

(Ver15)

**Questionnaire concerning Client privilege
(APAA Group Name: NEW ZEALAND)**

Date: 20th October 2009

Prepared By: Tom Robertson

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	<i>Lawyers & Barristers</i>	<i>Lawyers and Conveyancers Act 2006</i>
Non-lawyer patent professionals	<i>Patent Attorneys</i>	<i>s101 & s103 of the NZ Patents Act 1953</i>

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	<i>Yes</i>	<i>Yes</i>
ii) Opinion preparation concerning patent cases	<i>Yes</i>	<i>Yes</i>
iii) Representation in patent infringement litigations	<i>Yes</i>	<i>No, however able to assist Lawyer/Barrister</i>
iv) Representation in patent nullity procedures or litigations	<i>Yes</i>	<i>Yes if matter is heard before Patent Office, otherwise no if matter is before the courts</i>
v) Foreign patent filing and prosecution practices	<i>Yes</i>	<i>Yes</i>

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.

*** An NZ Lawyer is able to practice in any area of law, including IP, however a Lawyer cannot call themselves a Patent Attorney, unless they are actually a registered Patent Attorney.*

(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	<i>Yes</i>	<i>Yes</i>
ii) Opinion preparation concerning patent cases	<i>Yes</i>	<i>Yes</i>
iii) Representation in patent infringement litigations	<i>Yes</i>	<i>No, however able to assist Lawyer/Barrister</i>
iv) Representation in patent nullity procedures or litigations	<i>Yes</i>	<i>Yes if matter is heard before Patent Office, otherwise no if matter is before the courts</i>
v) Foreign patent filing and prosecution practices	<i>Yes</i>	<i>Yes</i>

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	<i>Lawyer</i>	<i>Yes</i>	<i>Law Degree</i>
Non-lawyer patent professionals	<i>Patent Attorney</i>	<i>Yes</i>	<i>s100 of the NZ Patents Act 1953</i>

(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	<i>22 to 28 subject papers</i>	<i>Compulsory subjects include: Legal Systems, Contract, Torts, Public Law, Criminal Law, Legal Ethics and Property Law</i>		<i>Lawyers and Conveyancers Act 2006</i>
Non-lawyer patent professionals	<i>Five</i>	<i>Patents (includes Designs and Copyright), Trade Marks, Foreign Law, Patent Drafting and Patent Interpretation and Criticism</i>	<i>No</i>	<i>S100 Patents Act 1953 and Reg 158 NZ Patent Regulations 1954</i>

Note under the Trans Tasman Mutual Agreement between New Zealand and Australia a registered Patent Attorney can be registered as a New Zealand Attorney without having to sit the NZ Patent Attorney exams. Similarly a NZ registered Patent Attorney is able to be registered as an Australian Patent Attorney without having to sit the AU exams.

(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	<i>Yes</i>	
Non-lawyer patent professionals	<i>No</i>	

(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	<i>No</i>		
Non-lawyer patent professionals	<i>No anyone can sit and pass the exams at anytime, however can only be registered as a NZ Patent Attorney once having completed working in the profession (or equivalent) in New Zealand for three years</i>		<i>Reg 156 NZ Patents Regulations 1954</i>

(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) *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	<i>New Zealand Council of Legal Education.</i>		<i>Lawyers and Conveyancers Act 2006</i>
Non-lawyer patent professionals	<i>Mainly NZ Patent Office (IPONZ), however the NZ Institute of Patent Attorneys does assist with the Patent Attorney Examination</i>	<i>n/a</i>	<i>S100 NZ Patents Act 1953</i>

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

(3) As 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) *No*

(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	<i>No</i>	
Non-lawyer patent professionals	<i>No</i>	

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*

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	<i>Yes. Obligations in regards to confidential information are covered by the Lawyers and Conveyancers Act (Lawyers - Conduct and Client Care) Rules 2008.</i>	<i>The penalty that applies is determined by the Lawyers and Conveyancers Act (Disciplinary Tribunal) Regulations 2008.</i>	<i>n/a</i>
Non-lawyer patent professionals	<i>Yes</i>	<i>Patent Attorney registration can be cancelled</i>	<i>S102 NZ Patents Act 1953</i>

(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)?

