



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Standing Committee on the Law of Patents, Twenty-Ninth Session, Geneva, December 3 to 6, 2018

Agenda point 8: Confidentiality of communications between clients and their patent advisors

05 December 2018

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 80 countries and regions, including Europe, China, Japan, South Korea and USA.

FICPI aims to enhance international cooperation amongst IP attorneys and promote the training and continuing education of its members and others interested in IP.

FICPI strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have an opportunity to state the following:

FICPI recognizes the importance of the protection of IP advice to allow a client to have frank, full, honest and uninhibited communications with their qualified or otherwise suitably accredited Intellectual Property Advisors and to opinions and advice therefrom. FICPI further understands that confidential communications between a client and their Intellectual Property Advisor may be subject to discovery in some jurisdictions, whether the Advisor acts inside or outside the jurisdiction and even where such communications by Intellectual Property Advisor acting within the jurisdiction are afforded protection from disclosure.

Intellectual property rights (IPRs) need to be enforceable in each jurisdiction where they exist.

Persons need to be able to obtain comprehensive, frank advice in confidence on the acquisition and enforcement of IPRs, based on full knowledge of the relevant facts, from IP advisors nationally and transnationally, and therefore communications to and from such advisors and documents created for the purposes of such advice need to be confidential to the persons so advised and protected from forcible disclosure to third parties (protection/privileged) unless and until the persons so advised voluntarily disclose such communications.

Consequently, member states are urged to support a requirement for confidentiality for such communications and to extend the protection/privilege which applies nationally to IP advice given by qualified or otherwise suitably accredited IP advisors in other countries and regions, to avoid causing or allowing confidential advice on IPRs given by IP advisors to be disclosed and thus, the confidentiality in that advice to be lost everywhere.



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Resolution of the Executive Committee, Sorrento, Italy, 29 September – 02 October 2013

“Confidentiality in IP advice”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held Sorrento, Italy, 29 September to 02 October 2013, passed the following Resolution:

Recognizing the importance of the protection of confidentiality of IP advice to allow a client to have frank, honest and open communications with its Intellectual Property Advisors and to obtain opinions and advice therefrom,

Understanding that confidential communications between a client and an Intellectual Property Advisor may be subject to discovery in some jurisdictions, whether the Advisor acts inside or outside the jurisdiction and even where they are afforded protection from disclosure within the jurisdiction,

Appreciating the adverse consequences the discovery of such communications may have in litigation in those jurisdictions as well as others,

Appreciating the increasingly international character of intellectual property litigation,

Having joined with AIPPI and AIPLA to organize a Colloquium to encourage a framework to protect such confidential intellectual property advice in Paris, France from 26 to 28 June 2013, and

Having conferred with AIPPI and AIPLA to develop the attached Communiqué and Joint Proposal based upon the consensus developed during that Colloquium,

Ratifies the Communiqué issued by the three organizations (Appendix 1), and

Adopts the Joint Proposal (Appendix 2) with the understanding that the three organizations will work together to urge countries and jurisdictions to enact laws consistent with the principles provided therein.

Colloquium

Protection of Confidentiality in IP Advice National and International Remedies

**June 26-28, 2013
Paris, France**

Communiqué from AIPLA, AIPPI & FICPI

The Colloquium was held to encourage consensus on a framework to protect confidential intellectual property advice given to a client by lawyer and non-lawyer IP advisors. In the complex area of international IP advice, there is a strong public interest to protect communications related to such advice so that correct and comprehensive legal advice can be sought and obtained without fear of disclosure.

The presenters at the Colloquium included government experts from Australia, Germany, Japan, Switzerland and the United States of America, and leading independent commentators including Judge Braden of the US Court of Federal Claims and John Cross, Professor of Law at the University of Louisville.

Two of the major problems identified were:

- some countries do not provide any, or sufficient, domestic protection to lawyer and/or non-lawyer IP advisor communications relating to IP advice; and
- several countries do not provide any, or sufficient, protection to foreign lawyer and/or non-lawyer IP advisor communications relating to IP advice.

The presentations and discussions between the participants demonstrated to the three host IP Associations that there are viable options to remedy these problems and that their resolution is of great importance. In both common and civil law systems an agreement could be made that communications relating to IP professional advice with lawyers and/or non-lawyer IP advisors shall be either confidential to the client or subject to professional secrecy and shall, in both cases, be protected from disclosure to third parties unless made public by or with the authority of the client. It was generally agreed that the protection should not extend to underlying facts subject to disclosure requirements such as prior art.

The three host IP Associations reported to the meeting that the comments and suggestions of the participants would be reviewed with the object of developing a proposal for further consideration by individual countries and jurisdictions.

The Joint Proposal of the AIPLA, AIPPI, and FICPI

Recognizing that

1. Intellectual property rights (IPRs) exist globally and are supported by treaties and national laws and that global trade requires and is supported by IPRs.
2. 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.
3. Persons need to be able to obtain advice in confidence on IPRs from IP advisors nationally and trans-nationally, and 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 forcible disclosure to third parties (***the protection***) unless and until the persons so advised voluntarily make public such communications, documents or other records.
4. 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.
5. The promotion of such full and frank transferring 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 but to be effective, the protection needs to be certain.
6. Nations need to support and maintain confidentiality in such communications including said documents or other records and to extend the protection which applies nationally to IP advice given by IP advisors in other nations, to avoid causing or allowing confidential advice on IPRs by IP advisors to be published and thus, the confidentiality in that advice to be lost everywhere.
7. 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.
8. National laws are needed which in effect provide the same minimum standard of protection from disclosure for communications to and from IP advisors in relation to advice on IPRs, and 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.

9. The minimum standard of the protection needs to allow for nations having or hereafter to have, such limitations, exceptions and variations as they see fit provided that they are of specific and limited effect which does 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.

1. In this Agreement,

'**intellectual property advisor**' means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person, where such advisor is officially recognized as eligible to give professional advice concerning intellectual property rights.

'**intellectual property rights**' includes all categories of intellectual property that are the subject of the TRIPS agreement, and any matters relating to such rights.

'**communication**' includes any oral, written, or electronic record whether it is transmitted to another person or not.

'**professional advice**' means information relating to and including the subjective or analytic views or opinions of an intellectual property advisor but not facts including mere statements of fact which are objectively relevant to determining issues relating to intellectual property rights (for example, the existence of relevant prior art).

2. Subject to the following clause, a communication made for the purpose of, or in relation to, an intellectual property advisor providing professional 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.

3. Jurisdictions 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 provision in clause 2 is intended to support, and the need which clients have for the protection to apply with certainty.



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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 if the consequences of doing so may be that their communications relating to the obtaining of IP advice are disclosed and used against them both locally and internationally.

FICPI strongly supports keeping this topic on the agenda of this Committee and also kindly suggests the Committee to engage in a further sharing session and to compile a reference document on this topic.

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions.

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