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**Answer to Questionnaire concerning Client privilege
(APAA Group Name: Japan Group)**

November 6, 2009

Prepared by the members of Japan Patents Committee

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	Attorney at law (or Bengoshi)	Article 3, Item 2 of Attorneys-at-law (AALL)
Non-lawyer patent professionals	Patent Attorney (or Benrishi)	Articles 4, 5, 6, 6-bis of Patent Attorney law (PAL)

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."

[Contents of the law/rule]

Attorneys-at-law Law (AALL):

Article 3 (Functions of a practicing attorney):

2. A practicing attorney may, without any further qualification, engage in the business of a Patent Attorney and/or a tax attorney.

Patent Attorney Law (PAL):

Article 4 (Services):

1. A Patent Attorney shall engage in the business of representation for procedures before the Patent Office relating to patents, utility models, ----- or international applications -----, and for procedures before the Minister of Economy, Trade, and Industry relating to oppositions or adjudications relating to patents, utility models, ----- as well as provision of expert opinions and other business matters relating to these matters concerning these procedures, upon the request of another party.

2. A Patent Attorney may also engage in the business of performing the following business matters upon the request of another party, in addition to the services set forth in the preceding paragraph.

(1) Representation in procedures before the Director of Customs relating to certification procedures provided for in Article 69-9, paragraph 1 and Article 96-12, paragraph 1 of the Customs Law, and in procedures before the Director of Customs or the Minister of Finance relating to an application under Article 69-4, paragraph 1 and Article 69-13, paragraph 1 of the same law and relating to an application by an applicant who files such an application or an application by a party who exports or imports goods for which the application is filed.

(2) Representation in procedures for alternative dispute resolution (meaning the procedure for alternative dispute resolution defined in Article 1 of the Law concerning Promotion of Alternative Dispute Resolution; the same shall apply hereunder in this item) in cases relating to patents, utility models, -----, which are dealt with by a body designated by the Minister of Economy, Trade and Industry as one deemed able to perform the services in alternative dispute resolution for such cases in a fair and proper manner.

3. A Patent Attorney may also engage, upon the request of another party, under the name "Patent Attorney," in the business of representation or mediation in concluding sales contracts, non-exclusive licensing contracts, and other contracts for rights relating to patents, utility models, ----- or for technical secrets; or consultations relating thereto, or in preparing a document relating to procedures or other matters concerning rights relating to patents, utility models, ----- in relation to foreign administrative office or its corresponding organization (limited only for the procedures carried out by a party whose address or residence is in Japan and in a case where a party is a company, its business office), provided that this shall not apply to matters for which the performance of

services is restricted by other laws.

Article 5:

1. A Patent Attorney may appear in court, present a statement, and/or interrogate as a legal assistant together with the party involved or a counsel for matters concerning patents, utility models, -----, international applications, -----.

(2.Omitted)

Article 6 (Counsel):

A Patent Attorney may act as a counsel for litigation provided for in Article 178, paragraph 1 of the Patent Law (a suit against an appeal board decision or a suit against a ruling to dismiss a written demand for an appeal or re-appeal), Article 47, paragraph 1 of the Utility Model Law, -----.

Article 6-2:

1. A Patent Attorney may act as a counsel for a client in cases in specified infringement litigations where an attorney at law has been entrusted by the same client, provided that the Patent Attorney has passed a Specified Infringement Litigation Representation Examination provided for in Article 15-2, paragraph 1, and that the fact is added to the registration under Article 27-3, paragraph 1.

