JPO’s Comments to the WIPO on the Attorney-Client Privilege (Response to C.8585)

1. As a response to C.8585, the JPO would like to introduce some court decisions in the U.S., in which Japanese companies and Japanese patent attorneys have been involved.

2. In the past, there were some court cases in which the attorney-client privilege was not granted to Japanese patent attorneys. Examples include the following four cases:
   Status Time Corp. vs. Sharp Electronics Corp. (82/03/17)
   Detection Systems Inc. vs. Pittway Corp. (82/11/08)
   Burroughs Wellcome Co. v. Barr Laboratories Inc. (92/08/03)
   Santrade vs. General Electric (93/04/05)

3. In 1998, Japan revised its Code of Civil Procedure, so that patent attorneys would be allowed the right to refuse to submit documents and testify on any matter covered by professional secrecy obligation, under Articles 197 and 220 of the Code of Civil Procedure of Japan.

4. Since then, in court decisions in the U.S., the attorney-client privilege has been granted to Japanese patent attorneys (and lawyers) based on the legal revisions stated in above 3. Examples include the following two cases:
   VLT Corp. v. Unitrode Corp., 194 F.R.D. 8 (D.Mass., 2000)
   Eisai Ltd. v. Dr. Reddy's Laboratories, Inc., 406 F.Supp.2d 341 (S.D.N.Y., 2005)

When considering the facts stated in above 2, 3, and 4, the JPO believes that it is essential for each country to take specific measures, such as revising its domestic laws, as stated above 3 in Japan, so as the attorney-client privilege properly to be granted to patent attorneys. Also, in order for foreign courts to make appropriate decisions based on these measures, it is important for us to continue discussions toward setting out certain minimum standards, so that the confidentiality of communications between patent attorneys and their clients can be adequately protected.