



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

May 2021

FICPI Position on Client Attorney Privilege

Virtual ExCo Meeting, 19 May 2021

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General

Intellectual Property Rights (IPRs) exist nationally and globally. They need to be enforceable on a national level and in each jurisdiction involved in trade in goods and services including IPRs.

Consequently, parties (clients) involved in enforcement procedures need to be able to obtain advice in confidence on IPRs from IP advisors on a national level and in cross-border situations. It is generally accepted, at least on a national level, that confidential communications to and from IP advisors, as well as documents and other records related to the provision of such advice (“Confidential Communications”), should be protected from any forced disclosure to third parties.

The protection of Confidential Communications helps to ensure that the information transferred between the IP advisors and their clients is full and frank.

Further, the protection of Confidential Communications supports both public and private interests in that it increases the likelihood that the advice provided is legally correct and compliant with the law.

The protection of Confidential Communications needs to be certain and based on law. The protection applying nationally should also extend internationally, i.e. the protection should have a cross-border effect. If protection is lost in one jurisdiction, protection is lost everywhere.

The consequences of loss of protection of Confidential Communications may include that IPR proprietors may decide not to trade or enforce their IPRs in jurisdictions not providing protection.

Such protection may also have noteworthy employment effects in cross-border situations. If protection of Confidential Communications is not available in one country, this might lead to exclusion of the IP (patent) advisors in that country from the communication in order to avoid losing confidentiality in all countries. Consequently, the IP (patent) advisors in that country might be rendered redundant.



FICPI and protection of Confidential Communications

FICPI has been engaged in work related to the protection of Confidential Communications for a long time.

FICPI, together with AIPLA and AIPPI, organised a joint colloquium in Paris, France, on 26-28 June 2013. This resulted in a **resolution** of the FICPI Executive Committee meeting, Sorrento, Italy, 28 September – 2 October 2013. The resolution was based on a communique from the joint colloquium, including a comprehensive position and a proposal for a solution in the form of an agreement on Client-Attorney Privilege. The resolution is attached as Annex 1.

FICPI has also actively participated in the discussions at the meetings of the WIPO Standing Committee on Patent Law (SCP).

- At the 29th meeting of the SCP held on 3-6 December 2018, FICPI made an **intervention** advocating a cross-border client-attorney-privilege arrangement. The intervention is attached as Annex 2.
- At the 30th meeting of the SCP FICPI, together with AIPPI, participated in a sharing session on “the confidentiality of communications between clients and their patent advisors” on 4 December 2019 by giving a detailed **presentation** on the subject. The presentation is attached as Annex 3.

Future work

FICPI has closely followed the discussion in Group B+. The Core Group (Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK) of B+ delegations presented a draft multi-lateral agreement on cross-border aspects of client-attorney privilege in September 2019. A revised draft appeared in August 2020.

The draft is largely based on the communique from the joint colloquium in 2013.

FICPI has reviewed the August 2020 draft and also discussed it with AIPPI, FICPI Australia and the Institute of Patent and Trade Mark Attorneys of Australia.

FICPI considers that some important amendments (heading and articles 1a, 2, 4 and 5) could be made to the draft without any larger revisions which might unnecessarily delay the process. The draft agreement including FICPI’s proposals for amendments is attached as Annex 4.

The reasons for proposing the amendments can be summarised as follows.

- Heading: The heading should preferably clarify that the agreement relates to “Client-Attorney-Privilege”. The gist of the agreement is the protection of the client, not the attorney. Also, in civil law countries, protection for a client is based on an attorney’s professional secrecy obligation.

Consequently, FICPI believes that the term “Client” should appear in the heading.



- Article 1a: Article 1a defines an advisor that is “officially certified to provide professional privileged advice”. However, while the advisor may be certified to provide professional advice, the advisor is not necessarily certified to provide advice that is currently privileged or otherwise protected. This is the general purpose of the agreement: to achieve protection for Confidential Communications for nationally and internationally authorized advisors both on a national and international level. The term “privileged” thus seems to be circular.

Consequently, FICPI believes that the term “privileged” should be deleted.

- Article 2: The present version of the article reads “A communication ..., shall be privileged, i.e., it shall be confidential and shall be protected from any disclosure to third parties, ...”. FICPI finds this wording misleading. Privilege does not provide confidentiality. In order for privilege to apply, the communication must be confidential.

