf of the Regional Group of Central European and Baltic States, expressed its support to the establishment of a working group to study the client-attorney privilege or protection from foreseeable disclosure of IP professionals' advice.
64. The Delegation of Argentina considered that the prerogative of professional secrecy in client-lawyer relations was a question of private law, for which national jurisdictions were responsible. Accordingly, the Delegation confirmed that it would be advisable to maintain the provisions of Article 2.3 of the Paris Convention and Article 1.1 of the TRIPS Agreement.
65. The Delegation of Morocco stated that, in principle, the national and regional patent offices were bound by the professional secrecy as regard the procedures relating to the patent system. It explained that, its Office was a public establishment whose staff had a status that was covered by professional secrecy. It prohibited the publication, disclosure or use of documents coming from the WIPO services. Consequently, everybody could be assured that the submitted information would not be disclosed.
66. The Delegation of the Republic of Korea observed that further discussions on the issue of the client-attorney privilege was beneficial for developing countries as well for developed countries, since in many developing countries, inventors were sometimes reluctant to file their patents in concerns of loosing the information and confidentiality in the process of filing patents. The Delegation considered that IP practitioners had to participate actively in discussing and developing any future harmonization on the issue of client-attorney privilege, since, in many countries, the client-attorney privilege was regulated by the association of those IP lawyers rather than the laws of the government. The Delegation further expressed its wish to share more information and experiences of various countries regarding the client-attorney privilege and to establish a working group that would including IP practitioners.
67. The Delegation of Brazil noted that there existed a variety of approaches regarding the concept of the privilege and the professional secrecy. The Delegation observed that the issue was new for the members of the Committee, was complex and involved a new area of concepts to be yet discussed and understood by the SCP. It believed that two important concepts were transparency in the relation of attorney and his client and accountability of IP advisors and other professionals of the area. In its view, the complexity of the subject derived mainly from differences between the civil law system and the common law system, and requested further reflection on the reality of civil law countries. The Delegation stated that, when considering the client-attorney privilege issue, the SCP should bare in mind the fact that the IP system lay on different legal tradition and, as stated in Article 1 of the TRIPS Agreement, Member States were free to implement IP provisions in a manner consistent with their own legal system and practice.
68. The Delegation of Australia associated itself with the positions stated by the Delegation of Germany on behalf of Group B. It appreciated the WIPO-AIPPI Conference on Client Privilege in Intellectual Property Advice, which was held in May 2008, and the availability of the materials relating to the Conference on the WIPO web site. The Delegation stated that while its government was considering legislative changes, international developments would be beneficial to address the issues and would benefit all WIPO Member States. The Delegation also expressed the need for wide analysis of national laws.
69. The Delegation of France associated itself with the statement made by the Delegation of the Czech Republic on behalf of the European Community and its 27 Member States, and explained that, as a civil law country, its procedure was based on the submission of proof and had no discovery procedure. Therefore, there was no client privilege regulations in France, but the professional secrecy existed in accordance with the Law of 1971. The Delegation, however, informed the Committee that its national legislation had a similar system concerning legal advisors as of 2004. The Delegation observed that an increased risk of disclosing information exchanged by IP professionals and their

clients due to an order by a foreign court was considerable. Therefore, it suggested that different options described in the document be given in-depth consideration in order to determine the best solution for the complex problem.

70. The Delegation of Norway associated itself with the statement made by the Delegation of Germany on behalf of Group B. It stated that a consultation process was underway in its country to introduce a client attorney privilege for the Norwegian and the European patent attorneys. The Delegation explained that, by following such strategy, it avoided a burdensome and costly national authorization scheme and took care of the necessary delimitation of the group of professionals who would be covered by the exemption. According to the proposal, provisions on confidentiality and legal proceedings for lawyers, priests, doctors and health care personnel in the Civil Procedure Act would be expanded to encompass the Norwegian and the European patent attorneys.

71. The Delegation of Ukraine supported the statement made by the Delegation of the Czech Republic on behalf of the European Community and its 27 Member States, and appreciated the information provided by the Delegation of the Russian Federation regarding the development of its national legislation. The Delegation stated that, in its country, the privilege applied only to attorneys who were also barristers at the same time. The Delegation requested that the issue remain on the agenda and supported the development of minimum standards.

