The Secretariat has considered the Australian situation in the documents SCP/13/4, SCP/14/2 and also briefly in SCP/16/4.

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

As discussed in SCP/13/4, Section 200(2) of the Australian Patents Act 1990 deals with the privileged nature of communications between applicants and their advisors. This section of the Act states:
A communication between a registered patent attorney and the attorney's client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client.

The requirement for a "registered patent attorney" has been considered by the Federal Court of Australia (*Eli Lilly & Co. v. Pfizer Ireland Pharmaceuticals* (2004), 137 F.C.R. 573 (Federal Court of Australia) ["*Eli Lilly & Co.*"]). It was concluded that privilege in relation to communications with a "registered patent attorney" is confined to communications with an attorney registered *in Australia*. This means that, as discussed in SCP/14/2, patent attorney privilege is not applicable to communication between clients and foreign attorneys who are not registered under the Australian Patents Act 1990.

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

The majority of Australian patent applications originate outside Australia. Accordingly, many foreign applicants use patent attorneys in their own country. Many patent applicants hold global patent portfolios, including a number of patents for the same invention in different jurisdictions. This means that a dispute in relation to a single invention may be prosecuted through litigation or negotiations simultaneously in a number of different jurisdictions. It is not always desirable or practical for parties to such disputes to limit their requests for advice to Australian patent attorneys. Excluding communications with a foreign patent attorney is therefore a significant issue for users of the patent system and limits their ability to effectively engage in legal proceedings relating to patents.

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

Currently, under Australian law there are no remedies of this sort available.

However, the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011, proposes amendments to the Patents Act which will extend client-attorney privilege to communications with foreign patent attorneys. This will be achieved by expanding the

definition of ‘patent attorney’ to include an individual authorised to do patents work under the law of another country or region. However, privilege will only apply to the extent that the attorney is authorised to provide intellectual property advice. Consequently communications with a foreign patent attorney relating to trade marks or other rights will be privileged only if the attorney is authorised to do that work in their home country in addition to patents work.