(2 and 3: Omitted)

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	Yes	Yes
ii) Opinion preparation concerning patent cases	Yes	Yes
iii) Representation in patent infringement litigations	Yes	Yes, if he/she is registered under Article 6-bis of Patent Attorney law.
iv) Representation in patent nullity procedures or litigations	Yes	Yes
v) Foreign patent filing and prosecution practices	Yes	Yes

Note (*4): If there are plural kinds or types of non-lawyer patent professionals (such as a patent agent, Patent Attorney, 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	Yes	Yes
ii) Opinion preparation concerning patent cases	Yes	Yes
iii) Representation in patent infringement litigations	Yes	Yes
iv) Representation in patent nullity procedures or litigations	Yes	Yes
v) Foreign patent filing and prosecution practices	No	No

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	Attorney at law (Bengoshi)	Yes	Judicial Examination Law
Non-lawyer patent professionals	Patent Attorney (Benrishi)	Yes	Article 9 of PAL

(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	8	Constitution, Administrative Law, Civil law, Civil Procedure Act, Commercial Law, Criminal Law, Criminal Procedure Act, and one selected from the prescribed eight subjects such as Intellectual Property Law, International Relation Law, Labor Law and the like.	Yes	Article 3 of Judicial Examination Law
Non-lawyer patent professionals	6	Patent Law, Utility Model Law, Design Law, Trademark Law, Treaties concerning Industrial Property and one selected from the prescribed subjects of technological subjects (e.g. basic material mechanics, basic physics, chemistry, biology, information theory) and legal subjects (e.g. civil law, civil procedure law, copyright law, unfair competition law).	Yes	Article 10 of PAL and Article 3 of Patent Attorney Enforcement Act

(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	No	
Non-lawyer patent professionals	No	

(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	No		
Non-lawyer patent professionals	No		

- (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?
 (Answer here: Yes or No)

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	-Ministry of Justice -Japan Federation of Bar Associations	Yes	Articles 4, 5, 9, 30-5, 31, 33, 45 and 56 of AALL
Non-lawyer patent professionals	-Ministry of Economy, Trade and Industry -Japanese Patent Office -Japan Patent Attorney's Association (JPAA)	Yes	Articles 10, 16-bis, 17, 31-bis, 32, 33, 54, 56, 61 and 69; Industrial Property Council Ordinance Article 1 and 2

[Contents of the law/rule]

Article 4 of AALL (Qualifications of a practicing attorney):

A person who has completed the training course for a legal apprentice shall be qualified to become a practicing attorney.

Article 5 of AALL (Exceptions to qualifications of a practicing attorney for those persons who are certified by the Minister of Justice):

Notwithstanding the provisions of the preceding Article, a person who comes under any of the following items and for whom the Minister of Justice has certified that he/she completed the training course for engaging in practice as a practicing attorney designated by the Minister of Justice, which is implemented by a juridical person specified in the Ministry of Justice Ordinance, shall be qualified to become a practicing attorney.

Article 9 of AALL (Request for registration):

A person who intends to become a practicing attorney shall make a request for registration to the Japan Federation of Bar Associations, through the bar association to which he/she intends to be admitted.

Article 30-5 of AALL (Scope of activity):

In addition to the practice set forth in Article 3, a Legal Profession Corporation may, by making provisions in its articles of incorporation, engage in all or part of the practice as those that may be practiced by a practicing attorney in accordance with laws and ordinances, as designated in a Ministry of Justice Ordinance.

Article 31 of AALL (Object and legal personality):

1. It shall be the object of a bar association, in view of the mission and duties of practicing attorneys and Legal Profession Corporations, to manage matters relating to the guidance, liaison, and supervision of members in order to maintain their dignity and improve and advance their work.

Article 33 of AALL (Articles of association):

1. A bar association shall formulate its articles of association with the approval of the Japan Federation of Bar Associations.
2. The following matters shall be stipulated in the articles of association of a bar association:
 - (3) Rules pertaining to admission of membership in or withdrawal from the association;

- (4) Rules pertaining to the Qualifications Screening Board;
- (7) Rules pertaining to the practicing attorneys' ethics and maintenance of discipline of its members;
- (8) Rules pertaining to disciplinary matters, the Disciplinary Actions Committee and the Discipline Maintenance Committee;
- (11) Rules pertaining to the training of legal apprentices;

Article 45 of AALL (Establishment, object, and legal personality):

1. All bar associations in the country shall together constitute the Japan Federation of Bar Associations.
2. The object of the Japan Federation of Bar Associations shall be, in view of the mission and duties of practicing attorneys and Legal Profession Corporations, to manage matters relating to the guidance, liaison, and supervision of practicing attorneys, Legal Profession Corporations, and bar associations, in order to maintain their dignity and improve and advance the work of practicing attorneys and Legal Profession Corporations.

