



AIPPI 

International Association
for the Protection of Intellectual Property

London Resolutions 2019

www.aippi.org
AIPPI General Secretariat
Tödistrasse 16
8002 Zurich
Switzerland

2019 AIPPI World Congress – London
September 15 - 18, 2019

About AIPPI

The International Association for the Protection of Intellectual Property, known as AIPPI (Association Internationale pour la Protection de la Propriété Intellectuelle), is the world's leading International Organization dedicated to the development and improvement of laws for the protection of intellectual property. It is a politically neutral, non-profit organization, based in Switzerland with over 9000 Members representing more than 125 countries.



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

Table of Contents

- Copyright in artificially generated works 4
- IP damages for acts other than sales 7
- Plausibility 10
- Consumer survey evidence 13
- Draft proposal for a multilateral agreement on client attorney privilege 15

Resolution

2019 – Study Question

Copyright in artificially generated works

Background:

- 1) This Resolution concerns the intersection of artificial intelligence (“AI”) and copyright.
- 2) This Resolution seeks to establish if and under what conditions Copyright and/or Related Rights should be available for works generated by AI.
- 3) This Resolution does not address the following related issues:
 - copyright infringement by AI-generated works;
 - copyright in computer programs or algorithms used for AI systems;
 - copyright in intermediate works, i.e. works created during each step of the process. Only the final work is within the scope of this Study Question.
- 4) For the purpose of this Resolution:
 - The term “Copyright” means the rights associated with copyright as set forth in the Revised Berne Convention 1979 (RBC). Certain jurisdictions also provide for exclusive rights protection as a copyright beyond the RBC and not regulated by the RBC. Such copyright protection is not included in the term Copyright.
 - The term “Related Rights” means all other copyright-type rights, e.g. “related rights”, “neighbouring rights”, “sui generis rights”, etc.
 - The term “Economic Rights” means the exclusive rights of Copyright or Related Rights granted to the owner, e.g. the right of reproduction (Art. 9 RBC), Art. 1 (4) World Copyright Treaty 1996 - WCT), the right of distribution (Art. 6 WCT) or the right of communication to the public (Art. 8 WCT).
 - The term “Moral Rights” means the rights of Copyright granted to the author apart from Economic Rights according to the RBC, e.g. the right to object to distortion of the work.
- 5) To provide a concrete basis for this Resolution, the following Working Example is adopted:
 - Step 1: One or more AI entities are created that are able to receive inputs from the environment, interpret and learn from such inputs, and exhibit related and flexible behaviours and actions that help the entity achieve a particular goal or objective over a period of time¹ The particular goal or objective to be achieved is selected by a human and, for purposes of this Study Question, involves generation of works of a type that would normally be afforded copyright protection.

¹ This is the AI definition proposed by Daniel Faggella, Emerj, <https://emerj.com/ai-glossary-terms/what-is-artificial-intelligence-an-informed-definition/>

- Step 2: Data is selected to be input to the one or more AI entities. The data may be prior works such as artwork, music or literature. The data also may be inputs from sensors or video cameras or input from other sources, such as the internet, based on certain selection criteria.
 - [Case 2a]. The data or data selection criteria are selected by a human.
 - [Case 2b]. The data or data selection criteria are not selected by a human.
 - Step 3: The selected data is input to the one or more AI entities, which achieve the particular goal or objective over time by generating “new works” that are not identical to any prior work.
 - [Case 3a]. A human makes a qualitative or aesthetic selection of one work from the new works.
 - [Case 3b]. No human intervention is involved in selection of a work from the new works.
- 6) 32 Reports were received from AIPPI’s National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 7) At the AIPPI World Congress in London in September 2019, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) Harmonization regarding the protection of AI generated works is desirable.
- 2) AI generated works should only be eligible for protection by Copyright if there is human intervention in the creation of the work and provided that the other conditions for protection are met. AI generated works should not be protected by Copyright without human intervention.

This principle is considered to apply to the Working Example as follows:

- In Step 1, the AI generated work should not be eligible for Copyright protection merely because of the human creation of the AI system to achieve a work as output;
- In Step 2, case 2a, the AI generated work should be eligible for Copyright protection where there are human data selection criteria for the input into the AI;
- In Step 2, case 2b, the AI generated work should not be eligible for Copyright protection where there is only non-human data selection or non-human data selection criteria;
- In Step 3, case 3a, the AI generated work should not be eligible for Copyright protection merely because of a human selection of one work from the newly generated works;
- In Step 3, case 3b, the AI generated work should not be eligible for Copyright protection merely because of non-human selection of one work from the newly generated works.

- 3) Originality (as interpreted by national laws) of the generated work resulting from the human intervention should be a condition for the protection by Copyright.
- 4) In case of Copyright protection for the work generated by AI, because the requirements set out in 2) (human intervention) and 3) (originality) above have been met, the protection regime should be identical to other works protected by Copyright. This is in particular true for:
 - Economic Rights;
 - Moral Rights (as interpreted by national laws).
 - Term of protection;
 - Exceptions and limitations;
 - Initial ownership.
- 5) AI generated works may be eligible for protection other than Copyright protection (as set forth in the RBC), even without human intervention.