(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	<i>Lawyers and Conveyancers Act 2006 (Disciplinary Tribunal) Regulations 2008</i>	<i>Matters can be heard before a Disciplinary Tribunal</i>	<i>Yes</i>	<i>Yes a Lawyer can be struck off</i>	
Non-lawyer patent professionals	<i>S102 NZ Patents Act 1953</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	

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) *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	No
What is protected from disclosure: Communication/documents?	<i>legal services and legal advice that is intended to be confidential</i>	

What kinds of communications are protected?	<i>Verbal, written, electronic</i>	
What kinds of documents are protected?	<i>Documentation that falls into the category of legal advice or legal services from a legal advisor (a legal advisor means a lawyer, registered patent attorney and oversease practitioner</i>	
Is legal advice protectable?	<i>Yes</i>	
Is technical advice protectable?	<i>Yes</i>	
Difference if any between legal advice and technical advice	<i>No</i>	

*** Section 54 of Evidence Act 2006

. *Privilege for communications with legal advisers*

(1) A person who obtains professional legal services from a legal adviser has a privilege in respect of any communication between the person and the legal adviser if the communication was—

(a) intended to be confidential; and

(b) made in the course of and for the purpose of—

(i) the person obtaining professional legal services from the legal adviser; or

(ii) the legal adviser giving such services to the person.

*(2) In this section, **professional legal services** means, in the case of a registered patent attorney or an overseas practitioner whose functions wholly or partly correspond to those of a registered patent attorney, obtaining or giving information or advice concerning intellectual property.*

(3) In subsection (2), **intellectual property** means 1 or more of the following matters:

(a) literary, artistic, and scientific works, and copyright:

(b) performances of performing artists, phonograms, and broadcasts:

(c) inventions in all fields of human endeavour:

(d) scientific discoveries:

(e) geographical indications:

(f) patents, plant varieties, registered designs, registered and unregistered trade marks, service marks, commercial names and designations, and industrial designs:

(g) protection against unfair competition:

(h) circuit layouts and semi-conductor chip products:

(i) confidential information:

(j) all other rights resulting from intellectual activity in the industrial, scientific, literary, or artistic fields.

(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) *No*

(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.

Under NZ Law overseas practitioners are protected and recognized for the purposes of client privilege. Section 51 of the Evidence Act 2006 defines a legal advisor a meanings

(a) a lawyer; or

(b) a registered patent attorney; or

(c) an overseas practitioner.

overseas practitioner as defined in Section 51 of the Evidence Act 2006 means—

(a) a person who is entitled to practise as a barrister, or a solicitor, or both in the High Court of Australia or in a Supreme Court of a State or a territory of Australia; or

(b) a person who is entitled to practise in Australia as a registered patent attorney or as a registered trade marks attorney; or

(c) a person who is, under the laws of a country specified by an Order in Council made under this section, entitled to undertake work that, in New Zealand, is normally undertaken by a lawyer or a patent attorney.

The countries for which paragraph (c) of this definition applies are listed in the Evidence (Recognition of Overseas Practitioners) Order 2008. This list includes some 86 countries.

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	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>
Communication	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>
Document	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>
Legal advice	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>

Technical advice	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>	<i>Yes</i>
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[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)

(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					
Communication					
Work product					
Legal advice					
Technical advice					

[Contents of the law/rule]

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	1, 4, 5				
Denied	3	2			

(1) 6tclr592 Yves St Laurent Parfums v Louden Cosmetics Ltd (No 3) – 26 July 1995

The plaintiff and the defendant were perfume manufacturers involved in litigation over packaging and branding details for various products. The defendants had set themselves up to offer products similar to those of the plaintiff's brand, but as cheaper alternatives.

The defendant was ordered to file an affidavit of further discovery, complying with the High Court Rules. The affidavit filed did not comply with the Rules as directed, and the defendant failed to produce a list of documents in date order with a key to their identity. In the affidavit it was deposed that the defendant had no relevant documents which had not already been produced. The affidavit stated that the defendant had consulted its solicitors, both in England and New Zealand, for advice regarding packaging and branding, and that these documents were privileged. However, in clause 11 of the affidavits, this privilege was waived and these documents were produced, some fully, others with portions blacked out.

The High Court held that section 34 of the Evidence Amendment Act (No 2) 1980 confers privilege on the advice of registered patent attorneys in New Zealand. Although the English firm of trade-mark agents consulted by the defendant would not be covered by the New Zealand legislation, it is likely that the Court would exercise its discretion under section 35 of the Evidence Amendment Act (No 2) 1980 and confer privilege on communications between patent and trade-mark attorneys in England and their clients which were made for the purpose of obtaining advice on matters covered by this litigation. On the wording of clause 11 of the affidavit there was a waiver of all privilege in relation to all of the defendant's documents to and from its solicitors requesting advice on whether the packaging used was distinct from the proprietary brand. The waiver was not required, but having given it, the defendant was required to produce the documents in their entirety to the Court. A decision would then be made as to whether they should be discovered to the plaintiff.

(2) 7tclr294 Hight v TV3 Network Ltd – 13 June 1996

This proceeding related to a discovery application. The discovery application related to a large number of documents. Rather than ask the Judge to inspect the documents, or even a sample of them, the Judge considered a question put by counsel, namely:

"Whether notes made by a solicitor of his or her telephone conversations or meetings with, or including persons, other than the solicitor's client, are privileged if they were made by the solicitor for the purpose of providing confidential legal advice to his or her client."

