



The Submissions of the International Association for the Protection of Intellectual Property (AIPPI) on Cross-border Confidentiality of Communications between Clients and their Patent Advisors.

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1. Summary and Principal Submission

Based on the work to date of the Standing Committee on Patents (SCP) regarding the confidentiality of communications between clients and their patent advisors including all WIPO Reports, the Submissions of the Member States and the NGOs, AIPPI submits that an internationally agreed upon minimum standard of protection of the confidentiality of IP professional advice would be the appropriate remedy to the well established problems of inadequate protection and cross border loss of protection.

The application of such a standard would benefit the processing of intellectual property rights by clients both nationally and internationally, as it would support the full disclosure of relevant facts to their advisors under protection from disclosure. As a result, advisors would be better enabled to provide correct legal advice, the obtainment of which is a public interest supported in both civil and common law countries.

A minimum standard would provide a base for common understanding by clients of the scope of their international protection, and therefore overcome the substantial uncertainties which currently exist (and compromise the client’s willingness to make full disclosure to their professional IP advisors) by reason of the significant variations from one country to another in the level of statutory protection available.

The work of the SCP on this matter has been invaluable in laying the groundwork on which the Member States can develop a minimum standard of protection for communications between clients and their professional IP advisors. AIPPI urges the SCP to continue its important work since national reactions to the needs of users of the IP systems as well as national laws relating to the protection of the confidentiality of professional IP advice are constantly shifting. For example, New Zealand, Australia, Sweden, Denmark, Norway and Switzerland have recently considered, proposed or enacted changes in law to better protect the subject confidentiality and have, in some cases, been influenced by the work of the SCP.

Accordingly, AIPPI commends and supports the continuing work of WIPO and the Member States in this field, particularly with respect to the issues that should be considered in establishing the platform on which a minimum standard of protection should be based.

2. Introduction

Pursuant to WIPO Circular 7999, WIPO has invited submissions on the topic of the confidentiality of communications between clients and their patent advisors. In particular, WIPO has requested information on:

- i) national laws and rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors;
- ii) problems in relation to cross-border aspects of confidentiality of communications between clients and patent advisors; and
- iii) remedies that are available in countries and regions to solve the problems that remain at the national, bilateral, plurilateral and regional levels.

AIPPI thanks WIPO and the Member States for the opportunity of making this submission.

In January and February 2010, AIPPI, through its Q199 Privilege Task Force Committee issued a Questionnaire to all of its National and Regional Groups in order to ascertain the views of the members of AIPPI on the national laws and rules pertaining to the possible forced disclosure of communications between intellectual property (IP) professionals and their clients. The Questionnaire sought to obtain some basic information from AIPPI's members as to the extent of domestic protection, if any, that is currently provided against the forced disclosure of IP advice, the types of IP advisors (lawyers, patent agents, trade-marks agents, etc.) in respect of which this protection may apply, any exemptions or exceptions to such protection, and the protection, if any, to communications with foreign IP advisors. The Questionnaire also sought from AIPPI members input in respect of possible remedies that AIPPI may wish to explore in seeking some form of harmonized national and international

approach to the problems that exist with respect to the forced disclosure of communications of this kind.

The information sought by the AIPPI Questionnaire included a great deal of information of the kind that WIPO's Circular 7999 is now requesting.

A total of 48 responses to the AIPPI Questionnaire were received by the AIPPI from the National Groups of Argentina, Australia, Austria, Belarus, Brazil, Canada, Chile, China, the Czech Republic, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Korea, Lithuania, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Panama, the Philippines, Poland, Portugal, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Thailand, Turkey and from the Arab Regional Group, the United Kingdom, the United States, Uruguay and Venezuela.

The individual AIPPI Member State responses to the Questionnaire are available on the AIPPI website at <https://www.aippi.org/?sel=publications&sub=onlinePub&cf=questionnaires>.

Additionally, a summary report of these responses was prepared by AIPPI's Q199 Privilege Task Force Committee and a copy of the same is attached to this submission for WIPO's ease of reference (Appendix II), along with a copy of the AIPPI Questionnaire itself (Appendix I), and a summary table of some of the responses which related to cross-border aspects of the confidentiality of communications (Appendix III), which has been prepared for the purpose of this submission.

As might be expected, the responses to the Questionnaire demonstrated a wide variety of approaches to the protection against forcible disclosure of IP professional advice, though there are nevertheless commonalities even among civil law and common law countries. It is also of some significance to note that many of the responses from the AIPPI National Groups acknowledged the inadequacy of the existing scope of protection nationally and internationally for particular categories of IP professionals (particularly in the case of non-lawyer IP professionals) whose clients should be protected, either by privilege or by an obligation of professional secrecy.

It should also be noted that AIPPI's submissions to WIPO in October 2010 and February 2011 refer, in part, to the results of the responses to the AIPPI Questionnaire. AIPPI has also provided WIPO with submissions on the issue of the confidentiality of communications between clients and their patent advisors dated October 31, 2008, August 31, 2009 and May 4, 2011.

Additionally, in October 2010, AIPPI supplied WIPO with some of the documents produced by the Q199 Privilege Task Force Committee in 2010, for use by WIPO and the Member States in relation to their work on remedies as they may be mandated to carry out by the SCP. These AIPPI documents were: the Guidelines for the Questionnaire referred to above, the Questionnaire itself, the Responses of the

National and Regional Groups of AIPPI to the Questionnaire, the Q199 Epitomes and Graphs of those Responses, the Q199 Synthesis of those Responses and the Q199 Report to the AIPPI Bureau on this process and its outcome which was presented at the ExCo Meeting of AIPPI on October 3, 2010.

This submission is specifically directed to the three categories of information referred to in the WIPO Circular 7999. They are based on AIPPI's previous submissions and the results of the AIPPI Questionnaire process referred to above.

3. National laws and rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors.

(a) Overview of domestic protection

National laws relating to the protection of communications between clients and patent advisors, including cross-border aspects of the same, are influenced by a number of factors, such as the availability of discovery or forced disclosure during the course of litigation, the particular type of patent professional involved (for example a lawyer versus a non-lawyer), and the common law or civil law legal practices of that jurisdiction.

Generally, most common law countries (where there is often some type of documentary and/or oral discovery as part of the litigation process) have both attorney-client privilege for communications between clients and lawyers and litigation privilege. The latter protection would under appropriate circumstances apply to communications between clients and third parties, including non-lawyer IP professionals.

In certain common law countries such as Canada and Malaysia, communications between clients and non-lawyer IP professionals are not protected by attorney-client privilege. In other common law countries, such as Australia, New Zealand and the United Kingdom, there are specific statutory provisions that provide for client/non-lawyer IP professional communications to be protected by a privilege equivalent to that of attorney-client privilege. Such protection is also extended to registered patent agents in Singapore and South Africa.

Generally, for civil law countries, there is a professional secrecy obligation imposed upon lawyers that would prevent them from disclosing the client's confidential information to third parties. While civil law countries typically do not provide for attorney-client privilege per se, such countries do not usually have the discovery obligations as found in common law jurisdictions.

A number of civil law jurisdictions (e.g. France and Argentina) also feature obligations of confidentiality for non-lawyer IP professionals such as patent agents. While this means that the risk of clients' confidential legal advice being disclosed is lower, disclosure may nevertheless be forced by the national courts.

The following paragraphs summarize some of the different approaches of various countries to the cross-border implications of the confidentiality of client and patent advisor communications.

(b) Communications between clients and their foreign IP professionals.

The responses of the AIPPI Questionnaire indicate that there are some countries which provide no statutory protection to communications between clients and their foreign IP professionals (e.g. Belarus, Estonia, South Korea, Lithuania, Poland, Romania and Turkey).

Other countries may provide protection to such communications depending on whether the profession of the foreign IP professional is one that is the subject of its own professional secrecy or confidentiality obligation (e.g. Argentina, Brazil and Chile). Similarly, some countries provide protection only if the foreign IP professional is a lawyer (e.g. Australia, Canada, Malaysia, Finland, Norway, Spain and Switzerland), regardless of the protection granted in the foreign IP professional's native jurisdiction.