Article 56 of AALL (Grounds for disciplinary action and the organ empowered to take disciplinary action):

1. A practicing attorney or Legal Profession Corporation shall be subject to disciplinary action where he/she or it violates this Law or the articles of association of the bar association to which he/she or it belongs or of the Japan Federation of Bar Associations, or damages the order or reputation of the said bar association or misbehaves in a manner impairing his/her or its own dignity, whether in the conduct of his/her professional activities or not.
2. Disciplinary action shall be taken by the bar association to which the practicing attorney or Legal Profession Corporation belongs.

Article 10 of PAL (Content of examination):

1. The examination by the short answer format shall be carried out for the following subjects:
 - (1) Laws relating to patents, utility models, designs, and trademarks (hereinafter referred to as "industrial property rights" in this Article and in the following Article, item 2);
 - (2) Treaties on industrial property rights; and

(3) Laws required for performing the services of a patent attorney as stipulated by the Ministry of Economy, Trade, and Industry Ordinance in addition to those listed in the preceding two paragraphs.

2. The examination by the essay format shall be carried out for the following subjects for persons having passed the examination by the short answer format:

(1) Laws relating to the industrial property rights and;

(2) One subject selected in advance by the examination taker from subjects relating to technologies or laws stipulated by the Ministry of Economy, Trade, and Industry Ordinance.

(3) The oral examination shall be carried out for laws relating to industrial property rights for persons having passed the written examination.

Article 16-bis of PAL (Content of Practice Training):

1. The practice training is carried out by the Minister of Economy, Trade, and Industry so that the person prescribed by each of the items of Article 7 of this law should master technique and advanced expert application ability which are needed to be a patent attorney.

Article 17 of PAL (Registration):

1. A person having qualifications as a patent attorney shall have his/her name, date of birth, location of office, and other matters stipulated by the Ministry of Economy, Trade, and Industry Ordinance registered in the Patent Attorneys Register maintained at the Japan Patent Attorneys Association in order to become a patent attorney.

Article 31-bis of PAL (Training):

1. A patent attorney should take the training for improving his/her competency provided by the Japan Patent Attorneys Association in accordance with the Ministry of Economy, Trade, and Industry Ordinance.

Article 32 of PAL (Types of disciplinary action):

When a patent attorney violates this Law or an order based on this Law, the Minister of Economy, Trade, and Industry may punish him/her as follows: (1) Admonition; (2) Suspension from practice for up to two years; and (3) Prohibition from practice.

Article 33 of PAL (Procedures for disciplinary action):

1. Any person may report the fact of a patent attorney falling under the preceding Article to the Minister of Economy, Trade, and Industry and request him/her to take suitable steps when believing there is such a fact.

Article 54 of PAL (Disciplinary action for illegal acts etc.):

1. The Minister of Economy, Trade, and Industry may admonish a Patent Profession Corporation, order the suspension of all or part of its business for a period set up to two years, or order its dissolution when deeming that the Patent Profession Corporation has violated this Law or an order based on this Law or deems its operation as significantly improper.

Article 56 of PAL (Establishment, object, and legal personality):

1. Patent attorneys shall establish a single Japan Patent Attorneys Association covering the entire country (hereinafter in this chapter referred to as the "Patent Attorneys Association," based on the stipulations of this Law.
2. The Patent Attorneys Association shall have as its object, in view of the mission and duties of patent attorneys, to manage matters relating to the guidance, liaison, and supervision of members in order to maintain the dignity of patent attorneys and improve and advance the services of patent attorneys and to manage matters relating to the registration of patent attorneys.
3. The Patent Attorneys Association shall be a judicial person.