AI generated works should not be precluded from obtaining protection by existing Related Rights on the basis they are AI generated and should obtain that protection as long as they meet the required criteria for obtaining protection. Jurisdictions may grant exclusive rights protection under their copyright regimes (not in the meaning of the RBC), as far as such protection already exists.

As AI is still developing, it is too early to take a position on the question, whether AI generated works not covered by such existing protection should be eligible for exclusive rights protection as a Related Right or as exclusive rights under copyright (not in the meaning of the RBC).

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Study Reports](#)

(All documents can be found on www.aippi.org)

Resolution

2019 – Study Question

IP damages for acts other than sales

Background:

- 1) This Resolution concerns the quantification of damages for acts of infringement that do not include a sale, such as importing, warehousing, manufacturing, using and offering. It also addresses the issue of ‘franking’. Franking means that there should be no further liability for infringement in relation to dealings in specific products found to infringe, once damages have been awarded in respect of those goods, and such goods are considered to have been “franked”.
- 2) The quantification of damages for infringement was addressed generally in AIPPI’s Resolution on “Quantification of monetary relief” (Sydney, 2017), referred to as the Sydney Resolution. The **Sydney Resolution** focussed on the quantification of damages by reference to sales of products by the infringer and/or the right holder.
- 3) This Resolution is aimed at assessing and quantifying the damage suffered by the right holder caused by the infringing acts, and not at assessing the unlawful profit made by the infringer. This Resolution is not concerned with statutory damages, punitive damages, or accounts of profit and other relief in which the unlawful profits of the infringer are rendered to the right holder. Specific issues in relation to FRAND (fair, reasonable and non-discriminatory) royalties in the context of standard essential patents are also outside the scope of this Resolution.
- 4) The Sydney Resolution established that where damage has been suffered but there is no causal nexus between the damage and the infringement, that damage should not be recoverable.
- 5) However, where such a causal nexus does exist between a non-sales infringement and damage, that damage should be recoverable and quantified despite there being no infringing sale which would establish a benchmark sales price for the quantification of damages.
- 6) In this Resolution:
 - the term **IP rights** includes patents and supplementary protection certificates, petty patents and utility models, trade marks, rights to prevent unfair competition or passing off, copyrights, semiconductor topography rights, database rights and design rights, but excludes trade secrets, rights of confidence and rights in know-how;
 - the term **damages** refers to monetary relief as provided for in relation to IP rights, including but not limited to i) actual loss suffered by the right holder as a result of the infringing activity, e.g. loss of sales or price erosion; ii) the “injury proven” as referred to in paragraph 6(a) of AIPPI’s Resolution on Q134 – “Enforcement of Intellectual Property Rights – TRIPS” (Rio de Janeiro, 1998); and iii) reasonable royalties awarded when actual loss is not proven;
 - the term **non-sales infringement** refers to acts of infringement that do not include a sale, including but not limited to importing, warehousing, manufacturing, using and offering; and
 - the term **IP rights in suit** refers to those IP rights found infringed in respect of which the court will need to quantify damages.

- 7) 37 Reports were timely received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 8) At the AIPPI World Congress in London in September 2019, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) Regardless of whether injunctive relief is available, damages should be available as a potential remedy for non-sales infringements.
- 2) Damages for all types of infringing acts (including both sales and non-sales infringements) should be determined using the same principles.
- 3) The right holder has the right to receive full compensation for all damage caused by the infringing acts. A causal nexus between the infringing act(s) and the damage must be established. As a minimum, the holder of the infringed IP right should be entitled to a reasonable royalty for the established infringement.
- 4) The principles stated in the Sydney Resolution should be followed in the quantification of damages, as applicable. When quantifying damages for infringing non-sales acts relating to specific products, any potential subsequent sales of the same specific products (whether infringing or non-infringing, and whether in the same jurisdiction or not) could be used as a benchmark for the quantification. The objective is to determine the economic effect of the non-sales infringement on the right holder.
- 5) The court should apply its normal fact-finding procedures and standard of proof to determine the extent of any potential subsequent sales. It is not necessary that there have been actual subsequent sales, but if actual subsequent sales were made then such sales would be a relevant factor to be taken into account.
- 6) When assessing damages for non-sales infringements in relation to a process that is protected by a patent, the court should, in addition to the principles stated in the Sydney Resolution, take into account the economic effect on the right holder of both (a) use of the process and, when relevant, (b) the products that may (or may not) result from the process:
 - a) In relation to patented processes (regardless of whether they result in the creation of a relevant product by the infringer), the court should inter alia consider:
 - whether the use of the process by the infringer produces an economic advantage to the infringer or a disadvantage to the right holder;
 - the turnover and potential sales associated with the use of the process as long as, in respect of the potential sales, the right holder proves a causal nexus between the infringement and the right holder's loss;
 - the frequency of use of the process.
 - b) In relation to products obtained by the patented process, regardless of whether those products infringe, the court should, take into account inter alia the following:

