

(Ver16)

**Questionnaire concerning Client privilege  
(APAA Group Name: SINGAPORE)**

Date: 21 October 2009

Prepared By: NG KIM TEAN

**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	Advocate and Solicitor	Patents Act Section 105
Non-lawyer patent professionals	Patent Agent	Patents Act Section 105

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]**

**Persons entitled to act as patent agents, etc.**

**105.** --(1) An individual shall not carry on a business, practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

[30/2001]

(5) An individual shall not —

- (a) carry on a business under any name or other description which contains the words “patent agent”; or
- (b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “patent agent”, unless he is a registered patent agent who has in force a practising certificate.

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	NO
iv) Representation in patent nullity procedures or litigations	YES	NO <b>(YES, for revocation matters before the Registrar)</b>
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, Benrishi, etc), then please indicate the scope of professional work, respectively. The above is also applied to the following questions below.

**[Contents of the Law/Rule]**

**Patents (Patent Agent Rules) Section 2 Interpretation**

"patent agency work" means any of the following types of work:

- (a) applying for, or obtaining, a patent in Singapore or elsewhere;
- (b) preparing specifications or other documents for the purposes of the Act or the patent law of another country;
- (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of a patent;

**Patents Act Section 105**

(4) For the purposes of this section, a person is taken to carry on a business, practise or act as a patent agent if, and only if, the person does, or undertakes to do, on behalf of someone else, any of the following in Singapore for gain:

- (a) applying for or obtaining patents in Singapore or anywhere else;
- (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country; or
- (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

(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	NO
iv) Representation in patent nullity procedures or litigations	YES	NO (YES, for revocation matters before the Registrar)
v) Foreign patent filing and prosecution practices	YES	YES

**[Contents of the Law/Rule]**

**Patents Act Section 105**

(13) This section shall not be construed as prohibiting an advocate and solicitor from taking part in proceedings relating to patents and applications for patents and, in particular, shall not derogate from section 93 as it applies to advocates and solicitors.

(14) No offence is committed under section 33 of the Legal Profession Act (Cap. 161) by any person by reason only of the preparation by him of a document (other than a deed) for use in proceedings before the Registrar in relation to any patent or application for a patent.

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	Advocate and Solicitor	Yes for qualification as an Advocate and Solicitor (Postgraduate Practical Law Course or Part B of the Singapore Bar Examinations)	Section 105 Patents Act read with [S12(1)(d) and (e) of the Legal Profession Act read with Rule 11(1) and (1A) of the Legal Profession Rules]
Non-lawyer patent professionals	Patent Agent	YES	Rule 6 Patent (Patent Agent) Rules

**[Contents of the Law/Rule]**

**Qualifications for admission**

12. —(1) Subject to section 15, no qualified person shall be admitted as an advocate and solicitor unless he —

- (a) has attained the age of 21 years;
- (b) is of good character;
- (c) has satisfactorily served the practice training period applicable to him, and has, during that period, received such supervised training in relation to the practice of Singapore law as may be prescribed by the Board;
- (d) has attended and satisfactorily completed such courses of instruction as may be prescribed by the Board;
- (e) has passed such examinations as may be prescribed by the Board; and

[35/2001]

(f) has kept such dining terms as may be prescribed by the Board.

**Persons entitled to act as patent agents, etc.**

**105.** —(1) An individual shall not carry on a business, practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

[30/2001]

(5) An individual shall not —

- (a) carry on a business under any name or other description which contains the words “patent agent”; or
- (b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “patent agent”, unless he is a registered patent agent who has in force a practising certificate.

**Entitlement to registration**

**6.** Subject to rules 7 and 8, an individual is entitled to be registered as a patent agent if he —

- (a) is resident in Singapore;
- (b) holds a university degree or equivalent qualification approved by the Registrar;
- (c) has passed the course specified in Part I of the Third Schedule;
- (d) has passed the examination specified in Part II of the Third Schedule; and
- (e) has completed internship in patent agency work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule, for —
  - (i) a continuous period of at least 12 months; or
  - (ii) a total period of at least 12 months within a continuous period of 24 months.