Article 61 of PAL (Action expelling a member from the Patent Attorneys Association):

The Patent Attorneys Association may expel a member liable to harm the good order or reputation of the Patent Attorneys Association upon receiving the approval of the Minister of Economy, Trade, and Industry.

Article 69 of PAL (Report of fact falling under disciplinary action):

1. The Patent Attorneys Association shall report to the Minister of Economy, Trade, and Industry any fact of a member deemed to fall under Article 32 or Article 54.

Article 1 of Industrial Property Council Ordinance (Organization):

4. The council can have examination members, when the council considers that it is necessary to prepare questions concerning the patent attorney examination stipulated by Article 9 of PAL or the Specified Infringement Litigation Representation Examination stipulated by Article 15-bis of PAL and to evaluate the test results.

Article 2 of Industrial Property Council Ordinance (Organization):

3. The examination members are designated by the Director General of the Patent Office from among patent attorneys and men of learning and experience for carrying out patent attorney examination and Specified Infringement Litigation Representation Examination.

(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?

(Answer here: Yes or No) 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?

Table 9:

Kind or type of patent professionals	Code of conduct or vocational ethics (yes or no)	Law and/or rule basis
Lawyers	Yes	-Code of conduct training inner rule 3 -Code of conduct training regulation 2
Non-lawyer patent professionals	Yes	-Article 31-bis of PAL -Patent Attorneys Association Rule 57

[Contents of the law/rule]

Code of conduct training inner rule 3:

1. The members should attend training concerning code of conduct at the time every year as prescribed by the regulation.
2. When the member was not able to attend the training prescribed by the previous item, he/she must attend the training to be held immediately after the above training.

Code of conduct training regulation 2:

1. The members must every year attend the training concerning code of conduct to be held in the year to which the date of the registration as an attorney-at-law was made (from April 1 to March 31, next year).

Article 31-bis of PAL (Training):

A Patent Attorney must take training provided by the Patent Attorneys Association for improving the competency of such a Patent Attorney in accordance with the Ministry of Economy, Trade and Industry Ordinance.

The details of the continuance training are specifically stipulated by Continuance Training Enforcing Detailed Regulation.

Patent Attorneys Association Rule 57 (Continuance training):

1. The Association performs the following training for patent attorneys as the continuance training stipulated by Patent Attorney Law enforcing rule 25, for the purpose of that the patent attorneys should accomplish their mission and duty as a patent attorney and improve the quality of the work as a patent attorney.

(1) Training on vocational ethics;

4. Questionnaire1-4 (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?

(Answer here: Yes or No) Yes for Attorneys at law.

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	Penal Code Article 134(1)	Not more than 100,000 yen	Not more than 6 months
Non-lawyer patent professionals	Article 80 of PAL	Not more than 500,000 yen	Not more than 6 months

[Contents of the law/rule]

Article 134 of Penal Code (Unlawful Disclosure of Confidential Information):

1. When a physician, pharmacist, pharmaceuticals distributor, midwife, attorney, defense counsel, notary public or any other person

formerly engaged in such profession disclose, without justifiable grounds, another person's confidential information which has come to be known in the course of such profession, imprisonment with work for not more than 6 months or a fine of not more than 100,000 yen shall be imposed.

Article 80 of PAL:

1. Any person who violates the provisions of Article 30 ---- shall be punished by imprisonment with work service of not more than six months or by a fine of not more than five hundred thousand yen.

Article 30 of PAL (Duty to maintain secrecy):

A patent attorney or a person who was previously a patent attorney shall not divulge nor illicitly utilize secrets that he/she came to know in the performance of his/her services without legitimate grounds.

(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 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?

