

Standing Committee on the Law of Patents

Thirty-Eighth Session Geneva, November 2 to 6, 2026

STUDY ON THE CATEGORIES OF PROFESSIONALS WHO ENJOY PROTECTION AGAINST FORCIBLE DISCLOSURE OF CONFIDENTIAL COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS IN COURT PROCEEDINGS UNDER NATIONAL/REGIONAL LAWS

Document prepared by the Secretariat

1. At its thirty-sixth session, held in Geneva from October 14 to 18, 2024, the Standing Committee on the Law of Patents (SCP) decided that a study on the categories of professionals who enjoy protection against forcible disclosure of confidential communications between clients and their patent advisors in court proceedings under national/regional laws, be prepared by the Secretariat and submitted to the thirty-eighth session of the SCP.
2. Pursuant to the above decision, Member States and regional patent offices were invited through Note C.9304, dated January 30, 2026, to submit information to the International Bureau on the above elements under the applicable law. In the preparation of the study, the Secretariat made use of information provided by the Member States¹, as well as other information made available through various SCP activities. In addition, the Secretariat consulted other sources of information to obtain supplementary material on the topic.

[Annex follows]

¹ The information received from Member States is available on the website of the SCP electronic forum at: https://www.wipo.int/en/web/scp/electronic-forum/meetings/session-38/comments_received. In total, 14 Member States provided input in response to C. 9304.

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I. INTRODUCTION, SCOPE AND TERMINOLOGY

1. This study primarily focuses on the categories of patent advisors whose confidential communications with clients enjoy protection against forcible disclosure in court proceedings under national/regional laws. The topic is important because legal and policy clarity on the different categories of patent advisors recognized to be shielded from such disclosure is key to providing quality advice to clients and administration of justice. Compelled disclosure in court proceedings can harm the interests of clients (i.e., inventors, patent applicants and/or patent holders). Moreover, confidentiality of communications in the context of patent advice raises distinct issues beyond general client confidentiality obligations in legal advice, as such communications often possess not only legal or commercial, but simultaneously technical character. The multi-phased lifecycle of patent protection and enforcement (from the initial invention disclosure through the preparatory stage of patent applications and prosecution, until grant, maintenance, freedom-to-operate analysis, licensing, and potentially litigation) requires interactions with a variety of advisors, beyond the conventional lawyers. Any communication by the client with any unprotected category in the chain of obtaining, monetizing and/or enforcing patents can significantly impact the patent holder's position in court proceedings and can have wider commercial implications.

2. The study examines how different jurisdictions protect qualified lawyers, patent attorneys, and patent agents and the extent of such protection. It identifies a divide between jurisdictions protecting only lawyer-client communications and those extending equivalent protection to non-lawyer patent professionals. As a consequence, identical communications may be treated differently in different countries, depending on the advisor's professional status. The study also examines whether protection extends to other categories of patent professionals apart from patent agents/attorneys and lawyers in the strict sense, namely other persons that provide patent-related services. The study further examines the conditions for protection within each category varying per jurisdiction, including registration or qualification, the requirement of acting in a professional capacity, and providing advice within the protected scope of practice.

3. The study compares distinct protection mechanisms: statutory provisions equating patent attorney communications with lawyer-client privilege in common law countries, and professional secrecy obligations with rights to refuse testimony or document production in civil law countries. The study also examines the treatment of communications with foreign patent professionals whose status is recognized in one jurisdiction, but not in the one where disclosure is sought in court proceedings.

A. SCOPE OF THE STUDY

4. In terms of the scope of the study, court proceedings are understood as judicial proceedings taking place outside IP Offices: before courts, tribunals, or other judicial bodies. General confidentiality and trade secret rules fall outside the scope of the study, but such protection often complements the protection available to statutorily recognized patent advisors. General trade secret protection can be of particular use to categories of patent advisors that are not benefitting from protection against disclosure. Although such rules may provide additional protection for communications between clients and their patent advisors, their application is generally based on the nature of the communications or on contractual arrangements, rather than on the professional status of the advisor or the client–advisor relationship.²

² See the input received from Spain in response to C.9304 explaining that other types of protection, as for example rules regulating trade secrets, may also complement the professional secrecy obligations applicable to patent attorneys or patent agents, in particular for companies and other professionals with whom patent applicants may interact.

5. Document SCP/29/5 provided a broad compilation of laws, practices and information regarding the confidentiality of communications between clients and their patent advisors in general.³ In particular, it addressed how, and to what extent, communications between clients and patent advisors are kept confidential under different legal systems. It also considered cross-border aspects of confidentiality, including possible remedies to overcome difficulties arising in that context. The study draws, where appropriate, on the information and analysis contained in SCP/29/5 and other relevant SCP materials.

6. The study, however, focuses specifically on the categories of professionals whose confidential communications between clients and their patent advisors are protected against forcible disclosure in court proceedings under national and regional laws, as well as the conditions under which such protection applies.

B. TERMINOLOGY

7. For the purposes of this study, the term “patent advisor” is used in a general way, to describe a person who is a professional representative on patent-related matters. Such a person is called “patent attorney” or “patent agent” in many countries. Often, the person needs to pass a qualification examination and be registered with a national authority or be a member of a chamber. The exact scope of professional activities and qualifications of patent advisors are defined in the applicable national/regional laws. It is important to note that a patent advisor may be a qualified lawyer or, if the applicable law permits, a non-lawyer.

8. The term “privilege” in connection with the qualified lawyers and their clients’ relationship (so called “attorney-client privilege”, “solicitor-client privilege”, “legal advice privilege” or “client-attorney privilege”) is well established in common law countries. One legal dictionary defines the term “attorney-client privilege” as follows:

“The client’s right to refuse to disclose and to prevent any other person from disclosing confidential communications between the client and the attorney — also termed *lawyer-client privilege*; *client’s privilege*”⁴.

It is apparent from the above definition that the privilege belongs to a client, not to an attorney, and hence only the client has the power to waive it. It is a concept used predominantly in common law countries.

9. The term “professional secrecy obligation” is used in the sense commonly understood in civil law countries and refers, in general, to the legal obligation, imposed on patent advisors, not to disclose communication with their clients made in their professional capacity.

10. The term “qualified lawyer” is used in the study to refer to a person who has obtained the professional qualifications required under the applicable law and is admitted, registered or otherwise authorized to practice in that capacity before the courts of the relevant jurisdiction, irrespective of the professional title used under national law (such as lawyer, attorney-at-law, advocate, *avocat* or *abogado*).

11. The terms “in-house legal advisor” and “in-house patent advisor” are used in the study to refer to legal advisors or patent advisors employed within a company rather than practicing independently as external legal or patent advisor.

12. The term “protection against forcible disclosure of confidential communications” is used to describe the legal status based on which confidential communication cannot be required by the

³ See SCP document SCP/29/5 Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information.

⁴ Black’s Law Dictionary (12th ed. 2024).

authority to be disclosed, irrespective of whether this outcome is the result of the application of the privilege rule or professional secrecy obligations.

II. UNDERLYING CONSIDERATIONS RELEVANT TO THE PROTECTION AGAINST FORCIBLE DISCLOSURE OF CONFIDENTIAL COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS IN COURT PROCEEDINGS

13. In general, when a client seeks an opinion from a qualified lawyer, communications between the lawyer and their clients are kept confidential. The purpose of establishing and preserving such confidentiality is to encourage full and frank communication between clients and their advisors. Clients should be able to disclose all relevant information, including matters that may be considered as adverse to their position, and advisors should be able to provide advice without concern that such communications may be later disclosed. In this way, confidentiality supports the quality of legal advice and the proper administration of justice.⁵

14. However, another significant public interest aspect exists, which is the necessity that all relevant information is available in court proceedings. Consequently, an inherent need arises to balance these competing interests.

15. Mechanisms have been therefore developed at the national level to ensure the protection of confidential communications with certain categories of professionals without compromising the exercise of justice.

16. In common law, the mechanism for protecting confidential communications operates within a specific evidentiary framework. During litigation, parties are normally required to identify and disclose to the court, and each other, all information they have that relates to the matters in dispute. The process of disclosing the records is called discovery. Where litigation involves pre-trial discovery (or disclosure), the notion of “privilege” has been developed giving a client the right to prohibit certain confidential communications or documents from being subject to forcible disclosure. In other words, privilege operates as a shield to the discovery of information in litigation.⁶ In common law countries, confidential communications between a client and an attorney are protected from disclosure under the client-attorney privilege. Privilege in common law countries belongs to and benefits the client.