Consequently, FICPI suggests the following wording: A confidential communication ..., shall be privileged, i.e., it shall be confidential and shall be protected from any disclosure to third parties, ...”.

- Article 4: The present version reads that “... privileged information must be blacked out.” FICPI believes that privilege as such provides a right and not an obligation.

Consequently, FICPI suggests that the term “must” should be changed to “may”.

- Article 5: FICPI only suggests a minor change in the wording as shown in the Annex 4.

FICPI has also considered the draft MLA and its Article 5 in view of extending the agreement to other areas of intellectual property and to advisors other than those (patent advisors) defined in Article 1.

Privilege is as important for other IP areas and IP advisors, e.g., trademarks and designs, as for patents. Presently this article is in an opt-in form. An opt-out form would perhaps be preferable.

Attachments

- Annex 1 // FICPI Resolution EXCO/IT13/RES/004
- Annex 2 // FICPI intervention at 29th meeting of the SCP, 5 December 2018
- Annex 3 // FICPI presentation at the 30th meeting of the SCP, 4 December 2019
- Annex 4 // Annotated draft MLA August 2020 with FICPI proposals for amendments

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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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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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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.

* * *

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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Confidentiality of communications between clients and their patent advisors

SCP 31st Session, WIPO
Geneva
4th December 2019

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Work in progress

- Joint Proposal – AIPLA/AIPPI/FICPI Colloquium on Privilege, June 2013
 - FICPI Resolution
- SCP/25/4 - COMPILATION OF COURT CASES WITH RESPECT TO CLIENT-PATENT ADVISOR PRIVILEGE , November 15, 2016
- SCP/29/5 - CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS: COMPILATION OF LAWS, PRACTICES AND OTHER INFORMATION, November 15, 2018



Topics

Introduction

Definitions

Confidentiality

Loss of confidentiality

Examples

Conclusions



Introduction (1/3)

- Intellectual property rights (IPRs), such as patents, trademarks, designs, etc., exist globally
- Global trade requires and is supported by IPRs
- Persons, i.e. clients, need to be able to obtain frank and full legal advice (IP professional advice) in confidence on IPRs from intellectual property (IP) advisors nationally and trans-nationally (cross-border)
- Therefore communications, including documents and other related records drafted therefor, to and from such IP advisors need to be protected from forcible disclosure to third parties



Introduction (2/3)

- Providing confidentiality for communicating full and frank legal advice (IP professional advice) supports both public and private interests in that (i) the persons so advised obtain correct advice and in that (ii) the advice is compliant with law and administration of justice
- Nations need to support and maintain confidentiality in such communications and to extend the protection which applies nationally also to legal advice (IP professional advice) given by IP advisors in other nations in view of the global dimension of IPRs



Introduction (3/3)

- Extending the protection trans-nationally avoids causing or allowing confidential advice to be published and thus confidentiality in that legal advice (IP professional advice) to be lost everywhere
- If the confidentiality of legal advice (IP professional advice) is lost in a particular nation, it can be used against the person both locally and internationally
- The adverse consequences of such loss of protection include owners of IPRs deciding not to trade or invest in particular nations or not to enforce IPRs in such nations, where protection is lost



Definitions (1/4)

- Client
 - A principal on whose behalf an IP advisor acts, either national or foreign
- IP advisors
 - IP advisors are IP professionals, such as a patent attorneys, trademark attorneys, design attorneys
 - IP professionals are often nationally or regionally (e.g. European patent attorneys before the EPO) qualified and registered
 - Some jurisdictions have publicly accessible registers for such IP professionals
 - Registered IP professionals are in general subject to a Code of Conduct (alternatively regulations or legislation) including provisions on professional secrecy obligation



Definitions (2/4)

- Generally this only applies to the IP professionals on their respective national levels
- IP professionals can be, but most often are not, attorneys-at-law/lawyers
- Communications
 - Communications in this context include oral and written IP professional advice, documents created for the purposes of such advice and other records related to such advice transferred between the IP advisors and the persons so advised
 - IP professional advice includes legal advice; which e.g. concerning patents may concern technical matters
 - The term “**advice**” is **specific** in the sense that it does **NOT** include e.g. prior art documents, laboratory note books, other documents containing data, or the like



