

# FEMIFI

Fédération Européenne des Mandataires  
de l'Industrie en Propriété Industrielle

Europäischer Verband der  
Industrie-Patentingenieure

European Federation of Industrial  
Property Agents in Industry

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**Mr. Francis Gurry**

Director General

**World Intellectual Property Organisation**

34, chemin des Colombettes

CH - 1211 - Geneva 20

Switzerland

Paris, the 19<sup>th</sup> of August, 2009

Dear Mr. Gurry,

**Re: Submission of the FEMIFI position paper on 'Client Attorney Privilege'.**

Further to your invitation to make submissions relating to the question of 'Client-Attorney Privilege', please find enclosed the FEMIFI position paper in this matter.

We will follow developments in this matter with interest.

Yours sincerely,



**Pierre Gendraud**

President

FEMIFI

Enc.

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## **“Client-Attorney Privilege” - FEMIFI's Position on a privilege for Intellectual Property Professionals working in-house**

FEMIFI, the European Federation of Industrial Property Agents in Industry, represents 11 national associations totalling more than 3500 Intellectual Property Professionals (IP Professionals) working in-house in industry throughout Europe.

### **Discussion of Background**

European industry places an important focus on innovation and on the development of new products and services. Since innovative enterprises need to invest in research and development even in times of macro-economical downturn, jobs created by innovative enterprises have been seen to be more crisis-proof than jobs in sectors with low innovation.

Investments in innovation need to be protected by an adequate intellectual property strategy and intellectual property rights (IP Rights) in accordance with such strategy. Because of the importance of such protection, more and more enterprises have decided to hire IP Professionals in order to have access to high-quality in-house advice on matters of IP Rights. This is not only true for large enterprises but also for innovative mid- and small-size companies depending on their IP strategy and the number of IP-Rights being created.

It is the duty of such in-house IP Professionals to provide adequate evaluations and advice to management and inventors. It is a further important task of such IP Professionals to manage, monitor and approve the work of outside IP counsels that have been commissioned by the company. Many in-house IP Professionals have therefore - in addition to their knowledge and qualification in technical and business matters - acquired qualifications at least equivalent to IP counsels in private practice.

The current situation, in which jurisdictions, especially of some common law countries, refuse to extend the Client-Attorney Privilege – that is the right to resist requests for disclosure of internal communications - to in-house IP Professionals, is unsatisfactory. The current situation not only weakens this important profession but furthermore harms the position of enterprises employing such IP Professionals.



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## Position of FEMIFI

FEMIFI therefore sees an essential need for a broader definition and application of a privilege for IP Professionals in an international context and welcomes and supports the efforts of the World Intellectual Property Organization in this respect.

FEMIFI urges the recognition of the importance of IP Professionals working as employees of small-, mid- or large-size enterprises.

FEMIFI invites the World Intellectual Property Organization to resume the discussion and to install a balanced and harmonized privilege at an international level including such in-house IP Professionals.

FEMIFI postulates that, for a grant of said privilege to an in-house IP Professional, compliance with one of the following two conditions shall be sufficient:

- the profile of duties and responsibilities of the IP Professional in his/her in-house function meets the defined criteria (adequate list of criteria to be established) or
- the IP Professional is admitted for representation before national or regional offices for IP matters (e.g. national patent offices, European Patent Office, OHIM).

Paris, the 19<sup>th</sup> of August, 2009,