In other jurisdictions, communications may be protected on the basis of judicial comity, if similar protection would apply in the other jurisdiction (e.g. Austria, the Czech Republic, Ireland, Portugal and Sweden).

As discussed above, many common law countries (such as Australia, Canada and the United States) also have a litigation privilege which could protect communications between clients and foreign IP professionals if they were made for the purpose of the litigation.

(c) Communications between domestic IP professionals and foreign IP professionals.

The responses of the AIPPI Questionnaire indicate that no statutory protection is provided in certain countries to communications of this kind (e.g. Belarus, Indonesia, Lithuania, Poland and Romania).

Some countries, however, protect communications of this kind through domestic professional confidentiality obligations (e.g. Brazil, Egypt, Estonia and Mexico). Other countries on the basis of judicial comity will protect the status of such communications when such communications are protected in the jurisdiction of the foreign IP professional (e.g. Austria, the Czech Republic, Ireland, Sweden and Turkey).

In some countries, protection may be available depending on the profession of the foreign IP professional (e.g. Argentina and Chile). In this regard, some countries only recognize the protected status of such communications if the foreign IP professional is a lawyer (e.g. Canada, Malaysia, Norway, the Philippines, Switzerland and the United Kingdom), and in some of these jurisdictions (e.g. Canada), the communications with the foreign lawyer will only be protected if he or she is advising on matters for which the foreign lawyer is qualified.

Finally, the common law litigation privilege may also apply in respect of communications of this kind depending on the circumstances.

(d) Limitations, exceptions and waivers that apply to the protection of communications relating to IP professional advice.

While certain countries provide no exceptions or limitations to the protection offered to communications between clients and their IP advisors (e.g. Finland, Germany, the Philippines and South Africa), many countries that provide some form of protection for these communications also provide exceptions or limitations on the application of that protection.

Such exceptions can occur for example in situations where the life or security of a person is in jeopardy (as in Canada, Brazil, Hungary and Spain) or be based on the discretion of the judge (e.g. Argentina, China, Indonesia, Israel, Panama and Venezuela).

Many countries also have an exception in situations involving criminal activity, such as money laundering (Australia, Austria, Brazil, Canada, Chile, the Czech Republic, Egypt, France, Hungary, India, Ireland, Malaysia, Norway, Romania, Russia, Singapore, Spain, Sweden, the United Kingdom and the United States).

Furthermore, most common law countries (including Ireland and Singapore), and some civil law countries (e.g. Greece South Korea, Norway, Panama, Romania and Sweden), have an exception for waiver by the client.

Finally, in many common law countries where there is litigation privilege, such a privilege is limited to communications made for the dominant purpose of contemplated or pending litigation.

4. Problems in relation to cross-border aspects of confidentiality of communications between clients and patent advisors.

While many AIPPI Members consider that their domestic law does not appropriately protect communications between clients and domestic patent advisors, the primary issue at hand is whether the privilege or confidentiality of communications – which are protected in some countries in certain circumstances as noted above – will be lost due

to cross-border effects, and in particular when such communications are sought to be produced as part of a legal proceeding in a foreign jurisdiction. In responding to the AIPPI survey, many National Groups expressed the view that the protection in this circumstance was insufficient.

The inconsistency in approach domestically amongst different jurisdictions can, and in fact does, lead to situations where communications take place between an IP advisor and a client on the understanding that those communications are confidential and protected from forced disclosure pursuant to the practice of the jurisdiction in which the communication took place, only to have those communications forcibly disclosed in litigation taking place in another jurisdiction resulting in the loss of privilege. Once privilege is lost and the information is disclosed, it can no longer be protected from disclosure anywhere.

There have been a number of examples of where a communication at the time it was made was considered protected in the country in which the communication took place, but was nevertheless forced to be produced in litigation in another jurisdiction. For example, in the *Lilly Icos* case, the Federal Court of Canada held that communications between the inventors and their UK non-lawyer IP advisors were not privileged and were required to be produced in Canadian litigation, even though UK domestic law granted privilege to such communications.¹ The decision was based on the fact that, in Canada, such communications are not protected. In the corresponding Australian proceeding, the Australian Federal Court of Appeal also ruled that the Australian statutory protection did not extend to foreign IP advisors.²

A number of courts in the United States have taken a different approach with respect to the application of a foreign jurisdiction's law on IP advisor-client privilege. In *Bristol-Myers Squibb Co. v. Poulenc*,³ the Court concluded that since communications between a French patent agent and a client were not, at that time at least, entitled under French law to an evidentiary privilege comparable to the solicitor-client privilege in the United States, such communications between Rhone-Poulenc and its French patent agents were producible. A number of subsequent United States decisions have concluded that where the communication made in the foreign jurisdiction would be considered privileged in that foreign jurisdiction, then the the U.S. court would respect that privilege and not order the communications produced. For example, this has happened in respect of communications with both U.K. patent attorneys and Japanese patent attorneys.

¹ *Lilly Icos LLC v. Pfizer Ireland Pharmaceuticals* (2006) 55 CPR (4th) 457 (rev'd on other grounds: 2006 FC 1501 and 2006 FC 1500)

² *Eli Lilly v. Pfizer* (No. 2), [2004] FCA 850.

³ *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer Inc.*, 52 U.S.P.Q. 2d 1897, 188 F.R.D. 189 (U.S. District Court, Southern New York, 1999).

5. Remedies that are available in countries and regions to solve the problems that remain at the national, bilateral, plurilateral and regional levels.

New Zealand has addressed the potential cross-border problems by implementing a legal provision whereby the communications between clients and foreign patent advisors are treated as privileged in New Zealand. Australia is in the midst of amending its own domestic legislation to create a similar protection. These are the only two countries that AIPPI is aware of that have implemented a domestic remedy of this kind.

This remedy, however, does not grant protection of New Zealand and Australian professional IP advice in other countries. AIPPI is not aware of any bilateral, plurilateral or regional remedy that has been adopted to address the cross-border problems associated with the confidentiality of communications between clients and their patent advisors.

As mentioned above, the primary concern is whether a protection that is established in one country will be lost in another. This issue was well summarized by WIPO in its Report SCP/13/4 (paras. 56-67), which also included a discussion of four possible mechanisms for dealing with the issue:

- i) Extend the privilege that may apply pursuant to domestic law to the communications taking place in other jurisdictions;
- ii) Recognize the privilege that may exist in another country and grant the same privilege domestically even if the domestic law would not normally provide for that privilege;
- iii) Apply the privilege that may exist under domestic law to foreign IP advisors, irrespective of any reciprocity considerations;
- iv) Establish minimum standards.

It is submitted that an international minimum standard of protection approach may best remedy the current imbalance between countries with respect to the availability of privilege. Indeed, a harmonized approach would provide clients with more certainty when dealing internationally with intellectual property rights in that they would not be forced to understand the details of every country's particular standards of protection. Necessarily, the chain of protection of privilege from one country to the next is only as strong as its weakest link. A minimum standard would, at the very least, establish and define the weakest protection available.

Appendix I

AIPPI Q199 Privilege Task Force Questionnaire

The Groups are asked to reply to the following questions in the context of what applies or what they may consider ought to apply in their own country or by agreement between their country and others, as may be appropriate to the particular question. The responses of each Group need to be endorsed by that Group. It will be helpful and appreciated if the Groups follow the order of the questions in their reports and use the questions and numbers for their responses.

1. PRESENT POSITION

Local position

1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and professionals within your country? When was this protection introduced into your law?

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

1.3 What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

Overseas communications

1.4 What protection of clients applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between clients and overseas IP professionals?

Limitations and exceptions

1.6 What limitations (eg dominant purpose test, judges' discretion to do justice etc) and/or exceptions (eg crime/fraud etc) and/or waivers apply to the protection described in your answers to previous questions denoted below?

(i) as to 1.1 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

(iii) as to 1.3 ie the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

(iv) as to 1.4 ie the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice where those communications are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

Quality of Protection – Local communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

(i) as to 1.1 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

(ii) as to 1.2 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

(iii) as to 1.3 ie the protection of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

Quality of Protection – Communications with overseas IP advisers

1.8 Does your Group consider that the protection described in answer to question 1.4 above is of appropriate quality or not, and if not, why not – what are the problems in practice?