72. The Delegation of Chile considered the very issue of the client-attorney privilege important, since it was meant to provide better professional advice in intellectual property. In its country, professional secrecy was recognized and had a great tradition in the law profession. The Delegation observed that, in Chile, many of the professionals who were involved in registration of and giving advice on intellectual property were lawyers, and as a result, the professional secrecy covered those intellectual property advice providers. The Delegation noted that since the issue was about the jurisdiction of the State, the authorities such as the Ministry of Justice should be listened to so as to maintain coherent systems. The Delegation considered that the issue involved international aspects even though each country had a different tradition, and therefore, required more analysis. It stressed the importance of holding wide discussions on the subject in the SCP, taking into account all the comments of the members.

73. The Delegation of the United States of America supported the statement made by the Delegation of Germany on behalf of Group B. The Delegation believed that further study of the issue was warranted, and that WIPO could play a useful role in enhancing understanding of the issue. At a minimum, the Delegation stated that WIPO could develop a comparative study, perhaps based on a survey methodology of what the actual situation was in various countries with regard to the client-attorney privilege. In its view, that would help WIPO Member States gaining greater understanding of the differences that existed and would serve a practical tool for practitioners even in the current environment.

74. The Delegation of the Islamic Republic of Iran associated itself with the statement made by the Delegation of Sri Lanka on behalf of the Asian Group. The Delegation noted that the function and authorization of attorneys had been regulated in different jurisdictions as a general principle that applied to various types of attorneys. Usually in civil law countries, the authorization given to the attorney by the client, the scope of authorization and the commitments of an attorney were specified in the power of attorney and, in case of breach of trust, specific punishments had been given. Or, through a contractual arrangement, any kind of contradiction of the commitments were protected under the civil and criminal laws. The Delegation sought clarification as to whether the privilege system had any particular differences with the above. In connection with paragraph 2 of the document, the Delegation was of the view that enforcement of IP rights and a relationship between a client and an attorney were two different concepts: the first referred to the enforcement of the IP rights against third parties and the latter referred to the commitments of a natural legal person to each other on doing or prohibiting any action. The Delegation requested further clarification with respect to the meaning of the client-attorney privilege and the scope of disclosure of communication in that

paragraph. The Delegation wondered if the disclosure meant the information contained in the application, such information had already been disclosed before the Office, and also could be submitted before the court. The Delegation observed that, for example, if the non-disclosure of the communication by the attorney contradicted with the public order, public health or security matters, as it was the case in compulsory licenses in a particular country, the attorney was under a pressure from the client because of the breach of the trust and from the government. It also raised questions as to the extent of the communication covered by the privilege and as to the degree of punishment against the whole or partial disclosure of communication. As regards paragraph 54 of the document, the Delegation wondered whether an IP advisor in a developing country or an LDC, who had limited IP activities, had consequently limited scope of privilege, and where the scope of the privilege was different in the country of an IP advisor and in the country of his client, which country's law should be applicable. In relation to the resolutions of non-governmental organizations in paragraphs 30 to 42, which referred to harmonization, the Delegation observed that a widespread similarity of national laws was usually the basis for harmonization of laws at the international level. The Delegation further noted that, as indicated in paragraph 18, qualifications of attorneys, sufficient knowledge of the language of the country concerned and continuing education were very important.

75. The Delegation of Egypt stated that there was some wisdom in granting Member States certain freedom under Article 2(3) of the Paris Convention so that each country, in accordance with its legal system and its economic and social conditions, might be able to determine the best possible way and the best possible framework for organizing the client-attorney relationship, taking into account the need for an appropriate balance between private rights and the public rights and freedom and the consideration concerning the public order. The Delegation considered that the preliminary study needed further clarification in order to show the different perspectives of relevant parties concerned, and should concentrate more on the aspect concerning the need to ensure justice and to fight against monopoly.

