

# Issues arising from protection in nations under civil law, including how discovery in common law countries affects civil law countries

## Switzerland

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Pascal Fehlbaum

Dr. iur., Attorney at Law, D.E.A.

Head Legal Services Patents & Designs

# Summary

- 1. Status quo of the protection provided – national and overseas (international) advice**
- 2. Why is the status quo bad?**
- 3. What is yet to be achieved, what are the obstacles?**
- 4. What could be the basis (including the AIPPI framework) for harmonizing Protection of Confidentiality in IP Advice (PCIPA) in order to gain protection for national advice overseas?**
- 5. Conclusion**

# 1. Status quo of the protection provided – national and overseas advice

## ■ **Trademark consultants in Switzerland :**

- not regulated by any legislation in Switzerland → no specific requirements

## ■ **Patent attorneys in Switzerland :**

### **Regulated under Art. 2 Federal Act on Patent Attorneys (PatAA)**

- higher education qualification in nat. sciences or engineering
- federal patent attorney examination (or a foreign patent attorney examination recognized in Switzerland)
- an address for service in Switzerland
- registration in the Swiss patent attorney registry



# 1. Status quo of the protection provided – national and overseas (international) advice

- **Rights and duties of patent attorneys registered in Switzerland**
  - May use the professional title “patent attorney”
  - May represent parties before the new Swiss Federal Patent Court
    - in proceedings concerning the validity of a patent
    - must engage in independent practice
  - Professional confidentiality

# 1. Status quo of the protection provided – national and overseas (international) advice

## Professional confidentiality (Art. 10 PatAA)



- Covers an indefinite period of time
- Includes all secrets entrusted to a patent attorney as a result of his profession or that come to his knowledge while practicing his profession

# 1. Status quo of the protection provided – national and overseas (international) advice

**NEW: exception for turning over documents to the courts**

- No obligation to turn over documents to the court which derive from the correspondence between the parties and a patent attorney under the PatAA
- Includes documents from parties involved and third parties
- Revision of the Swiss Civil Procedure Code (CPC) entered into force on May 1, 2013
- PCIPA for patent attorneys in civil proceedings is completed



## 2. Why is the status quo bad?

**Questions as to whether professional confidentiality could be invoked under Art. 10 PatAA/160 CPC have not been resolved**

- **Preserving confidentiality for communications between a client in Switzerland and a foreign patent attorney**
- **Preserving confidentiality for communications between a client in a foreign country and a Swiss patent attorney**

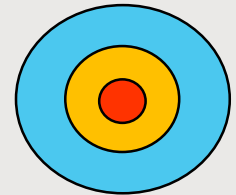


### 3. What is yet to be achieved, what are the obstacles?

Options for solving the issue of the cross-border aspects of confidentiality between clients and patent advisers :

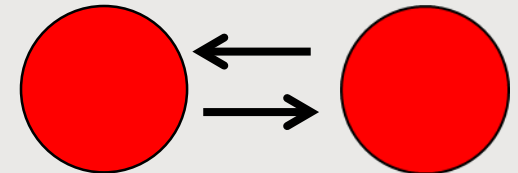
- **Unilateral solution (Australia, New Zealand)**

- Advantages: simple, quick and no negotiation required
- Disadvantages: no guarantee of reciprocity from another country



- **Bilateral solution**

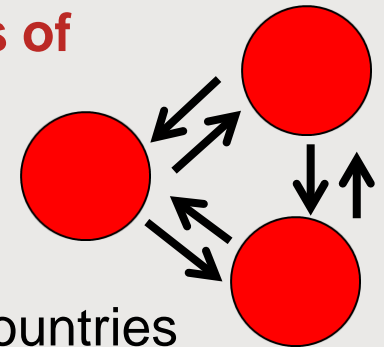
- Advantages: possible in a short period
- Disadvantages: solves the issue for only two countries





### 3. What is yet to be achieved, what are the obstacles?

Options for solving the issue of cross-border aspects of confidentiality between clients and patent advisers:



- **Multilateral agreement**
  - Advantages: solves the issue between some countries and may serve as an example
  - Disadvantages: solves the issue only in a few countries
- **WIPO: Standing Committee on the Law of Patents (SCP)**
  - Advantages: solves the issue for many countries
  - Disadvantages: the chances of successful solution within the SCP in reasonable period of time is very low

## 4. What could be the basis (including the AIPPI framework) for harmonizing PCIPA in order to gain protection for national advice overseas?

### Possible basis for harmonization of PCIPA:

- International guidelines
  - example of provisions which may be adopted
  - list of countries with equivalent protection which may recognize each others PCIPA
- Draft of an International Agreement
  - bilateral
  - Multilateral
  - (AIPPI Proposal)



## 5. Conclusion

**Are there any other options?**

**What could these options be?**

- Advantages?
- Disadvantages?

**Which options should be pursued?**



# Thank you for your attention!

## Direct contact:

Pascal Fehlbaum / Tel. +41 31 377 72 39 / [pascal.fehlbaum@ipi.ch](mailto:pascal.fehlbaum@ipi.ch)