(Answer here: Yes or No) 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	AALL 56, 57	Yes	Yes	Order to secede from the bar association to which he/she belongs; or Disbarment.	Reprimand
Non-lawyer patent professionals	PAL 32	Yes	Yes	Prohibition of work	Reprimand

[Contents of the law/rule]

Article 56 of AALL (Grounds for disciplinary action and the organ empowered to take disciplinary action):

1. A practicing attorney or Legal Profession Corporation shall be subject to disciplinary action where he/she or it violates this Law or the articles of association of the bar association to which he/she or it belongs or of the Japan Federation of Bar Associations, or damages the order or reputation of the said bar association or misbehaves in a manner impairing his/her or its own dignity, whether in the conduct of his/her professional activities or not.
2. Disciplinary action shall be taken by the bar association to which the practicing attorney or Legal Profession Corporation belongs.
3. The grounds for a disciplinary action that a bar association may impose on a Legal Profession Corporation having a secondary office within the jurisdiction of the bar association shall be limited to those relevant to the secondary office.

Article 57 of AALL (Kinds of disciplinary action):

1. There shall be four kinds of disciplinary action against practicing attorneys, as follows:

- (1) Reprimand;
- (2) Suspension of practice for not more than two years;
- (3) Order to secede from the bar association to which he/she belongs; or
- (4) Disbarment.

2. There shall be four kinds of disciplinary action against Legal Profession Corporations, as follows:

- (1) Reprimand;
- (2) Suspension of practice of the Legal Profession Corporation or its specific law office for not more than two years;
- (3) Order to secede from the bar association to which it belongs (This action shall be limited to Legal Profession Corporations that have only a secondary law office in the region covered by the association.); or
- (4) Disbarment (This action shall be limited to Legal Profession Corporations that have their principal law office in the region covered by the association.).

3. If a bar association takes the disciplinary action set forth in Item (2) of the preceding paragraph against a Legal Profession Corporation that has only a secondary law office in the region covered by the association, it may only order the suspension of the law office located in said region.

4. In connection with the application of the provisions of Paragraph 2 or the preceding paragraph, the Japan Federation of Bar Associations shall be deemed to be a bar association in whose region the Legal Profession Corporation in question has its principal law office.

Article 32 of PAL (Types of disciplinary action):

When a patent attorney violates this Law or an order based on this Law, the Minister of Economy, Trade, and Industry may punish him/her as follows:

- (1) Reprimand;
- (2) Suspension of work for up to two years; and
- (3) Prohibition of work.

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. ?

(Answer here: Yes or No)

(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	No
What is protected from disclosure: Communication/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		

(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) Yes

(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?	Yes. Concerning IP related litigation in Japan, comprehensive obligation to testify or produce documents is stipulated under the Civil Code of Procedure (CCP) Art. 197 and Art. 220, and under Patent Act Art. 105. Notwithstanding above, patent attorneys and attorneys at law can be immune from such testimony and document production as long as the professional secrecy provision applies (CCP Art. 197 I (2), Art. 220 (4) (c)).	
What is protected from disclosure: Communications/documents?	Exempt from comprehensive obligation to testify or produce documents: -Facts obtained in the course of patent attorneys or attorneys at law's professional duties; and should be kept confidential (CCP Art.197 I(2), Art. 220 (4) (c)) -Matters relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Documents created for internal use only (CCP Art. 220 (4) (d))	
What kinds of communications are protected?	-Confidential communications containing facts provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6) -Confidential communications containing facts provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220 (4) (c), AALL Art. 3)	
What kinds of documents are protected?	-Confidential documents containing facts provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6) -Confidential documents containing facts provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220 (4) (c), AALL Art.3) -Documents relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c))	

	-Documents created for internal use only (CCP Art. 220 (4) (d))	
Is legal advice protectable?	-Confidential legal advices provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6) -Confidential legal advices provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220 (4) (c), AALL Art.3)	
Is technical advice protectable?	-Confidential technical advices provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6) -Confidential technical advices provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220 (4) (c), AALL Art.3)	
Difference if any between legal advice and technical advice	-No differences	

[Contents of the law/rule]

Article 105 (Production of documents, etc.):