76. The Delegation of Pakistan sought clarification from the Secretariat on two points. First, as regards paragraph 15 concerning the expression "general opinion", the Delegation asked whose opinion that could be. Second, concerning paragraphs 63 and 64 on the issue of recognition of the professional qualifications of patent attorney services between countries, the Delegation observed that such issue came under Mode 4 of the WTO GATS Agreement, and asked which organization was the appropriate forum to raise the issue.

77. The Delegation of Denmark associated itself with the statements made by the Delegations of Germany on behalf of Group B and the Czech Republic on behalf of the European Community and its 27 Member States. The Delegation noted that, as its country was looking into the topic at the national level, it welcomed the investigation in the SCP as to how the challenges posed by the interaction of different legal systems could be solved. The Delegation wished to place the topic high on the agenda of the Committee, and supported further investigation of the options outlined in the preliminary study, including the establishment of minimum standards on the privilege applicable to communications with IP advisers.

78. The Delegation of Colombia observed that legislation was sometimes too general and could not clarify the ways things were being organized. The Delegation explained that, in its country, IP advisory services was provided by lawyers, who were covered by privilege applicable to lawyers in accordance with the corresponding legislation. The Delegation wished to arrive at an IP system where everybody would be fully informed about the nature and validity of the rights. It explained that, in Andean countries, that would be possible provided that administrative *démarche* for getting the patent would not be challenged. On the other hand, patentability and examination of applications did not prevent the applicant to file the necessary documents.

79. The Delegation of Japan associated itself with the statement made by the Delegation of Germany on behalf of Group B. The Delegation believed that IP owners should be able to communicate frankly with IP advisers and that third parties needed to consult IP advisers freely on

matters such as patent infringement. In its view, the client-attorney privilege had come into play to address those principles, and the lack of uniform rules and regulations among countries sometimes caused problems. The Delegation was of the opinion that Member States did not necessarily have comprehensive information on different practices at respective countries with regard to disclosure proceedings or the client-attorney privilege. It also pointed out that the scope of the IP advisers was not clear enough in the document, and therefore needed to be carefully defined. The Delegation therefore was of the view that a further study on the topic, for example by a questionnaire methodology, would be an appropriate direction.

80. The Delegation of Angola noted that the issue was new to the Committee and shared the concerns voiced by other delegations. As regards the scope of the privilege, the Delegation noted that its legal system recognized privilege for attorneys and lawyers in a purely civil procedure. Such privilege, however, was not applicable to the business circles. As regards the international recognition of the privilege, it should be initially dealt with on a bilateral and multilateral basis. With respect to a multilateral framework, the Delegation was of the view that a recognition of the qualifications of the attorneys fell within the framework of services, and it should be governed by the TRIPS Agreement. It believed that the recognition of privilege should be dealt with on a bilateral basis and Article 2(3) of the Paris Convention should apply.

81. The Delegation of Tunisia was of the view that the client-attorney privilege was not consistent with certain tradition of civil law. The Delegation sought clarification as regards the compliance of the client-attorney privilege with the principle of the disclosure in the field of patents, i.e., whether the client-attorney privilege would be enforced in some countries after filing an application for a patent.

82. The Delegation of Indonesia associated itself with the statement made by the Delegation of Sri Lanka on behalf of the Asian Group. The Delegation considered that particularly the rules that governed confidentiality of information required careful attention. It explained that, there was no specific law in Indonesia that regulated the relationship of client and IP advisor. Taking into account the complexity and different approaches in dealing with the client-attorney privilege, the Delegation was of the view that further studies were needed on the points mentioned by the Delegation of Sri Lanka as to provide more clarity on the issue of the client-attorney privilege.

