

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

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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**

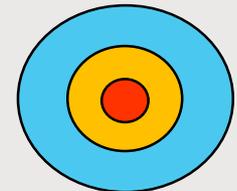


3. What is yet to be achieved, what are the obstacles?

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

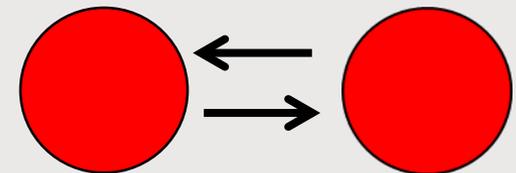
- **Unilateral solution (Australia, New Zealand)**

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



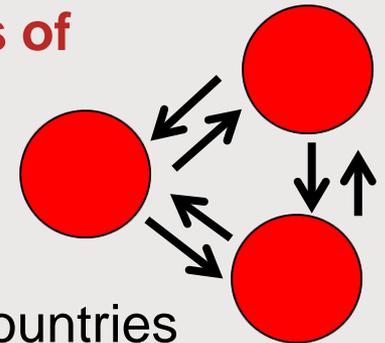
- **Bilateral solution**

- 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)**

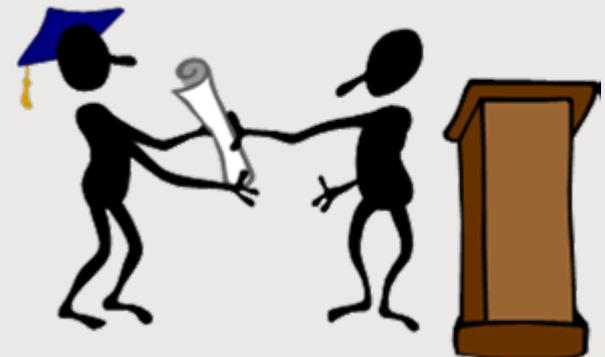
- Advantages: solves the issue for many countries
- Disadvantages: the chances of successful solution within the SCP in reasonable period of time is very low

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!

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