- (1) In litigation concerning the infringement of a patent right or exclusive license, the court may, upon a motion of a party, order the other party to produce documents that are required to prove the said act of infringement or to calculate the damage arising from the said act of infringement; provided, however, that this shall not apply where there are reasonable grounds for the person possessing the documents to refuse production of the said documents.
- (2) When the court finds it necessary for determining whether or not there are reasonable grounds as provided in the proviso to the preceding paragraph, the court may cause the person possessing the documents to present such documents. In such a case, no person may request the disclosure of the documents presented.
- (3) In the case of the preceding paragraph, where the court finds it necessary to hear opinions by disclosing the documents as provided in the latter sentence of the preceding paragraph to make a decision concerning the existence of reasonable grounds as provided in the proviso to paragraph (1), the court may disclose the documents to the parties, etc. (the parties (or, in the case of juridical persons, their

representatives), their representatives (excluding attorneys and assistant), employees and other workers, the same shall apply hereinafter), attorneys or assistant.

(4) The preceding three paragraphs shall apply mutatis mutandis to the presentation of the subject-matter of the inspection that is required to prove the act of infringement in litigation concerning the infringement of a patent right or exclusive license.

Article 197 of CCP (Right to refuse to testify):

I. In the following cases, a witness may refuse to testify:

(1) The case set forth in Article 191(1);

(2) Where a doctor, dentist, pharmacist, pharmaceuticals distributor, birthing assistant, attorney at law (including a registered foreign lawyer (Gaikokuho-Jimu Bengoshi)), patent attorney, defense counsel, notary or person engaged in a religious occupation, or a person who was any of these professionals is examined with regard to any fact which they have learnt in the course of their duties and which should be kept secret;

(3) Cases where the witness is examined with regard to matters concerning technical or professional secrets.

II. The provision of the preceding paragraph shall not apply where a witness has been exempted from the duty to keep secret.

Article 220 of CCP (Obligation to Submit Document):

I. A holder of a document may not refuse the production thereof in the following cases:

(1) When the party himself/herself is in possession of the document to which he/she has referred in the litigation;

(2) Where the party who offers evidence may make a request to the holder of the document for the delivery or inspection of the document;

(3) Where the document has been prepared in the interest of the party who offers evidence or with regard to the legal relationships between the party who offers evidence and the holder of the document.

(4) In addition to the cases listed in the preceding three items, in cases where the document does not fall under any of the following categories:

- (a) A document stating the matters prescribed in Article 196 with regard to the holder of the document or a person who has any of the relationships listed in the items of said Article with the holder of the document;
- (b) A document concerning a secret in relation to a public officer's duties, which is, if submitted, likely to harm the public interest or substantially hinder the performance of his/her public duties;
- (c) A document stating the fact prescribed in Article 197 I(2) or the matter prescribed in Article 197 I(3) which is not exempted from the duty of secrecy;
- (d) A document prepared exclusively for use by the holder thereof (excluding a document held by the State or a local public entity, which is used by a public officer for an organizational purpose);
- (e) A document concerning a suit pertaining to a criminal case or a record of a juvenile case, or a document seized in these cases.

Note: As for the contents of Articles 4 and 6 of PAL and Article 3 of AALL, please refer to the captions below Table 1 in pages 2

to 4.

(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)

(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					
Communication					
Document					
Legal advice					
Technical advice					

[Contents of the law/rule]

(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)

–Yes, for foreign lawyers registered (Gaikokuho-Jimu-Bengoshi) in the Japan Federation of Bar Associations (JFBA) so long as legal advice is related to the law of the state of primary qualification.

