

**MALAYSIAN POSITION ON
INTELLECTUAL PROPERTY
ADVISER-CLIENT
PRIVILEGE**

Outline of Talk

- Status of IP Advisers in Malaysia
- Privilege Position of IP Advisers
- Scope of Privilege
- Assessing the Current Position & Proposed Change
- Conclusion

Status of IP Advisers in Malaysia

Current IP Legislation formally recognise the following IP Advisers:

- Registered Patent Agent
- Registered Trade Mark Agent
- Registered Industrial Design Agent
- Registered Geographical Indications Agent

Relevant legislation gives exclusive right to such Registered IP Agents to file for Intellectual Property Right (IPR) in the respective fields of IP

However:

- Other areas of IP practice (e.g. giving advice and enforcement) are not exclusive to such Registered IP Agents
- Only practising lawyers can litigate IP matters in court

Privilege Position of IP Advisers

- The relevant IP legislation does not confer privilege for Registered IP Agents
- IP Advisers who are not Registered IP Agents also do not have privilege under the IP legislation

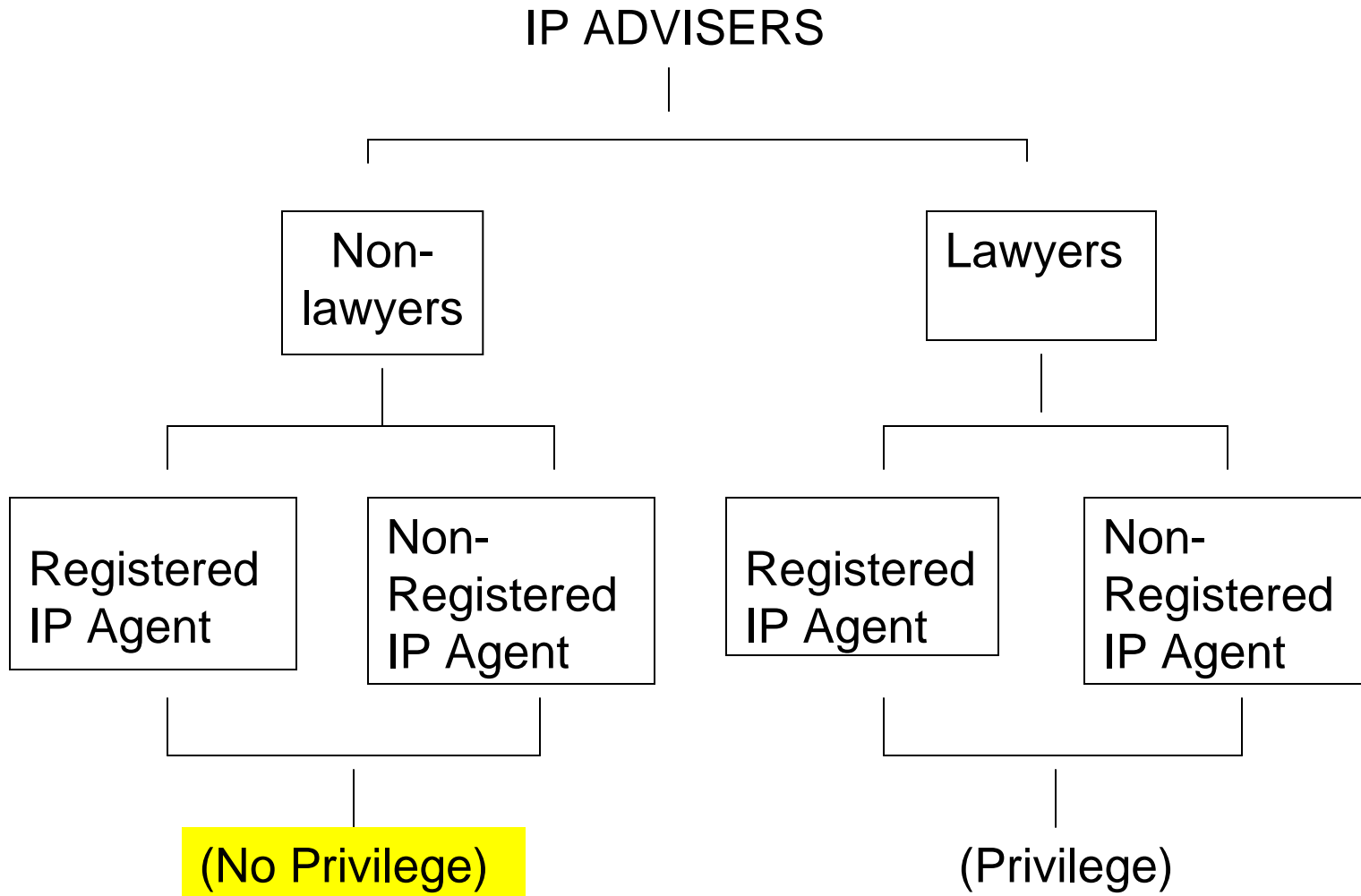
Privileges for Lawyers

- However under relevant legislation and common law principles lawyers generally are entitled to privilege in respect of communication between the lawyer and his client
- Such privilege would apply to all IP legal matters acted upon by the lawyer for his client, whether or not the lawyer is also a Registered IP Agent