83. The Delegation of India associated itself with the statement made by the Delegation of Sri Lanka on behalf of the Asian Group. The Delegation was of the view that the preliminary study appeared to draw extensively on works undertaken by international associations of patent attorneys and reflected their concerns. The Delegation therefore sought a more comprehensive study taking into account views of all stakeholders, especially from the perspective of public interest. In its view, the study did not devote sufficient attention to the client-attorney privilege as an exception to the general rule of disclosure. Where an exception was made available, it was provided on the basis that the relationship involved was of sufficient social importance to justify the sacrifice of availability of evidence. Hence, the Delegation observed that the need for such exception, where allowed, had to be related to the socio-economic conditions of the country concerned. Since such condition varied from country to country, in its view, the nature and extent of protection against disclosure would also vary. The Delegation was of the opinion that it was in reflection of such reality that Article 2(3) of the Paris Convention expressly left to national law the establishment of provisions on judicial procedures, allowing for diversity in judicial procedures between States. The Delegation was therefore of the view that every country should be allowed to set its level of privilege and extent of disclosure at a level that suited its socio-economic circumstances, ability and capacity to regulate and its particular level of development. The Delegation further stated that harmonization of client-attorney privileges implied harmonization of the law of exceptions to disclosure requirement. In its opinion, since disclosure was a substantive element of the patent system, harmonization of client-attorney privilege could have substantive implications and involve elements of substantive harmonization, and such harmonization would also keep more information out of the public domain adversely affecting the quality of patents, access to information and innovation, especially for developing countries. The Delegation therefore

requested the Secretariat to undertake a more detailed and comprehensive study on the subject focusing on the above aspects.

84. The Delegation of Singapore supported the statement made by the Delegation of Sri Lanka on behalf of the Asian Group. Singapore's legislation generally provided that communication with respect to any matter relating to patents between a person and a registered patent agent was privileged from disclosure in legal proceedings in Singapore in the same way as communication between a person and his solicitor. The Delegation noted that the international dimension highlighted in the preliminary study provided valuable information for its consideration. The Delegation therefore supported further analysis of the existing privilege and secrecy provisions in the various jurisdictions in order to enable the Committee to enhance its understanding on the situations in other countries as well as concerns of the various stakeholders, including patent holders, possible users, members of the public and patent attorneys and patent agents.

85. The Delegation of Turkey believed that the Committee should continue its deliberations on the topic, and stated that civil society groups as well as relevant public authorities were very much interested in the issue in Turkey. In its view, even if the privilege could be considered as a subject within the national jurisdiction of each Member State, there was an important international dimension to the topic. In Turkey, attorneys were given privilege by the law, but patent agents, which did not have to be attorneys, were subject to general law and obligations, and that law in practice would give discretion to the courts. The Delegation considered that the deliberations in the Committee would also assist its authorities for their further consideration.

86. The Representative of the EPO stated that the revised EPC explicitly provided for confidentiality for communications between the professional representative and his client or any other person. The regulatory part of the EPC contained further new provisions which also governed the subject and gave examples of the types of information which were subject to professional secrecy, most notably communications or documents relating to the assessment of patentability, the preparation or prosecution of European patent applications or opinions concerning the scope of protection. Further, the Representative supported the statements made by the Delegations of the Czech Republic on behalf of the European Community and its 27 Member States and Germany on behalf of Group B.

87. The Delegation of Chile clarified its previous statement by saying that, although it was important to further evaluate the issue, the Delegation did not consider it necessary to establish a working group.

88. The Representative of AIPPI noted that in 2003-2004, the courts in Canada and in Australia forced disclosure of non-lawyer patent advice, since neither Canada nor Australia recognized the non-lawyer patent attorneys in the United Kingdom for client privilege in their own countries. The Representative, however, observed that both Australia and the United Kingdom applied privilege to non-lawyer patent attorneys, but not between them: the United Kingdom did not recognize Australia's non-lawyer patent attorneys and *vice-versa*. The Representative noted that, at the AIPPI-WIPO Conference on privilege in May 2008, 20 experts had provided a very substantial comparative legal resource on privilege, and that the findings of the Conference included findings in relation to some of the matters on which the delegations had expressed their concerns. One of those issues was what was the theory that lay behind the privilege and what was the public interest in it. The Representative stated that the two major objectives of privilege and also the concept of professional secrecy were: first, the enforcement of the law by the giving of professional advice to the clients on the basis of full and frank disclosure; and second, the public interest in obtaining correct advice. In its view, they could not be achieved without full and frank disclosure. Therefore, the Representative observed that it was not surprising that the majority of countries provided such protection in a distinct public interest. He was, however, of the view that what was surprising was that such protection for full and frank disclosure was provided within their own borders, but not when the advice, which had been given within those borders, went beyond the borders. The Representative considered that, though not deliberate, it had a negative effect on what protection was intended for, that was, best advice and enforcement of the law. The Representative was supportive to the further study, and pointed out that

