

Questionnaire concerning Client privilege

(APAA Group Name: AUSTRALIA)

Prepared By Members of the Australian Patents Committee – 28 October 2009 (Updated on 30 December 2009 and 3 February 2010)

Part 1 (As for qualification for patent professionals):

1. Questionnaire 1-1

Concerning the qualifications for patent professionals*1:

Note*1: A patent professional is admitted for and able to professionally work for at least one of the following practices. In this case, "patents" include utility models.

- practicing patent prosecution before the Patent Office (including any Office administering patent filing, prosecution and/or registration);
- opinion preparation concerning patent actions;
- representation in patent infringement litigations;
- representation in patent nullity procedures or litigations; and
- foreign patent filing and prosecution practices (such as evaluation of patentability of a foreign application, preparing a patent document to be sent to a foreign associate, and sending technical comments to the foreign associate in response to an Office Action)

In your country, what kinds or types of patent professionals (e.g., patent agents, patent attorneys, attorneys at law, etc.) are admitted for conducting professional work relating to practicing patent prosecution before the Patent Office, opinion preparation concerning patent cases, patent infringement litigations, patent nullity procedures or litigations, and foreign patent filing and prosecution practices? If there are plural kinds or types of patent professionals who are admitted for such professional work, please specify them. In such a case, please indicate the kinds or types of patent professionals and the title names in Table 1 below, by reference to the related law or rule stipulating such patent professionals.

Table 1:

Kinds or types of patent professionals	Title name of patent professional in your country	Related law or rule*2 stipulating the patent professionals
Lawyer*3 patent professionals	Solicitor, Barrister	Various Legal Practitioners Acts
Non-lawyer patent professionals	Registered Patent Attorney	s198 of Patents Act 1990 ("PA")

Note (*2): If the professionals are stipulated only in an internal rule of a related organization to which the patent professionals belong, please reproduce the content of such internal rule. In the following, when the law or rule is referred to, please also understand that "law" and "rule" include internal rules if there is any internal rule of a certain organization governing the patent professionals.

Note (*3): "Lawyers" refers to persons licensed to practice law, including attorneys at law, solicitors, barristers, and the like. Please specify the title name in the table. Hereinafter, "Lawyer patent professionals" will be simply referred to as "Lawyers."

2. *Questionnaire 1-2 (scope of patent related practices or work for which patent professionals are admitted):*

(1) Questions are raised about the following kinds of professional work.

- practicing patent prosecution before the Patent Office;
- opinion preparation concerning patent cases;
- representation in patent infringement litigations;
- representation in patent nullity procedures or litigations; and
- foreign patent filing and prosecution practices.

If there are plural kinds or types of professionals, then please indicate the kinds of professional work admitted for in relation to the kinds or types of patent professionals shown in Table 2 as follows, by reference to the related law or rule stipulating the patent professionals. Please explain such kind or type of patent professionals and classify them into lawyers and non-lawyer patent professionals.

Table 2:

Scope of professional work admitted for:	Lawyers (yes or no)	Non-lawyer patent professionals*4 (yes or no)
i) Patent prosecution practice before the Patent Office	No – prohibited from filing and/or amending patent specifications in Australia for compensation	Yes
ii) Opinion preparation concerning patent cases	Yes	Yes
iii) Representation in patent infringement litigations	Yes	No
iv) Representation in patent nullity procedures or litigations	Yes – Court or Patent Office	Yes – Patent Office only
v) Foreign patent filing and prosecution practices	No – prohibited from filing and/or amending patent specifications overseas for compensation	Yes

Note (*4): If there are plural kinds or types of non-lawyer patent professionals (such as a patent agent, Benrishi, etc), then please indicate the scope of professional work, respectively. The above is also applied to the following questions below.

(2) In the scope of the professional work as listed in Questionnaire 2(1) above, what professional work can be conducted only by the patent professionals (i.e. if a non-qualified person works for compensation, he or she would be punished)?

Table 3:

Scope of professional work admitted for:	Lawyers (yes or no)	Non-lawyer patent professionals*4 (yes or no)
i) Patent prosecution practice before the Patent Office	No	Yes
ii) Opinion preparation concerning patent cases	Yes	Yes
iii) Representation in patent infringement litigations	Yes	No
iv) Representation in patent nullity procedures or litigations	Yes – Court or Patent Office	Yes – Patent Office only
v) Foreign patent filing and prosecution practices	No	Yes

3. *Questionnaire 1-3 (the conditions under which a person may act as a patent professional):*

(1) What are the conditions under which a person may act as a patent professional for the above scope of work? Please answer the following sub-questions.