Definitions (3/4)

- Privilege
 - Client privilege is a mechanism in common law jurisdictions which allows clients to resist discovery of confidential advice given to the client by an attorney-at-law/lawyer; *i.e. protection from forcible disclosure to a third party/court*
 - “In law of evidence, client’s privilege to refuse to disclose and to prevent any other person from disclosing confidential communications between him and his attorney. Such privilege protects communications between attorney and client made for purpose of furnishing or obtaining professional legal advice or assistance.” [Black's Law Dictionary, (6th ed. 1990), ISBN 0-314-76271-X]
 - Some common law countries give privilege to patent attorneys/IP attorneys



Definitions (4/4)

- Professional secrecy obligation
 - In civil law jurisdictions attorneys-at-law/lawyers are bound by an obligation of professional secrecy (the term privilege is not used); *i.e. the professional's obligation to keep information received secret*
 - Patent attorneys/IP attorneys in most countries are subject to professional secrecy obligation
 - **Generally** privilege or professional secrecy obligation **applies only** on a **national** level both in common law jurisdictions and civil law jurisdictions
 - In some jurisdictions privilege or professional secrecy obligation applies also for foreign attorneys-at-law/lawyers



Confidentiality (1/2)

- The purpose of providing privilege or obligation of professional secrecy is to encourage those who seek legal advice (IP professional advice) and those who provide advice to be fully transparent and honest in the process of communicating such advice
- If the communication is publicly disclosed, there is a disadvantage for those who seek advice
- In other words, the purposes of protection from forcible disclosure of legal advice (IP professional advice) given by IP advisors is to (i) achieve the public interest of having clients correctly advised and (ii) the law being enforced in the process



Confidentiality (2/2)

- In order to ensure high quality of advice, communication of such legal advice (IP professional advice) should not be restricted due to fear of disclosure of the communication
- Due to the global nature of IPRs, the privilege or the professional secrecy obligation should apply trans-nationally (cross-border)
- Confidentiality of communications should thus be recognized also when legal advice (IP professional advice) is provided by foreign IP advisors



Loss of confidentiality (1/1)

- In a jurisdiction where there are provisions on privilege or professional secrecy obligations the communication of legal advice (IP legal advice) between clients and their IP advisors is protected from disclosure in that jurisdiction
- However, when the communication of legal advice (IP professional advice) takes place between one jurisdiction and another, protection may be lost if privilege or professional secrecy obligations are not available in the other jurisdiction
- Further, despite privilege or professional secrecy obligation being provided in both jurisdictions, protection is lost, if privilege or professional secrecy obligation for IP advisors in one jurisdiction is not recognized for the IP advisors of another jurisdiction



Examples (1/2)

Company A (HQ) / FR-patent
- Advised by European patent attorneys (EPAs)

Communication advising on validity and scope of patent including advice communicated between FR and AU

Company A / UK-patent
- Advised by UK lawyers and UK patent attorneys
- Possible infringement and later litigation in UK with discovery