17. In civil law countries, no discovery or disclosure process obliges the parties to disclose all relevant information in their possession during court proceedings. The inter-related concepts of discovery and the privilege granted to clients as an exception to it are therefore not common in these countries. Protection of confidential communications is ensured through the professional secrecy obligation, according to which certain professionals, including lawyers, are obliged to keep information that they have received through their professional activities secret. It is well accepted that lawyers can only properly fulfill their role if there is a relationship of trust between a lawyer and a client. Therefore, the relationship between lawyers and client is protected by professional secrecy. In order to comply with that legal obligation, lawyers are entitled to refuse cooperation in court proceedings to the extent that it would lead to the breach of their professional secrecy obligation.⁷ Breach of professional secrecy is generally a criminal offence and may also give rise to civil liability.

⁵ The Attorney-Client Privilege, Thomas C. Dawson Jr. John T. Tucker III, Kevin J. Whyte, University of Richmond Law Review, 1985, Volume 19 Issue 3, Article 9.

⁶ See paragraph 32 of document SCP/29/5 “Confidentiality of communications between clients and their patent advisors: compilation of laws, practices and other information” explaining what discovery proceedings in common law countries are in general.

⁷ See paragraphs 33 to 35 of document SCP/29/5 “Confidentiality of communications between clients and their patent advisors: compilation of laws, practices and other information” explaining the framework in civil law countries in general.

18. While rooted in different legal traditions, the client-attorney privilege and professional secrecy pursue comparable objectives. Both seek to ensure confidentiality of communications between clients and their legal advisors, thereby encouraging full and frank disclosure of relevant information. This confidentiality enables legal advisors to provide effective legal assistance. When examining such protection across different categories of advisors, this underlying objective should be kept in mind.

19. Clients must be able to share all relevant facts with their patent advisors, including sensitive information and potentially harmful details without fearing that confidential communications made for the purposes of obtaining professional advice may be subject to disclosure. Where patent advisors provide technical and legal advice, such full and frank communication enables them to provide sound evaluations on validity or infringement. If clients cannot rely on the confidentiality of their communications with patent advisors, effective advice, representation and compliance with the patent law may be compromised. Protection of confidential communications between patent advisors and their clients benefits not only the professional relationship, but also the overall intellectual property system and the public in general, because open communication between a client and their representative, paired up with the professional obligations and liabilities of the advisor, ensures compliance with the applicable laws.

20. Where protection of confidential communications between clients and their patent advisors is provided, conditions attached to the recognition of the professional category, such as registration requirements or professional capacity requirements, will act as regulatory calibration tools for the balance between protection and the public interest in disclosure.

21. In the cross-border context, ensuring that protection of confidential communications with patent advisors provided in one jurisdiction is recognized in another jurisdiction reduces the risk that a confidential communication protected in one country becomes subject to forcible disclosure in another. Greater predictability as to the treatment of such communications across jurisdictions serves legal certainty and the objective of promoting full and frank communications between clients and their representatives.

III. INTERNATIONAL LEGAL FRAMEWORK

22. The issue of confidentiality of communications between clients and their patent advisors is not expressly regulated in any international intellectual property treaty. As identified in document SCP/29/5, certain provisions of the Paris Convention for the Protection of Industrial Property and the TRIPS Agreement, as well as, to a more limited extent, the General Agreement on Trade in Services (GATS), may nevertheless be relevant to the issue. Since the international legal framework was examined in detail in document SCP/29/5, the study does not reproduce that analysis.⁸

23. However, these international instruments do not regulate the categories of patent advisors whose communications with clients are protected against forcible disclosure in court proceedings. The determination of the professional categories whose confidential communications benefit from such protection, the conditions under which the protection applies and its effects in judicial proceedings remain primarily governed by national law and, where applicable, regional legal frameworks.

⁸ See paragraphs 52 to 73 of document SCP/29/5 "Confidentiality of communications between clients and their patent advisors: compilation of laws, practices and other information".

IV. REGIONAL FRAMEWORK

24. In Europe, the Charter of Fundamental Rights of the European Union⁹ and the Agreement on a Unified Patent Court (UPCA) are relevant regarding the protection of confidential communications between clients and their professional advisors.

Charter of Fundamental Rights of the European Union

25. Within the European Union framework, the Charter of Fundamental Rights of the European Union protects the fundamental rights people enjoy in the European Union (EU).

26. Article 7 of the Charter of Fundamental Rights of the European Union concerns respect for private and family life.

It states that:

Everyone has the right to respect for his or her private and family life, home and communications.

27. While not addressing the forcible disclosure of confidential communications between clients and patent advisors in court proceedings, the Court of Justice of the European Union (CJEU) has held that Article 7 of the Charter guarantees the secrecy of legal consultation, both with regard to its content and to its existence, in addition to the protection afforded to the activity of legal defense.¹⁰

Agreement on a Unified Patent Court (UPCA)

28. At the regional level, the Unified Patent Court (UPC) is a Court common to the Contracting Member States. It has exclusive competence in respect of European patents and European patent applications within the Court's jurisdiction, European patents with unitary effect, as well as supplementary protection certificates (SPCs).

29. The Agreement on a Unified Patent Court (UPCA) sets out the institutional framework of the Court, including its jurisdiction, organization, composition, applicable law, and procedural principles. It also governs who may represent parties before the Court and contains provisions concerning the rights and immunities of those representatives, including the protection of confidential communications.

30. The Rules of Procedure (RoP) of the Unified Patent Court are a comprehensive set of procedural rules adopted pursuant to the UPCA. They regulate the conduct of proceedings before the UPC.

31. The UPCA and the RoP establish and protect legal privilege during all proceedings before the Unified Patent Court.

32. Article 48 of the UPCA concerns representation before the Unified Patent Court (UPC) and the related protection of professional communications.

33. In particular, Article 48 of the UPCA states:

⁹ Charter of Fundamental Rights of the European Union 2016/C 202/02).

¹⁰ See for example Court of Justice of the European Union, C-694/20 Orde van Vlaamse Balies and Others v Vlaamse Regering, December 8, 2022.

“1. Parties shall be represented by lawyers authorised to practise before a court of a Contracting Member State.

2. Parties may alternatively be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications such as a European Patent Litigation Certificate.

[...]

5. Representatives of the parties shall enjoy the rights and immunities necessary for the independent exercise of their duties, including the privilege from disclosure in proceedings before the Court in respect of communications between a representative and the party or any other person, under the conditions laid down in the Rules of Procedure, unless such privilege is expressly waived by the party concerned.”

[...]

34. Rule 287 of the Rules of Procedure of the Unified Patent Court provides for the detailed rules for attorney-client privilege before the court. It protects confidential communications between a client and a lawyer or between a client and a patent attorney from being disclosed in proceedings before the Court or in arbitration or mediation proceedings before the Centre.

35. Rule 287 states:

“1. Where a client seeks advice from a lawyer or a patent attorney he has instructed in a professional capacity, whether in connection with proceedings before the Court or otherwise, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is privileged from disclosure, whilst it remains confidential, in any proceedings before the Court or in arbitration or mediation proceedings before the Centre.

2. This privilege applies also to communications between a client and a lawyer or patent attorney employed by the client and instructed to act in a professional capacity, whether in connection with proceedings before the Court or otherwise.

3. This privilege extends to the work product of the lawyer or patent attorney (including communications between lawyers and/or patent attorneys employed in the same firm or entity or between lawyers and/or patent attorneys employed by the same client) and to any record of a privileged communication.

4. This privilege prevents the lawyer or patent attorney and his client from being questioned or examined about the contents or nature of their communications.

5. This privilege may be expressly waived by the client.

6. For the purpose of Rules 287 and 288:

(a) the expression “lawyer” shall mean a person as defined in Rule 286.1 and any other person who is qualified to practise as a lawyer and to give legal advice under the law of the state where he practises and who is professionally instructed to give such advice.

(b) the expression “patent attorney” shall include a person who is recognised as eligible to give advice under the law of the state where he practises in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice.

7. The expression “patent attorney” shall also include a professional representative before the European Patent Office pursuant to Article 134 (1) EPC.”

36. The text of this provision establishes the principle that any confidential communication relating to the seeking or the provision of advice in connection with UPC proceedings, but also otherwise (whether written or oral) between a client and a lawyer or a patent attorney is privileged from disclosure before the UPC or the Patent Mediation and Arbitration Centre. Two conditions have to be met for the privilege from disclosure to apply: the communication must remain confidential, and the client must have instructed these advisors in a professional capacity. The provisions extend attorney-client privilege to communications between a client and a lawyer or patent attorney employed by the client (in-house advisors) and instructed to act in a professional capacity. Since the privilege may be expressly waived by the client, the privilege essentially belongs to the client under the UPC.