it had no negative impact on anyone willing to make the study. The result could only be no change or a change which further supported the public interest in good governance. In his view, the result of such a change would be positive for obtaining advice of better quality as well. As contributions from the practitioners, the Representative stated that, first, the weight of the issue should not be judged only by the incident of litigation involved. He said that, in order to avoid communications on legal advice, the disclosure of which could be prejudicial, in practice, lawyers, patent attorneys and their clients had to apply strategies that involved additional costs. In his view, nobody could quantify the ways and costs which were involved in the practices, and they induced the opposite of what the national laws intended which was full and frank disclosure in order to obtain the public benefits. As to litigation, Canada has refused to recognize protection from disclosure and proceedings in Canada of a UK in-house patent attorney's advice and the same applies in Australia. He noted that those cases in aggregate involved both civil law and common law countries alike. Therefore, the Representative stated that it was not confined to common law countries, but had an effect in civil law countries as well. As a hypothetical example, the Representative noted that: a UK client consulted a UK patent agent about legal opinions received from the UK, Australia, Brazil, India, Canada and Nigeria, in which patents on the same subject were registered. He explained that all of the opinions would be subject to discovery in Australia and Canada, and if published in the proceedings, the opinions would not be secret any longer anywhere, including Brazil, India and Nigeria. In conclusion, the Representative suggested conducting a more detailed study, which was well justified by and in support of the public interest in improving national governance.

89. The Representative of APAA was supportive for taking another step in-depth on the client privilege issue. While the home countries of the members of APAA included both developing and developed countries, common law countries, such as India, Malaysia, the Philippines and Australia, and civil law countries such as the Republic of Korea and Japan, the Representative was aware of the importance of the client privilege in the context of the global filing and jurisdictional litigation. In her view, where many prosecution and litigation arose in many jurisdictions, even if national law gave a sort of privilege to local IP advisers, it was not sufficient and might bring considerable chilling effect to hamper full and frank communication with clients. The Representative considered that, unless client privilege was admitted in every jurisdiction for both local IP advisers and foreign IP advisers, once a patent was litigated in one country with discovery proceedings, confidential information on infringement or validity between client and IP advisers in other countries was under the risk of forcible disclosure to an adverse party. The Representative explained that the courts of the United States of America had made inconsistent decisions on the issue of whether client privilege should be extended to communication between a foreign IP adviser and his clients, which had been made outside the United States of America, in relation to the foreign law. Thus, clients and IP advisers in the Asian region had confronted the problems of non-privilege due to the uncertainty of the United States case law. Speaking of a Korean example as one of civil law countries, the Representative said that confidential communication between Korean patent attorneys and lawyers and clients was found out of privilege, since the United States courts found no more than professional secrecy obligation in the Korea law. Concerning the Japanese experience as one of civil law countries, the Representative noted that the privilege of IP advices made by Japanese patent attorneys had been denied by US courts as seen in the case, *Honeywell v. Minolta* in 1986, where all communications made by Japanese patent attorneys had been forcibly disclosed. The Representative observed that, after the amendment to the Japanese Civil Code of Procedures in 1998, which gave rights to refuse to testify as an exception to document production order, the privilege of IP advice made by Japanese patent attorneys appeared to have become admissible before the United States courts as a matter of comity. In some cases, even under the amended Japanese law, he observed that no privilege was admissible before other courts, such as Australia and Canada in the light of *Eli Lilly v. Pfizer* case. The Representative was of the view that an international consensus to set minimum standards of the client privilege was necessary with a view to protect both local IP advisers and foreign IP advisers by way of mutual recognition in every jurisdiction without prejudice and without exception. She believed that it would be beneficial for applicants and patentees, third parties and the public. Referring to the APAA Resolution adopted in October 2008 in Singapore, the APAA urged that WIPO be a driving force to realize such international consensus on the client privilege. In her view, setting up a working group for

further study on the client privilege issue could facilitate resolving step-by-step the current considerable differences in, for example, the scope of the privilege and the qualifications of IP advisers. The Representative believed that such universal client privilege would also raise the qualification of IP advisers for ensuring high-quality IP services.