(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	Not Applicable	Not applicable	NO	Section 105 Patents Act
	7 for Postgraduate Practical Law Course conducted by the Board of Legal Education	<ol style="list-style-type: none"> <li>1. Criminal Procedure</li> <li>2. Civil Procedure</li> <li>3. Commercial Practice</li> <li>4. Family Law and Probate</li> <li>5. Professional Responsibility</li> <li>6. Conveyancing</li> <li>7. Legal Skills</li> </ol>	<u>No</u>	S12(1)(d) and (e) of the Act read with Rule 11(1) and (1A) of the Legal Profession Rules



	<p>14 compulsory modules for LL.B Hons from the National University of Singapore</p>	<p>For LLB.Hons:</p> <p><b>1st Year Compulsory Courses (40 credits)</b></p> <ol style="list-style-type: none"> <li>1. Law of Contract</li> <li>2. Law of Torts</li> <li>3. Legal Analysis, Writing &amp; Research I</li> <li>4. Singapore Legal System</li> <li>5. Criminal Law</li> <li>6. Introduction to Legal Theory</li> <li>7. Legal Analysis, Writing &amp; Research II</li> </ol> <p><b>2nd Year Compulsory Courses</b></p> <ol style="list-style-type: none"> <li>1. Company Law</li> <li>2. Comparative Legal Traditions</li> <li>3. Principles of Property Law</li> <li>4. Introduction to Trial Advocacy</li> <li>5. Equity &amp; Trusts</li> <li>6. Public Law</li> <li>7. Legal Case Studies</li> </ol>	<p>Yes</p>	<p>Part II of the LEGAL PROFESSION ACT (CHAPTER 161, SECTION 2 (2)) Legal Profession (Qualified Persons) Rules</p>
--	--	---	------------	--

	17 Law Core Course modules for LL.B (Hons) from the Singapore Management University	<ol style="list-style-type: none"> <li>1. Commercial Conflict of Laws</li> <li>2. Comparative Legal Systems</li> <li>3. Constitutional &amp; Administrative Law (1.5 course unit)</li> <li>4. Contract Law 1</li> <li>5. Contract Law 2</li> <li>6. Corporate Law</li> <li>7. Criminal Law (1.5 course unit)</li> <li>8. Economic Analysis of Law</li> <li>9. Law &amp; Regulation</li> <li>10. Law of Business Organisations</li> <li>11. Law of Equity &amp; Trusts (1.5 course unit)</li> <li>12. Law of Evidence &amp; Civil Procedure (1.5 course unit)</li> <li>13. Law of Property (1.5 course unit)</li> <li>14. Law of Torts (1.5 course unit)</li> <li>15. Legal Research &amp; Writing</li> <li>16. Legal System, Legal Method &amp; Analysis</li> <li>17. Legal Theory &amp; Philosophy</li> </ol>	Yes	Part II of the Legal Profession Act (Chapter 161, Section 2 (2)) Legal Profession (Qualified Persons) Rules
Non-lawyer patent professionals	9	<ol style="list-style-type: none"> <li>1. General Introduction to Law</li> <li>2. Law of Trade Marks and Unfair Competition</li> <li>3. Law of Copyright and Designs</li> <li>4. Law of Patents and Trade Secrets</li> <li>5. Special Topics</li> <li>6. Drafting of Patent Specification</li> <li>7. Amendment of Patent Specification</li> <li>8. Interpretation and Validity of a Patent Specification</li> <li>9. Singapore Patent Law</li> </ol>	NO	Rule 6 Patent (Patent Agent) Rules

(iii) Does the test cover a code of conduct or vocational ethics? NO

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	Professional Ethics. Legal Professional Conduct Rule
Non-lawyer patent professionals	NO	

**[Contents of the Law/Rule]**

(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, for admission as an Advocate and Solicitor	6 months practice training contract	s.13 Legal Profession Act
Non-lawyer patent professionals	YES	a continuous period of at least 12 months; or (ii) a total period of at least 12 months within a continuous period of 24 months.	Rule 6 Patent (Patent Agent) Rules

