Australian Government
IP Australia

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PATENTS
TRADE MARKS
DESIGNS
PLANT BREEDER'S RIGHTS

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Robust intellectual property rights delivered efficiently

Overview of presentation

- History of client-attorney privilege in Australia
- Initiative for change
- Recent statutory amendments
- Aspirations
- Mechanism for change
- Treaty process in Australia

History of client attorney privilege in Australia – statutory basis

- First introduced in the *Patents Act 1903*
- *Patents Act 1952* (re-introduced in 1960)
- Current *Patents Act 1990*, subsection 200(2)
  - amended in 1998

Initiative for change

- *Eli Lilly v Pfizer Ireland Pharmaceuticals (No 2)* [2004] FCA 850
- Institute of Patent and Trademark Attorneys (IPTA) & Law Council of Australia identified possible area for legislative change
- A need to achieve a standard of certainty
- A desire to have court proceedings focus on key merits of right (i.e. novelty, inventive step etc.) rather than on what should be discoverable

Recent statutory amendments

- *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* came into effect on 15 April 2013.
  - Extends privilege to overseas attorneys who are authorised to provide intellectual property advice.
  - Better aligns patent and trademark attorney privilege with that attaching to communications to and from lawyers.

Patents Act 1990, subsection 200(2)

(2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is 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.

(2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

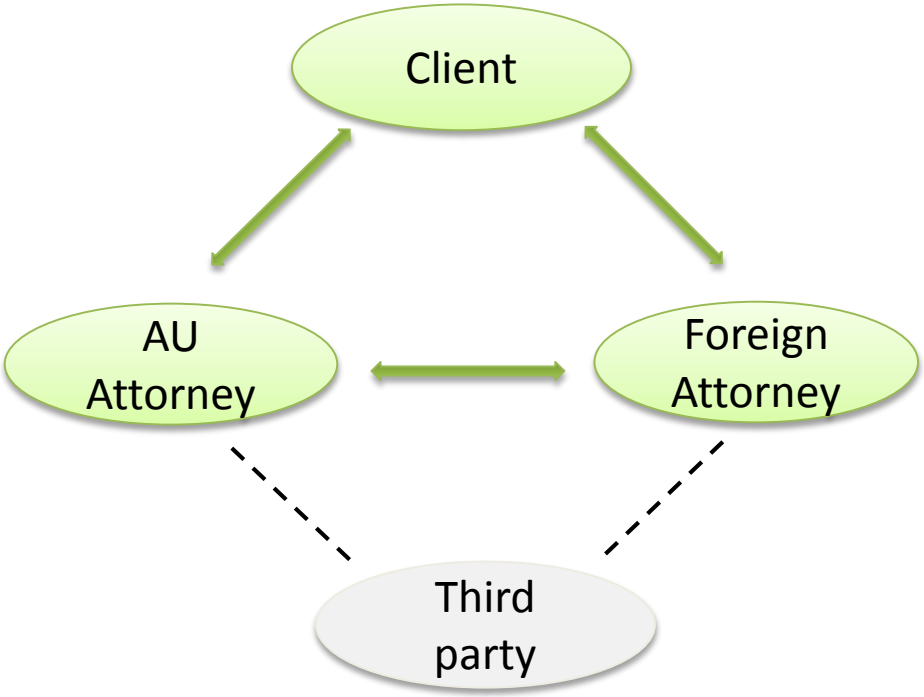
Patents Act 1990, subsection 200(2) - continued

(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.

(2C) ***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.

Privilege in Australia under the *Patents Act 1990*, subsection 200(2)



Channel of privileged information

Aspirations

- Unilateral introduction of privilege into each country's national law to:
  - Extend privilege to overseas attorneys who are authorised to provide intellectual property advice
  - Better align (non-lawyer) patent and trademark attorney privilege with that attaching to communications to and from lawyers.

Mechanism for change

1. Unilateral introduction of privilege in national law
   - (no international action required)

2. Exploring the merits of establishing a minimum standard in respect of privilege applicable to communications with IP advisers at the international level.
   - (model guidelines, treaty – time, complexity, ease of implementation, resistance)

Treaty process in Australia

- Mandate to negotiate
- Regulation Impact Statement
- Involvement of the States and Territories
- Consultation
- Negotiations and final text
- Government approval
- Scrutiny by Parliament
- Implementing Legislation
- Ratification/Accession

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Thank you

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IP Australia has achieved certification for its quality and environmental management systems.

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