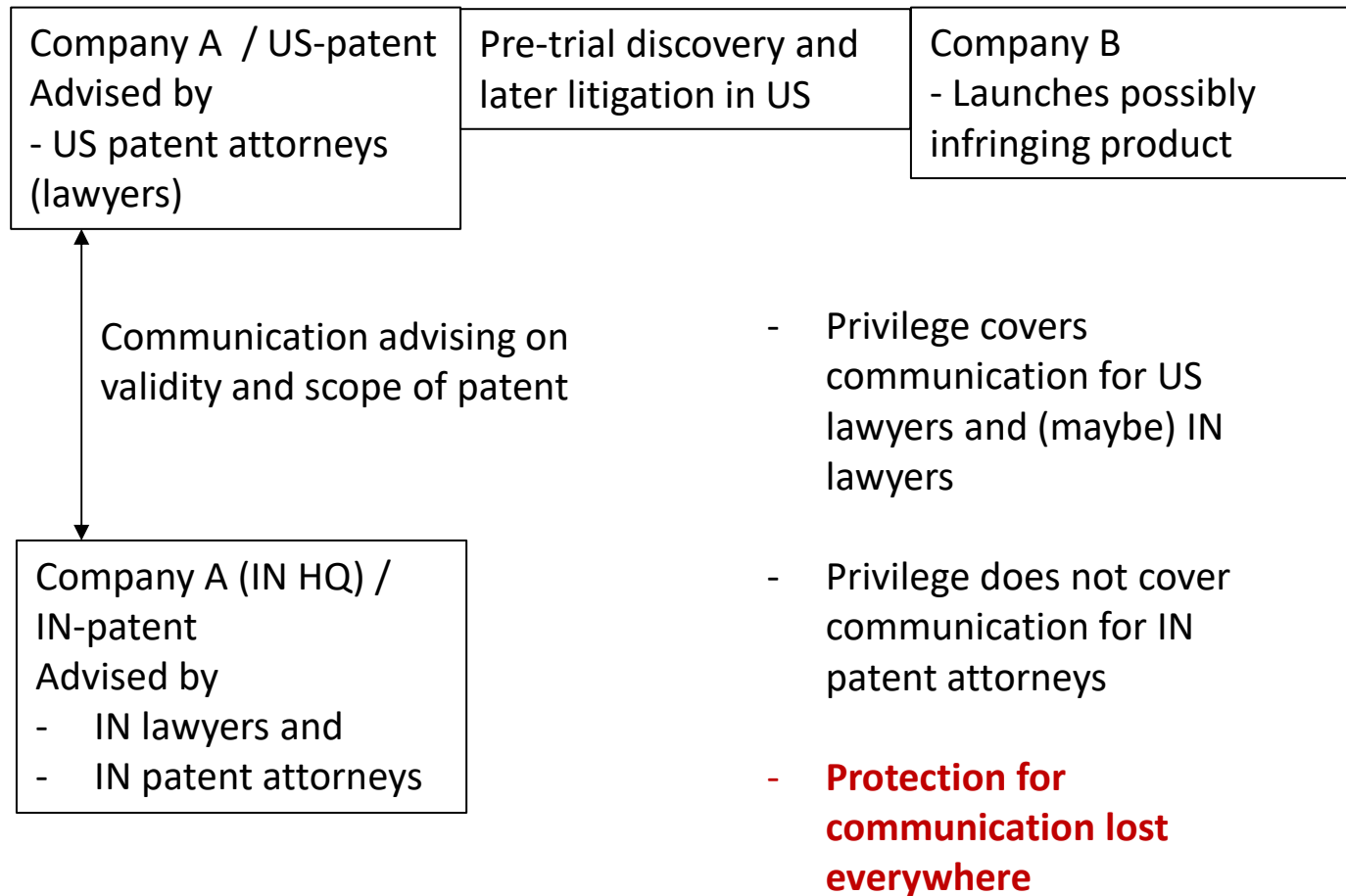
Communication advising on validity and scope of patent

Company A (AU branch) / AU-patent
- Advised by AU lawyers and AU patent attorneys

- Privilege covers communication for UK lawyers and (maybe) foreign lawyers
- Privilege covers communication for UK patent attorneys and EPAs
- Privilege does not cover communication for AU patent attorneys
- **Protection for communication lost everywhere**



Examples (2/2)





Conclusions (1/3)

- The key issue is the **protection of confidentiality in IP professional advice** (legal) communicated between clients and their IP advisors against forcible disclosure by a court to an opposing party
- IP professional advice is to a large extent given by **IP advisors, such as patent attorneys, trademark attorneys, design attorneys** who to a large extent are not lawyers, whereby a traditional client-attorney privilege (e.g. based on law of evidence) is not sufficient for IPRs
- IP professional advice is most often also **communicated trans-nationally** (cross-border), whereby there presently is a problem in this respect since protection provided by **national law** for national IP professional advice **does not recognize and apply the protection to foreign IP professional advice**



Conclusions (2/3)

- The protection is called privilege in common law countries, which has a different meaning in civil law countries
- Thus the term “**protection**” is more appropriate because it applies to the outcome, i.e. non-disclosure of confidential IP professional advice



Conclusions (3/3)

- What is needed is a **minimum** standard providing:
 - that (i) IP professional advice given by IP advisors is confidential and protected from forcible disclosure to an opposite party in litigation on a **national level**;
 - that (ii) **cross-border** IP professional advice is **treated in the same way** as it is nationally;
 - a (iii) **balance between common law and civil law** in that it does not require civil law jurisdictions to adopt any common law concept or *vice-versa*; and
 - that **includes**
 - definition of IP advisor, e.g. qualified advisors in given jurisdictions
 - definition of communication
 - definition of advice



Thank you very much for kind attention!