2. REMEDIES

The 'device' to be agreed and applied within and between countries

The Working Guidelines indicate that such a 'device' could be on a scale between unilateral changes and treaties. However, unilateral changes will not solve the problem that no country is immune from the potential that IP legal advice which is protected from disclosure within its own borders, will be required to be disclosed in another country or countries (see para 2.4 (viii)). The Groups are requested to focus on the standard or principle required to remedy problems nationally and internationally (see para 4.6).

Limitations – Tests such as the 'dominant purpose' test

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Limitations – Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

Limitations – Qualifications required of IP advisers

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP adviser 'to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given'?

2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

2.8 If for some category of IP adviser in your country, no qualification is required—

(i) What category is that?

(ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

(iii) As to your answer to sub-para (ii), why?

Limitations – Scope of protection against forcible disclosure: the differences between lawyer client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.25 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

2.10 If no to 2.9 (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?

2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it?

Limitations – Exceptions and waivers

2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPPI, does your Group agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such an exception or waiver should it wish to do so in the future, in other words, that there should be liberty to vary or abolish a presently applied exception or waiver?

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it, in particular should e.g. the limitation for the “3-point-exception” as discussed in para 4.28 above also set limits in this case?

2.16 Since the introduction of protection against forcible disclosure of IP professional advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction - if so, what are the details?

The AIPPI proposal compared with the alternative described in Section 5 above

2.17 Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section 5 above), does your Group prefer and if so why?

Proposals from your Group

2.18 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your Group.

2.19 The Groups are invited to submit any further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

2.20 With the introduction of protection against forcible disclosure of IP professional advice or any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

Appendix II

Summary Report of AIPPI Q199 Privilege Task Force Questionnaire

Remedies to Protect the Right of Clients against Forcible Disclosure of their IP Professional Advice

The Q199 Committee is a special committee of the AIPPI focused on the issue of the protection from forced disclosure of communications between IP owners and their IP advisors in relation to the provision of professional IP advice.

Part of the mandate of the Q199 Committee is to promote and support WIPO, and the Standing Committee on Patents (SCP), in the study of the problem of forced disclosure of IP professional advice with the goal of developing some form of harmonized approach to the problem at both the national and international level.

With this in mind, the basic purpose of the Questionnaire herein was to ascertain the views of the members of AIPPI as to potential remedies for the protection problems and issues relating to them. The Questionnaire was also designed to provide data and a basis upon which AIPPI could encourage the SCP to pursue the study of remedies going forward.

In a general sense, the Questionnaire sought to obtain some basic information from the National Groups as to the extent of domestic protection, if any, that is currently provided against the forced disclosure of IP advice, the types of IP advisors (lawyers, patent agents, trade-mark agents, etc.) in respect of which this protection may apply, any exemptions or exceptions to such protection, and the protection, if any, provided for advice received from off-shore IP advisors. The Questionnaire also sought the National Groups' input in respect of possible remedies that AIPPI may wish to pursue with the SCP in seeking some form of harmonized national and international approach to the problem.

A total of 48 Reports were received by the Reporter General. Reports were received from the National Groups of Argentina, Australia, Austria, Belarus, Brazil, Canada, Chile, China, the Czech Republic, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Korea, Lithuania, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Panama, the Philippines, Poland, Portugal, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Thailand, Turkey, the United Arab Emirates (Middle East), the United Kingdom, the United States, Uruguay and Venezuela.

As might be expected, the responses to the Questionnaire show a wide variety of approaches to protection against forcible disclosure, though there are some commonalities even among civil law and common law countries.

It is of some significance to note that the responses from many National Groups acknowledged the inadequacy of the present scope of protection for particular categories of IP professionals (particularly in the case of non-lawyer IP professionals) whose clients should be protected, either by privilege or by an obligation of professional secrecy. Summaries of how the National Groups responded to the particular questions are provided below.

1. PRESENT POSITION

Local position

1.1 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and IP professionals within your country?

Generally, most common law countries (where there is often some type of documentary and/or oral discovery as part of the litigation process) such as Australia, Canada, Malaysia, New Zealand, Singapore, South Africa, the United Kingdom, and the United States have both attorney-client privilege for communications between clients and lawyers and litigation privilege, which would include communications with third parties, which might include non-lawyer IP professionals.

In certain common law countries such as Canada and Malaysia, communications between clients and non-lawyer IP professionals are not protected by attorney-client privilege. In other common law countries, such as Australia, New Zealand and the United Kingdom, there are statutory provisions that provide for client/non-lawyer IP professional communications to be protected by a privilege equivalent to that of attorney-client privilege. Such protection is also extended to registered patent agents in Singapore and South Africa.

Additionally, in most common law countries, in-house counsel are treated as equivalent to external lawyers for the purposes of the application of attorney-client privilege, provided the in-house lawyer is acting in his/her capacity as a lawyer (and not in some other executive or business capacity within the company).

Generally, for civil law countries (e.g. Argentina, Austria, Belarus, the Czech Republic, Egypt, France, Germany, Italy, South Korea, Mexico, Poland, Turkey and Uruguay), there is a professional secrecy obligation upon lawyers that would prevent them from disclosing the client's confidential information to third parties. While civil law countries typically do not provide for attorney-client privilege *per se*, such countries do not usually have the discovery obligations as found in common law jurisdictions.

A number of civil law jurisdictions such as France, Argentina, Germany, Belarus, Brazil, the Czech Republic and Estonia also feature obligations of confidentiality for non-lawyer IP professionals such as patent agents.

Additionally, civil law countries generally do not provide any such protection for in-house counsel.

1.2 What protection of clients against forcible disclosure of communications relating to IP professional advice applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

Belarus, France, Greece, Indonesia, South Korea, Lithuania, Malaysia, Mexico, the Netherlands, Norway, Poland, Romania, Spain and Sweden do not provide any such protection.

In Germany, there is only protection if the third party acts as an assistant to a patent lawyer or attorney.

In Hungary, Russia and Switzerland, there is limited protection by virtue of business/trade/commercial secret protection.

Argentina, Austria, Chile, Brazil, the Czech Republic, and Portugal only provide such protection where the profession of the third party is one that is the subject of its own professional secrecy or confidentiality obligation.

As noted above, most common law countries (e.g. Australia, Canada, India, South Africa, the United Kingdom, and the United States) may provide protection under certain circumstances by virtue of litigation privilege. However, litigation privilege only lasts for the duration of the litigation.

Denmark, Finland, Panama, the Philippines, Singapore and the United States provide protection if communications with third parties are carried out at the instruction of a lawyer or a lawyer is involved in carrying out the acts.

1.3 *What protection of clients against forcible disclosure of communications relating to IP professional advice applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?*

Argentina, Austria, Brazil, Chile and Portugal may have protection depending on whether the profession of the third party is one that is the subject of its own professional secrecy or confidentiality obligation.

Belarus, Mexico, Poland, Romania and Sweden do not have any such protection.

Many common law jurisdictions (e.g. Canada, India, South Africa, the United Kingdom and the United States) have protection by virtue of litigation privilege.

In addition, in many common law jurisdictions such as Australia, Canada, Malaysia and the United States, the common law doctrine of legal professional or attorney-client privilege may apply, depending on the circumstances, to communications between lawyer IP professionals and third parties. However, since the Australian statutory protection for non-lawyer patent and trade-mark attorneys (mentioned in 1.2 above) only applies between IP professionals and their clients and not third parties, there would be no protection for communications between non-lawyer IP professionals and third parties in Australia.

Indonesia and the Philippines may only receive protection through domestic contracts providing for confidentiality.

France, Spain, Lithuania and Turkey only have such protection if the third party is a lawyer/attorney. In France, there is no similar protection for in-house IP advisors.

Denmark, Germany, Norway and Panama have protection if the third party is acting under the direction of a lawyer or a lawyer is involved in giving instructions.

In Japan and Ireland, there is full protection from disclosure.