90. The Representative of ASIPI noted that the client-attorney privilege had the nature of public order and that the issue was an actual issue, not a museum piece. The Representative supported the proposal made by AIPPI based on a study made by his organization, in which it had looked into, in particular, the protection of information in intellectual property advice by non-lawyers and the protection of information coming from abroad. In his view, a further study regarding the existing situations in each jurisdiction was needed.

91. The Representative of ICC noted that his members, whether large or small businesses, operating locally or in export markets, required advice from professional advisors to understand how they could act within the limits of their own rights, and without infringing on the rights of others. For that reason, the Representative believed that the issue of client-attorney privilege was important, as it impacted on the quality of advice given to businesses in all countries by their local advisors or those in the markets where they had activities. Because of the increasingly international nature of commercial transactions involving IP rights, the Representative also believed that there was an important international dimension to the issue, which merited thorough consideration by WIPO. In his view, the issue was also important for the IP system in general, since privilege against disclosure of clients and advisor communications played a key role in the transparency of the IP system which was important for all stakeholders, and also helped to ensure respect for national laws. The Representative noted that the concept of confidentiality of professional advice was not a new concept in civil law countries nor in common law countries. In civil law countries, for example, it might already apply to different professions such as medical doctors, nurses, midwives, and attorneys-at-law. The Representative observed that IP professionals provided similar services to legal attorneys, but were not subject to the confidentiality obligation in several countries. It was the opinion of the Representative that assurance of confidentiality for communications between clients and their local professional advisors, including, for example, professionally qualified patent attorneys who might not be lawyers, encouraged full and frank exchange of information and advice between them. He believed that such full and frank exchanges promoted the rule of law by ensuring that clients had accurate and complete understanding of the IP rights that might apply to their activities. Therefore, the Representative was of the view that the client privilege promoted clear understanding of IP rights, and was at least as important to clients confronted by the IP rights of others as to IP right holders. Similarly, the Representative observed that full and frank exchange of information and advice between a client and a local IP professional helped better transparency of the scope and validity of IP rights by ensuring that the client understood what he could or could not do legally. He stated that the current differences in legal systems in regard to the protection of such exchanges of information and advice between clients and their local professional advisors meant that assurance of confidentiality was not available in many situations. This in turn meant that, in his view, local professional IP advisors were constrained to limit their advice by concerns that it might be disclosed publicly, for instance during litigation in their own country or elsewhere. The Representative noted that such situation could not be considered fully without also recognizing an increasing need for commerce in multiple jurisdictions across the world, with full understanding of all, possibly related, IP rights in all such jurisdictions. In his opinion, obstacles to such understanding were also obstacles to such commerce at a time when commerce was needed more than ever by all. In response to some Delegations which expressed concerns about the possibility of client-attorney privilege detracting from the role of the patent system in putting technical information in the public domain, the Representative clarified that the client-attorney privilege, or professional secrecy, applied only to advice given to a client by his or her professional advisor, and it did not cover publicly available information such as all the technical and other information relating to patents contained in patent applications. The client-attorney privilege, or professional secrecy, did not therefore in anyway detract from general patent disclosure requirements or the patent system's important role in putting technical information in the public domain. As an example of the client-attorney privilege, the Representative explained that, if an inventor or business sought advice on the

validity of a patent due to a risk of infringing that patent by putting his product on the market, such inventor or business should not be risked to be forced to hand over the advice he had obtained to the patent owner in later patent infringement proceedings. In conclusion, the Representative stated that the complexity of the issue called for further and deeper analysis to help clarify problems and identify opportunities and solutions, and urged the SCP to study the privilege issue further.