Please do not hesitate to refer back for any information, with any questions or with any comments to

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**AGREEMENT
ON CROSS-BORDER
ASPECTS
OF CLIENT-PATENT ATTORNEY
PRIVILEGE**

(Draft proposal for a multilateral agreement presented by the Core Group of B+ delegations of

*Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and
UK).*

[THE FOLLOWING STATES ... : / THE PARTIES TO THIS
AGREEMENT:]

Recognising that intellectual property rights (IPRs) exist globally and are supported by treaties and national laws and that global trade requires and is supported by IPRs,

Acknowledging that 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,

Noting that Persons need to be able to obtain advice in confidence on IPRs from IP advisors nationally and transnationally,

Further noting that 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 unless and until the persons so advised make public such communications, documents or other records,

Acknowledging that 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,

Further acknowledging that 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

Recognising however that, in order to be effective, this protection needs to be certain, and States 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 States,

In order 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,

Noting that the adverse consequences of such loss of the protection include owners of IPRs deciding not to trade in particular States or not to enforce IPRs in such States 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,

Reaffirming that 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 and that 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,

Further reaffirming that the minimum standard of protection needs to allow for States 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,

HAVE AGREED AS FOLLOWS:

Article 1

In this Agreement,

- a) *patent advisor* means an advisor who is authorised to act before a competent administrative or judicial authority in a jurisdiction of a signatory State or to which a signatory State participates, and officially certified to provide professional ~~privileged~~ advice concerning patent. The criteria of qualification and the categories of certification are defined by national and international law.
- b) *communication* includes any oral, written, or electronic record.
- c) *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:
 - 1. they are communicated with the “dominant purpose” of seeking or giving advice;
 - or
 - 2. 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.
- d) *professional advice* means advice given on patent law within the patent advisor’s area of expertise, as defined by the national or international law that stipulates the professional qualifications whether it is transmitted to another person or not.

Article 2

A confidential communication made for the dominant purpose of a patent advisor providing professional advice to a client, shall be privileged, i.e. it 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.

Article 3

This Agreement applies to communications between a patent advisor and that advisor’s client regardless of the territory of the signatory State in, or on behalf of, which the patent 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 of a document containing privileged and not privileged information has to be disclosed, the privileged information ~~must~~may be blacked out.

Article 5

The Parties may at any time extend, 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. Such declaration shall be deposited with the ~~Depository~~Depository and ~~precise~~specify whether ~~they are~~it is made unilaterally with effect for all the Parties, or on the basis of reciprocity with effect only for the other Parties having made ~~a~~the same declaration.

Article 6

States may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in Article 2, including specific requirements which a 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.

Article 7

This Agreement shall be open for signature from ... to ... by [the following/the above mentioned States] at the Federal Department of Foreign Affairs of the Swiss Confederation, Berne, and is subject to ratification. It is further open for accession by any State Member of the United Nations. The instruments of ratification and of accession shall be deposited with the Depositary.

Article 8

This Agreement shall enter into force on the thirtieth day following the date of deposit of the [second] instrument of ratification or accession. For each State ratifying or acceding to it after the deposit of the second instrument of ratification or accession, it shall enter into force on the thirtieth day after deposit by such State of its instrument of ratification or accession.

Article 9

Any Party may at any time withdraw from this Agreement by giving written notice to the Depositary. The Depositary shall inform the other Signatories and Parties of such a notice. The withdrawal shall become effective on the 30th day following the date on which the notice has been received by the Depositary.

Article 10

No other reservation than that provided for in article 6 may be made in respect of any provision of this Agreement.

In witness whereof the undersigned Plenipotentiaries, being duly authorised thereto by their respective Governments, have signed the present Agreement.

DONE at [Geneva], this ... of ... two thousand and twenty ..., in the English and French languages, each text being equally authentic, in a single copy to be deposited with the Swiss Federal Council.

For the Republic of ...

For the Swiss Confederation

For the Republic of ...