37. Rule 287.6(a) further defines “lawyer” broadly to include, in addition to lawyers referred to in Rule 286(1), any other person who is qualified to practice as a lawyer and to give legal advice under the law of the state where he/she practices and who is professionally instructed to give such advice. Accordingly, the provision does not limit the protection to communications with lawyers practicing in a UPC Contracting Member State. Communication with a lawyer practicing in another jurisdiction may be protected provided the lawyer satisfies the professional requirements set out in Rule 287.6(a) under the law of the state where the lawyer practices and that the communication arises in the context of the professional advisory function for which the lawyer has been instructed. For the purposes of the privilege, Rule 287.6(b) provides that the definition of “patent attorney” shall include a person who is recognized as eligible to give advice under the law of the state where he practices in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice. This provision also adopts a broad definition of patent attorneys for the purposes of privilege.

38. In addition, Rule 287.7 states that the term “patent attorney” shall also include a professional representative before the European Patent Office pursuant to Article 134(1) EPC.

39. Rule 288 of the Rules of Procedure of the Unified Patent Court provides for similar privilege when a party (or their lawyer or patent attorney) communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings, including proceedings before the European Patent Office.

40. Rule 288 states:

“Where a client, or a lawyer or patent attorney as specified in Rule 287.1, .2, .6 and .7 instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings, including proceedings before the European Patent Office, such communications shall be privileged from disclosure in the same way and to the same extent as provided for in Rule 287”.

41. The UPCA harmonizes the protection of communications between clients and their patent advisors in proceedings before the UPC. This framework nevertheless coexists with the national protection regimes of EU Member States, which may provide for different standards and scope of protection.

V. CATEGORIES OF PROFESSIONALS WHO ENJOY PROTECTION AGAINST FORCIBLE DISCLOSURE OF CONFIDENTIAL COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS

42. The technical and legal nature of the patent system implies that patent-related legal advice may often be provided by different categories of professionals. Depending on the applicable law, certain categories of professionals may benefit from the protection of their communications in one jurisdiction but not in another. The categories of professionals whose communications with clients may benefit from protection against forcible disclosure vary across jurisdictions. These differences reflect the legal framework and tradition of the countries concerned, or the manner in which the relevant professions are regulated.

43. Under the national law of some countries, protection applies only to communications between a client and a qualified lawyer, with the consequence that confidential communications between a client and a patent advisor who is not a lawyer does not enjoy protection. In some other countries, protection also applies to confidential communications between clients and patent advisors, who are not qualified lawyers.

44. An additional consideration concerns the cross-border recognition of protection afforded to confidential communications between clients and patent advisors. National laws differ as to whether, and under what conditions, protection afforded to communications with a patent advisor under the law of one country is recognized in court proceedings in another country. Consequently, even where a communication is protected in a jurisdiction, equivalent protection may not necessarily be recognized in another jurisdiction. This creates legal uncertainty for IP right holders, particularly in a context in which patent prosecution and litigation involve professionals and proceedings in multiple jurisdictions.

45. These issues – differences in the protection against forcible disclosure of confidential communications between clients and their patent advisors under national laws and the treatment of such protection in cross-border situations – have long been the subject of discussions within the SCP and among international non-governmental organizations.¹¹

46. Previous SCP documents have used the term “patent advisor” as a general term to encompass professionals providing advice on patent matters. This section examines more specifically the different categories of professionals whose communications with clients may enjoy protection against forcible disclosure under national and regional laws.

A. QUALIFIED LAWYERS

47. Qualified lawyers (or other terms used as attorneys-at-law, advocates, solicitors, barristers) constitute one of the categories of professionals whose activities may include the provision of legal advice on patent matters. A qualified lawyer may specialize in patent matters and advise on patentability, enforcement strategies, including issues of validity or infringement, ownership issues, licensing or litigation. Qualified lawyers are generally authorized to represent clients in patent-related matters before courts.

48. The legal basis for protecting confidential communications between clients and qualified lawyers varies across jurisdictions. In common law countries, the rules governing privilege may

¹¹ See information provided regarding the work undertaken by International Non-governmental Organizations available here: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-07_work_undertaken_international_ngos.pdf tracing the history of the discussions and containing a Joint Proposal from AIPLA, AIPPI and FICPI for the establishment of a minimum standard of protection against the forced disclosure of confidential IP advice. SCP activities on the topic are available at: <https://www.wipo.int/en/web/patents/topics/confidentiality>. Group B+ has discussions on a Draft Agreement on Cross Border Aspects of a Client Patent-Attorney Privilege with the objective of guarantying the same minimal level of protection in every jurisdiction for communications between client and IP advisors in relation to advice on patent law.

derive from the common law, statutory provisions or a combination of both.¹² In these countries, privilege belongs to the client.

49. In civil law countries, protection is generally based on the professional secrecy obligation which prohibits qualified lawyers to disclose information obtained from the client. Professional secrecy obligations may be found in various sources of law, including constitutional provisions or laws regulating the legal profession.¹³ In some civil law countries, procedural rules provide provisions to ensure compliance with professional secrecy obligations.¹⁴ A number of national laws also provide criminal penalties in case of breach of professional secrecy obligations.

1. Conditions of protection

50. Qualified lawyers providing legal advice on patent matters generally enjoy protection against forcible disclosure of their communications in court proceedings.

51. In some countries, protection of communication against forcible disclosure is attached to the lawyer status only. Although patent related activities may be provided by both lawyers and non-lawyer IP professionals, IP professionals who are not lawyers do not enjoy protection in these countries. For example, in Chile, IP practitioners as such are not recognized as a distinct protected professional category and they are not subject to a specific professional examination or qualification. In practice, however, according to comments made by Chile, many IP practitioners are qualified lawyers. Accordingly, where an IP practitioner is a lawyer, the duty of confidentiality and the right to refuse to disclose information obtained in her/his professional capacity are both applicable.¹⁵

52. Conditions under which confidential communications between clients and qualified lawyers are protected vary across jurisdictions. However, the following aspects have been identified.

53. Qualified lawyers must generally be admitted, registered to the legal profession and authorized to practice as a member of the profession. This means that where national law limits lawyer-client protection to persons who are admitted, registered and otherwise authorized to practice as members of the legal profession, a person who merely has legal training or provides legal information does not necessarily fall within the protected category.

54. Qualified lawyers must generally be acting in a professional legal capacity, and communications must be made for the purpose of seeking or providing legal advice. Accordingly, the protection is attached to the exercise of the lawyer's professional functions. Where a lawyer acts in a capacity other than as legal counsel, for example, in a personal or purely business capacity, protection does not apply.

¹² See for example information provided by Singapore available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_singapore.pdf referring to the Evidence Act 1983 as the main source of law for Legal Advice Privilege or information provided by Australia available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_australia_2.pdf referring to the Evidence Act 1995 (Cth).

¹³ See for example inputs received from Ecuador in response to Circular C.9304 referring to both constitutional framework and organic laws (Organic Judicial Function Code; General Organic Procedural Code; Comprehensive Organic Criminal Code). See for example inputs received from El Salvador in response to C.9304 referring to the Code of Judicial Ethics. See also for example inputs received from Algeria, Chile, Colombia, Czech Republic, France, Georgia, Slovakia, Spain in response to Circular C.9304 and information provided by Brazil available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_brazil.pdf.

¹⁴ See for example inputs received from Japan in response to Circular C.9304, where protection is provided through the Attorney Act and the Code of Civil Procedure or Sweden referring to the Swedish Code of Judicial Procedure and the Charter of the Swedish Bar Association. See also inputs received from Switzerland referring to the Swiss Civil Procedure Code, the Swiss Criminal Procedure Code and the Federal Act on Administrative Procedure protecting the confidentiality of communications with qualified lawyers against forcible disclosure.

¹⁵ See for example, information provided by Chile available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_chile.pdf.

55. Sustained confidentiality of the communication between clients and qualified lawyers itself constitutes a condition in some jurisdictions.

56. Protection of confidential communications between a client and a qualified lawyer may be subject to exceptions, the scope of which varies from one country to another, including (but not limited to) where the privilege is waived by the client or where communication between the lawyer and the client has the purpose of committing a crime or fraud.

57. In summary, qualified lawyers that provide legal advice on patent matters constitute a widely recognized category of professionals whose confidential communications with clients may enjoy protection against forcible disclosure under many national laws.

2. *Foreign lawyers*

58. Given that the confidentiality of communications between clients and qualified lawyers is protected under the national laws of many countries, a question arises as to the extent to which such protection applies to foreign lawyers.

59. National laws of some countries specifically extend legal privilege or apply professional secrecy obligations to foreign lawyers.

60. In some countries, registration or authorization to practice in that country provides a domestic basis for the recognition of the foreign professionals as enjoying protection against forcible disclosure of their communications.