The High Court held that while there has been a widening of the documents which might have privilege claimed for them, not every document made by a solicitor loosely on instructions for a client ought necessarily to have privilege attached to it. Notes of the kind referred to in the question are privileged if the notes were made pursuant to a brief which had been received from the client. If, on the other hand, they were made simply to record what was said, there being no brief for particular work to be done, then no privilege attached.

(3) 9tclr498 Rio Beverages Ltd v Frucor Beverages Ltd – 6 December 1999

The plaintiff, a fruit drink manufacturer, had issued proceedings against the defendant, another such manufacturer, for passing-off and breach of the Fair Trading Act 1986. The defendant claimed a number of its documents were privileged under section 34 of the Evidence Amendment Act (No 2) 1980 as patent

attorney–client communications made for the purpose of obtaining or giving advice on trade marks or trade mark applications. Solicitor-client privilege was not invoked by the defendant. It was common ground that communications between patent attorneys and their clients are not privileged at common law.

The Court held that section 34 does not create a statutory privilege as between patent attorneys and their clients and others, or at least not in the general sense created by the UK and Australian statutes and by solicitor-client privilege. It creates a prohibition on disclosure by registered patent attorneys and others of communications which come within the ambit of the section. There being no common law privilege, a communication must come within the terms of section 34 or be disclosed. Being a statutory prohibition on disclosure, the well recognised exceptions to solicitor-client or legal professional privilege do not apply. The Court's interpretation of section 34 does not inevitably lead to an order for production in relation to documents for which privilege is claimed under section 34. In the first place, an order for production is discretionary under r 307(1) High Court Rules and the Court is debarred from making an order under reg. 307 unless it is necessary. Secondly, section 35 of the Evidence Amendment Act (No 2) 1980 may be applicable to the facts under consideration. The Court also observed that while the limited scope of privilege under section 34 may cause concern to patent attorneys and their clients, any broadening of the prohibition would appear to lie with Parliament having regard to the plain words of the section. The discovery application was adjourned part-heard for the parties to consider their positions in the light of the Court's ruling as to the ambit of section 34 of the Evidence Amendment Act (No 2) 1980.

(4) 10tclr1 Frucor Beverages Ltd v Rio Beverages Ltd – 22 March 2001

The appellant and respondent were fruit beverage manufacturers. The respondent marketed a beverage under the trade mark "c2" and the appellant intended to market a similar beverage in Australia under the trade mark. The respondent had issued proceedings alleging passing off, breach of the Fair Trading Act 1986, and conspiracy. As a result of a ruling by Williams J (reported at (1999) 9 TCLR 498), the appellant had been directed to produce for inspection certain documents, communications with its patent attorney relating to trade marks or applications for them. This was because the Court ruled that section 34 of the Evidence Amendment Act (No 2) 1980 does not confer statutory privilege for the patent attorney-client relationship in the same way that privilege exists between solicitor and client, that is, the client was not protected. In 1977 the Torts and General Law Reform Committee presented a report on professional privilege in evidence law which recommended, among other things, that communications to and from patent attorneys be protected in the same way as communications between solicitor and client. This was a recognition that "a legal quality permeates all [a patent attorney's] work". When in 1979 the relevant

Bill to amend the Evidence Act 1908 was introduced, the explanatory note began by saying the Bill implemented the committee's recommendations. It went on to say clause 41 (which became section 34) set out the privilege over communications relating to patents, trade marks, and designs but that it was "framed in a different manner" from what the committee had recommended. The explanatory note also said of the clause 41 privilege that "the Bill attempts to prescribe the privilege in its own terms". Section 34 appears in Part III of the Evidence Amendment Act (No 2) 1980, dealing with the privilege of witnesses. Section 35 gives a general discretion to the Court to excuse a witness from breaking a confidence. In the High Court Williams J appeared to take the approach that sections 34 and 35 should be read together and provided a legislative scheme.

On appeal the appellant submitted that by implication section 34 did confer on such communications a privilege between client and patent attorney because it was the policy of the Act. The respondent submitted that the words of section 34 were incapable of any such meaning. However, the respondent did not claim legal professional privilege for the documents in issue and it was not disputed that the common law offered no protection in respect of communications between patent attorneys and their clients.