Overseas communications

1.4 What protection of clients applies in your country against forcible disclosure of communications applies to clients relating to IP professional advice where those communications are

(a) between their local IP professionals in your country and overseas IP professionals?

Argentina and Chile may have protection depending on the profession of the overseas IP advisor.

Canada, Malaysia, Norway, the Philippines, Switzerland and the United Kingdom have protection if the overseas IP advisor is a lawyer.

Belarus, Indonesia, Lithuania, Poland and Romania have no such protection.

In Austria, the Czech Republic, Ireland, Sweden and Turkey, there may be protection depending on the law in the native jurisdiction of the overseas IP advisor.

In Brazil, Egypt, Estonia and Mexico, there is protection on the basis of professional confidentiality obligations.

In Australia, if a lawyer communicates with an overseas IP professional (lawyer or non-lawyer), the communication will be protected if it satisfies the dominant purpose test. Where a non-lawyer IP professional communicates with an overseas IP lawyer, legal professional privilege will similarly attach. However, where a non-lawyer IP professional in Australia communicates with an overseas non-lawyer IP professional, there will not be any protection.

In the United States, communications between a lawyer and an overseas IP professional (lawyer or non-lawyer) may be protected, but the protection for a non-lawyer overseas IP professional would seem to depend on the principle of comity and whether any protection would extend to that overseas professional in their native jurisdiction.

(b) between clients and overseas IP professionals?

Argentina, Brazil and Chile may provide protection to clients depending on whether the profession of the overseas IP advisor is one that is the subject of its own professional secrecy or confidentiality obligation.

Protection of this kind is not provided in Belarus, Estonia, South Korea, Lithuania, Poland, Romania and Turkey.

Austria, the Czech Republic, Ireland, Portugal, Sweden and the United States may have protection depending on whether any protection would extend to that overseas IP professional in their native jurisdiction.

In Australia, Canada, Malaysia, Finland, Norway, Spain and Switzerland, there may be protection if the overseas IP professional is a lawyer, but not if the overseas IP advisor is not a lawyer.

In most common law countries (such as Australia, Canada and the United States), these communications may also attract litigation privilege.

Limitations and Exceptions

1.6 What limitations (e.g. dominant purpose test, judges' discretion to do justice, etc.) and/or exceptions (e.g. crime/fraud, etc.) and/or waivers apply to the protection described in your answers to previous questions denoted below?

i) as to 1.1 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

ii) as to 1.2 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is required to enable legal advice related to IP to be obtained and given?

iii) as to 1.3 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

iv) as to 1.4 i.e. the protection (if any) of clients which applies in your country against forcible disclosure of communications relating to IP professional advice as to those communications which are (a) between their local IP professionals in your country and overseas IP professionals, and (b) between the clients and overseas IP professionals?

The following comments apply in respect of questions 1.5(i)-(iv):

Argentina, China, Indonesia, Israel, Panama and Venezuela have exceptions based on the discretion of the judge.

Australia, Austria, Brazil, Canada, Chile, the Czech Republic, Egypt, France, Hungary, India, Ireland, Malaysia, Norway, Romania, Russia, Singapore, Spain, Sweden, the United Kingdom and the United States have an exception for criminal activity or fraud (including money laundering).

Most common law countries, and also Greece, Ireland, South Korea, Norway, Panama, Romania, Singapore and Sweden have an exception for waiver by the client.

Canada, Brazil, Hungary and Spain have an exception for situations in which the life or security of a person is in jeopardy.

Finland, Germany, the Philippines and South Africa have no exceptions.

Additionally, in many common law countries where there is litigation privilege, such a privilege only applies if the communication was made for the dominant purpose of the contemplated or pending litigation.

Quality of Protection – Local Communications

1.7 Does your Group consider that the protection described in answer to questions denoted below is of appropriate quality, or not, and if not, why not – including what are the problems in practice?

i) as to 1.1 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and IP professionals within your country?

The Chilean, Australian, Austrian, Estonian, Finnish, German, Greek, Hungarian, Indonesian, Irish, Japanese, Mexican, Dutch, Romanian, Singaporean, South African, Swedish, Swiss⁴, Thai, United Kingdom, and Venezuelan Groups feel the current protection is adequate.

The Argentine, Canadian, Czech, Danish, Egyptian, French, Indian, Israeli, Italian, South Korean, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Portuguese, Russian, Spanish, Turkish and American Groups feel the current protection is inadequate.

COMMON REASONS FOR INSUFFICIENCY OF PROTECTION

The Egyptian, French, Polish and Turkish Groups feel there should be clear regulations as to who and what is protected.

The Canadian, Indian, Malaysian, Norwegian, Panamanian, Filipino, Portuguese, Russian and Spanish Groups feel the protection is insufficient for non-lawyer IP professionals.

The American Group feels the protection for communications involving non-lawyer IP professionals, such as patent agents, is not well-defined across various jurisdictions and that uniformity is desirable.

The Israeli and Lithuanian Groups feel the protection is insufficient because it is not based in statute.

ii) as to 1.2 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies in your country as to such communications between clients and third parties (such as technical experts) where their advice is require to enable legal advice related to IP to be obtained and given?

The Austrian, Chilean, Danish, Finnish, Hungarian, Irish, Israeli, Japanese, Mexican, Dutch, Portuguese, Romanian, Singaporean, South African, Thai, United Kingdom and Venezuelan Groups feel the current law is adequate.

The Argentine, Australian, Brazilian, Canadian, Czech, Egyptian, French, German, Greek, Indian, Indonesian, Italian, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Russian, Spanish, Swedish, Swiss and Turkish Groups feel the current law is inadequate.

COMMON REASONS FOR INSUFFICIENCY OF PROTECTION

The Egyptian, French and Turkish Groups feel the current protection is inadequate owing to unclear rules and uncertainty.

The Malaysian, Norwegian, Filipino, Russian and Spanish Groups feel the current protection is inadequate owing to insufficient protection for non-lawyer IP professionals.

The Swiss Group felt the protection was weak for communications between clients and third parties that were not lawyers or patent attorneys.

⁴ The Swiss Group felt the protection was excellent for lawyers and patent attorneys, but relatively weak for in-house counsel and pure trade-mark agents.

The Australian, Indonesian and Lithuanian Groups feel the current protection is inadequate because it is not contained in a statute. The Australian Group also feels the protection of communications between clients and third parties for the purposes of enabling a non-lawyer IP professional to give advice is insufficient, as statutory privileges may not apply (even if for the dominant purpose of enabling legal advice related to IP to be obtained and given).

The Panamanian and Polish Groups feel the current protection is inadequate because there is no protection at all in this situation.

iii) As to 1.3 i.e. the protection (if any) of clients against forcible disclosure of communications relating to IP professional advice which applies as to such communications between IP professionals and third parties (such as technical experts) where their advice is required to enable IP legal advice to be obtained and given?

The Austrian, Chilean, Finnish, German, Hungarian, Irish, Israeli, Japanese, Mexican, Dutch, Romanian, Singaporean, Spanish, Swiss, Thai, United Kingdom and Venezuelan Groups feel the current protection is adequate.

The Argentine, Australian, Brazilian, Canadian, Czech, Danish, Egyptian, French, Indian, Italian, South Korean, Lithuanian, Malaysian, Norwegian, Panamanian, Filipino, Polish, Portuguese, Russian, South African, Swedish, Turkish and American Groups feel the current protection is inadequate.

COMMON REASONS FOR INSUFFICIENCY OF PROTECTION

The Malaysian, Norwegian, Filipino, Portuguese and Russian Groups feel the protection is inadequate for non-lawyer IP professionals.

The Australian and Belarusian Groups feel the protection is inadequate because the law is not based in statute. The Australian Group also feels that the protection of communications between non-lawyer IP professionals and third parties is inadequate, as statutory privilege may not apply to communications between clients and third parties.

The American Group feels the protection for communications involving non-lawyer IP professionals, such as patent agents, is not well-defined across various jurisdictions and that uniformity is desirable.

The Egyptian, American, French, South African and Turkish Groups feel the protection is inadequate because the law is unclear.