61. For example, in Australia, client legal privilege applies to Australian registered foreign lawyers in accordance with Section 117 of the Evidence Act 1995 (Commonwealth (Cth)).¹⁶ In Japan, the duty of confidentiality applies to foreign lawyers registered in Japan. They are listed along with attorney-at-law as professionals who have a right to refuse to testify on any fact learned in the course of duty.¹⁷ In Germany, the obligation of confidentiality provided in Section 43a of the Federal Code of Lawyers applies to foreign lawyers from non-EU-countries who are authorized under the law of their home country to exercise their profession in their home country and have been admitted to the competent German bar association to practice their profession in Germany.¹⁸

62. The absence of domestic registration does not necessarily preclude protection in some countries.

63. In Australia, under Section 117 of the Evidence Act 1995 (Cth), the definition of lawyer explicitly includes an overseas registered foreign lawyer or a natural person who, under the law of the foreign country, is permitted to engage in legal practice in that country. Legal privilege applies to communications between a client and overseas registered foreign lawyers provided they meet the standard requirement for privilege.

64. Under UK case law, legal advice privilege applies only to communications between clients and their lawyers and not to other advisors merely because they provide legal advice. In relation to foreign lawyers, the relevant consideration is whether the communication is made with a foreign lawyer acting in the capacity or function of a lawyer, in connection with the provision of

¹⁶ See information provided by Australia available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-australia_2.pdf referring to Section 117, Evidence Act 1995.

¹⁷ See for example inputs from Japan in response to Circular C.9304.

¹⁸ See information provided by Germany available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_germany.pdf referring to Section 207(3) *Bundesrechtsanwaltsordnung* (BRAO), applying, among other things, the duty of confidentiality provision provided in Section 43(a) to the professionals referred to in Section 206. See also information provided by Germany regarding the application of secrecy obligation to lawyers admitted in a European country practicing their profession in Germany as regulated in Sections 6 and 27 of the *Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland* (EuRAG) in conjunction with Section 43a BRAO.

legal advice. Where this condition is satisfied, the communication benefits from the same legal advice privilege as communications with English lawyers.¹⁹

B. PATENT ATTORNEYS, PATENT AGENTS, OR OTHER INDUSTRIAL PROPERTY ATTORNEYS OR AGENTS

65. Patent practice is a specialized field where legal and technical or scientific expertise are closely interconnected. In many countries, patent advisors are recognized as playing an important role in the functioning of the patent system. They generally advise and assist inventors and applicants in obtaining and maintaining patent protection. They may also represent parties in opposition, invalidation or other proceedings before patent offices and, in certain countries, before courts. In addition, they may advise clients on the full range of available IP protection and enforcement options. Accordingly, their advice typically covers a broad range of legal and technical issues.

66. Clients often need to communicate openly with their patent advisors – among other things, about the technical details and the patentability prospects of their inventions, patenting or other procedural (e.g., opposition) strategies, or other technological options currently not included in a patent application. In these situations, they need certainty that any communication to and from patent advisors will remain confidential and will not be revealed to a third party, in court or otherwise made public.

67. The rationale for protecting confidential communications with patent advisors is similar to that applicable to communications with lawyers. Such protection facilitates full and frank communication between clients and their advisors, strengthens trust in professional relationships, and supports the effective administration of justice in patent-related matters.

68. In many countries, patent-related professional advice may be provided by professionals referred to, *inter alia*, as patent attorneys, patent agents or industrial property attorneys or agents.

69. In a number of countries, they must satisfy professional qualifications and regulatory requirements established under national laws in order to be authorized to practice. These requirements vary across jurisdictions and may include qualification examinations and registration with the national intellectual property office or another competent authority or professional body. They are also bound by high standards of professional codes of conduct.

70. Although they may all provide advice in relation to patent matters, the authorized activities associated with each professional category vary among jurisdictions, and no uniform set of functions is attached to any one category or designation. In some countries, patent attorneys and patent agents cover distinct categories of professionals whose legal status and qualifications differ (for example, in the United States of America *patent attorneys* are qualified lawyers admitted to a bar and authorized to practice before courts in any matter, while also being registered to practice in patent matters before the United States Patent and Trademark Office (USPTO), whereas *patent agents* are also registered to practice in patent matters before the USPTO but are not qualified lawyers). The same professional title does not necessarily designate professionals having the same legal status, qualifications or function in a different jurisdiction. For example, patent agents in some countries can represent parties in court

¹⁹ See information provided by the United Kingdom available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_united_kingdom.pdf). See also PJS Tatneft v Bogolyubov & Ors [2020] EWHC 2437 (Comm), The English Commercial Court has held that legal advice privilege under English law extends to communications with foreign in-house lawyers provided they act in their capacity as a lawyer. The Court considered that legal advice privilege is extended to foreign lawyers regardless of their local standards and regulations, provided they act in the capacity or function of a lawyer.

proceedings under certain conditions whereas in others, their authorized function is more limited to providing technical expertise as consultants, but not as representatives.

71. The various categories of patent advisors often constitute distinct professional categories, separate from the category of qualified lawyers. In the absence of uniformity in either designation or status, national laws determine the required qualifications, registration requirements and authorized functions for such professionals, as well as the protection of their communications with clients.

72. Generally, where a professional secrecy obligation applies to a patent attorney or patent agent, that obligation continues even after the professional has ceased to practice, unless it is waived by the client or, where applicable, by the client's successor.

73. National laws of a number of countries specifically regulate the protection of confidential communications made with patent attorneys, patent agents or industrial property attorneys or agents distinctly from the category of qualified lawyers. National approaches remain, however, diverse regarding how the protection is framed and under which conditions confidential communications are protected.

1. Patent attorneys, patent agents, industrial property attorneys or agents in a domestic environment

1.1 National laws providing for protection

74. In Australia, patent attorney privilege has been extended to patent attorneys by statute. Section 200 of the Patents Act 1990 (Cth) provides that patent attorneys' communications (records and documents) made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client are privileged "in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client."²⁰

75. Similarly, in Singapore, communications with a patent agent that satisfies the conditions set out in Section 95(1) of the Patent Act are privileged from disclosure in the same way as a communication between a person and a solicitor.²¹

76. In Canada, Section 16.1(1) of the Patent Act introduced in 2016 establishes a privilege covering confidential communications between clients and their patent agents.²² It states that "a communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding".

77. In the Czech Republic, Georgia, Hungary, Japan and Switzerland, for example, national laws identify patent attorneys as a professional category whose communications with clients enjoy protection. In the Republic of Slovakia, national law identifies patent representatives as a professional category whose communications may enjoy protection.

78. In South Africa, patent attorneys and patent agents are distinct but closely related professional categories. Patent agents are specialized patent professionals, whereas patent attorneys combine the relevant patent qualification with qualification as an attorney. Section 24(9) of the Patent Act 1978 provides that communications made by or to a patent agent in his or her capacity as such are privileged from disclosure in legal proceedings in the same manner

²⁰ See inputs provided from Australia in response to Circular C.9304.

²¹ See Section 95(1) of the Patents Act 1994 of Singapore (amended up to March 9, 2025) and also information provided by that country available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_singapore.pdf.

²² See Section 16.1(1) of the Patent Act of Canada R.S.C., 1985, c. P-4.

as communications made by or to an attorney in his or her professional capacity. Section 24(9) of the Patent Act covers communications involving a patent attorney acting in the capacity of a patent agent.²³

79. In the United States of America, common law client-attorney privilege has been generally extended to U.S. patent attorneys.²⁴ Privilege has been recognized in limited circumstances to patent agents who provide legal advice to clients within the scope of their authorized practice. These are decisions of U.S. courts at the federal and state levels recognizing such protection. However, the treatment of communications with a non-attorney patent agent is not uniform and depends on the treatment of such a request for privilege by the court.²⁵

80. In France, industrial property attorneys (*conseils en propriété industrielle*) are professionals subject to an obligation of professional secrecy under Article L. 422-11 of the Intellectual Property Code (CPI).

81. Likewise, in Spain, industrial property agents are a category of professionals whose communications are protected against forcible disclosure.

82. In the Republic of Moldova, authorized intellectual property attorneys are subject to a duty of confidentiality under Section 3 of the Government Decision of the Republic of Moldova No. 541 of July 18, 2011 on approving the Regulation on the patent attorneys.

83. In some countries, although patent agents constitute a regulated profession, protection is linked to the status of qualified lawyers and patent agents may enjoy protection against forcible disclosure of their confidential communications only where they are also lawyers and the communications fall under the scope of the applicable law.²⁶

1.2 Conditions of protection

84. A number of national laws regulate the conditions of recognition of the protection of confidential communications with patent attorneys, patent agents, industrial property attorneys or agents.

a. Registration and authorization to practice

85. Generally, communications must be made with a patent attorney, patent agent, industrial property attorney or agent who is entitled to provide the defined professional services required under the applicable law, in order to qualify for protection. This includes professionals who are registered and authorized to practice before the IP Office.

