



2019 AIPPI World Congress - London
Adopted Resolution
September 18, 2019

Resolution

Standing Committee on Client Attorney Privilege

Draft proposal for a multilateral agreement on client attorney privilege presented by the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and the UK

Background:

- 1) It is well accepted that legal advisers can only properly perform their function if their clients can rely on absolute confidentiality. If clients were not confident that their confidential information and the instructions given to their advisers will not be disclosed, they may withhold relevant facts and thus make it impossible for their advisers to effectively represent and protect their interests. Equally, if legal advisers could not be sure that the advice they give remains absolutely confidential and safe from disclosure, any advice given would necessarily need to be curtailed so that any subsequent disclosure does not cause prejudice to the client.
- 2) Client attorney privilege (in this Resolution, “**Privilege**”) is a ground for resisting the disclosure of any communications – whether oral or written – between a client and their legal advisers. Privilege exists for the purpose of allowing those seeking advice and those giving advice to be fully frank with each other, enabling the client to receive legal advice which best protects their interests, and in turn ultimately serves the public interest.
- 3) Privilege can be invoked as a ground for resisting documentary disclosure in systems of law that have discovery obligations. Privilege might also be invoked in connection with a witness giving oral evidence in court who is being cross-examined, or in connection with a witness being deposed and giving oral evidence.
- 4) The person entitled to claim Privilege is the client. In addition, a client’s lawyer may claim privilege on behalf of the client.

- 5) AIPPI believes that with respect to advice sought and given in respect of intellectual property rights (IP rights), the same rules on Privilege should apply irrespective of whether the person providing the advice is a lawyer admitted to practice within a regulated legal profession or an IP adviser who is not a lawyer but is admitted or permitted to practice as an IP professional. At its EXCO meeting in Lucerne in 2003, AIPPI passed the following Resolution:

“That AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize that the protections and obligations of the attorney-client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.”

- 6) In 2005, AIPPI submitted to WIPO a proposal for the study of a treaty establishing minimal standards on privilege and protection from disclosure of communication relating to IP rights (AIPPI Submission to WIPO for a treaty to be established on Intellectual Property Adviser Privilege):

“A communication to or from an intellectual property adviser which is made in relation to intellectual property advice, and any document or other record made in relation to intellectual property advice, shall be confidential to the person for whom the communication is made and shall be protected from disclosure to third parties, unless it has been disclosed with the authority of that person.

***‘intellectual property advice’** is information provided by an intellectual property adviser in relation to intellectual property rights.*

***‘intellectual property adviser’** means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person qualified under the law of the country where the advice is given, to give that advice.*

***‘intellectual property rights’** includes any matters relating to such rights.”*

- 7) In subsequent years, AIPPI actively supported the work of the Standing Committee of Patents (SCP) of WIPO regarding the confidentiality of communications between clients and their IP advisers with numerous submissions and presentations.
- 8) In 2013, AIPPI along with FICPI and AIPLA, hosted a Colloquium with the purpose of reaching a consensus on a global framework to protect confidential intellectual property advice given to a client by lawyer and non-lawyer IP advisors, and this led to the issuance of a Joint Proposal for a multilateral agreement on Privilege, including cross-border aspects of the same.

- 9) In September 2019, the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK presented a Draft proposal for a multilateral agreement on Cross-border aspects of client/patent attorney privilege (“**B+ Draft Agreement**”), a copy of which is annexed to this Resolution, and which is largely based on the AIPPI/FICPI/AIPLA Joint Proposal.
- 10) AIPPI welcomes and appreciates the B+ Draft Agreement. It establishes, on an international level, minimum standards on Privilege and protection from disclosure of privileged materials.
- 11) Privileged advice within the B+ Draft Agreement only includes “advice given on patent law.” AIPPI welcomes the "opt in" provision foreseen in Article 5 of the B+ Draft Agreement providing for the ability of signatory countries, at their choosing, to extend the protection beyond patent law advice. Nevertheless, in due course, AIPPI would also welcome the general extension of the arrangements to include other fields of IP than patent law.
- 12) AIPPI sought the opinions of its National and Regional Groups of AIPPI on the B+ Draft Agreement.
- 13) This Resolution was proposed by AIPPI’s Standing Committee on CAP, and supported unanimously by the committee. The committee’s members are from the following countries: Argentina, Australia, Austria, Canada, Belarus, Brazil, Chile, China, Colombia, Croatia, Czech Republic, Egypt, Estonia, Finland, Iceland, Indonesia, Italy, France, Georgia, Germany, Greece, Hungary, India, Ireland, Israel, Japan, Lithuania, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Pakistan, the Philippines, Poland, Portugal, Romania, Russia, Serbia, Singapore, South Africa, South Korea, Spain, Sweden, Switzerland, Thailand, Ukraine, the United Kingdom, the United States of America and Venezuela.

AIPPI resolves that:

- 1) AIPPI supports and welcomes the adoption of the B+ Draft Agreement.
- 2) AIPPI would also welcome the extension of the B+ Agreement to cover other types of IP, and specifically those types of IP in respect of which there exist professional advisers qualified to advise on, for example, trade marks and designs.
- 3) In AIPPI’s view, the specific requirements set by any nation under Article 6, which an intellectual property advisor must meet, should:
 - a) be made available by that nation in a public register, so that it is possible to easily verify whether a specific communication with an adviser in that nation is a communication to or from a qualifying individual;

- b) not include any limitations which would have the effect of denying protection simply because the adviser is not domiciled in or a national of that nation.

ANNEX

Draft proposal for a multilateral agreement on Cross-border aspects of client/patent attorney privilege (B+ Draft Agreement)

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

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 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.
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 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.
6. 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.
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 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.
9. 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 advisor**” means an advisor who is authorised to act before a competent administrative or judicial authority in his/her own jurisdiction, and officially certified to provide professional privileged advice concerning patent. The criteria of qualification and the categories of certification are defined by national law.

“**communication**” includes any oral, written, or electronic record.

“**professional advice**” means advice given on patent law within the patent advisor’s area of expertise, as defined by the national law that stipulate 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 an patent 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 made public with the authority of that client.

Article 3

This Agreement applies to communications between an patent advisor and his client regardless of the territory of the signatory State in 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 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 intellectual property 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.