



THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
FICPI AUSTRALIA

21 February 2020

**By email**

To: Mr Martin Devlin  
Assistant Director  
International Policy and Cooperation  
IP Australia

Dear Mr Devlin

**Consultation on Client Attorney Privilege**

**About FICPI Australia**

FICPI Australia is the Australian National Association of the International Federation of Intellectual Property Attorneys (FICPI).

FICPI is the only international NGO whose membership consists exclusively of IP attorneys in private practice. FICPI, therefore, represents a key constituency of the international IP system.

Founded in 1906, FICPI now has more than 5,000 members in over 86 countries, including the US, Japan, Australia, New Zealand, India, China and most countries of Europe.

**Proposed Multi-Lateral Agreement – Privilege**

FICPI Australia welcomes the proposal for a multi-lateral agreement to address cross-border aspects of client/patent attorney privilege (**CAP**).

FICPI Australia and FICPI International have a long history of being involved in addressing jurisdictional difficulties for the protection of patent attorney/client communications. Together with AIPPI and IP Australia, FICPI Australia was directly involved in rectifying the situation in this country following on from the problematic decision in *Eli Lilly v Pfizer* [2004] FCA 250. As IP Australia is aware, this ultimately resulted in the amendment of s.200(2) of the *Patents Act* 1990 to the following form:

**Privileges**

(2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

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(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

(2C) **Intellectual property advice** means advice in relation to:

- (a) patents; or
- (b) trade marks; or
- (c) designs; or
- (d) plant breeder's rights; or
- (e) any related matters.

Importantly, this provision is not limited to “patent” advice and it does not require that the advice be privileged in the country in which the advice is given. The second of these matters was recognised as necessary when drafting the amendments to s.200(2) to ensure that the provision had the desired effect in countries that do not have legal systems having rules relating to privilege.

FICPI Australia’s involvement in achieving this reform included:

- Multiple meetings with government, IP Australia and industry stakeholders
- The retention of Mr Neil Young SC in providing advice and suggested language for amending s.200
- Various consultations with government and IP Australia regarding the final form of s.200(2)

Internationally, FICPI has also been very active in encouraging cross-border CAP reform. This has included:

- Organising with AIPLA and AIPPI a colloquium in Paris in June 2013. Representatives from the UK Patent Office, the European Patent Office, the Canadian Patent Office, the USPTO and the Australian Patent Office were actively involved in the Colloquium, as were a number of industry participants. A copy of the communique from the Colloquium is **attached**.
- Attendance at and submissions for SCP meetings of WIPO at which the problems of the inconsistent application of privilege has been canvassed by FICPI now for many years. This process has run continuously by WIPO since SCP 12 held in June 2008.

FICPI Australia recognises that an international agreement to address cross-border aspects of CAP may be many years off and therefore supports the initiative of the core group of B+ countries in working towards a multi-lateral agreement before a broader agreement can be concluded.

We offer the following suggestions and recommendations regarding the draft form of the Agreement:

### **1) Patents or intellectual property rights? (Clause 1)**

The recitals of the proposed Agreement properly indicate that the cross-border issues which concern CAP impinge not only on patents but other IPRs. However, in the operative clauses of the Agreement it is proposed that the cross-border protections would be limited to “advice concerning patents”. First, there is a disconnect between the recitals and the Agreement. If the Agreement is to be limited to patent rights and advice concerning inventions, then the recitals should be similarly restricted. If this is what is required to achieve a first agreement, FICPI Australia would prefer this to no Agreement at all.

However, we consider that there are difficulties if the Agreement is limited to “patents”. For example, it will often be the case that a person with a new development will seek advice on securing protection and this protection may take the form of a patent or alternatively, a registered design. Indeed, in the United States designs are protected by “design patents”. Whilst the United States is not a proposed signatory to the draft

Agreement, the use of this nomenclature in the United States indicates how closely aligned these intellectual property rights are.

## 2) Professional privileged advice (Clause 1)

In some of the countries forming the core group of B+ delegations, the concept of “privilege” is foreign. For example the laws of Sweden, Spain and Switzerland do not recognise “privilege” and therefore do not provide certification that a person can provide “privileged advice”. FICPI Australia submits that if the relevant communication is provided with the dominant purpose of providing IP advice, then it should be protected against forcible disclosure in any one of the countries that are signatories to the Agreement.

With all these matters in mind, FICPI Australia proposes that the first definition in Article 1 of the draft Agreement be amended to read as follows:

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

Alternatively, if the scope of the Agreement is to be limited to industrial property, FICPI Australia would propose that in Article 1 the definition of “patent advisor” be amended to read as follows:

**Industrial property advisor** means an advisor who is authorised to act before a competent administrative or judicial authority in the jurisdiction of a signatory State and officially certified to provide professional advice concerning inventions, designs, patent applications, patents, design applications and registered designs. The criteria of qualification and the categories of certification are defined by national law.

## 3) Other Definitions in Clause 1

We suggest the following further amendments to the definitions in Clause 1 of the draft Agreement:

**communication** includes any form of communication whether oral, written or electronic

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

**advice** – no amendment proposed

## 4) Article 2

FICPI Australia supports the intent of Article 2 as drafted. We suggest that it be clarified to ensure that the disclosure of professional advice with the authority of the client does not destroy privilege in circumstances where the advice is provided to a person having a common interest with the client and where that person is also bound by an obligation of confidence. This would mean that Article 2 would read:

“A communication made for the dominant purpose of 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”

## 5) Article 3

FICPI Australia agrees with proposed Article 3. However, we suggest that the provision be amended so that it is gender neutral, i.e.:

“This Agreement applies to communications between an intellectual property advisor and that advisor’s client regardless of the territory of the signatory State in which the intellectual property advisor is officially recognised and certified and regardless of the territory of the signatory state in which the communications take place”

## 6) Articles 4, 5 and 6

FICPI Australia agrees with the proposed language in each of these Articles.

A tracked version of the draft Agreement showing these suggested amendments is **attached**.

Those proposed amendments in items 3 to 6 above are premised on the adoption of the definition “intellectual property advisor”. If the alternative proposal discussed above for “industrial property advisor” was to be adopted, the other clauses of the agreement would of course, mutatis mutandis, adopt this description.

### General

FICPI Australia considers this to be a most important project. This is particularly the case given the broad scope of protection now conferred in Australia under s.200(2) of the *Patents Act*. At present, communications between a UK patent attorney and that attorney’s client are privileged in legal proceedings in Australia due to s.200(2). However, in legal proceedings in the United Kingdom, whilst the UK Patents Act confers privilege on communications between UK patent attorneys and their clients, this privilege does not extend to communications between Australian patent attorneys and their clients (the privilege arising under statute rather than under common law) and this places Australian litigants at an unfair disadvantage if it comes to enforce an Australian person’s intellectual property rights in the United Kingdom (see s.280 of the *UK Copyright Designs and Patents Act, 1988*). Similar considerations apply to some of the other countries forming the core group of B+ delegations to be involved in the Agreement.

We urge the Australian delegation to press for a multi-lateral agreement. If FICPI Australia can provide any further assistance, or should you require clarification with respect to any of the matters above, please do not hesitate to contact us.

Yours sincerely



Greg Chambers  
Immediate Past President  
FICPI Australia

Att.