(i) Whether or not a qualification test is required? If so, please indicate the law or rule stipulating the qualification test. If there are plural kinds or

types of patent professionals required to take the qualification test, then please answer the questions, respectively. In such a case, please explain which kind or type of patent professionals is required to take a qualification test in Table 4 below, by specifying the kind or type of the patent professionals in Table 4 as follows, and by reference to the related law or rule stipulating the qualification test.

Table 4:

Kind or type of patent professionals	Title name of patent professional in your county	Is qualification test required? (yes or no)	Related law or rule stipulating the qualification test, if any
Lawyers	Solicitor, Barrister	Yes	Various Legal Practitioners Acts
Non-lawyer patent professionals	Registered Patent Attorney	Yes	S198 of PA

(ii) If a qualification test is required, please briefly answer the following a) to c) and fill in Table 5 below. Also, please indicate the related law and rule stipulating the following items:

- a) How many subjects are covered?
- b) What kinds of subjects are covered?
- c) Is an interview needed?

Table 5:

Kind or type of patent professionals	How many subjects are covered?	What kinds of subjects are covered?	Is an interview needed?	Related law or rule, if any
Lawyers		Full bachelor degree legal qualification – full-time study of 4 or 5 years	No	Various Legal Practitioners Acts
Non-lawyer patent professionals		Legal process and overview of IP; Professional conduct; Trade mark law; Trade mark practice; Patent law; Patent system; Drafting patent specifications; Interpretation of validity of patent specifications; Designs	No	Regulation 20.3 of the Patents Regulations 1991 (“PR”)

(iii) Does the test cover a code of conduct or vocational ethics?

If the answer is yes, please refer to the law or rule stipulating a code of conduct or vocational ethics.

Table 6:

Kind or type of patent professionals	Is a code of conduct or vocational ethics included as a subject? (yes or no)	Related law or rule, if any
Lawyers	Yes	Various Legal Practitioners Acts
Non-lawyer patent professionals	Yes	Regulation 20.8 of the PR

(iv) Is practical training required before taking the test?

If the answer is yes, how long a term of training is required?

In this case, please refer to the law or article stipulating this point.

Table 7:

Kind or type of patent professionals	Is practical training required? (yes or no)	How long?	Law and/or rule basis
Lawyers	Yes	12 months of Articled Clerk training OR equivalent graduate or post-graduate supported training	Various Legal Practitioners Acts – note that these requirements are changing and are different from State to State.
Non-lawyer patent professionals	Yes	2 years of effective experience in certain skills	Regulation 20.10 of the PR

(2) Concerning how to govern, control, administrate or maintain the qualification of patent professionals:

Is there any organization governing, controlling, administrating or maintaining the qualification of the patent professionals?

YES

If the answer is yes, please answer the following sub-questions.

- a) Which organization governs, controls, administrates or maintains the qualification of the patent professionals?
- b) Whether or not the organization has been established so that the members of the organization can professionally represent their clients?

Table 8:

Kind or type of patent professionals	Sub-question a) above	Sub-question b) above	Law and/or rule basis
Lawyers	Supreme Court of Australia and Legal Services Board established pursuant to the Legal Practitioners Acts	Yes	Legal Practitioners Acts
Non-lawyer patent professionals	Professional Standards Board for Patent and Trade Marks Attorneys	Yes	Patents Act 1990 (Cth) and Patents Regulations 1991

(3) As for the conditions for maintaining the qualification:

Please answer the following sub-questions:

(i) Are patent professionals required to complete an obligatory subject or lecture (such as code of conduct or vocational ethics, and lectures on practice change or law amendment) in order for him/her to maintain the qualification for the professional work?

YES

(ii) If yes in Item (i), please answer whether or not a code of conduct or vocational ethics is included as the obligatory subject?

NO

Table 9:

Kind or type of patent professionals	Code of conduct or vocational ethics (yes or no)	Law and/or rule basis
Lawyers	Yes	The Law Institute Continuing Professional Development Rules 2008 (these rules are different from State to State); Legal Practitioners Board
Non-lawyer patent professionals	No	Professional Standards Board for Patent and Trade Marks Attorneys

4. Questionnaire 1-4 (concerning the penalty when patent professionals do not meet the conditions for being admitted for the professional work):

(1) Is there any criminal penalty imposed when a patent professional releases or divulges confidential information obtained from his or her client, without any justifiable reason?

