

From: Ploeger-He@bmj.bund.de
Sent: Wednesday, August 12, 2009 2:10 PM
To: Forum, Scp
Subject: 13th session of WIPO SCP, letter from the secretariat dated April 20th 2009

Dear Tomoko,

thanks a lot for the opportunity to comment on the reports prepared for the 13th session of the SCP. We would like to seize this opportunity and propose an amendment of the document SCP/13/4. The current wording in No. 35 (describing the situation in Germany) should be replaced by the following text:

"In Germany patent attorneys and lawyers are under a professional obligation of secrecy (section 39a paragraph 2 of the Patent Attorney Act, section 43a of the Federal Lawyers' Code). This duty relates to everything that becomes known to them in the course of the practice of their profession. This does not apply to facts that are common knowledge or that do not need to be kept secret given their significance.

Patent attorneys as specialised legal counsels may represent their clients before the German Patent and Trademark Office, the German Office for Plant Variety Protection, the German Federal Patent Court (in patent, utility model, trademark and plant variety protection cases, including nullity cases) before the German Federal Supreme Court with regard to patent validity cases and compulsory licensing, and before all the authorities where representation by an attorney-at-law is not obligatory. The latter is required e.g. in patent violation cases before a District Court.

In order to protect the professional secrecy the German codes of civil and criminal procedure provide for a right for legal counsel to refuse to give evidence in court. The same right applies when the right holder claims a right on information from the legal counsel in accordance with the Directive on the enforcement of intellectual property rights (2004/48/EC). German Criminal Law outlaws the unauthorized disclosure of information relating to the client."

To my mind it would also have merits to focus in further discussions on the questions if and how a national „Client Attorney Privilege“ (especially in a civil law country) is being recognized in a different jurisdiction (especially in a common law country). It seems to me that a lot of the uncertainty stakeholders may feel concerning the international dimension of the client attorney privilege stems from the fact that they cannot be absolutely sure that the privilege granted by their own jurisdiction enjoys full recognition in any other foreign jurisdiction.

Best regards from Berlin

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