**[Contents of the Law/Rule]**

**Service of practice training period**

**13.** —(1) A qualified person shall serve his practice training period, and receive supervised training in relation to the practice of Singapore law during that period —

(a) under a practice training contract;

(b) through working —

(i) as a Legal Service Officer; or

(ii) under the supervision of a relevant legal officer (referred to in this section and section 14 as a qualifying relevant legal officer) who is an advocate and solicitor of not less than 5 years' standing and who, for a total of not less than 5 out of the 7 years immediately preceding the date of commencement of the supervised training, has been a relevant legal officer or has been in active practice in a Singapore law practice or both;

(c) under 2 or more practice training contracts;

(d) through working under the supervision of 2 or more qualifying relevant legal officers;

(e) partly through working as a Legal Service Officer and partly through working under the supervision of one or more qualifying relevant legal officers;

(f) partly under one or more practice training contracts and partly through working as a Legal Service Officer or under the supervision of one or more qualifying relevant legal officers; or

(g) partly under one or more practice training contracts, partly through working as a Legal Service Officer and partly through working under the supervision of one or more qualifying relevant legal officers.

**Persons entitled to act as patent agents, etc.**

**105.** —(1) An individual shall not carry on a business, practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

*[30/2001]*

(5) An individual shall not —

(a) carry on a business under any name or other description which contains the words “patent agent”; or

(b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “patent agent”, unless he is a registered patent agent who has in force a practising certificate.

**Entitlement to registration**

**6.** Subject to rules 7 and 8, an individual is entitled to be registered as a patent agent if he —

- (a) is resident in Singapore;
- (b) holds a university degree or equivalent qualification approved by the Registrar;
- (c) has passed the course specified in Part I of the Third Schedule;
- (d) has passed the examination specified in Part II of the Third Schedule; and
- (e) has completed internship in patent agency work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule, for —
  - (i) a continuous period of at least 12 months; or
  - (ii) a total period of at least 12 months within a continuous period of 24 months.

**Entitlement to registration**

6. Subject to rules 7 and 8, an individual is entitled to be registered as a patent agent if he —

- (a) is resident in Singapore;
- (b) holds a university degree or equivalent qualification approved by the Registrar;
- (c) has passed the course specified in Part I of the Third Schedule;
- (d) has passed the examination specified in Part II of the Third Schedule; and
- (e) has completed internship in patent agency work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule, for —
  - (i) a continuous period of at least 12 months; or
  - (ii) a total period of at least 12 months within a continuous period of 24 months.

(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?

Ministry of Law and Intellectual Property Office of Singapore (IPOS)

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	Law Society of Singapore, Singapore Academy of Law, Supreme Court of Singapore	YES	
Non-lawyer patent professionals	Ministry of Law, IPOS	YES	Section 104 (Patents Act), Rule 5, Patents (Patent Agents) Rules 2001

**[Contents of the Law/Rule]**

**Registration of patent agents**

**104.** —(1) The Minister may make rules for the registration of individuals as patent agents.

*[30/2001]*

(2) Without prejudice to the generality of subsection (1), the rules may provide —

(a) for the keeping, by such person as the Minister may determine, of a register of patent agents;

- (b) for the form and manner of application for registration as a patent agent, the qualifications and other requirements for registration, the fees payable for registration, and the conditions of registration;
- (c) for the issue of practising certificates to registered patent agents;
- (d) for the correction of errors and updating of entries in the register of patent agents; and
- (e) for transitional matters in relation to the registration of individuals as patent agents, and exclude or vary the operation of this Act in relation to such transitional matters.

