

Allens Arthur Robinson



**WIPO/AIPPI**

**Conference on Client Privilege in Intellectual Property  
Professional Advice (*CPIPPA*)**

**Prospects for Improvement: What are the options?**

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# The Options – General Comments (1)

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- Are we dealing with something esoteric ?
- The subjects are 2 things **first** confidentiality of IP advice, **secondly** security against disclosure of such IP advice to third parties in legal proceedings
- Practicalities, not controversies

## The Options – General Comments (2)

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- What are the needs of clients that drive the need for a harmonious standard of privilege globally
- The need to compare and rationalise IP advice from place to place
- The need is fundamental – it is negligent not to make the comparisons

## The Options – General Comments (3)

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- Options – realistic possibilities
- To do what? – ‘Improvements’ nationally and internationally
- Unilateral action?
- Bilateral agreements?
- Global treaty

## The Options – General Comments (4)

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- Why hold back nationally pending a treaty?
- Will the scope of non-lawyer privilege be linked to the privilege applicable to lawyers?
- What then is the justification for delay nationally because of the prospect of a treaty?
- Various factors – qualifications of the professionals whose relationship gives rise to privilege
  - \* Scope of privilege
  - \* A combination of categories of professionals and categories of activities?

# The Options: Conclusion

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- National and international changes are necessary
- Treaty by WIPO/Member States process, the best way to proceed for IP subjects
- Do not delay national changes – the need exists for those right now and there is no reason to delay

## Background to AIPPI's CIPPA Treaty Proposal (1)

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- Reporter General (Jochen Buehling) introduced you to QI63's Resolution
- Are we dealing with a matter of controversy – amazingly – **NO!**
- Why does privilege exist – Suggest the concepts are acceptable like motherhood?
- Best legal advice
- Get the law enforced
- Serious issue – on the face of it, change is contrary to the subjective interests of lawyers and patent attorneys?
- Present state - good for business of lawyers and not good for clients

## Background to AIPPI's CIPPA Treaty Proposal (2)

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- Q163 was a serious and substantial study, but not universal
- Preliminary findings – factors involved ‘in the mix’.
  - (a) The availability of discovery or forced disclosure in the jurisdiction
  - (b) The status of patent or trade mark professional in the jurisdiction
  - (c) The common law/civil law condition of the jurisdiction
  - (d) The imposition of criminal penalties on patent or trade mark attorneys who reveal their clients’ confidential information

## Background to AIPPI's CIPPA Treaty Proposal (3)

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### Preliminary conclusion of Q163

### Conclusions – a real and serious issue for clients with intellectual property in multiple jurisdictions

- (a) The role of (non-lawyer) patent and trade mark attorneys – becoming increasingly important
- (b) Clients reasonably expect their communications to be treated the same way whichever professional they deal with
- (c) IP systems will benefit from extension of privilege to non-lawyer patent and trade mark attorneys – full and frank disclosure

## The resolution of Q163

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AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognise that the protections and obligations of the attorney-client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law, as well as agents admitted or licensed to practice before their local or regional patent and trademark offices, and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.

## Timeline of AIPPI's efforts

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- Pre-2003 – the enquiries made by Q163
- 2003 AIPPI EXCO Meeting in Lucerne – Q163 Resolution
- 2005 AIPPI's proposal to WIPO – the CPIPPA treaty proposal
- May 2008 WIPO/AIPPI Conference Geneva

**Already 6 years plus in running!**

# AIPPI CIPPA Treaty Proposal

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- The negative experiences of clients
- Greater efforts necessary – how should AIPPI best explain what it had in mind?
- AIPPI proposal made at WIPO's invitation to explain AIPPI's state of mind
- AIPPI acknowledges that it is the Member States' function to negotiate and draft treaties
- AIPPI's proposals – they are part of its contribution to the process of WIPO and the Member States

## **AIPPI's submission to WIPO in relation to the CIPPA Treaty Proposal (1)**

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- Lack of uniformity of the scope of privilege causing clients to lose confidentiality and privilege in their intellectual property advice
- The same where third parties are engaged by their IP advisers
- Owners stressed in relation to carrying on business in places where to do so risks losing their privilege in a country of greater economic importance to them

## AIPPI's submission to WIPO in relation to the CIPPA Treaty Proposal (2)

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- A trade barrier to owners of IP stated this way
  - “2.5 Recognition of the potential for instructions and advice to be compromised by being published, can in effect be a barrier to trade. This is because owners of IPR may decide that it is not practical to enforce IPR where the consequences of doing so may be that their instructions and advice get published and used against them whether locally or internationally.”

# **AIPPI's submission to WIPO in relation to the CIPPA Treaty Proposal (3)**

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## **The Australian Experience**

### **Positive**

- Acceptance that non-lawyer patent attorneys have similar obligations to clients and therefore their clients should have the same privilege in IP advice from non-lawyer patent attorneys as they would have in respect of lawyers
- Of course, limited to the qualifications which patent attorneys actually have.

### **Negative**

- Third parties – no!
- Overseas patent attorneys – no!

## **AIPPI's submission to WIPO in relation to the CIPPA Treaty Proposal (4)**

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***Mind the (further) gap!***

**Non-recognition of overseas non-lawyer patent attorney IP advice**

- The chain is only as strong as its weakest link
- Hence, the need for a treaty for all countries to apply the same minimum protection to clients in relation to privilege in IP professional advice

## Another activity of AIPPI in support of the CIPPA Treaty Proposal

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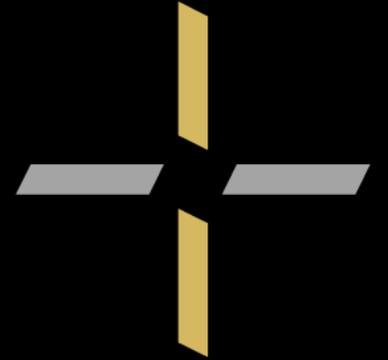
- The formation of Q199 Privilege Task Force
- PTFr connections with governments
- PTFr enquiries into treaty issues (a work in progress)
- The imperative to avoid 'railway sidings'

# Considerations involved in the AIPPA CPIPPA Treaty Proposal

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- The nature and meaning of ‘privilege’
- The scope of that ‘privilege’
- The qualifications of IP advisers in relation to the requisite ‘privilege’ of the client

**Over to Eric Le Forestier**



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