Seminar on the Confidentiality of Advice from Patent Advisors

Patent Advisors’ Perspectives

AIPPI, AIPLA, FICPI

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Professional Secrecy in civil law countries

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Civil law approach

- Professional secrecy – IP advisor obligation
  - Obligation to keep information relating to clients confidential
  - Primarily an obligation of the IP advisor (lawyer, patent attorney)
  - Advisor cannot be forced to disclose such information in court
  - Also, normally no or limited disclosure
  - It’s an obligation of the advisor, not his right

- It is an obligation of the advisor, not a right of the client
  - It is not a property right
  - It does not add any intellectual property
  - It does not extend the scope of existing intellectual property
  - It does not create a trade secret for the client
  - It is merely a procedural issue
  - It exists for all lawyers, not merely IP lawyers
  - Patent attorneys provide legal advice, similar to lawyers
Is the client protected?

- **Professional secrecy is primarily an obligation of the advisor**
  - The advisor cannot be forced to disclose communications with his client
  - This would not work if the client could be forced to do so
  - Therefore the client cannot be forced to disclose that same information
    - However, this is not always as clear
    - Communications by advisor with third party (expert) also unclear

- **Professional secrecy is limited to client-attorney communications**
  - It relates to the advice given to the client
    - But to be able to give advice, the advisor needs relevant documents
  - **Client cannot be forced to disclose such advice and communications**
    - Otherwise the advisor’s privilege would be pointless
  - **But the client cannot refuse to disclose those facts**
    - If there are means to obtain such disclosure
Legal basis for professional secrecy

- **Professional regulatory law - secrecy**
  - Laws governing the professional statute of lawyers and patent attorneys

- **Procedural law – right to refuse testimony**
  - Lawyers and patent attorneys may refuse testimony
  - They cannot be forced to produce documents themselves
  - Documents in their possession are not subject to seizure
    - But of course the client may be forced to produce documents (facts)

- **Waiver of protection**
  - The client can always waive protection and disclose the advice
  - The advisor needs the client’s consent to disclose
    - But even then he still has a responsibility to protect his client

- **Exceptions**
  - No protection in case of abuse
  - No protection in case of criminal offence
Other issues

• **Limited disclosure introduced in civil law countries**
  - 2006: EU Enforcement Directive introduces some disclosure
  - 2016: Unified Patent Court can issue orders for limited disclosure
  - Further disclosure may be developed under national law

• **Position of in-house lawyers**
  - Weaker in many countries, or unclear
  - In EU competition law: CJEU denied protection, lack of independency

• **International position**
  - Often unclear
  - May be weak in common law countries for advisors from civil law countries due to difference in concept
    - Especially if common law country has disclosure
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