

WIPO Standing Committee on the Law of Patents (SCP)

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Seminar on the Confidentiality of Advice from Patent Advisors

Patent Advisors' Perspectives

AIPPI, AIPLA, FICPI

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Geneva

CONFIDENTIALITY OF IP ADVICE – COMMON LAW JURISDICTIONS INCLUDING INDIA

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WHAT IS PRIVILEGE?

Wigmore on Evidence (1940) –

“Where legal advice of any kind is sought from a professional legal adviser in his capacity as such, the communications relating to that purpose, made in confidence by the client, are at his instance, permanently protected from disclosure by himself or by the legal adviser, except when the protection be waived.”

RELATIONSHIPS WHICH ENJOY PRIVILEGE

- Attorney-client
- Doctor-patient
- Accountant-client
- Husband-wife
- Priest-penitent
- Government privilege etc.

FEATURES OF PRIVILEGE

- Oldest privilege known to common law: client-attorney
- Species of confidence
- Balance hunt for truth v. Unfairness of revealing client-attorney communication (Three Rivers case)
- Why Privilege – ensure full and frank communication

FEATURES OF PRIVILEGE

- Whose Privilege: Client, not legal adviser
- Who can waive: Client
- How long: Survives death of Client
- Nature of Right: Substantive, not procedural
- Whether grant of privilege is discretionary: No (Law Commission and *Three Rivers* case)
- Confidentiality in itself not sufficient to render communication privileged but it is an essential requirement

FEATURES OF PRIVILEGE

- Seeking discovery of privileged communication – akin to taking short cuts
- Privilege law in India
 - ✓ Client cannot be compelled to give evidence regarding communications with legal professional adviser (S. 129)
 - ✓ Barrister, Attorney, Vakil and Pleader cannot be compelled to give evidence regarding communications with, documents exchanged and advice given to client (S. 126)

WHO ARE COVERED?

- **Status, not function** – “Legal professional adviser” narrowly construed (i.e. practicing advocate)
- Engagement in professional capacity (not over drinks at a bar)
- **Practicing advocate:** Yes
- **Chartered accountant:**
 - ✓ India: Not “legal professional adviser”; but disclosure is misconduct
 - ✓ R v Special Commissioner of Income Tax - Not covered; dissent says covered
- **Government law officers:** Probably not owing to Right to Information Act, 2005

WHO ARE COVERED?

- **In house attorneys:**
 - ✓ No since not “independent” (as per Justice Srikrishna’s opinion and Akzo Nobel case in EU)
 - ✓ Yes as per *Bombay Municipality* case and Lord Denning’s opinion in *Alfred Crompton* case
- **Foreign lawyers**
 - ✓ May be covered since may fall in “barrister”, “attorney” or “pleader” (Not decided)
 - ✓ Covered under common law

WHO ARE COVERED?

- **Patent agents, Indian or foreign**
 - ✓ May not be covered although may be “attorneys” or “pleaders” (Not decided)
 - ✓ *Wilden Pump* case in UK and *Wundowie Foundry* in Australia say not covered
 - ✓ Subsequent legislative amendments in UK, South Africa and Australia
 - ✓ Australia: extended to foreign patent agents (Raising the Bar Act); also in New Zealand
- **Technical witnesses:** No

WHO IS THE CLIENT?

- Employees authorized to deal with external lawyers (*Three rivers case*)
- Is a law firm a “client”?
- Is a foreign client covered?
 - ✓ Probably yes (not decided)

NEED FOR PRIVILEGE FOR IP ADVISERS

- IP advisers performing same functions as lawyers
- Specialization is the norm
- No frank discussion between patent agent and client – leads to weaker patents
- Problems for multijurisdictional litigation
 - ✓ No protection to communications with foreign patent agents (*Eli Lilly v Pfizer* in Australia and Canada)
 - ✓ Leads to forum shopping

INDIA'S OPPOSITION TO EXPANSION OF PRIVILEGE

- Will keep out prior art leading to defective patents
 - ✓ If disclosure of prior art required by law, privilege will not come in the way
 - ✓ Keeps out the communication and not the information contained therein
 - ✓ Keeps out the lawyer's advice; nothing else
- Privilege norms to be set based on socio – economic conditions
 - ✓ Defendants/ SMEs need this protection as much as patentees and MNCs

INDIA'S OPPOSITION TO EXPANSION OF PRIVILEGE

- Information can be protected through non – disclosure agreements
 - ✓ Confidentiality does not by itself make information immune from discovery
- Respecting the privileges of other countries violates India's sovereignty
 - ✓ Full and frank communication not possible if disclosure possible in another jurisdiction
- TRIPS and Paris Convention do not mandate such expansion
 - ✓ Expanding privilege law helps India

EFFORTS TO CHANGE INDIAN LAW

- Expand privilege to legal practitioners (Law Commission in 2003)
- Legal practitioners would include any person authorized to appear before judicial or administrative authority
- This would include Indian patent agents but not foreign patent agents
- Two law commissions in the last 60 years but no amendment yet