



Protection of Confidentiality in IP Advice in The Netherlands & Bird & Bird

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Status quo of protection: classical approach

- Legal basis in statutory law: right to refuse to testify, following from professional secrecy
 - Article 165 section 2 sub b Code of Civil Procedure
 - Article 218 Code of Criminal Procedure
 - *He who, by virtue of his appointment, profession or employment is bound by confidentiality can be excused from the obligation to testify with regard to information that he has been entrusted with in that quality.*
 - No specific professions are mentioned
 - Traditionally accepted for:
 - Lawyers admitted to the bar
 - Priests, physicians, civil law notaries
 - Includes right to refuse disclosure

Status quo of protection: general test

- **Supreme Court 22-12-1989, NJ 1990/779, International Tin Council**
 - **No closed system**
 - **Requirements**
 - A legal obligation of confidentiality
 - It must be clear that the legislator was aware that privilege would be the consequence; if not, it is up to the court to decide on a case-by-case basis whether the witness has to answer to a question
 - The general interest that the truth is disclosed has to be balanced against the interest of confidentiality
 - **If privilege is awarded under these criteria outside the traditional professions, the scope may be more limited**

Status quo: exceptions

- **Supreme Court 6-5-1986, NJ 1986/814, Tax advisor**
 - Does the person invoking privilege have a legal position that requires people who want their legal interests represented to hire his services
 - Tax adviser does not
- **European Court of Justice 14-9-2010, C-550/07, Akzo Nobel**
 - In-house lawyer admitted to the bar
 - The requirement of independence means the absence of any employment relationship between the lawyer and his client
 - Supreme Court 15-3-2013, LJM BY6101 slightly opened the door again: privilege in national context not excluded on the sole ground that the lawyer is employed
 - In-house lawyer who is not admitted to the bar has no legal privilege

IP Advisors

- **Patent attorneys**
 - **Article 23b section 4 Dutch Patent Act**
 - A patent attorney has an obligation of confidentiality
 - Explanatory note to parliament:
 - This is similar to the privilege awarded to lawyers and notaries
 - It is common at an international level (EPO, US)
 - Foreign patent attorneys already enjoy privilege under their laws, and so should Dutch patent attorneys
 - This implies recognition of foreign privilege
- **Trademark attorneys**
 - No statutory regulation of profession
 - No statutory duty of confidentiality
 - No legal privilege

To be achieved/standing in the way

- **To be achieved**
 - Legal privilege for trademark/design right attorneys/others?
 - International protection/recognition of legal privilege
- **Standing in the way**
 - Government does not want to award new legal privileges
 - Assumption that protection is already sufficient
 - Preference to work within EU framework
 - Misunderstanding about our purpose: priority to international recognition of existing rights
 - But: trademark/design right attorneys/others?
 - Need to get the issue on the political agenda

Basis for progress

- **Trademark/design right attorneys:**
 - Rights at Benelux level
 - Possibly a protocol to the Benelux Treaty on Intellectual Property
- **At European Union level**
 - EU Regulation or Directive
- **At international level**
 - International agreement on the recognition of PCIPA
 - AIPPI framework is a good solution

Implementation

- If an international agreement is intended to provide concrete protection, it does not require implementation
 - Direct effect under article 94 Dutch Constitution
 - Intention needs to be clear
 - If not clear, implementation into national law required
- EU instruments
 - Regulation does not require implementation
 - Directive does require implementation into national law
 - Both do not provide guarantee outside EU, not optimal



Thank you & Bird & Bird

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