92. In response to the question raised by the Delegation of Pakistan, as regards paragraph 13, the Secretariat noted that it referred to the framework in which the question under consideration was brought up, namely, the WIPO-AIPPI Conference in which representatives from Member States, NGOs and other stakeholders had participated, and clarified that it was not meant to be generally reflecting the entire membership of the SCP. Concerning the question as to whether the issue should be dealt with in WIPO or WTO, the Secretariat stated that it was not an issue for the Secretariat to decide.

93. The Representative of FICPI stated that the increasing nature of global trade and IPRs made it very important to establish a level playing field so that individuals and companies, whether they were in developing countries or developed countries, were fully protected regardless of where the IP litigation occurred. In his view, clients who were in countries where there was no adequate recognition of privilege, or professional confidentiality, were at a serious and significant disadvantage. He continued that if the clients became involved in the litigation in foreign countries, which recognized and protected privileged information, and which allowed some discoveries, he would be protected from having to disclose any of its communications from its own IP advisers in that foreign country, whereas confidential communications between client and its IP advisers in its home country would have to be disclosed in the absence of recognition of the privilege. Therefore, in his view, it was important for all countries to adopt a minimum standard of privilege which would be recognized in all countries, regardless where the IP dispute or IP litigation occurred. He further continued that countries which did not adopt a minimum standard of privilege were subjecting their own citizens and companies to serious disadvantage when there was an IP dispute in other countries. Referring to the questions raised by some Delegations, the Representative clarified that the client-attorney privilege improved both patent quality and cost by ensuring more complete and frank disclosure, thereby providing more certainty and productivity. In addition, he stated that the client-attorney privilege protected the citizens and companies regardless of whether they were in developed or developing countries, and, the client-attorney privilege enhanced competition by securing better informed participation and increased certainty and productivity.

94. The Representative of GRUR stated that the protection of confidential information was guaranteed in Germany through various provisions contained, for instance, in the code on civil, criminal or administrative procedure, with an exception of the European patent attorneys or European trademark attorneys, which were not expressly mentioned in the various legal instruments. He stated, however, that the national perspective was not sufficient in view of the growing international impact of all professional advice, in particular, in the field of the protection of intellectual property. Referring to the international aspect of legal advice, the Representative noted that there seemed to be a concern not only for developed countries, but also for developing countries because all professional advisers having their residence in developing countries were constantly exposed to the uncertainties caused by the divergences in the protection of the professional secrecy. The Representative recalled that the protection of confidentiality was an element of due process of law guaranteed by the European Convention on Human Rights. Therefore, the Representative supported the initiative started by FICPI, AIPPI, ICC and the other international NGOs to establish a reliable international legal framework for the protection of confidential information exchanged between a client and his professional IP adviser. The Representative noted that such international legal instrument would have to set out who was protected, what was protected, where and when the protection applied, how the protection operated and how it was going to be implemented. The Representative continued that the most reasonable approach was to set up a minimum standard of protection combined with the obligation to grant national treatment and most-favored-nation treatment. In his view, the protection should be accorded to the professional adviser, in addition to the client, because the obligation of the professional adviser

to guarantee professional secrecy should also be respected. He stated that the secrecy could be lifted by the client. The Representative emphasized that the subject matter of protection was the confidential information as such, which was to be protected against all types of disclosure, be it through the production of the documents in discovery proceedings in the United States of America, or be it through the taking of depositions as witness where the professional adviser was exposed to questions about his advice he had given to the client and the confidential information he received. The Representative added that the protection should operate in all types of proceedings whether they were civil, criminal or administrative. The legal instrument should cover all types of proceedings be they for national or international courts, for instance the European Court of Justice, the Court of Appeal of the European Patent Office, a future European patents court on national or international administrative authorities, like the EPO and the European Commission before the Office in Alicante. The Representative stated that the European Commission should get involved in any negotiations about the initiative. It was convinced that the time was right to pursue the initiatives vigorously and urgently in WIPO.