The Indian, Panamanian and Polish Groups feel the protection is inadequate because there is no actual protection in this situation.

Quality of Protection – Communications with overseas IP advisors

1.8 Does your Group consider that the protection described in answer to question 1.4 above (Overseas Communications) is of appropriate quality or not, and if not, why not – what are the problems in practice?

The Austrian, Chilean, Belarusian, Finnish, German, Greek, Hungarian, Israeli, Italian, Japanese, Malaysian, Portuguese, Romanian, Swiss, Thai, Middle Eastern, American and Venezuelan Groups feel the protection is adequate.

The Canadian, Australian, Czech, Finnish, French, Indian, Indonesian, Irish, South Korean, Dutch, Norwegian, Filipino, Polish, Singaporean, South African, Spanish, Swedish, Turkish and United Kingdom Groups feel the protection is inadequate.

COMMON REASONS FOR INSUFFICIENCY OF PROTECTION

The Czech, Dutch, Egyptian, Finnish, French, Irish, Norwegian, Filipino, Turkish and American Groups feel that the law in this area is unsatisfactory because it is uncertain and unclear.

The Argentine and Singaporean Groups feel the law is unsatisfactory because there is inadequate protection for non-lawyer IP professionals.

The Indonesian, South Korean, Malaysian, South African, Swedish and United Kingdom Groups feel that the law is unsatisfactory because there is insufficient protection for overseas IP professionals.

The Canadian Group feels protection is insufficient in light of the lack of privilege for communications between IP owners and non-lawyer agents (both foreign and domestic), and the lack of privilege for lawyers acting in their capacity as agents.

The Australian Group feels that privilege attaching to communications between non-lawyer IP professionals and overseas IP professionals (especially where not a lawyer) needs to be established or made certain by statute.

2. REMEDIES

Limitations – Tests such as the ‘dominant purpose’ test

2.1 Does your Group agree that provision should be made in the agreed principle or standard that countries may limit the documents to which protection applies in their country to such standard or by such test as defines what relationship is required between the documents and the IP legal advice for which protection from disclosure is claimed?

The Australian, Austrian, Belarusian, Canadian, Chilean, Czech, Greek, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Mexican, Dutch, Norwegian, Filipino, Polish, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, United Kingdom, American and Venezuelan Groups agree.

The Argentine, Brazilian, Danish, Egyptian, Estonian, Finnish, French, German, Hungarian, Malaysian, Panamanian, Romanian, Swiss, Thai and Turkish Groups disagree.

2.2 As to your answer to 2.1 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

The Australian, South Korean, Polish, South African, Spanish and Swedish Groups agree because they feel that any approach to protecting IP professional advice at an international level is more likely to be widely adopted if countries are allowed to continue applying features from their existing national laws.

The Czech Group agrees because it believes this discretion would be helpful in accommodating the various differences between civil law and common law approaches to protection.

The Hungarian, Panamanian, Swiss and Turkish Groups disagree because they feel there is better protection under the current national law in their countries than there would be under any approach to protection that allows countries to keep applying features from their existing national laws.

The Canadian and Malaysian Groups believe the protection granted to non-lawyer IP professionals should be akin to solicitor-client privilege, which they believe has sufficient limiting features (e.g. only communications for the purpose of giving legal advice would be protected) to ensure that protection would not extend too broadly. The American Group agrees for similar reasons, namely that protection should only extend to documents that constitute communications relating to legal advice, and not so far as to include documents that merely contain facts relevant to a dispute without constituting communications.

The Brazilian, Finnish, Japanese, Filipino and Romanian Groups disagree because it would cause uncertainty.

The Egyptian and German Groups disagree because they want blanket protection with as few limitations and exceptions as possible.

Limitations – Judicial discretion to deny protection

2.3 Does your Group agree (as para 2.7 of the Working Guidelines suggests) that provision should be made in the agreed principle or standard, that countries may allow judicial discretion to deny protection from disclosure where that is found on reasonable grounds to be required in order to enable the court to do justice between the parties?

The Australian, Belarusian, Chilean, Czech, Danish, Indian, Israeli, Italian, Japanese, South Korean, Lithuanian, Mexican, Filipino, Portuguese, Russian, Spanish, Thai and American Groups all favoured such an approach.

The Argentine, Austrian, Brazilian, Canadian, Egyptian, Estonian, Finnish, French, German, Greek, Hungarian, Indonesian, Irish, Malaysian, Dutch, Norwegian, Panamanian, Polish, Romanian, Singaporean, South African, Swedish, Swiss, Turkish and United Kingdom Groups were all opposed to such an approach.

2.4 As to your answer to 2.3 (bearing in mind that it would not be mandatory for any country to have such a limitation), why?

Of the Groups that agreed with the allowance of judicial discretion to deny protection, the Belarusian, Indonesian, Israeli, Italian and South Korean Groups did so on the basis that such an approach was already consistent or compatible with their existing national law.

The Thai, American, Spanish, Australian and Japanese Groups agreed on the basis that there is a need for flexibility in the law. Australia also agreed on the basis that there would not be widespread adoption of any proposed approach to protection without allowing some flexibility for each National Group.

The Argentine, Austrian, Brazilian, Canadian, Egyptian, Finnish, Greek, Indian, Irish, Malaysian, Norwegian, Panamanian, Romanian, Singaporean, South African, Swedish, Turkish and United Kingdom Groups disagreed with the idea of judicial discretion on the basis that the law would be rendered vague and unpredictable, which would cause clients to use caution when disclosing information to IP professionals, instead of giving clients the confidence to make full and open disclosure.

The German, Polish and Danish Groups disagreed because they want to minimize the limitations on protection (though they agreed with the crime/fraud exception).

2.5 If your Group considers that the limitation in relation to judicial discretion would be acceptable if expressed differently from 2.3, how would you express it?

The Italian and Swiss Groups believe the judge should be able to consider explicit requests from parties for the production of documents.

The Danish, South Korean, South African and Portuguese Groups would add an exception to the effect of a public interest exception, where the judge may determine production to be in the public interest or justified as a result of constitutional imperatives.

The United Kingdom, Swedish and Singaporean Groups believe that, in effect, the crime/fraud exception adequately covers anything a judicial discretion exception would cover.

The Australian Group feels a judicial discretion limitation would be acceptable if it were only to apply to disclosure in respect of communications between lawyers and clients in the same country.

Limitations – Qualifications required of IP advisors

2.6 Does your Group agree (as para 4.14 of the Working Guidelines suggests) that the standard required by the principle agreed should be no more than requiring the IP advisor ‘to be qualified to give the IP advice in relation to which the question arises, in the country in which the advice is given’?

The Austrian, Australian⁵, Belarusian, Canadian, Czech, Estonian, Greek, Hungarian, Indian, Indonesian, Irish, Italian, South Korean, Mexican, Filipino, Polish, Romanian, Russian, South African, Spanish, Swiss, Thai, Turkish and Venezuelan Groups agreed with this proposition.

The Brazilian, Danish, French, Argentine, Danish, Egyptian, Finnish, French, Israeli, Malaysian, Norwegian, Panamanian, Portuguese, Singaporean, Swedish, United Kingdom, American, German and Japanese Groups disagreed.

2.7 If your answer to 2.6 is no, if your Group considers that the limitation would be acceptable if differently expressed, how would you express it?

The Argentine, Australian, Danish, Egyptian, Finnish, French, Israeli, Malaysian, Norwegian, Panamanian, Portuguese, Singaporean, Swedish, United Kingdom, American and German Groups all felt that IP advisors should be required to register or obtain legal qualification from a regulatory body or agency, so as to gain the public’s confidence.

2.8 If for some category of IP advisor in your country, no qualification is required –

i) What category is that?

⁵ The Australian Group stated that it agreed with the way the standard was expressed, but noted that in Australia, patent and trade-mark attorneys are required to be registered.

In Argentina, Chile, the Czech Republic, Egypt, Finland, Ireland, Italy, Japan, Malaysia, Mexico, Netherlands, the Philippines, Romania, Sweden, Thailand, the United Kingdom and Venezuela, certain classes of IP professionals are permitted to practice without any qualification.

