

Group B+

Draft Agreement on Cross Border Aspects of a Client- Patent-Attorney Privilege



Confidentiality of communications between clients and their patent advisors
Standing Committee of the Law of Patent
34th session
26-30 September 2022

What is the Issue with a Client-Attorney Privilege (CAP)?



- Problem: lack of legal certainty and predictability without legal solution
- Users cannot rely on the confidentiality of their information (patent applicants, holders, patent advisors)
- Users (especially attorneys and the industry) have been pushing for a solution for years
- An issue which could be solved by Group B+

Goal of the project

Guarantee the **same minimal level of protection** in every jurisdiction for communications between client and IP advisors in relation to advice on patent law.

A process trigger by the users and the professional associations

Joint Proposal of AIPLA, AIPPI and FICPI (June 2013):

*“National laws are needed which in effect **provide the same minimum standard of protection from disclosure for communications to and from IP advisors in relation to advice on IPRs [...].”***

Work of the Core Group



1. The definition of “intellectual property advisor” (IP advisor)
2. The scope of privileged communication, i.e. the definition of “professional advice”
3. The extent of the flexibility granted to national legislation

Article 1 – Definitions / Patent advisor

- *patent advisor* means an advisor who is authorised to act before a competent administrative or judicial authority in a jurisdiction of a signatory State or to which a signatory State participates, and officially certified to provide professional advice concerning patents. The criteria of qualification and the categories of certification are defined by national and international law.

Article 1 – Definitions / Advice

- *advice* means the subjective or analytic views and opinions of the patent advisor. Raw data and mere facts are not privileged in and of themselves unless:
 - they are communicated with the “dominant purpose” of seeking or giving advice; or
 - they are contained in a document containing privileged information and they are related or connected to the privileged information and have been communicated with the “dominant purpose” of seeking or giving advice.

Article 1 – Definitions / Professional advice

- *professional advice* means advice given on patent law within the patent advisor's area of expertise, as defined by the national or international law that stipulates the professional qualifications whether it is transmitted to another person or not.

Article 2 – Scope and limit of the privilege

- A [*confidential*] communication made for the dominant purpose of a patent advisor providing professional advice to a client shall be privileged, meaning it shall be protected from any disclosure to third parties, unless it is or has been disclosed with the authority of that client.

Article 5 – Opt-in clause

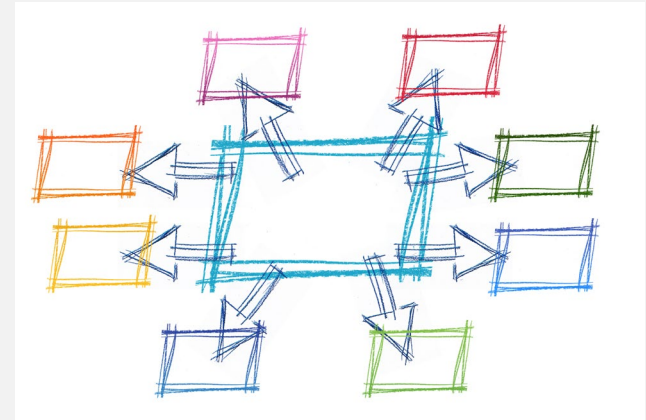
- *The Parties may at any time extend, the scope and effect of this Agreement on their territory to other areas of intellectual property law and to advisors other than those defined in Article 1. Such declaration shall be deposited with the Depository and specify whether it is made unilaterally with effect for all the Parties, or on the basis of reciprocity with effect only for the other Parties having made the same declaration.*

Article 6 – Flexibilities for national legislation

- *States may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in Article 2, including specific requirements which a patent advisor must meet in order for Article 2 to apply to them, provided that such requirements, limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of Article 2 having due regard to the recitals to this Agreement.*

Stakeholder consultation

- The Core Group is consulting:
 - AIPPI / FICPI on a global and regional level;
 - Inter-American Association of Intellectual Property;
 - Korea Intellectual Property Association (KINPA);
 - Japanese Intellectual Property Association (JIPA);
 - Intellectual Property Institute of Canada (IPIC);
 - Institute of Professional Representatives before the European Patent Office (EPI);
 - Institute of Patent and Trade Mark Attorneys of Australia, New Zealand Intellectual Property Attorneys Incorporated, Law Council of Australia – Intellectual Property Committee
- The consultation runs **until 25 November 2022**.



Roadmap 2022-2023



1. The Core Group keeps going until the next Plenary Meeting.
2. The Core Group consults stakeholder organizations.
3. The Core Group will analyze the results of the consultation, present its analysis and indicate its intentions for the future at the next Plenary Meeting.

Conclusion



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