86. For example, in Australia, privilege applies to confidential communications between a client and a patent attorney that is registered, i.e. entered on the Register of Patent Attorneys maintained by the Designated Manager under section 198 of the Patents Act 1990 (Cth) (in particular, the patent attorney must meet the required qualifications and comply with the professionals' standards).

87. In Canada, Section 16.1(1) of the Patent Act applies to communications with a patent agent. The term patent agent is defined in Section 2 of the College of Patent Agents and Trademark Agents (CPATA) Act as an individual who holds a patent agent licence or a patent

²³ See information provided by South Africa available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_south_africa.pdf.

²⁴ See information provided by the United States of America available at https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_united_states_of_america.pdf.

²⁵ See information provided by the United States of America available at https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_united_states_of_america.pdf.

²⁶ See for example, information provided by Malaysia available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_malaysia.pdf.

agent in training licence issued by that College. Licenced patent agents are authorized to practice before the Patent Office. The CPATA maintains a register where licenced patent agents are recorded.

88. In Japan, professional secrecy obligation applies to patent attorneys. Patent attorneys are professionals who have passed the examination conducted by the Japan Patent Office, completed the required practical training and have been registered in the registry maintained by the Japan Patent Attorneys Association before practicing as patent attorneys. In Spain, professional secrecy obligation applies to industrial property agents, that are professionals registered in the Special Register of Agents of the Spanish Patent and Trademark Office, while in France, professional secrecy obligation applies to industrial property attorneys, professionals included on the list of qualified industrial property professionals and registered with the IP Office in order to practice their profession.

89. In Sweden, only authorized patent attorneys are subject to a duty of confidentiality and protected against forcible disclosure of communications in court proceedings. In this respect, the submission from Sweden explains that individuals who provide patent advice without being formally authorized under the Swedish system do not benefit from equivalent statutory protection. They may be bound by contractual confidentiality obligations, but such obligations do not in themselves prevent a court from ordering disclosure or testimony.²⁷

b. Professional capacity and nature of the communication

90. Even if a communication is made with a patent professional whose communications are protected, in some countries, it must relate to advice falling within the scope of the patent professional's activities for which the protection is provided. In addition, the patent attorneys, patent agents, industrial property attorneys or agents must act in their professional capacity. The following paragraphs illustrate these elements.

91. In Australia, confidential communications and documents are privileged under Section 200 of the Patents Act 1990 (Cth) if they were made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client.²⁸ Patent attorneys must be acting in their capacity as a patent attorney rather than engaging in purely commercial or technical capacity. In addition, the privilege attracts to only "intellectual property advice" as defined by subsection 200(2C), of the Patents Act (Cth).²⁹

92. In Canada, application of the privilege under Section 16.1(1) of the Patent Act is limited to confidential communications made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention. Consequently, privilege does not apply where a patent agent's communications with a client or related work do not concern the protection of an invention.

93. In Singapore, privilege applies to communications (with respect to any matter relating to patents) made for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing the person's patent agent or a registered foreign

²⁷ In Sweden, patent attorneys do not legally need to be authorized to practice, but they can voluntarily seek official authorization from an independent government authority. Patent attorneys who obtain such authorization are authorized patent attorneys and they are subject to professional rules, including the duty of confidentiality.

²⁸ Section 200(2C) of the Patents Act 1990 of Australia states that "Intellectual property advice means advice in relation to: (a) patents; or (b) trade marks; or (c) designs; or (d) plant breeder's rights; or (e) any related matters".

²⁹ In *Australian Mud Company Pty Ltd v Coretell Pty Ltd* [2014] FCA 200, the Federal Court of Australia stated that the amendment made in Section 200 of the Patent Act were made "to align the wording in the Patents Act with the wording of section 118 of the Evidence Act. It added that "thus the communication, record or document must be for the 'dominant' purpose of a patent attorney providing intellectual property advice in order for the communication, record or document to attract the privilege. This will ensure that the test for client-attorney privilege is consistent with the test for client-lawyer 'advice' privilege." Further, the court stated that "the amendment also includes a definition of 'intellectual property advice'." This limits the scope of the privilege to only those fields in which patent attorneys have specialist qualifications and knowledge.

patent agent. By using the wording “information which a person is seeking for the purposes of instructing the person’s patent agent”, the provision seems to also protect communications made for the purpose of obtaining information necessary to instruct the patent agent.

94. In countries where the duty of confidentiality is tied to a professional’s status, information obtained or communicated in the course of performing the professional duties entrusted to that professional is protected. For example, in France, the professional secrecy obligation extends to all information, in all matters and in relation to all services entrusted to the industrial property attorney. Article 176 of the Law on Patents, No. 24/2015 of July 24, 2015, of Spain uses a similar wording extending the professional secrecy obligation to matters in which the industrial property agent is involved and identifies certain matters covered by that obligation.³⁰

95. In some countries, privilege only applies provided the communication is confidential or is intended to be confidential. This means that the protection does not cover all communications between the advisor and the client, only those that were shared in confidence, with the specific purpose of sharing information that was meant to be kept in secret.

1.3 Basis of protection

96. National laws use different legal mechanisms to protect confidential communications of patent attorneys and patent agents.

97. In civil law countries, protection generally derives from different sources of laws.³¹ Protection is usually based on a professional secrecy obligation. Many countries have adopted statutory provisions under which patent attorneys, patent agents, industrial property attorneys or agents have an obligation not to disclose any communications between them and their clients in the course of their profession. In some countries, protection is also coupled with the right to refuse to testify in court on any matter falling under the professional secrecy obligation or produce documents containing information covered by such secrecy obligation.

98. In addition, the protection is further supported in some countries by rules providing for penalties in the event of breach of the duty of confidentiality by patent attorneys, patent agents, industrial property attorneys or agents.

99. Consequently, in civil law countries there is no uniform approach as to how protection against forcible disclosure of confidential communications between clients and their patent attorneys or patent agents is framed under the law. The legal basis, scope and mechanisms through which such protection is afforded vary according to each country’s legal framework and legislative approach.

100. In France, Article L. 422-11 of the Intellectual Property Code specifies the scope of secrecy obligation binding industrial property attorneys. This provision introduces a duty of professional secrecy for industrial property attorneys the scope of which is similar to the one applicable to lawyers.³² This was confirmed by the Paris appeals court, which considered that a

³⁰ See inputs received from Spain in response to C.9304. Spanish law provides an illustrative list of communications or documents subject to confidentiality, including: (a) the assessment of the patentability of an invention, or the registrability of an industrial design, a trademark or a trade name; (b) the preparation or processing of an application for a patent, utility model, industrial design, trademark or trade name; and (c) any opinion regarding the validity, scope of protection or infringement of the subject matter of a patent, utility model, industrial design, trademark or trade name, as well as of an application for any of these types of intellectual property.

³¹ See for example, inputs received from Spain in response to Circular C.9304.

³² See inputs received from France in response to Circular C.9304.

letter sent in confidence by the industrial property attorney to the opposing party's lawyers is covered by professional secrecy and may not be produced in proceedings.³³

101. Under the national laws of other countries, provision regarding the obligation of secrecy and right to refuse to testify or produce documents are both contained in the Patent Act or Patent Attorney Act.

102. In Spain, industrial property agents are required to maintain confidentiality in respect of matters in which they are involved and have the right to refuse to disclose communications exchanged with clients or third parties regarding proceedings before the Spanish Patent and Trademark Office in accordance with Article 176.5 of the Law on Patents No. 24/2015 of July 24, 2015. Article 371 of the Law on Civil Procedure (LEC) lays down the procedure applicable in civil proceedings when a witness invokes, by reason of their status or profession, a duty of secrecy concerning facts on which they are questioned. The witness must state the grounds for refusing to testify, and the court decides whether the witness is exempt from answering.³⁴

103. The Patent Attorneys Act of Hungary contains an obligation of secrecy and imposes on a person exercising patent attorney activities the obligation to refuse to give witness evidence or supply data on patent attorney secrets in any official or judicial proceedings.³⁵

104. Another example is Belgium where patent attorneys are subject to professional secrecy obligation and provisions have been introduced in the Belgian Code of Economic Law that gives anyone the right to refuse to make certain communication between the patent attorney and his client public, within the context of judicial or administrative proceedings and forbids anyone to make such communication public without the consent of the client of the patent attorney.³⁶

105. In other countries, including the Czech Republic, Georgia, the Republic of Moldova and the Slovak Republic, the Patent Attorney or Patent Agent Acts set out professional secrecy obligations by which patent attorneys or patent agents must maintain confidentiality of information and facts obtained in connection with the provision of patent attorney services.³⁷

³³ See decision of the Paris Court of Appeal, of November 24, 2015, No. 14/16359. Recalling the absolute nature of the duty of professional confidentiality, similar to that applicable to lawyers, pursuant to Article L. 422-11 of the Intellectual Property Code, the court held that correspondence sent by an industrial property attorney to a lawyer was covered by professional secrecy where it had been transmitted on a confidential basis and expressly referred to Article L. 422-11 of the Intellectual Property Code. The Court rejected the argument that the recipient lawyer could freely disclose the correspondence on the ground that the secrecy obligation applicable to industrial property attorneys did not apply to that lawyer. It considered that such an interpretation would undermine the effectiveness of that obligation, which is intended to protect the interests of the client concerned (non-official translation).