The Court of Appeal allowed the appeal, holding that a purposive interpretation is required to give effect to Parliament's will. A problem existed relating to the confidentiality of communications between patent attorneys and their clients. If the literal meaning of section 34 is adopted, Parliament will not have dealt with the problem or mischief giving rise to concern. Rather, it will have enacted a provision for which there is no sound rationale and which is anomalous, illogical, and futile in terms of Parliament's objective. No such absurd intention should be attributed to Parliament. Moreover, the practical consequences will be inconvenient and confusing, and Parliament should not be thought to have intended to create those consequences. The Court should also bear in mind that patent attorneys and their clients appear to have relied on and acted on the assumption that Parliament has done what it set out to do, and done what it said it was doing in the explanatory note to the Bill. The justification for a purposive interpretation is compelling. The Court of Appeal held that while it is true that there are no particular words in section 34 which are ambiguous or obscure, in this case the purposive interpretation must be founded on the section read as a whole. The section must be read as implicitly giving clients protection against having to disclose the category of documents defined in section 34(4). It would frustrate Parliament's intended purpose not to give effect to it merely because there are no particular words or phrases that are ambiguous or obscure to which the purposive interpretation can be attached.

(5) 66ipr661 Pfizer Ireland Pharmaceuticals v Eli Lilly – 4 August 2005

In the course of patent infringement and patent revocation proceedings, the defendant (Lilly) sought orders for the production and inspection of three documents. The disputed documents were part of a series disclosed in the plaintiffs' list of documents referring to investigations by Pfizer to ascertain whether a field of use claim might be filed in respect of its compound sildenafil citrate. The disputed documents summarised responses to a Pfizer in-house patent agent from patent agents in a series of different jurisdictions. Edited versions had been supplied to the defendants and the court showing the headings of the summary of responses but not the contents of the responses.

*Lilly contended that the whole of the disputed documents including all the responses from foreign patent agents were relevant and the Court should use its power to inspect the documents if there was any doubt as to relevance. In relation to Pfizer's claim to patent attorney privilege in respect of the New Zealand content of the documents, Lilly contended that section 34 of the Evidence Amendment Act (No 2) 1980 did not protect this information because section 34(4) provides that "protected information or advice" means information or advice "relating to any patent . . . or to . . . any application in respect of a patent". Lilly contended that, as the patent attorney advice had been sought in advance of any patent application being filed, there was no application to which the advice from the New Zealand patent attorneys could relate. As an alternative, Lilly argued that if privilege pertained, Pfizer had waived this. The disputed documents were part of a continuum and privilege should be waived on fairness grounds pursuant to the "cherry picking" principles in *Nea Karteria Maritime Co Ltd v Atlantic & Great Lakes No 2 [1981] Com LR 138*. Finally Lilly argued that, if privilege as to the New Zealand content of the disputed documents was upheld, the balance of the information of the documents should be produced on the grounds that it was relevant and not privileged.*

Pfizer contended that:

(a) In so far as the documents contained information and advice from New Zealand patent attorneys this was relevant but privileged under the patent attorney privilege in section 34. The advice provided by its New Zealand patent attorneys was clearly intended as a prelude to a PCT patent application lodged soon after the disputed documents and on its face "related" to that intended application. It further pointed to the absurdity of an interpretation which would require a client to file an application for a patent before advice on it or in respect of it could be privileged. It was a very common experience that substantial advice is sought from local advisers before the application is filed so that a purposive construction of section 34(4) was required. Pfizer contested the claim to waiver of privilege or "cherry picking". It had given discovery as required by the High

Court Rules and had consistently maintained its claim to confidentiality and privilege. It had not sought to deploy or use or rely on the disputed documents.

(b) The documents were not relevant insofar as they contained information or advice from overseas patent attorneys. That advice had no relevance to the current proceedings which were directed to Pfizer's New Zealand patents.

The High Court dismissed the discovery application holding that:

Relevance

(i) As to relevance, the only relevant parts of the disputed documents were those relating to advice from New Zealand patent attorneys. The responses from agents in other jurisdictions as to the possibility of registering broad field of use claims in those jurisdictions did not have any or sufficient relevance to the matters in issue.

Patent Attorney privilege

(ii) As to patent attorney privilege in section 34 the words . . . relating to any patent . . . or any application in respect of a patent . . . whether or not the information or advice relates to a question of law" were sufficiently broad to include under the ambit of "protected information or advice", information or advice that relates to an application in its putative or formative stages. Here the communication "related to" the patents in suit. The advice was sought and given in the context of the intended prosecution of the PCT patent application.

Waiver of privilege

(iii) References in material properly disclosed on discovery to the fact that Pfizer had sought and received advice from its New Zealand patent attorneys did not constitute use or deployment of the privileged advice. Reference to the existence of privileged material did not enable Lilly to access the substance and content of the advice (in respect of which Pfizer claimed privilege).

(iv) The so called rule against "cherry picking" did not assist Lilly. Here Pfizer had not sought to use or deploy the disputed documents. It had simply disclosed a sequence of relevant communications and claimed that privilege to which it was entitled in relation to the New Zealand patent attorney information and advice. There had been no collateral or imputed waiver of privilege.

Table 17: Civil law countries:

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