“Indirect” Privilege

In view of the above, should a client require privilege for advice being sought from IP Advisers who are not lawyers, the solution will be for the client to instruct his lawyer to obtain such advice as such communication would be protected by privilege

Summary of Current Position



Scope of Privilege

The privilege for practising lawyers is found in Section 126 of the Evidence Act 1950:

- “(1) No [advocate] shall at any time be permitted, unless with his client’s express consent, to disclose any communication made to him in the course and for the purpose of his employment as such [advocate] by or on behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment:

Cont'd

Provided that nothing in this section shall protect from disclosure –

- *(a) any such communication made in furtherance of any illegal purpose;*
 - *(b) any fact observed by any [advocate] in the course of his employment as such showing that any crime or fraud has been committed since the commencement of his employment.*
- (2) It is immaterial whether the attention of the [advocate] was or was not directed to the fact by or on behalf of his client.”*

The client also enjoys privilege in respect of communication with his legal professional adviser under Section 129:

“No one shall be compelled to disclose to the court any confidential communication which has taken place between him and his legal professional adviser unless he offers himself as a witness, in which case he may be compelled to disclose any such communications as may appear to the court necessary to be known in order to explain any evidence which he has given, but no others.”

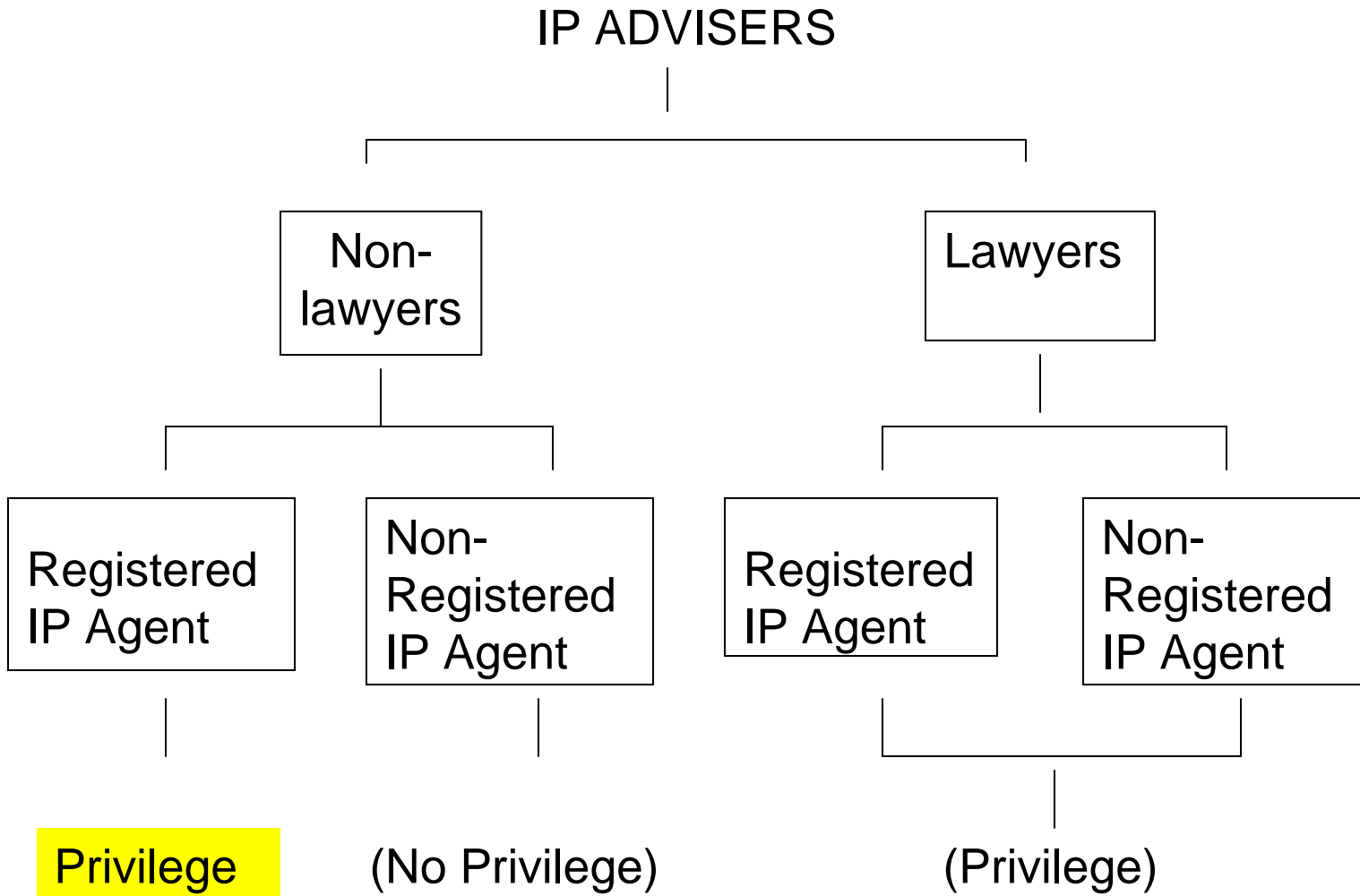
Such privilege under Section 129 would probably include communication with an in-house legal counsel or a foreign lawyer due to the wider term “legal professional adviser” but would probably not include IP Advisers who are not lawyers

