Summary of National Laws and Practices

Origin and Scope

Origin of the general legal privilege and secrecy obligations

The need for a client to disclose all facts to his or her legal advisor in order to obtain the best advice to respect the law is common to all countries. To that end, the desirability of the confidentiality of communications between the legal advisor and the client is probably uncontested, unless the maintenance of confidentiality is overridden by a fundamental public policy such as the prevention and punishment of criminal acts.

One of the important points of departure between common law countries and civil law countries is the different approaches taken in protecting confidential communications in those countries. Civil law countries impose secrecy obligations on the part of professionals in ensuring that clients’ confidential information is kept secret through specific laws regulating the activities of professionals or through the respective national criminal law system. In principle, attorneys may refuse to testify any information received from a client during the course of professional duty. Similarly, an attorney may refuse to produce any document that contains such confidential information. In general, the disclosure of confidential documents by legal advisors is subject to sanctions. In civil law countries, the rule of evidence is that a plaintiff needs to substantiate his or her claim, and the fact that a document is in the possession of the defendant does not change this burden of proof. This could be regarded as a reason why the concept of “client-attorney privilege” has not developed in civil law countries. Such an assumption may be confirmed by the fact that when the Japanese Civil Procedure Law introduced a broader scope of the duty to produce documents, it also provided a broader right for an owner of a document containing communications with a lawyer or patent advisor protected by professional secrecy to refuse the production of such a document to the court.

Common law privilege originates from the solicitor–client privilege under the common law system which would later be known as legal professional privilege. The main purpose of the legal professional privilege in common law countries is to avoid confidential communications between an attorney and his or her clients from being disclosed to the court during the discovery stage. Privilege in common law countries applies to communications relating to legal advice whether there is litigation or not, subject only to the dominant purpose test and any established common law exceptions (such as for crime/fraud) and any statutory limitations.

Professionals bound by the privilege and secrecy

Generally, in common law countries, certain types of professionals are required keep client information confidential. There are two legal bases of privilege: common law privilege and statutory privilege. The former, applies only to communications between qualified lawyers, including in-house lawyers, and the clients. It is not applicable to patent advisors who are not qualified lawyers. However, this common law approach has been modified by Statute in some common law countries such as Australia, New Zealand and the United Kingdom, which extend the client-attorney privilege to patent attorneys and patent agents who are not qualified lawyers. In any event, the privilege that prevents the disclosure of communications concerning legal advice belongs to the client. Therefore, the client may waive the client-attorney privilege.
Confidentiality of Communications between Clients and their Patent Advisors

In civil law countries, the professional secrecy obligation is created by statutes governing lawyers and many other professionals. In general, non-lawyer patent attorneys and patent agents are also bound by the professional secrecy obligation. In some countries such as France and Japan, non-lawyer patent attorneys have a right to refuse to testify in court any matter falling under the professional secrecy obligation, while in the Russian Federation, no immunity in respect of testimony in court is granted to non-lawyer patent attorneys. With respect to documents that contain information covered by the professional secrecy obligation, in some countries, the owners of such documents, who may be patent attorneys, their client or any third party, may refuse to produce such documents in court.

Scope of the privilege/secrecy obligations

The client-attorney privilege protects confidential communications between a lawyer and client made for the purpose of obtaining and giving legal advice. Similarly, where applicable, the same scope of privilege is provided for the client with respect to communications between a patent attorney (agent) and client under the relevant statute. The exact types of communications covered by the client-patent attorney (agent) privilege are not the same among countries, since the scope of the professional activities of those professionals (for example, whether copyright matters can be dealt with or not) is different from one country to the next. In particular, the question of whether the privilege does extend to communications by lawyers and clients with third parties is dealt with differently among the common law countries (For example, to see how it is dealt with in Australia, see *Pratt Holdings Pty Ltd and Another v. Commissioner of Taxation* [2004] FCAFC 122).

According to the information gathered in the Compilation of National Laws and Practices (also found in Annex III to SCP/20/9), the professional obligation to keep secrets in civil law countries attaches to information and documents obtained from clients in the course of the professional relationship as between an attorney or a patent attorney and a client. It does not apply in other situations, for example, where attorneys act in their non-professional capacity such as that of a director, business advisor or business partner to the client.

This obligation of confidentiality extends beyond the life of the attorney–client relationship and is typically the result of rules of professional conduct that are put in place by the appropriate body responsible for regulating the legal profession in any given jurisdiction. The civil law countries in the compilation of national laws and practices also extend the secrecy obligations even after the end of the professional relationship between the patent attorney and patent agents with their clients.

Exemptions and limitations of the privilege and secrecy obligations

One of the limitations of the legal professional privilege under the common law system is the fact that clients may decide to waive the privilege and thus allow the privileged communication to be disclosed to the court. Express and implied waivers are available under the common law systems of the United Kingdom, Australia and New Zealand. Malaysia only recognizes express waiver by the client.

The compilation of national laws and practices shows that both in civil and common law countries, there is an exception to the secrecy obligation and the privilege, if such confidential communications involve fraud or criminal acts.

Penalties for breach of secrecy/disclosure
Among the countries in the compilation, a breach of the secrecy obligation in civil law countries may lead to criminal prosecution. In both civil law and common law jurisdictions, a breach of secrecy and disclosure of privileged information may lead to professional disciplinary actions.

Qualifications of patent advisors

Qualifications to become a patent attorney or patent agent vary from one country to another, whether common law or civil law applies. Many countries such as Germany and the United Kingdom require patent agents and patent attorneys to be technically qualified. The United States of America allows non-lawyers who are technically and scientifically qualified to become patent agents, although patent attorneys must have legal qualifications. In some countries such as Brazil, Malaysia and South Africa, both lawyers who are not technically qualified and non-lawyers who are technically qualified may become patent agents.