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

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	-Facts obtained in the course of patent attorneys professional duties; and should be kept confidential (CCP Art.197 I(2), Art. 220 (4) (c)) -Matters relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Documents created for	-Facts obtained in the course of patent attorneys or attorneys at law's professional duties; and should be kept confidential (CCP Art.197 I(2), Art. 220 (4) (c)) -Matters relating to technical secret or	-N/A	-N/A	-Facts obtained in the course of registered foreign lawyers' professional duties concerning the law of his/her state of primary qualification; and should be kept confidential (CCP

	internal use only (CCP Art. 220 (4) (d))	trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Documents created for internal use only (CCP Art. 220 (4) (d))			Art.197 I(2), Art. 220 (4) (c) -Matters relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Documents created for internal use only (CCP Art. 220 (4) (d))
Communication	-Confidential communications containing facts provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220(4)(c), PAL Art.4, Art.6)	-Confidential communications containing facts provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220(4)(c), AALL Art. 3)	-N/A	-N/A	-Confidential communications containing facts provided by registered foreign lawyers concerning the law of his/her state of primary qualification (CCP Art.197 I (3), Art. 220(4)(c), Special Measures Act for

					Registered Foreign Lawyers)
Work product	<ul style="list-style-type: none"> -Confidential documents containing facts provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220(4)(c), PAL Art.4, Art.6) -Documents relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220(4)(c)) -Documents created for internal use only (CCP Art. 220(4)(d)) 	<ul style="list-style-type: none"> -Confidential documents containing facts provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220(4)(c), AALL Art.3) -Documents relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220(4)(c)) -Documents created for internal use only (CCP Art. 220(4)(d)) 	<ul style="list-style-type: none"> -Documents relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220(4)(c)) -Documents created for internal use only (CCP Art. 220 (4) (d)) 	-N/A	<ul style="list-style-type: none"> -Confidential documents containing facts provided by registered foreign lawyers concerning the law of his/her state of primary qualification (CCP Art.197 I (3), Art. 220(4)(c), Special Measures Act for Registered Foreign Lawyers) -Documents relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Documents created

					for internal use only (CCP Art. 220(4)(d))
Legal advice	-Confidential legal advices provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6)	-Confidential legal advices provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220 (4) (c), AALL Act Art.3)	-Written legal advices relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220(4)(c)) -Written legal advices created for internal use only (CCP Art. 220 (4) (d))	-N/A	-Confidential legal advices provided by registered foreign lawyers concerning the law of his/her state of primary qualification (CCP Art.197 I (3), Art. 220 (4) (c), Special Measures Act for Registered Foreign Lawyers)
Technical advice	-Confidential technical advices provided by patent attorneys on IP prosecutions, IP opinions, IP licenses, IP litigations (CCP Art.197 I (3), Art 220 (4) (c), PAL Art.4, Art.6)	-Confidential technical advices provided by attorneys at law on IP legal matters (CCP Art.197 I (3), Art. 220(4)(c), AALL Art.3)	-Written technical advices relating to technical secret or trade secret (CCP Art. 197 I (3), Art. 220 (4) (c)) -Written technical advices created for internal use only	-N/A	-Confidential technical advices provided by registered foreign lawyers concerning the law of the state of primary qualification (CCP Art.197 I (3), Art.

			(CCP Art. 220 (4) (d))		220 (4) (c), Special Measures Act for Registered Foreign Lawyers)
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[Contents of the law/rule]

Please refer to the contents of the laws listed below Table 13.

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					
Denied					

Table 17: Civil law countries:

Professional secrecy	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Accepted	None	None	Yes*1	None	None
Denied	None	None	None	None	None

[Comments]*1

Supreme Court decision, March 10, 2000:

The court held that the defendant can refuse to testify regarding matters relating to secrecy of technology or profession, if the disclosure of the matters would cause detrimental effects to professional activities or activities based on technology.

Supreme Court decision, November 12, 1999:

The court held that the document (the circular intended to get the approval of a decision in a certain bank) was prepared exclusively for use by the holder thereof and can be protected. The test for “exclusively for use by the holder thereof” is to evaluate the followings:

- (1) sole purpose of internal use
- (2) not expected to be disclosed to third parties, and
- (3) disclosure would seriously harm Clients who possess documents, such as impeding decision making process.

End