

Confidentiality of Communication between Clients and their Patent Advisors

European Patent Convention (EPC)

With a view towards protecting the confidentiality of communications between European patent attorneys and their clients, Article 134a providing an attorney-client evidentiary privilege applicable in EPO proceedings was introduced into the European Patent Convention (EPC) at the Diplomatic Conference in 2000. This initiative goes back to the *Bristol-Myers Squibb Co. v Rhone-Poulenc*¹ case in which the question was raised whether attorney-client privilege applied to communications between a European patent attorney and his client.

The following part of Article 134a EPC provides the general legal basis for the attorney-client evidentiary privilege in EPC proceedings and provides the Administrative Council (AC) of the European Patent Organisation with the competence to establish relevant provisions on this topic:

“Article 134a EPC - Institute of Professional Representatives before the European Patent Office

(1) The Administrative Council shall be competent to adopt and amend provisions governing:

...

(d) the obligation of confidentiality on the professional representative and the privilege from disclosure in proceedings before the European Patent Office in respect of communications between a professional representative and his client or any other person.”

As a consequence of the introduction of this provision, the AC adopted the following detailed rule on the attorney-client evidentiary privilege in the Implementing Regulations to the EPC:

“Rule 153: Attorney-client 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 the 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.”

¹ *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.* United States District Court, S.D. New York. Nov 26, 2001. 95 Civ. 8833.

Since the implementation of these provisions, it is now standard practice to observe patent-attorney evidentiary privilege in EPO proceedings. The EPC contracting states have recognised this privilege and greatly harmonised their practices with the practice at the EPO.