NO

If the answer is yes in item (1), please give the following information in Table 10 below.

(i) Which law or rule governs such penalty?

(ii) Amount of fine, if any

(iii) Term for imprisonment, if any

Table 10

Kind or Type of patent professionals	Information i) above	Criminal Penalty	
		Amount of fine (ii)	Term for imprisonment (iii)
Lawyers	No	N/A	N/A
Non-lawyer patent professionals	No	N/A	N/A

(2) Is there any penalty imposed when a patent professional has become unsuitable for being admitted for the professional work (for example, he or she has failed to meet the conditions for the qualification (for example, he or she violates the Association laws or rules, damages the order or reputation of the association or misbehaves in a manner impairing his/her or its own dignity) after he or she has become qualified)?

YES

If the answer is yes in item (2), please give the following information in Table 11 below.

- (a) Which law or rule governs such penalty?
- (b) Disciplinary action, if any
- (c) Suspension of professional work, if any
- (d) Deprivation of the qualification, if any
- (e) Other penalty, if any

Table 11

Kind or Type of patent professionals	Information (a) above	Penalty			
		Disciplinary action (b)	Suspension of professional work (c)	Deprivation of the qualification (d)	Other penalty (e)
Lawyers	Legal Practitioners Acts and Legal Practitioners Board	Yes	Yes	Yes	N/A
Non-lawyer patent professionals	Professional Standards Board for Patent and Trade Marks Attorneys	Yes	Yes	Yes	N/A

Part 2 (As for Client privilege or professional secrecy):

Before raising the following questions, it would be useful to comment on some points concerning the terminology used in the following questions, in order to avoid any possible confusion derived from any possible misunderstanding of the terminology.

General concept:

1. Client privilege is the right of a client not to have to disclose information (communications and/or documents*) which would otherwise have been required. In common law countries, client privilege may allow a client or a patent professional to keep communications and/or documents secret and to be silent on certain issues under a discovery system.
2. In the following questions, the term "a discovery system" means a system comparable to the discovery system employed in the U.S. litigation procedure. The discovery procedure is the procedure for collecting evidence before a trial in the U.S. The discovery procedure is stipulated in the Federal Rules of Civil Procedure: Rule 26 (FRCP R26).

Note*: Communication takes place usually in the form of letters. Here, "documents" do not include communication documents. The scope of documents stipulated in the Federal Rules of Civil Procedure: Rule 34 (FRCP R34) may include writings (such as work products and expert opinions), drawings, graphs, charts, photographs and the like.

3. In civil law countries, professional secrecy may allow a patent professional or a client not to disclose confidential communications or not to produce confidential documents, such confidential communications and/or documents having taken between the patent professional and his or her client or prepared thereby.

1. Questionnaire 2-1

(1) If your country is a common law country, please fill in Table 12 below, taking the following questions into consideration.

- (i) Is there any discovery system corresponding to that employed in the U.S. ?

YES

- (ii) If yes, please answer the following a) to c).

- (a) In the discovery procedure, can patent professionals be immune from testimony or document production (such as "work product"*5)

before the courts?

Note*5 "Work product" is the term used in the U.S. discovery procedure and means the document or tangible thing which has been prepared by a lawyer in anticipation of litigation or for trial by or for another party or its representative (FRCP R. 26(b)(3)(A))

(b) If the answer is yes, what kinds of communications and/or documents are covered?

(c) Is there any difference between immunity as to technical advice and immunity as to legal advice? If yes, please explain the difference.

Table 12

Common law countries		
Discovery system	Yes	
What is protected from disclosure: Communication/documents?	Both	
What kinds of communications are protected?	<p>Patent attorney privilege s200(2) of the Patents Act 1990 (Cth)</p> <p>A communication between a registered patent attorney and the attorney's client in intellectual property matters, and any record or document made <i>for the purposes of such a communication.</i></p> <p>Legal professional privilege – common law and various legislations.</p> <p><i>A confidential communications between a lawyer and a client (or their agents or with third parties) made for the dominant purpose of giving or receiving legal advice, or for use in actual or contemplated litigation.</i></p>	
What kinds of documents are protected?	<p>Patent attorney privilege</p> <p>A communication between a registered patent attorney and</p>	

	<p>the attorney's client in intellectual property matters, and any record or document made <i>for the purposes of such a communication</i>.</p> <p>Legal professional privilege</p> <p>Legal professional privilege</p> <p>A <i>confidential</i> communications between a lawyer and a client (or their agents or with third parties) made <i>for the dominant purpose</i> of giving or receiving legal advice, or for use in actual or contemplated litigation.</p>	
Is legal advice protectable?	Yes	
Is technical advice protectable?	Yes, if a communication between a registered patent attorney and the attorney's client in intellectual property matters	
Difference if any between legal advice and technical advice	Legal advice is provided by a lawyer as defined by Legal Practitioners Acts	

(2) If your country is a civil law country, please fill in Table 13 below, taking the following questions into consideration.