³⁴ See inputs from Spain in response to Circular C.9304. Article 371 of the Law 1/2000 on Civil Procedure states that: "1. When, due to his status or profession, the witness has a duty to keep secret regarding the facts about which he is questioned, he will state his reasoned opinion and the court, considering the grounds for the refusal to testify, will decide, by means of a ruling, what is appropriate in law. If the witness is released from answering, this will be recorded in the minutes. 2. If the witness alleges that the facts about which he is questioned belong to a matter legally declared or classified as reserved or secret, the court, in cases where it considers it necessary for the satisfaction of the interests of the administration of justice, will request ex officio, by means of a ruling, from the competent body the official document that proves said character.

The court, having verified the basis of the allegation of the reserved or secret nature, will order the document to be attached to the case file, noting the questions affected by official secrecy".

³⁵ Article 15 of Act No. XXXII of 1995 on Patent Attorneys (consolidated text of January 1, 2018) states: (2) The person exercising patent attorney activities shall be obliged to keep patent attorney secrets, unless this Act provides otherwise. This obligation of secrecy shall extend to documents and other data carriers of the patent attorney that contain patent attorney secrets and (3) The person exercising patent attorney activities shall refuse to give witness evidence or supply data on patent attorney secrets in any official or judicial proceedings, except if the owner of the patent attorney secret released him from the obligation of secrecy.

³⁶ See information provided by Belgium available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_belgium.pdf.

³⁷ See inputs received from the Czech Republic, Georgia, the Republic of Moldova and the Republic of Slovakia in response to Circular C.9304. National laws of other countries have introduced a professional secrecy obligation for patent attorneys or patent agents, for example Argentina, Austria. See information provided for these countries

106. In some countries, patent attorneys or patent agents' professional secrecy obligations are coupled with provisions contained in civil and/or criminal procedural law.³⁸

107. In Japan, Article 30 of the Patent Attorney Act imposes a duty of confidentiality on patent attorneys (and former patent attorneys). Article 197(1)(ii) of the Code of Civil Procedure includes patent attorneys, alongside attorneys-at-law, among the professionals who may refuse to testify on facts learned in the course of their professional duties that are subject to confidentiality. Article 220(iv) of the Code of Civil Procedure further governs the production of documents. Under that provision, a person in possession of a document containing information covered by the duty of confidentiality referred to in Article 197(1)(ii), or information constituting a technical or professional secret under Article 197(1)(iii), may refuse to produce that document, provided that the relevant duty of confidentiality has not been lifted. The person in possession of the document may be the professional concerned, the client, or a third party.

108. In Sweden, a patent attorney authorized under the Act on Authorization of Patent Attorneys is bound by a duty of confidentiality according to Section 6 of this Act. In addition, patent attorneys are prevented from being compelled to testify concerning matters entrusted to them in the course of their professional practice or produce a written document if its content is such that they may not be heard as a witness regarding it according to the Swedish Code of Judicial Procedure.³⁹

109. In Switzerland, Article 10 of the Patent Attorney Act regulates the professional secrecy obligations of patent attorneys. They are required to maintain confidentiality concerning all secrets they are entrusted in their professional capacity or which come to their knowledge in the course of their professional activities. In addition, a patent attorney is not bound by the duty to cooperate in civil proceedings pursuant to Art. 160(1)(b) of the Civil Procedure Code and is allowed to refuse to produce a document that is subject to professional secrecy. A patent attorney may refuse to testify in relation to confidential matters that have been confided to them or come to their knowledge in the course of their professional work in criminal proceedings in accordance with Article 171 of the Swiss Criminal Procedure Code.⁴⁰

110. In certain common law countries, including Australia, Canada, Singapore, South Africa and the United Kingdom, statutory provisions in the Patent Act govern privilege of communications between a client and a patent attorney or patent agent.

111. In the national law of several countries, criminal sanctions in case of breach of professional secrecy by patent attorneys, patent agents or industrial property attorneys or agents are also provided to enforce and punish the unauthorized disclosure of confidential client communications.⁴¹

available at: https://www.wipo.int/en/web/scp/electronic-forum/confidentiality_advisors_clients/national_laws_practices.

³⁸ See inputs received from Japan, Sweden, Switzerland in response to Circular C.9304. Also see information provided by Germany available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_germany.pdf.

³⁹ See inputs received from Sweden in response to C.9304, referring to Section 6 of the Act on Authorization of Patent Attorneys (2010:1052) and Chapter 36 of the Swedish Code of Judicial Procedure (1942:740). See also Chapter 38 Section 2 of the same code regarding the producing of documents.

⁴⁰ See inputs received from Switzerland in response to C.9304 and information provided by the country available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_switzerland.pdf. It is to be noted that, unlike lawyers, communications with patent attorneys are excluded from the exemption to the obligation to cooperate provided in Article 13 of the Federal Act on Administrative Procedure.

⁴¹ See for example information provided by Germany and Switzerland available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_germany.pdf ; https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_switzerland.pdf and inputs received from France and Spain in response to Circular C.9304 (in these countries, however, criminal sanctions do not expressly refer to patent attorneys or patent agents but are applicable to breaches of confidentiality by professionals who are bound by a duty of professional secrecy).

2. *European Patent Attorneys*

112. In Europe, a European patent attorney is a category of professionals distinct from the national patent attorneys or patent agents. A European patent attorney has his/her own professional status and rules of qualification.

113. Article 134 of the European Patent Convention (EPC) regulates the profession of European patent attorneys. Under this provision, they are entered on the list of professional representatives maintained by the European Patent Office (EPO). They are authorized to represent inventors and businesses before the EPO and are bound by a professional secrecy not to disclose information accepted in confidence in the exercise of their duties unless they are released from the obligation.⁴²

114. European patent attorneys enjoy privilege in relation to communications made with clients and any other person in proceedings before the European Patent Office in accordance with Rule 153 of the EPC.

115. However, whether European patent attorneys, who are entered on the list of professional representatives of the EPO, enjoy protection against forcible disclosure of their communications in national court proceedings is a matter of domestic law.

116. Some European countries and the UPC recognize them within their applicable laws as professionals that enjoy protection of their confidential communications with clients in national court proceedings.

117. For example, in Denmark, European patent attorneys may generally refuse to testify on knowledge acquired through their work.⁴³ In Belgium, European patent attorneys enjoy the same protection as patent attorneys that are members of the national patent attorney institute giving them the right to refuse the disclosure of certain communications within the context of judicial or administrative proceedings and the obligation not to make such communication public without the client's consent.⁴⁴ In the United Kingdom, privilege provided in Section 280 of the Copyright, Designs and Patents Act 1988 applies to communications with a person on the European List (i.e., a European patent attorney) in accordance with Section 280(3).

3. *Foreign patent attorneys, patent agents or industrial property attorneys or agents*

118. Patent protection is commonly sought in multiple jurisdictions, and patent prosecution frequently involves patent practitioners located in different countries. Patent applicants and patent holders may therefore rely on the services of patent professionals established or qualified in different jurisdictions. In this context, the extent to which confidential communications with foreign patent professionals are protected in a jurisdiction, as well as the extent to which protection afforded to communications with domestic patent professionals is recognized when disclosure is sought in another jurisdiction, may be of particular importance to patent applicants and patent holders.

119. Only a few national laws address the treatment of communications involving foreign patent professionals.

120. The national laws of some countries expressly recognize foreign patent attorneys or patent agents as professionals whose confidential communications may enjoy protection against forcible disclosure under their jurisdiction.

⁴² See Article 2 of the Regulation on discipline for professional representatives of 21.10.1977.

⁴³ See information provided by Denmark available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_denmark.pdf referring to Section 170 of the Consolidate Act on the Administration of Justice (Consolidate Act No. 1284 of November 14, 2018).

⁴⁴ See information provided by Belgium at: [docs-en-confidentiality-advisors-clients-docs-03_belgium.pdf](https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_belgium.pdf)

121. For example, Section 200(2B) of the Australian Patents Act 1990 states:

“200(2B) A reference in subsection 2 or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided”.

