ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE
INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INTELLECTUAL PROPERTY
INTERNATIONALE VEREINIGUNG FÜR DEN SCHUTZ DES GEISTIGEN EIGENTUMS

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Protection of Confidentiality in IP Advice (*PCIPA* or the *Protection*) − National and International Remedies

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Introduction of the Primer and Proposed AIPPI Solution

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Road Map

Part 1 - The protection and its problems;
the objectives of the Colloquium;
the contributors to solving the problems.

Part 2 - The Primer – The project on remedies;
recitals to the remedy it proposes;
examples of the problems.

Part 3 – The Primer – The proposed remedy – its operative provision; meaning of 'intellectual property advisor; coping with limitations and exceptions.

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Part 1

- Meaning of 'the protection'

- The problems (introduction)

- The objectives of the Colloquium

- Contributors – reflecting who is needed to solve the problems

Part 2 – The Primer (recitals)

- The beginnings of the project on solving the problems (ie towards remedies)

- AIPPI Resolution 163 (2003); *Eli Lilly v Pfizer* in Australia; costs of discovery

- Decision of US courts on civil law circumstances.

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Part 2 – The Primer (recitals)

- The protection is long established in common and civil law; common public interests apply
- Development of the new category of legal advisors – NLPAs
- Effects on clients
- Other things to take into account on remedies – limitations and exceptions, variations between common law nations, categories of the privilege, the requirement of certainty

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Part 2 – The Primer (recitals)

- The problems (particulars)
- No protection for the clients of NLPAs
- Non recognition of the protection in other nations
- Widespread uncertainty on what would happen if a party to litigation sought disclosure of professional IP advice given to another party overseas

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Part 2 – The Primer (recitals)

Summary to date

- Deal with the problems – agree on a minimum standard of the protection

- The pivot of the agreement – confidentiality / secrecy

- Preservation of the protection where it exists with its existing bells and whistles (eg limitations, exceptions and variations)

- Achieve a predictable degree of certainty

- Do NOT require either traditional system of law to take on a principle or practice of the other if unnecessary for the agreed minimum standard to be achieved

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Part 3 – The Primer (the remedy)

- Appendix 5 of the Primer

- Clause 2: the main operative provision

  2. Subject to the following clause, a communication made for the purpose of, or in relation to, an intellectual property advisor providing advice on or relating to intellectual property rights to a client, **shall be confidential to the client and shall be protected from disclosure to third parties,** unless it is or has been made public with the authority of that client.

- Definitions – 'intellectual property advisor'

  '**intellectual property advisor**' means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person qualified or authorised in the nation where the advice is given, to give that advice.

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Part 3 – The Primer (the remedy)

- Limitations and exceptions

- Clause 3 – inclusion of limitations and exceptions on condition

- The critical words –

  Nations may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in clause 2 **provided that such limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of clause 2,** having due regard to the need to support the public and private interests described in the recitals to this Agreement, which the effect of the provisions in clause 2 is intended to support, and the need which clients have for the protection to apply with certainty.

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In Conclusion

- AIPPI is generally against requiring in an international remedy that either system of law should adopt a feature of the other system which is unnecessary

- How does the AIPPI proposal for the remedy stand with that principle?

- Confidentiality is required for certainty