(i) Is professional secrecy protectable?

(Answer here: Yes or No)

N/A

(ii) If yes, please answer the following questions a) to c).

(a) Does a patent professional have to testify or produce documents before the courts?

(b) If the answer is yes, what kinds of communications and/or documents are covered?

(c) Is there any difference between technical advice and legal advice as to professional secrecy? If yes, please explain the difference.

Table 13

Civil law countries		
Is professional secrecy protectable?		
What is protected from disclosure: Communications/documents?		
What kinds of communications are protected?		
What kinds of documents are protected?		
Is legal advice protectable?		
Is technical advice protectable?		
Difference if any between legal advice and technical advice		

(3) As for treatment of foreign patent professionals in common law countries:

(i) In your country, is there any law or rule to provide the same privilege as provided to domestic patent professionals to foreign patent professionals?

(Answer here: Yes or No)

YES

(ii) If the answer is yes, then please explain the content of the law or rule.

Table 14: Common law countries (answer in yes or no):

	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Client privilege	Yes	Yes	Yes	No privilege applies	Yes Legal professional privilege applies to the advice of foreign lawyers. The party claiming privilege
	Patent attorney privilege s200(2) of the Patents Act 1990 (Cth)	Legal professional privilege – common law and various legislations.			

	A communication between a registered patent attorney and the attorney's client in intellectual property matters, and any record or document made <i>for the purposes of such a communication</i> .	A <i>confidential</i> communications between a lawyer and a client (or their agents or with third parties) made <i>for the dominant purpose</i> of giving or receiving legal advice, or for use in actual or contemplated litigation.			bears the onus of establishing the basis of the claim. A "lawyer" for the purpose includes "a natural person who, under the law of a foreign country, is permitted to engage in legal practice in that country".
Communication	As above	As above			Yes, as per legal professional privilege
Document	As above	As above			Yes, as per legal professional privilege
Legal advice	Yes, as above	Yes, as above			Yes, as per legal professional privilege
Technical advice	Yes, as above	Yes, as above			Yes, as per legal professional privilege

(4) As for treatment of foreign patent professionals in civil law countries:

(i) In your country, is there any law or rule to provide the same professional secrecy as provided to domestic patent professionals to foreign patent professionals?

(Answer here: Yes or No)

N/A

(ii) If the answer is yes, then please explain or exemplify the content of the law or rule.

As per table 14 above

Table 15: Civil law countries (answer in yes or no):

	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Professional secrecy					
Communication					
Work product					
Legal advice					
Technical advice					

2. *Questionnaire 2-2*

Please give the following information on your country concerning the cases where Client Privilege or professional secrecy was an issue (including past cases). Specifically, please briefly explain the following points as shown in Tables 16 and 17.

- (1) Cases where Client Privilege or professional secrecy was accepted or recognized in your country.
- (2) Cases where Client Privilege or professional secrecy was denied in your country.

Table 16: Common law countries:

Client Privilege	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Accepted	<i>Patent attorney privilege - s200 (2) of the Patents Act 1990 (Cth);</i>	<i>Mann v Carnell (1999) 201 CLR 1; [1999] HCA 66;</i> <i>Rickard Constructions Pty Ltd v Richard Hails Moretti Pty Ltd [2006] NSWSC 234;</i> <i>Unified Evidence Act ss 117, 118, 119 and 120</i>			<i>Michael Wilson and Partners Ltd v Robert Colin Nicholls and Ors [2009] NSWSC 763;</i> <i>Kennedy v Wallace [2004] 142 FCR</i> <i>Grofam Pty Ltd v ANZ Banking Group (1993) 45 FCR 445</i>
Denied				<i>Eli Lilly v Pfizer Ireland (2004) 137 FCR 573</i>	

Table 17: Civil law countries:

Professional secrecy	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Accepted					
Denied					