122. The provision expands the definition of “patent attorney” to include an individual authorized to do patents work under the law of another country or region. The privilege applies to the extent that the attorney is authorized to provide intellectual property advice similar to the one provided by Australian registered patent attorneys.

123. Section 16.1(4) of the Patent Act of Canada also includes a provision regarding communications with patent agents from countries other than Canada:

“(4) A communication between an individual who is authorized to act as the equivalent of a patent agent under the law of a country other than Canada and that individual’s client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between a patent agent and their client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).”

124. Under the national law of Canada, privilege of communications with foreign patent agents is applicable if the communication is: (i) between someone authorized to act as the equivalent of a patent agent under the law of a country and their client; (ii) intended to be confidential; (iii) made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention; and (iv) privileged under the law of the foreign country.

125. Section 54 of the Evidence Act of New Zealand provides that privilege may apply to foreign patent advisors whether the functions of overseas patent advisors correspond to those of a registered patent attorney.

126. Most national laws, however, do not address the treatment of confidential communications between clients and foreign patent attorneys or patent agents.

127. In the absence of an express statutory provision, some common law courts recognize the legal mechanisms regarding the confidentiality of communications between clients and patent attorneys established in another jurisdiction as foreign privilege, in accordance with choice of law rules.

128. United States case law has developed different approaches to determining whether privilege applies to foreign patent attorneys under different doctrines. Under the non-choice of law approach, no privilege for a foreign patent practitioner is recognized, because he or she is neither a US attorney nor the agent or immediate subordinate of an attorney. However, another approach applied by a number of U.S. federal courts, is the “touching base” approach.

129. To assess whether a confidential communication with foreign patent advisors is protected from discovery, U.S. courts will first determine whether the communication involves or “touches base” with U.S. or foreign law and examine whether the applicable law thus identified recognizes privilege for the communication involved. Communications touching base with the United States are generally governed by U.S. privilege law, whereas communications relating predominantly to foreign patent matters may be governed, as a matter of comity, by the law of the relevant foreign country. Thus, communication with a foreign patent agent regarding assistance in prosecuting foreign patent applications may be privileged if the privilege would apply under the law of the foreign country in which the patent application is filed and that law is not contrary to the public policy of the United States (See *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1169-71 (D.S.C. 1975)). Courts have also referred to the “comity plus function approach”, whereby the Court will abide by the outcome dictated by comity when the

foreign patent agent renders independent legal services. In *Mendenhall v. Barber-Greene Co.* 531 F. Supp. 951, 952 (N.D. Ill. 1982), the court held that where a U.S. client sought a foreign patent through his/her U.S. attorney, the U.S. attorney operated only as a conduit for information between the client and the foreign agent. Therefore, communication was effectively between a U.S. client and a foreign agent, and communication was privileged only if the foreign law would recognize such a privilege. Courts have also referred to the “most direct and compelling interest” approach under which the court will weigh the competing interests of all involved states and decides which one has the greatest interest in seeing its own law applied.⁴⁵

130. In South Africa, national law does not extend expressly privilege to foreign patent agents or foreign patent attorneys. However, information provided by South Africa indicates that, in accordance with the common law, courts may recognize privilege of communications between a client and a foreign patent agent or a foreign patent attorney acting in the capacity of a patent agent (e.g. advising on the patentability of an invention or drafting, filing and prosecuting a patent application) if the foreign advisor is either (i) a legal advisor being contacted for the purpose of obtaining legal advice or (ii) if such communications are privileged under the law of the foreign country concerned.⁴⁶

131. At the European level, the Rules of Procedure of the UPC provide a broad definition of what is a patent attorney and state that “the expression “patent attorney” shall include a person who is recognised as eligible to give advice under the law of the state where he practises in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice” (see Rule 287.6(b) of the Rules of Procedure).

132. In the absence of uniform rules governing the cross-border protection of confidential communications between clients and patent advisors, possible legal remedies and practical approaches to cross-border issues are contained in document SCP/29/5, in paragraphs 144 to 169. Further, reference is made to documents presented during the Sharing Session Focusing on Cross-Border Aspects of Confidentiality of Communications between Clients and Their Patent Advisors which took place in 2022, in particular the Group B+ Draft Agreement on Cross Border Aspects of a Client Patent-Attorney Privilege.⁴⁷

C. PERSONS ATTRACTING PROTECTION BEYOND THE CATEGORY OF PATENT ATTORNEYS, PATENT AGENTS, INDUSTRIAL PROPERTY ATTORNEYS OR AGENTS

133. While protection is generally attached to communications made with the professional categories described above, it may also be relevant to consider whether protection is applicable to persons that do not belong to these categories of professionals.

134. An example where protection is not limited to industrial property agents is Spain. Article 176(6) of the Law on Patents 24/2015, of July 24, 2015 applies the duty of confidentiality and right to refuse to disclose communications regarding proceedings conducted before the Spanish Patent and Trademark Office to persons who are not industrial property agents but interested parties with capacity to act before the IP Office as provided in Article 175(1)(a) of the law. Article 175(1)(a) extends the protection to persons who do not hold the status of Industrial Property

⁴⁵ See information provided by the United States of America available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_united_states_of_america.pdf.

⁴⁶ See information provided by South Africa available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-03_south_africa.pdf.

⁴⁷ Webcast of the session available here: https://webcast.wipo.int/video/SCP_34_2022-09-28_116794 and Group B+ Draft Agreement on Cross Border Aspects of a Client-Patent-Attorney Privilege available at: https://www.wipo.int/edocs/mdocs/scp/en/scp_34/scp_34_b_cap.pdf.

Agent but who, under the conditions established by the applicable law, may act as representatives before the Spanish Patent and Trademark Office.

135. In some countries, protection of confidential communications attached to the patent attorney may cover employees, assistants or other persons working under the supervision of the patent attorney. Nature and scope of the coverage vary.

136. For example, Article 6(2) of the Patent Attorneys Act of Estonia states that “information entrusted to a patent attorney is confidential. A patent attorney or an employee of a patent attorney’s firm may not be questioned as a witness or required to provide an explanation regarding circumstances that have come to their attention while providing legal services”.

137. In Switzerland, Article 10.2 of the Federal Act of March 20, 2009, on Patent Attorneys requires that patent attorneys ensure that persons assisting them maintain professional secrecy.

138. Patent matters may require the services of other persons providing patent-related services, including technical or scientific experts providing specialist knowledge concerning the technology underlying an invention, patent search professionals conducting and analyzing prior-art or other patent-related searches, technology transfer officers working in universities, research institutions or other similar organizations and coordinating the protection and commercialization of inventions, patent portfolio management consultants assisting with the strategic management of patent assets, licensing professionals involved in the commercial exploitation and transfer of patented technology, and providers of administrative patent services, for example, persons arranging payment of renewal or annuity fees.

139. Such activities do not automatically place those persons within a professional category whose communications are independently benefiting from protection against forcible disclosure.

140. Whether they fall within the scope of protection will depend on whether the person falls under the category whose communications are protected under the applicable law and whether the communication or advice fall within the scope of protection.

141. Where no such statutory protection applies, confidentiality may be established by agreement between the parties; however, such contractual obligations do not, in themselves, provide protection against disclosure in court proceedings.

D. IN-HOUSE LEGAL ADVISORS AND IN-HOUSE IP ADVISORS

142. Companies, universities and other entities that seek patent protection for their innovations may employ advisors to provide day-to-day legal advice, including on patent-related matters. These advisors play an important role in helping such entities manage the legal and practical obligations associated with the protection, management and enforcement of patents. In many cases, these entities employ patent attorneys for the drafting and prosecuting of their patent applications.

143. Issues regarding whether the protection of the confidentiality of communications should be extended to communications between in-house legal advisors and their clients (their employer) have already been examined in the SCP. It has been argued that, as employees of the company they advise, in-house legal advisors do not have the same independent status as an attorney in private practice, and therefore, privilege should not apply.⁴⁸ On the other hand, particularly where an in-house legal advisor is a qualified lawyer, the advisor is obliged to perform legal duties in full conformity with the professional disciplinary code of conduct as other

⁴⁸ See paragraph 143 of document SCP/29/5 Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information.

lawyers in private practice. This supports the argument that in-house legal advisors should enjoy the same privilege as independent qualified lawyers.