*[30/2001]*

(3) The rules may make provision to regulate the professional conduct of registered patent agents and their practice and, for that purpose, may make provision for and in relation to all or any of the following:

- (a) making complaints against registered patent agents and hearing and deciding upon such complaints;
- (b) imposing penalties on registered patent agents, including issuing a reprimand, and suspending or cancelling registration;
- (c) summoning witnesses;
- (d) receiving evidence from persons on oath or affirmation;
- (e) administering oaths or affirmations to persons giving evidence;
- (f) requiring persons to produce documents or articles;
- (g) restoring any registration that has been cancelled and lifting the suspension imposed on any registration.

*[30/2001]*

(4) The rules may provide that a contravention of the rules shall be an offence and may provide penalties not exceeding a fine of \$5,000 or imprisonment for a term not exceeding 12 months or to both.

### **Register of patent agents**

**5.** —(1) The Registrar shall keep and maintain a register of patent agents which shall contain —

- (a) the names and practice addresses in Singapore of all individuals registered as patent agents under these Rules;



- (b) the dates of their registration;
- (c) the terms of practising certificates issued to them (if any); and
- (d) such of their other particulars as the Registrar may determine.

(2) The register need not be kept in documentary form.

(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) 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	NO	
Non-lawyer patent professionals	NO	

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) 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	Not Applicable	NO	NO
Non-lawyer patent professionals	Not Applicable	NO	NO

(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	Legal Profession Act	YES	YES	YES	Fine
Non-lawyer patent professionals	Rules 17 and 20 Patents (Patent Agents) Rules	YES	YES	YES	Reprimand or other order as it considers appropriate

**[Contents of the Law/Rule]**

**Complaint against registered patent agent**

17. (1) The Registrar or any person (referred to in this Part as the complainant) may make a complaint or provide information to the Disciplinary Committee that a registered patent agent (referred to in this Part as the affected person)—

- (a) has been convicted of a criminal offence implying a defect of character which makes him unfit for his profession;

- (b) has been guilty of fraudulent or grossly improper conduct in carrying out his professional duties;
- (c) has been adjudicated bankrupt and has been guilty of any of the acts mentioned in section 124 (5) (a), (b), (c), (d), (e), (f), (h), (i), (k), (l) or (m) of the Bankruptcy Act (Cap. 20);
- (d) has allowed any person who is not a registered patent agent to carry out any patent agency work in his name, where that other person was not under his direct and immediate control and supervision when carrying out the work;
- (e) has obtained registration as a patent agent or a practising certificate by fraud or misrepresentation;
- (f) has breached any condition to which his registration or the issue of his practising certificate is subject, or has breached any undertaking made to the Registrar; or
- (g) has been guilty of conduct unbecoming a member of his profession.

(2) Any complaint or information made or given by any person other than the Registrar shall be forwarded to the Registrar and shall —

- (a) be in Form F;
  - (b) state the name of the affected person and his address, if known;
  - (c) state the nature of the complaint;
  - (d) state the name and address of the complainant;
  - (e) be signed by the complainant; and
  - (f) be accompanied by —
    - (i) a statutory declaration verifying the facts on which the complainant relies in support of his complaint or information; and
    - (ii) the applicable fee in the First Schedule, which is refundable at the end of the inquiry of the Disciplinary Committee unless it otherwise determines under rule 18 (5).
- (3) The Registrar shall forward the matters received under paragraph (2) to the Disciplinary Committee.
- (4) The Disciplinary Committee may require the complainant to provide such further information or document as it may consider necessary for its inquiry and may, if he fails without lawful excuse to do so, dismiss the complaint or matter.

### **Powers of Disciplinary Committee upon inquiry**

**20.** (1) Where, upon due inquiry into the complaint or matter, the Disciplinary Committee is satisfied that the affected person has been convicted or guilty of any of the matters referred to in rule 17 (1) (a) to (g), it shall —

- (a) reprimand the affected person;
- (b) order that his registration as a patent agent be suspended for a period not exceeding 12 months;
- (c) order that his registration as a patent agent be cancelled; or
- (d) make such other order as it considers appropriate.

(2) The Disciplinary Committee may, in addition to the facts of the complaint or matter, take into account any past conduct of the affected person in order to determine what order should be made.