Additionally, in Argentina, Malaysia, Mexico, the Philippines, Sweden and the United Kingdom, anybody can give advice in IP matters.

ii) Do you think that protection from forcible disclosure of IP professional advice should apply to communications relating to the advice between clients and persons in that category?

The Argentine, Brazilian, Egyptian, Finnish, Filipino, Romanian, Thai and Venezuelan Groups agree that there should be protection for these categories of IP professionals that do not require any qualifications.

The Chilean, Czech, Irish, Italian, Japanese, Malaysian, Mexican, Swedish and United Kingdom Groups do not agree that there should be any protection for these groups.

iii) As to your answer to sub-para (ii), why?

The Brazilian, Egyptian, Filipino, Thai and Venezuelan Groups believe there should be protection because generally, IP advice to a client should be confidential. Allowing a break in this 'chain of confidentiality' would effectively render all communications unprotected.

The Swedish and United Kingdom Groups do not think there should be any protection because only registered IP advisors should be entitled to protection. The extra protection would be an incentive to encourage IP professionals to register.

Limitations – Scope of protection against forcible disclosure: the differences between lawyer-client privilege and litigation privilege

2.9 Does your Group agree in principle (para 4.5 of the Working Guidelines raises this question) that the standard or principle agreed should allow countries to limit the protection they provide according to categories of privilege which are currently part of their law?

The Australian, Austrian, Belarusian, Brazilian, Canadian, Czech, Danish, Finnish, Greek, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Malaysian, Mexican, Filipino, Polish, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, Turkish, United Kingdom and American Groups agree that any approach to the protection of IP professional advice should allow countries to limit the protection according to categories of privilege which are currently part of their law.

The Argentine, Egyptian, Estonian, French, German, Hungarian, Dutch, Norwegian, Panamanian, Romanian and Venezuelan Groups do not agree with this proposition.

2.10 If no to 2.9, (bearing in mind that such a limitation would not import any effect on a country that does not already have such a limitation unless it voluntarily adopted such a limitation), why?

The Argentine, Estonian, Hungarian, Panamanian and Swiss Groups disagree because they take the view that the absence of such limits will lead to uniformity and predictability in the law and encourage clients to give full and frank disclosure to IP advisors without worrying about exceptions from one country to the next.

The Dutch and Norwegian Groups disagree because their current national protection schemes already provide better and more predictable protection than any approach that would allow for countries to keep existing limitations.

2.11 As to any country which applies a limitation referred to in para 2.9, do you agree that the agreed standard or principle should not deny such a country the right to vary or abolish such a limitation should it wish to do so in the future – in other words, there should be liberty to vary or abolish a presently applied limitation?

The Australian, Austrian, Belarusian, Canadian, Czech, Danish, Egyptian, Finnish, French, Greek, Hungarian, Indian, Irish, Israeli, Italian, South Korean, Lithuanian, Mexican, Norwegian, Panamanian, Filipino, Polish, Portuguese, Romanian, Russian, Singaporean, South African, Spanish, Swedish, Swiss, Thai, Turkish, United Kingdom, American and Venezuelan Groups agree.

The Argentine, Chilean, German, Indonesian, Malaysian and Dutch Groups disagree.

2.12 If yes to 2.11, what limitation (if any) should apply to the liberty to vary or abolish a previously applied limitation and how would you express it?

The Austrian, Egyptian, French, Hungarian, Indian, Israeli, Norwegian, Panamanian, Singaporean, Spanish, Swedish, Turkish and United Kingdom Groups believe that there should only be liberty to abolish or vary a previously applied limitation for a result that increases protection. The Groups do not want countries to be able to reduce protection by varying or abolishing limitations.

The Danish, German, Polish, South African and Swiss Groups believe that there should not be any limits on privilege.

The Portuguese and Russian Groups agree because they do not think it is realistic that countries will surrender their power to modify their domestic law.

The Australian Group felt the only limitation should be to ensure that if any applicable categories of privilege are varied or abolished in respect of IP advisors, they should be similarly varied in respect of lawyers.

Limitations – Exceptions and Waivers

2.13 Does your Group agree in principle (para 4.30 of the Working Guidelines suggests this) that the standard or principle agreed should in any particular country be subject to any exception (such as the crime-fraud exception) and waivers which are already part of the law of that country.

The Australian, Austrian, Belarusian, Brazilian, Canadian, Chilean, Czech, Danish, Egyptian, Estonian, French, German, Greek, Hungarian, Indian, Indonesian, Irish, Israeli, Italian, Japanese, South Korean, Lithuanian, Malaysian, Mexican, Norwegian, Panamanian, Filipino, Portuguese, Russian, Singaporean, South African, Spanish, Swedish, Thai, Turkish, United Kingdom and American Groups agree.

The Argentine⁶, Dutch, Polish, Swiss and Venezuelan Groups disagree.

⁶ The Argentine Group did not agree in principle and said it should be treated on a case by case basis.

2.14 Assuming that the maintenance of exceptions and waivers already part of the law of any country is accepted in AIPPI, does your Group agree that the allowance of existing exceptions and waivers should not deny any country the right to vary or to abolish any such an exception or waiver should it wish to do so in the future, in other words, that there should be liberty to vary or abolish a presently applied exception to waiver?

The Australian, Austrian, Belarusian, Brazilian, Czech, Danish, Egyptian, Estonian, Greek, Hungarian, Indian, Indonesian, Irish, Israeli, Japanese, South Korean, Lithuanian, Mexican, Dutch, Norwegian, Panamanian, Filipino, Polish, Portuguese, Romanian, Russian, Singaporean, Spanish, Swedish, Swiss, Thai, Turkish, United Kingdom and American Groups agree.

The Argentine, Canadian, German, Italian, Malaysian and Venezuelan Groups disagree.

2.15 If yes to 2.14, what limitation (if any) should apply to the liberty to vary or abolish a previously applied exception or waiver and how would you express it? In particular, should e.g. the limitation for the “3 point exception” as discussed in para. 4.28 above also set limits in this case?

The Austrian, Hungarian, Indian, Israeli, South Korean, Dutch, Panamanian, Singaporean, South African, Spanish, Swedish, Turkish and United Kingdom Groups feel that there should only be a power to expand protection.

The Czech, Danish, Egyptian and Thai Groups feel there should not be any limits or exceptions to the law of privilege.

The Brazilian, Estonian, Japanese, Norwegian and Polish Groups feel that the 3 point exception would or could be appropriate.

2.16 Since the introduction of protection against forcible disclosure of IPP advice in your country, have you experienced any adverse effects including as reported in case law or known empirically, from that introduction – if so, what are the details?

The American Group was the only to have reported any problems, namely the abuse of privilege, though this has been dealt with through inspection of documents on an *in camera* basis.

The Australian, Belarusian, Brazilian, Canadian, Danish, French, German, Hungarian, Indian, Irish, Israeli, Japanese, South Korean, Lithuanian, Malaysian, Polish Portuguese, South African, Spanish, Thai and Turkish Groups have not experienced any adverse effects.

The AIPPI proposal compared with the alternative described in Section 5 above

2.17 Leaving aside the potential need to provide for limitations and exceptions in relation to the AIPPI proposal, and assuming there are no other proposals, from the Groups as an alternative to the AIPPI proposal, which of these two proposals (the AIPPI and the alternative in Section above), does your Group prefer and if so why?

The Argentine, Australian, Austrian, Belarusian, Brazilian, Canadian, Czech, Danish, Egyptian, Finnish, Greek, Indian, Indonesian, Irish, Italian, Japanese, South Korean, Dutch, Norwegian, Filipino, Polish, Portuguese, Russian, South African, Spanish, Swiss, Thai, Turkish and Venezuelan Groups prefer the AIPPI proposal.

The Japanese, South Korean, Dutch, Norwegian and Thai Groups prefer the AIPPI proposal because it reduces unpredictability and provides minimum standards on a larger scope for every country.

The Estonian, French, German, Malaysian, Panamanian, Romanian and Singaporean Groups prefer the Section 5 proposal.