144. Similarly, in the field of IP, the issue of whether communications between an in-house patent advisor (for instance, a formally recognized patent attorney) and their client, i.e., an employer, should be given the same level of protection of confidentiality of advice as in the case of independent patent practitioners has been addressed on the basis of similar arguments.⁴⁹

145. The status of in-house legal advisors varies around the world. In some countries, there is no distinct professional status for in-house legal advisors, and members of the relevant profession may practice either externally or as employees of a company. In other countries, in-house practice is subject to specific professional rules governing the exercise of the profession. In yet other countries, the regulated profession applicable to external legal advisors cannot be exercised within an ordinary employment relationship with the company receiving the advice. In such countries, persons providing legal advice within a company do not have the same professional status as external legal advisors. However, it is important to note that the privilege available to qualified lawyers or patent attorneys may be distinctly available to in-house counsels and in-house patent advisors unless local laws impose a bar or presume voluntary suspension of practice owing to their status as employees of a company. For example, in India, the Supreme Court has noted that in-house lawyer's economic dependence and close ties with its employer does not enjoy a level of independence comparable to that of an external lawyer. However, the communication by the in-house counsel is entitled to protection insofar as any such communication is made to the external legal advisor of his employer.⁵⁰

146. Different approaches have been adopted regarding the protection against forcible disclosure of confidential communications between a client and an in-house legal advisor.

147. In some common law jurisdictions, in general, the fact that a lawyer is employed by a client does not, in itself, prevent client-attorney privilege from applying. However, particular importance is attached to the capacity in which the in-house lawyer acts and to the nature or purpose of communication. Subject to the applicable law, privilege may protect confidential communications where the in-house lawyer is acting in a professional legal capacity and the communication satisfies the applicable test and is made for the purpose of providing or obtaining legal advice.⁵¹

148. Section 128A of the Evidence Act of Singapore establishes a duty of confidentiality for legal counsel in an entity.⁵² In addition, Section 131 of the same act establishes that "no one may be compelled to disclose to the court any confidential communication which has taken place between him or her and his or her legal professional adviser", the term "legal professional adviser" including a legal counsel employed in an entity (Section 131(2)(b)).

⁴⁹ Issue regarding the protection of the confidentiality of communications between an in-house patent advisor and his/her client, i.e., an employer, has been presented during SCP/21 in particular in presentations [SCP/21/REF/A/CAP/DESAI](#) Protection of Confidentiality in IP Advice: The In-House Counsel Perspective and [SCP/21/REF/A/CAP/BLOECHLE](#) Client's Perspective: How Privilege Plays a Role and was addressed in paragraph 143 of document SCP/29/5 Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information and paragraphs 50 to 52 of document SCP/13/4 The Client-Attorney Privilege.

⁵⁰ Suo Motu Writ Petition (Criminal) No.2 of 2025.

⁵¹ See information provided by Australia, the United-Kingdom and the United States of America available at: https://www.wipo.int/en/web/scp/electronic-forum/confidentiality_advisors_clients/national_laws_practices.

⁵² Section 128A of the Evidence Act of Singapore states: "In-house counsels are prohibited, except with their entity's express consent, to disclose any communication made to him or her in the course and for the purpose of his or her employment as such legal counsel, or to state the contents or condition of any document with which he or she has become acquainted in the course and for the purpose of his or her employment as such legal counsel, or to disclose any legal advice given by him or her to the entity, or to any officer or employee of the entity, in the course and for the purpose of such employment."

149. In some countries, in-house lawyers are subject to the same or substantially the same professional rules, including professional secrecy obligations, as lawyers in private practice. Consequently, a duty of confidentiality applies to in-house lawyers in the same way as to external lawyers.

150. For example, in Spain an in-house attorney is subject to the same professional secrecy obligations as an external attorney. Article 39 of the Royal Decree 135/2021, of March 2, 2021 regulating the legal profession provides that attorneys may practice the legal profession as corporate counsel under an employment relationship. Notwithstanding their employment relationship, they must exercise the profession with freedom, independence and professional secrecy. Article 21 of the same decree applies to all legal professionals, irrespective of the form in which they practice, including where they act in an employment relationship. It establishes a duty of confidentiality in respect of all facts and information of which legal professionals become aware in the course of their professional activities, and a right not to disclose such information.

151. Another approach taken is to adopt a specific regime regarding the protection against forcible disclosure of confidential communications between clients and in-house legal advisors.

152. Article 167a) has been recently introduced in the Swiss Civil Procedure Code. It allows a third party to a proceeding who works in an in-house legal service the possibility to refuse to cooperate with the court and to refuse to produce documents connected with the activities of its in-house legal service if:

- the company is registered as a legal entity in the Swiss Commercial Register or in a comparable foreign register;
- the legal service is headed by a person who holds a cantonal license to practice law or who fulfils the professional requirements for practicing law in their country of origin; and
- the activity would be considered profession-specific for a lawyer.

The protection available to such in-house advisors is limited to civil court proceedings.⁵³

153. In France, Article 58-1 has been introduced in the Act of December 31, 1971 reforming certain judicial and legal professions by an amendment provided in the Act of February 23, 2026, the entry into force of the law being postponed to a date that will be provided by decree. Under this new law, legal opinions, defined as “a personalized intellectual service aimed at providing an opinion or advice based on the application of a legal rule” made by in-house counsels are treated as confidential if they meet certain conditions. The confidential character applies to communications made by in-house counsels (or, at their request and under their supervision, by a member of their team under their authority) provided that the conditions concerning the qualifications of the in-house counsel, the nature of legal advice and the formal identification of the communications as confidential are satisfied. Under this new rule, protected legal advice cannot be seized or relied upon in civil, commercial or administrative proceedings. The confidentiality attached to the legal advice provided by an in-house counsel cannot be invoked in criminal or tax proceedings, or in the context of the investigative or supervisory powers of European Union authorities.⁵⁴

154. Regarding patent attorneys and patent agents, in some countries, the fact that a patent attorney or patent agent works in-house, does not in itself, exclude that professional from enjoying the protection.

155. For example, Section 200 of the Patent Act 1990 (Cth) of Australia establishes a privilege for a registered patent attorney. According to the information provided by Australia, privilege is

⁵³ See inputs received from Switzerland in response to C.9304.

⁵⁴ See inputs received from France in response to C.9304.

applicable to communications with an in-house patent attorney provided that the in-house patent attorney meets the conditions set out in Section 200 of the Act: (a) the patent attorney is registered under the Patents Act; (b) the patent attorney is acting in their capacity as a patent attorney rather than in any commercial or technical capacity; (c) the privilege exists “in the same way, and to the same extent” as communications, records or documents made for the dominant purpose of a legal practitioner providing legal advice to a client (subsections 200(2) and 200(2A), Patents Act 1990); (d) the privilege adheres to only “intellectual property advice” as defined by subsection 200(2C), Patents Act 1990.⁵⁵

156. In Germany, in-house attorneys admitted to the Bar as *Syndikusrechtsanwälte*, as well as in-house patent attorneys admitted as *Syndikuspateentanwälte*, are subject to the professional duty of confidentiality applicable to lawyers and patent attorneys. Under Sections 43a and 46c of the Federal Code for Lawyers (BRAO) and Section 39a and 41d of the Patent Attorney Code (PAO), the secrecy obligation applicable to lawyers and patent attorneys applies to in-house attorneys and in-house patent attorneys. This obligation of secrecy is accompanied by procedural rules governing the right to refuse testimony concerning information subject to professional secrecy in civil legal procedure.

157. As indicated in paragraph 35, Rule 287(2) of the Rules of Procedure of the Unified Patent Court extends the attorney-client privilege to communications between a client and a lawyer, or patent attorney employed by the client and instructed to act in a professional capacity.

VI. CONCLUDING OBSERVATIONS

158. The previous sections of the study showed that there is no uniform approach among national and regional laws as regards the categories of patent professionals whose confidential communications with clients are protected against forcible disclosure.

159. Qualified lawyers constitute a principal category of professionals whose confidential communications generally enjoy protection in many jurisdictions. Where a lawyer provides legal advice in patent matters, protection typically derives from the general rules governing client-attorney privilege or lawyers' professional secrecy. However, the basis, application and scope of protection afforded by privilege or professional secrecy obligations varies across countries.

160. The treatment of patent attorneys, patent agents, IP attorneys or agents is more diverse. In some countries, rules of privilege or professional secrecy obligations apply to qualified lawyers only, with the consequence that patent advisors who are not lawyers do not benefit from equivalent protection. In other countries, national law expressly recognizes patent attorneys, patent agents (and IP attorneys and agents) as categories of professionals whose confidential communications enjoy protection against forcible disclosure.

161. The legal mechanisms through which such protection is provided also differ. Notwithstanding these differences, certain common conditions may be observed. In particular, protection generally requires that the patent attorney, patent agent, IP attorney or IP agents are entitled to provide patent related services under the applicable legal framework and is acting in his or her professional capacity. In addition, the communication must generally relate to advice or services falling within the scope of the professional activities for which protection is provided.

162. Further complexity arises where patent advice has a cross-border dimension. Differences among the national approaches affect the predictability of protection in cross-border situations.

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⁵⁵ See information provided by Australia available at: https://www.wipo.int/documents/d/scp/docs-en-confidentiality-advisors-clients-docs-australia_2.pdf.