(3) Where, upon due inquiry into the complaint or matter, the Disciplinary Committee is not satisfied that the affected person has been convicted or guilty of any of the matters referred to in rule 17 (1) (a) to (g), it shall dismiss the complaint or matter.

(4) The Disciplinary Committee shall serve notice of its decision on the Registrar, the affected person and the complainant (if he is not the Registrar).

(5) If the Disciplinary Committee orders that the registration of the affected person be suspended, the Registrar shall enter the order and the period of suspension in the register.

(6) If the Disciplinary Committee orders that the registration of the affected person be cancelled, the Registrar shall remove the name and other particulars of the affected person from the register.

**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 11 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? YES

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?	Documents or information exchanged between a solicitor and his client are exempted from disclosure.	Section 128 Evidence Act (2) Nothing in this section shall protect from disclosure: (a) Any such communication made in furtherance of an illegal activity; (b) any fact observed by an advocate or solicitor in the course of his employment as such showing that any crime or fraud has been committed since the commencement of employment.
What kinds of communications are protected?	Any communication with respect to any	

	<p>matter relating to patents:</p> <p>(a) between a person and his registered patent agent; or</p> <p>(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent,</p> <p>is privileged from disclosure in legal proceedings. Sections 94 and 95 Patents Act</p>	
What kinds of documents are protected?	Limited discovery of an alleged infringing process that is a trade secret.	
Is legal advice protectable?	YES	
Is technical advice protectable?	YES	
Difference if any between legal advice and technical advice	No difference.	

(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)

(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.

**Privilege for communications with patent agents**

**Patents Act Section 95.** -(1) A communication with respect to any matter relating to patents —

(a) between a person and a registered patent agent, a partnership entitled under Part XIX to describe itself as a firm of patent agents or a body corporate entitled under Part XIX to describe itself as a patent agent; or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent, is privileged from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

(2) In this section, "legal proceedings" includes proceedings before the Registrar.

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		
Communication	YES	YES	YES		
Document	YES	YES	YES		
Legal advice	YES	YES	YES		
Technical advice	YES	YES	YES		

**[Contents of the law/rule]**

**Extension of privilege for communications with solicitors relating to patent proceedings**

**94.** —(1) It is hereby declared that the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an advocate and solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to an advocate and solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in Singapore extends to such communications so made for the purpose of any pending or contemplated proceedings before the Registrar under this Act.

(2) In this section, "legal proceedings" includes proceedings before the Registrar; and references to "legal proceedings" and "pending or contemplated

proceedings” include references to applications for a patent and to international applications for a patent.

[*UK Patents 1977, s. 103*]

### **Privilege for communications with patent agents**

**95.** —(1) A communication with respect to any matter relating to patents —

(a) between a person and a registered patent agent, a partnership entitled under Part XIX to describe itself as a firm of patent agents or a body corporate entitled under Part XIX to describe itself as a patent agent; or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent, is privileged from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

(2) In this section, “legal proceedings” includes proceedings before the Registrar.

(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. YES
- (2) Cases where Client Privilege or professional secrecy was denied in your country. NO

Table 16: Common law countries:

Client Privilege	Non-lawyer patent professional	Lawyer	Client	Foreign non-lawyer patent professional	Foreign Lawyer
Accepted	Yes	YES	Yes		Yes
Denied	No	NO	No		No

Table 17: Civil law countries:

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

**[Case where client privilege was accepted or recognized]**

Skandinaviska Enskilda Banken AB (Publ) Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd and other appeals [2007] SGCA 9

(1) Section 128 of the Evidence Act (Cap 97, 1997 Rev Ed) (“the Act”) read with s 131 of the Act made it clear that the full effect of the legal advice privilege was that the client was protected from having to disclose to any other party any legal advice which he had obtained from his legal adviser, whether he was an advocate or a solicitor. In that connection, it was implicit that the nature of the business or enterprise involved in a client obtaining legal advice from a lawyer had to have the element or quality of confidentiality in the communication to the lawyer or the advice given to the lawyer.

End