95. The Representative of CIPA and EPI stated that the problems addressed in document SCP/13/4 were very well summarized in paragraph 261 of document SCP/12/3 Rev.2. According to his view, it was short, brief and understandable by all. The Representative stated that EPI and CIPA welcomed the fact that the SCP was looking very seriously to the problems caused by the non-uniform privilege provisions around the world. He noted that EPI and CIPA were willing to assist SCP and the Secretariat in any way possible in moving everyone to a solution to the benefit of all.

96. The Representative of IPIC stated that the issue of privilege for non-lawyer IP advisers had been a priority for IPIC for over 10 years. IPIC had commissioned numerous reports and legal opinions, as well as consulted all possible stakeholders on how it could be implemented in Canada for all IP advisers. The Representative stated that in Canada, there was a common-law solicitor-client privilege. However, in his opinion, Canadian courts had been slowly eroding the privilege for lawyer-IP advisers such that there was no longer certainty that IP legal advice relating to obtaining rights was protected by it. The Representative continued that, recently, Canadian courts had not recognized the statutory privilege of a UK patent attorney because there was no equivalent legislation in Canada. In his view, there were negative economic implications because of that development. It considered that IP owners needed certainty that they could rely on privilege to protect their IP legal advice, both, locally and around the world, in whatever country they did their business. They should be able to freely and fully communicate with their IP advisers on issues upon which they required such advice. The Representative further stated that IPIC urged WIPO to treat the issue as a matter of high priority and take the appropriate action to advance it as soon as possible.

97. The Representative of TWN noted that it was important in the discussion not to forget the public interest of the courts having sufficient information to make fair and accurate decisions. The Representative stated that American courts had noted that the attorney-client privilege inhibited the search for truth and so should be confined within the narrowest possible limits. The Representative found it interesting that the Representatives of professional associations had not mentioned the problem of the abuse of the current level of privilege in many countries. As an example, the Representative mentioned the Nobel-Pharma case, where the inventors had given the Swedish patent agent a draft patent application which had included the citation to a book written by the inventor which had described the use of the invention more than two years earlier. The book was later held to anticipate the patent. However, the patent agent had deleted all references to the book from the patent application that had been filed in Sweden and the United States of America. The court had found that this evidence of actual deletion was defrauding the Patent Office. The Representative continued that if the communication with the agent had been privileged, the Patent Office and the court would never have found that out, and the patent would still be standing. The Representative noted that there were other cases where inventors had not mentioned their own public use of the invention more than one and half or two years before filing a patent application. And often only the inventor could know about the prior use. Therefore, the Representative considered that given the

existing problems with the current level of privilege, even between lawyers and clients, there might be a need to consider the impact on patent quality and economies of extending the privilege even further. The Representative stated that the types of cases of abuse provided above even of the narrow lawyer-client privilege highlighted the importance of being very cautious of any further extension of it. In her view, in many jurisdictions, lawyers had the privilege because they had a strict primary duty to the court and that was enforced by a strong professional code of conduct. Abusing the privilege had serious consequences for lawyers. According to the opinion of the Representative, if that privilege was extended to other actors, such as patent attorneys and patent agents and in-house counsels who were not lawyers and did not have such a duty to the court, then that was more likely to result in abuse. Therefore, the Representative was of the view that there was a need for further examination of the situation on the ground in each country, as to whether the SMEs and domestic companies in developing countries, which were usually not intellectual property owners, would really be assisted by extending such privilege. She further noted that if the privilege was extended to patent attorneys and patent agents, that would create pressure on governments to extend the privilege to other professionals, like chartered accountants and auditors. In conclusion, the Representative stated that given the abuses seen even of lawyer-client privilege in jurisdiction that had strong professional codes of conduct and enforcement of these codes of conduct, extending the privilege without corresponding responsibility to non-lawyers and in-house counsels might need to be treated in caution.

98. The Representative of JPAA stated that the question of client privilege was an international issue. Therefore, the Representative strongly supported every activity to make an international agreement regarding client-attorney privilege between the Member States. In his view, first of all, it was necessary to study each national law on client-attorney privilege and the qualifications of the IP representatives or IP advisers. Therefore, the Representative stated that it supported all the efforts to establish a Working Group on the issue.

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