The French and Panamanian Groups prefer the Section 5 proposal because it appears to be more compatible with the Civil Law, and settles the most detrimental issues with the most sophisticated countries.

The Swedish and United Kingdom Groups do not favour either proposal.

2.18 Assuming that your Group would prefer a proposal different from those proposed by AIPPI or in Section 5, please describe the preferred proposal of your group.

The Thai Group would prefer an approach that provides protection against the disclosure of confidential information and can be adopted on a voluntary basis.

The Swiss Group would prefer that all countries simply adopt the new laws on protection that Switzerland has just passed.

The Austrian and Estonian Groups would prefer Section 5 if in-house IP counsel were not protected, or if privilege for in-house counsel were not required in countries which do not provide for it locally and do not accept it from other countries.

2.19 The Groups are invited to submit and further comments they might have with regard to the principles of remedies in the context of this Questionnaire, which have not been dealt with or mentioned specifically in the Questionnaire.

The Norwegian Group would like to make it so that communications between clients and IP professionals belonging to a registered group are protected, whether or not they are overseas.

The Romanian Group would like to harmonize the rules for communications between IP professionals and clients with the rules for IP professionals (who are also lawyers) and clients.

The United Kingdom Group believes the aim should not be to define privilege, but to instead extend what already exists in a country to a defined group of foreign advisors in the same way as is done for lawyers.

2.20 With the introduction of protection against forcible disclosure of IP professional advice to any other remedy as discussed above into your national law, do you expect any adverse effects on your national law, the patent system as such or any other? If so, what are the details?

The Swiss Group believes there may be a conflict since Switzerland's new legislation (Art. 321) does not apply to in-house counsel.

The Australian, Belarusian, Danish, French, Hungarian, Indian, Indonesian, Irish, Japanese, South Korean, Lithuanian, Norwegian, Panamanian, Portuguese, Romanian, South African, Spanish, Thai and American Groups do not expect any adverse effects.

Conclusions

While 96% of the countries for which a response was provided offer some form of national protection, 73% of the National Groups acknowledged the inadequacy of the current scope of protection for particular categories of IP professionals (particularly non-lawyer IP professionals) whose clients should

be protected, either by privilege or by an obligation of professional secrecy. Additionally, 30% of the countries presently extend no protection to communications with overseas IP professionals.

In terms of the qualifications required to give IP advice, there was a wide range of answers, but two categories of responses stood out. 59% of the National Groups felt that it would be sufficient if the IP professional was 'qualified' in the country from which the advice came. 32% of the National Groups felt that the IP professionals should be 'registered' or 'permitted' to provide services for clients in relation to the local IP office.

In terms of exemptions and exceptions, 58% of National Groups were not in favour of a judicial discretion exception. Its detractors cited the unpredictability of judicial discretion and its souring effect on disclosure from clients. The majority of National Groups agreeing with a judicial discretion exemption were countries whose national law already featured such an exemption. Several National Groups felt that the crime/fraud exception would likely cover all of the situations where a judicial discretion to force disclosure might arise. The crime/fraud exception is adopted in almost every country.

In terms of a country's power to modify or abolish existing limitations to privilege, 55% of the National Groups felt this power should be restricted to use only for the purposes of expanding protection, as opposed to allowing it to be used to narrow protection.

The majority of National Groups preferred the AIPPI proposal when compared to the Section 5 proposal. Common reasons cited were the AIPPI proposal's potential reduction in uncertainty in the law and setting a minimum standard for protection across all countries.

Appendix III

Summary Tables of Some AIPPI Member Responses to Q199 Privilege Task Force Questionnaire Relating to Cross-border Aspects of Confidentiality of Communications

The following tables are meant only as an overview of the information received by the AIPPI Q199 Committee in response to its 2010 Questionnaire on the national laws of AIPPI Member States in respect of the protection available for the confidential communications between clients and their IP advisors. For more detailed and complete information of a particular country's national laws and practices in respect of this issue, please refer to the individual Member State responses to the AIPPI Questionnaire available online at:

<https://www.aippi.org/?sel=publications&sub=onlinePub&cf=questionnaires>.

Statutory Protection of Communications From Forcible Disclosure in Civil Law Jurisdictions

<i>Communications between:</i>	Local lawyer	Local non-lawyer	Local client
Foreign lawyer	<p>Possible protection.⁷ CHILE</p> <p>Possible protection (Doctrine of Comity).⁸ CZECH REPUBLIC</p> <p>Protected by professional secret/confidentiality obligations of local lawyer.⁹ ARGENTINA,¹⁰ BRAZIL, ESTONIA,* FRANCE¹¹</p> <p>Protected (if foreign attorney acts for client). Otherwise, protected by professional secret/confidentiality obligations of local lawyer.¹² GERMANY</p> <p>No protection.¹³</p>	<p>Possible protection.¹⁴ CHILE</p> <p>Possible protection (Doctrine of Comity).¹⁵ CZECH REPUBLIC, GERMANY¹⁶</p> <p>Protected by professional secret/confidentiality.¹⁷ ARGENTINA,¹⁸ BRAZIL[†], ESTONIA,¹⁹ FRANCE[‡]</p> <p>No protection.²⁰</p>	<p>Possible protection.²¹ ARGENTINA, BRAZIL, CHILE</p> <p>Possible protection (Doctrine of Comity).²² CZECH REPUBLIC</p> <p>Protected if foreign lawyer is supervising a local lawyer or “Conseil en propriété intellectuelle”.²³ FRANCE</p> <p>Protected (if foreign attorney acts for client).²⁴ GERMANY</p> <p>No protection.²⁵</p>

⁷ AIPPI Summary Report, Q199 Privilege Task Force, Remedies to Protect the Right of Clients Against Forcible Disclosure of Their IP Professional Advice, August 2010, ¶ 1.4(a) [AIPPI Summary].

⁸ *Ibid.*

⁹ *Ibid.*

¹⁰ Argentina's Response to AIPPI Questionnaire Q199, April 5, 2010, ¶ 1.1 [Argentina's Response 2010].

* Most Patent and TM agents in Estonia are not lawyers.

¹¹ France's Response to AIPPI Questionnaire Q199, May 23, 2010, ¶ 1.4(a) [France's Response 2010].

¹² Germany's Comments on confidentiality of communications between clients and their patent advisors dated August 4, 2011, received by the Standing Committee on the Law of Patents, Seventeenth session (Geneva, December 5-9, 2011), at 1 [Germany's Comments 2011].

¹³ AIPPI Summary, *supra* note 7.

¹⁴ *Ibid.*

¹⁵ *Ibid.*

¹⁶ Germany's Comments 2011, *supra* note 12, at 2.

¹⁷ AIPPI Summary, *supra* note 7.

¹⁸ Argentina's Response 2010, *supra* note 10, ¶ 1.1.

	BELARUS	BELARUS	BELARUS, ESTONIA
Foreign lawyer non-	Possible protection. ²⁶ CHILE	Possible protection. ³³ ARGENTINA, CHILE	
	Possible protection (Doctrine of Comity). ²⁷ CZECH REPUBLIC	Possible protection (Doctrine of Comity). ³⁴ CZECH REPUBLIC, GERMANY ³⁵	Possible protection (Doctrine of Comity). ³⁸ ARGENTINA, BRAZIL, CHILE, CZECH REPUBLIC, GERMANY ³⁹
	Likely protection based on professional secret/confidentiality obligations of local lawyer. ²⁸ ARGENTINA, ²⁹ BRAZIL, ESTONIA*, FRANCE, ³⁰ GERMANY ³¹	Protected by professional confidentiality obligations. ³⁶ BRAZIL, [†] ESTONIA, FRANCE [‡]	May be protected if advisor is supervising a local lawyer or "Conseil en propriété intellectuelle". FRANCE ⁴⁰
	No protection. ³²	No protection. ³⁷	No protection. ⁴¹

[†] The protection of communications is provided in Brazil's Professional Code of Conduct and Ethics on the Industrial Property Agent (Patent and TM Office resolution). See Brazil's Response to AIPPI Questionnaire Q199, January 19, 2010, ¶ 1.1.

