

Cross-border aspects of client/patent attorney privilege (CAP) – Draft proposal for a multilateral agreement presented by the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK.

RECOGNISING THAT

- a. Intellectual property rights (IPRs) exist globally and are supported by treaties and national laws and that global trade requires and is supported by IPRs.
- b. IPRs need to be enforceable in each jurisdiction involved in trade in goods and services involving those IPRs, first by law and secondly, by courts which apply due process.
- c. Persons need to be able to obtain advice in confidence on IPRs from IP advisors nationally and transnationally. Therefore communications to and from such advisors and documents created for the purposes of such advice and other records relating to such advising need to be confidential to the persons so advised and protected from forced disclosure to third parties (the protection) unless and until the persons so advised make public such communications, documents or other records.
- d. The underlying rationale for the protection of confidentiality of such communications, documents or other records is to promote information being transferred fully and frankly between IP advisors and the persons so advised.
- e. The promotion of such full and frank transfer of information supports interests which are both public and private namely in the persons so advised obtaining correct legal advice and in their compliance with the law. However, in order to be effective this protection needs to be certain.
- f. Nations need to support and maintain confidentiality in such communications including said documents or other records and to extend the protection that applies nationally to IP advice given by IP advisors also in other nations. This is to avoid causing or allowing confidential advice on IPRs by IP advisors to be published in another jurisdiction and thus, the confidentiality in that advice to be lost everywhere.
- g. The adverse consequences of such loss of the protection include owners of IPRs deciding not to trade in particular nations or not to enforce IPRs in such nations where the consequences of doing so may be that their communications relating to the obtaining of IP advice get published and used against them both locally and internationally.
- h. National laws are needed which, in effect, provide the same minimum standard of protection against disclosure for communications to and from IP advisors in relation to advice on IPRs. Such laws should also apply the protection to communications to and from overseas IP advisors in relation to those IPRs including their overseas equivalent IPRs.
- i. The minimum standard of protection needs to allow for nations to have limitations, exceptions and variations provided that they are of specific and limited effect and do not negate or substantially reduce the effect of the protection required by the minimum standard.

IN ORDER to give effect to the statements recited above, the nations cited in the Schedule to this Agreement have executed this Agreement on the dates stated respectively in that Schedule.

The nations so cited **AGREE** as follows.

Article 1

In this Agreement,

'~~patent~~ intellectual property **advisor**' means an advisor who is authorised to act before a competent administrative or judicial authority in a jurisdiction of a signatory State, and officially certified to provide professional privileged advice concerning ~~patent~~ intellectual property. The criteria of qualification and the categories of certification are defined by national law.

'**communication**' includes any form of communication whether oral, written, or electronic ~~record~~.

'**professional advice**' means advice given ~~on patent law in relation to intellectual property~~ within the ~~patent intellectual property~~ intellectual property advisor's area of expertise, as defined by the national law that stipulates the professional qualifications whether it is transmitted to another person or not.

"**advice**" means the subjective or analytic views and opinions of the advisor. Raw data and mere facts are not privileged in and of themselves unless:

- they are communicated with the "dominant purpose" of seeking or giving advice; or
- they are contained in a document containing privileged information and they are related or connected to the privileged information and have been communicated with the "dominant purpose" of seeking or giving advice.

Article 2

A communication made for the dominant purpose of ~~a patent~~ an intellectual property advisor providing professional advice to a client, shall be confidential and shall be protected from any disclosure to third parties, unless it is or has been disclosed with the authority of that client, apart from cases where it is disclosed to another person having a common interest with the client and that person is bound by an obligation of confidence.

Article 3

This Agreement applies to communications between ~~a patent~~ an intellectual property advisor and ~~his~~ that advisor's client regardless of the territory of the signatory State in which the ~~patent intellectual property~~ intellectual property advisor is officially recognised and certified, and regardless of the territory of the signatory State in which the communications take place.

Article 4

In case a document containing privileged and not privileged information has to be disclosed, the privileged information must be blacked out.

Article 5

Nothing prevents Nations from extending unilaterally or on the basis of reciprocity the scope and effect of this Agreement on their territory to other areas of intellectual property law and to advisors other than those defined in Article 1.

Article 6

Nations may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in Article 2, including specific requirements which an patent advisor must meet in order for Article 2 to apply to them, provided that such requirements, limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of Article 2 having due regard to the recitals to this Agreement.