

European Patent Convention (EPC)

Cross-border aspects

Clarification to facilitate the recognition by foreign courts

At the regional level, the case *Bristol-Myers Squibb Co. v. Rhone-Poulenc* motivated the EPO to amend the EPC to which the US domestic law refers to decide whether attorney–client privilege applies to communications between a European patent attorney and his client. With a view to protecting – in the course of US proceedings – the confidentiality of communications between European patent attorneys and their clients, a new provision, Rule 153, was introduced in the Implementing Regulations to the European Patent Convention (EPC) (Basic Proposal for the Revision of the European Patent Convention (MR/2/00), October 13, 2000, Munich, page 191), as follows:

“Rule 153: Attorney evidentiary privilege

- “(1) Where advice is sought from a professional representative in his capacity as such, all communications between the professional representative and his client or any other person, relating to that purpose and falling under Article 2 of the Regulation on discipline for professional representatives, are permanently privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client.
- (2) Such privilege from disclosure shall apply, in particular, to any communication or document relating to:
 - (a) the assessment of the patentability of an invention;
 - (b) the preparation or prosecution of a European patent application;
 - (c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application.”

The new rule created a European patent attorney–client privilege applicable in EPO proceedings, modeled after the evidentiary privilege existing in the United States (Basic Proposal for the Revision of the European Patent Convention (MR/2/00), October 13, 2000, Munich, page 191). However, it is unclear whether and how the privilege will be recognized under national laws of the EPC Member States, if the disclosure of the relevant privileged communication becomes an issue in national court proceedings.