¹⁹ Estonia's Response to AIPPI Questionnaire Q199, March 30, 2010, ¶ 1.1 [Estonia's Response 2010].

[‡] Communication is protected with a non-lawyer if the advisor is a "Conseil en propriété intellectuelle". See France's Response 2010, *supra* note 11, ¶ 1.4(a).

²⁰ AIPPI Summary, *supra* note 7.

²¹ *Ibid.*, ¶ 1.4 (b).

²² *Ibid.*

²³ France's Response 2010, *supra* note 11, ¶ 1.4 (b).

²⁴ Germany's Response to AIPPI Questionnaire Q199, May 2010, ¶ 1.4.

²⁵ AIPPI Summary, *supra* note 7, ¶ 1.4 (b).

²⁶ *Ibid.*, ¶ 1.4 (a).

²⁷ *Ibid.*

²⁸ *Ibid.*

²⁹ Argentina's Response 2010, *supra* note 10.

* Most Patent and TM agents in Estonia are not lawyers.

³⁰ France's Response 2010, *supra* note 11, ¶ 1.4 (a).

³¹ Germany's Comments 2011, *supra* note 12, at 1.

³² AIPPI Summary, *supra* note 7.

³³ *Ibid.*

³⁴ *Ibid.*, ¶ 1.4 (b).

³⁵ Germany's Comments 2011, *supra* note 12, at 2.

³⁶ Estonia's Response 2010, *supra* note 19, ¶ 1.1.

[†] The protection of communications provided in Brazil's Professional Code of Conduct and Ethics on the Industrial Property Agent (Patent and TM Office resolution). See Brazil's Response to AIPPI Questionnaire Q199, January 19, 2010, ¶ 1.1.

	BELARUS	BELARUS	BELARUS, ESTONIA
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Statutory Protection of Communications From Forcible Disclosure in Common Law Jurisdictions

<i>Communications between:</i>	Local lawyer	Local non-lawyer	Local client
Foreign lawyer	<p>Possible protection (Doctrine of Comity).⁴² IRELAND</p> <p>Protected by legal professional privilege subject to dominant purpose test.⁴³ AUSTRALIA, UNITED STATES⁴⁴</p> <p>Protected.⁴⁵ CANADA, UNITED KINGDOM</p> <p>Not protected – but litigation privilege is available.⁴⁶</p>	<p>Possible protection (Doctrine of Comity).⁴⁷ IRELAND</p> <p>Protected by legal professional subject to dominant purpose test.⁴⁸ AUSTRALIA</p> <p>Possible protection in the common law of each States' jurisdiction.⁴⁹ UNITED STATES</p> <p>Protected.⁵⁰ CANADA, UNITED KINGDOM</p> <p>Not protected – but litigation privilege is available for patent</p>	<p>Possible protection (Doctrine of Comity).⁵² IRELAND, UNITED STATES⁵³</p> <p>Protected if the qualifications of foreign IP advisor are recognized by State. CANADA,⁵⁴ NEW ZEALAND⁵⁵</p> <p>Protected.⁵⁶ UNITED KINGDOM</p> <p>Not protected (unless lawyer registered under the Australian Patents</p>

[‡] Communication is protected with a non-lawyer if the advisor is a “Conseil en propriété intellectuelle”. France’s Response 2010, *supra* note 11, ¶ 1.4(a).

³⁷ AIPPI Summary, *supra* note 7.

³⁸ *Ibid.*, ¶ 1.4 (b).

³⁹ Germany’s Comments 2011, *supra* note 12, at 1.

⁴⁰ France’s Response 2010, *supra* note 11.

⁴¹ AIPPI Summary, *supra* note 7, ¶ 1.4 (b).

⁴² *Ibid.*, ¶ 1.4 (a).

⁴³ *Ibid.*

⁴⁴ The communication will be protected if made for the dominant purpose of providing legal advice to the local lawyer’s client. The United States’ Response to AIPPI Questionnaire Q199, April 30, 2010, ¶ 1.4 [US Response 2010].

⁴⁵ AIPPI Summary, *supra* note 7.

⁴⁶ New Zealand’s Response to AIPPI Questionnaire Q199, April 21, 2010, ¶ 1.4(a) [New Zealand’s Response 2010].

⁴⁷ AIPPI Summary, *supra* note 7.

⁴⁸ *Ibid.*

⁴⁹ US Response, *supra* note 44.

⁵⁰ AIPPI Summary, *supra* note 7.

	NEW ZEALAND	attorneys. ⁵¹ NEW ZEALAND	Act 1990) – but litigation privilege applies. AUSTRALIA ⁵⁷
Foreign lawyer	non-	Possible protection (Doctrine of Comity) – litigation privilege is also available. ⁵⁸ IRELAND, UNITED STATES ⁵⁹ Protected by legal professional privilege subject to dominant purpose test. ⁶⁰ AUSTRALIA Not protected – but litigation privilege is available. ⁶¹ CANADA, NEW ZEALAND, ⁶² UNITED KINGDOM	Possible protection (Doctrine of Comity). ⁶³ IRELAND, UNITED STATES Not protected – but litigation privilege is available for patent attorneys. ⁶⁴ NEW ZEALAND Not protected. ⁶⁵ AUSTRALIA, CANADA, UNITED KINGDOM Protected if the qualifications of foreign IP advisor are recognized by State. NEW ZEALAND, ⁶⁸ UNITED KINGDOM ⁶⁹ Not protected. ⁷⁰ AUSTRALIA, CANADA ⁷¹

⁵² *Ibid.*, ¶ 1.4 (b).

⁵³ US Response 2010, *supra* note 44, ¶ 1.4.

⁵⁴ Communications will likely be protected if they were made in respect of the provision of legal advice that the lawyer was qualified; litigation privilege is also available. Canada's Response to AIPPI Questionnaire Q199, April 7, 2010, ¶ 1.4 [Canada's Response 2010].

⁵⁵ Legal privilege is available for certain communications with foreign IP advisors (from designated countries) who are entitled to undertake work that, in New Zealand, is normally undertaken by a lawyer or a patent attorney. New Zealand's Response 2010, *supra* note 45, ¶ 1.1, 1.4(b). Litigation privilege is also available, ¶ 1.2.

⁵⁶ The United Kingdom's Response to AIPPI Questionnaire Q199, March 25, 2010, ¶ 1.4(b) [UK Response 2010].

⁵⁷ New Zealand's Response 2010, *supra* note 45, ¶ 1.4(a).

⁵⁷ Note that Australian law is subject to a new legislative amendment, the Intellectual Property Laws Amendment Bill 2011, which would extend protection to foreign lawyers. Australia's Comments on confidentiality of communications between clients and their patent advisors received by the Standing Committee on the Law of Patents, Seventeenth session (Geneva, December 5-9, 2011)

⁵⁸ AIPPI Summary, *supra* note 7.

⁵⁹ US Response 2010, *supra* note 44, ¶ 1.4.

⁶⁰ AIPPI Summary, *supra* note 7.

⁶¹ *Ibid.*

⁶² New Zealand's Response 2010, *supra* note 45, ¶ 1.4(a).

⁶³ AIPPI Summary, *supra* note 7.

⁶⁴ New Zealand's Response 2010, *supra* note 45, ¶ 1.4(a).

⁶⁵ AIPPI Summary, *supra* note 7.

⁶⁶ *Ibid.*, ¶ 1.4 (b).

⁶⁷ US Response 2010, *supra* note 44, ¶ 1.4.

⁶⁸ Legal privilege is available for certain communications with foreign IP advisors (from designated countries) who are entitled to undertake work that, in New Zealand, is normally undertaken by a lawyer or a patent attorney. New Zealand's Response 2010, *supra* note 45, ¶ 1.1, 1.4(b). Litigation privilege is also available, ¶ 1.2.

⁶⁹ Communications are protected if the foreign IP advisor is a UK/European registered patent attorney or a UK/OHIM registered TM attorney. UK Response 2010, *supra* note 56, ¶ 1.4(a).

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⁷⁰ AIPPI Summary 2011, *supra* note 7, ¶ 1.4 (b).

⁷¹ Canada's Response 2010, *supra* note 54, ¶ 1.4.