Assessing the Current Position

There is a strong argument to extend privilege to IP Advisers as this benefits the client who will then be able to obtain advice from such professionals without concerns as to discovery and confidentiality

However, it makes sense to extend such privilege to only IP Advisers who are Registered IP Agents as such IP Advisers have legal qualifications which are statutorily recognised

Chart for Proposed Extension of Privilege



It can also be argued that such privilege should also extend to communication with foreign IP Advisers due to:

- Multi jurisdictional nature of IP
- Need for foreign expertise
- Cost factor (no need for “indirect” privilege)

However, again such privilege should only extend to foreign IP Advisers who are themselves protected by privilege in their own jurisdictions

Conclusion

It would appear beneficial to Malaysia to consider favourably any treaty which would seek to confer privilege on communication between the IP Adviser and his client consistent with the above principles

**SURVEY FROM SELECTED
ASEAN COUNTRIES
ON IP ADVISER – CLIENT PRIVILEGE**

QUESTIONNAIRE

		Brunei	Indonesia	Malaysia
1.	Do lawyers in your country generally have Client Privilege?	YES	YES	YES
2.	If yes to Q1, does the Client Privilege cover IP work done by the lawyer?	YES	YES	YES
3.	Do you have IP Advisers (as defined above) in your country who are not lawyers (as defined above)?	YES	YES	YES
4.	If yes to Q3 do such IP advisers have a recognized status in your country such as registration or licence granted by your IP office?	NO	YES	YES

QUESTIONNAIRE

		Philippines	Singapore	Thailand
1.	Do lawyers in your country generally have Client Privilege?	YES	YES	YES
2.	If yes to Q1, does the Client Privilege cover IP work done by the lawyer?	YES	YES	YES
3.	Do you have IP Advisers (as defined above) in your country who are not lawyers (as defined above)?	YES	YES – for patents & TM	YES
4.	If yes to Q3 do such IP advisers have a recognized status in your country such as registration or licence granted by your IP office?	YES	YES – for Patents	YES – for Patents

QUESTIONNAIRE

		Brunei	Indonesia	Malaysia
5.	Do IP Advisers who are <u>not</u> lawyers in your country have Client Privilege?	NO	YES	NO
6.	If yes to Q5 is there a difference between IP Advisers (who are not lawyers) who are recognized (under Q4) and those who are not recognized i.e. (a) all IP Advisers (whether recognized or not) have Client Privilege (b) only recognized IP Advisers have Client Privilege	N/A N/A	YES NO	N/A N/A
7.	<u>Optional to answer</u> (a) If currently in your country IP Advisers (who are not lawyers) do <u>not</u> have Client Privilege, in your view should client Privilege be given to IP Advisers? (b) Should Client Privilege be only given to recognized IP Advisers and not to non-recognised IP Advisers	NO N/A	YES NO	YES YES

QUESTIONNAIRE

		Philippines	Singapore	Thailand
5.	Do IP Advisers who are <u>not</u> lawyers in your country have Client Privilege?	NO	YES – for Patents	NO
6.	If yes to Q5 is there a difference between IP Advisers (who are not lawyers) who are recognized (under Q4) and those who are not recognized i.e. (a) all IP Advisers (whether recognized or not) have Client Privilege (b) only recognized IP Advisers have Client Privilege	N/A becoz of 5	NO YES	N/A N/A
7.	<u>Optional to answer</u> (a) If currently in your country IP Advisers (who are not lawyers) do <u>not</u> have Client Privilege, in your view should client Privilege be given to IP Advisers? (b) Should Client Privilege be only given to recognized IP Advisers and not to non-recognised IP Advisers	YES NOT SURE	YES YES	YES NO

THANK YOU