- potential sales to be made by the infringer of any products manufactured using the process, as long as the right holder proves a causal nexus between the infringement and the right holder's loss;
 - whether the product resulting from the process is protected by the patent in question, directly or indirectly;
 - whether that product competes with products not produced using the patented process;
 - any timing advantage in launching the products given to the infringer through the use of the process (i.e. a springboard advantage).
- 7) Without prejudice to the court's power to award injunctive relief, and subject to the limitation on double recovery in paragraph 8 below, the court should award damages in respect of each infringing act. This may validly result in recovery of multiple awards of damages for corresponding multiple infringing acts that concern a single product. The court may make one award of damages covering all of the multiple infringing acts.
- 8) While full compensation of the right holder is desired, "double recovery" should be avoided. The term "**double recovery**" in this context means recovering more than once in respect of the same loss suffered by the right holder. For example, if a right holder loses sales because an infringer has imported, kept and sold infringing products, the right holder may recover only once in relation to the lost sales caused by the infringing sales, even though those lost sales may have been caused at least in part by all three infringing acts (importing, keeping and selling).
- 9) Effective and proportionate procedures, including relevant disclosure by the right holder, should exist to reduce the risk of double recovery with respect to multiple infringements concerning a single product.
- 10) Without prejudice to any rules in relation to exhaustion and res judicata, there should be no 'franking'.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Study Reports](#)

(All documents can be found on www.aippi.org)

Resolution

2019 – Study Question – Patents

Plausibility

Background:

- 1) This Resolution concerns the question whether “plausibility” should be considered as a (further) patentability requirement, and if so, how to define its preconditions.
- 2) Plausibility, if considered as a patentability requirement, generally addresses the question whether there is sufficient evidence/disclosure in the patent application that the purported technical effect of a claimed invention can be actually achieved, as opposed to “speculative” patent applications. In this respect the plausibility requirement can relate to various established disclosure requirements, including sufficiency, clarity, utility, industrial applicability and use of post-filing data, as well as traditional patentability requirements such as novelty and inventive step. The issue of plausibility is becoming relevant, in some countries, in the chemical and pharmaceutical fields, and may become relevant to other technologies such as those involving artificial intelligence.
- 3) Given the (potentially) extremely broad and sweeping implications of this notion, the scope of this Resolution is limited to the sub-issues of (1) the general credibility of the invention, (2) the general prohibition of speculative patent claims and (3) specific restrictions regarding “prophetic” examples. In the context of the resolution, these sub-issues are understood as follows:
 - credibility of the invention refers to whether patent claims found in applications which describe a technical effect appear credible or not, for example because the described effect contradicts the common perception;
 - speculative patent claims refers to patent claims for an invention that was not made, conceived or disclosed] until after the application is filed;
 - “prophetic” examples refer to description which does not describe experiments that have actually been performed but which rather predicts that a specific experiment will prove a technical effect.
- 4) This Resolution does not consider the general sufficiency of disclosure and inventive step requirements, the general utility requirement or the use of post-filing data.
- 5) 37 Reports were received from AIPPI’s National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 6) At the AIPPI World Congress in London in September 2019, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

No need for a stand-alone plausibility requirement

- 1) There should be no stand-alone ground of patentability or validity based on plausibility. The already existing patentability (novelty, inventive step, industrial application and/or utility) and validity (e.g. sufficiency, right to priority, added matter) requirements are sufficient to ensure that the invention protected by the claims is commensurate with the technical contribution made by the specification to the state of the art. The introduction of a separate plausibility requirement would create legal uncertainty without a commensurate benefit.
- 2) If plausibility is to be examined (in any of its possible aspects, notably as a requirement of credibility of the technical effect, as a prohibition of speculative patent or as condition of use of prophetic examples), it should be considered as one of many elements of the examination of the already existing patentability and validity requirements.

Aspects of plausibility relating to the credibility of the invention, speculative claims and use of prophetic examples

- 3) If credibility of the claimed invention is considered with respect to the requirements of patentability and validity, the threshold should be low and narrowly understood.
- 4) The credibility threshold should be met when, based on the specification and common general knowledge, at least one of the following is satisfied:
 - the patent application contains, even implicitly, a convincing explanation as to why a technical effect may be obtained; or
 - it is credible for the person skilled in the art that at least one of the technical effects disclosed in, or derivable from, the application of the claimed invention may be obtained; or
 - the person skilled in the art has no serious reason to doubt that at least one of the said technical effects could work as described.
- 5) Any effect claimed or relied upon for the assessment of the patentability (e.g. novelty or inventive step) and validity of the patent should be credible. But a promise of the specification that is not claimed or relied upon for such assessment does not have to be credible.
- 6) The patentability and validity requirements should prohibit speculative claims, i.e. the patent application should provide a basis for the skilled person, with their common general knowledge, to establish that the inventor has in fact made the technical contribution for which protection is claimed.
- 7) A claim should not be considered speculative for the mere reason that the purported technical effect or the substantiation thereof is not explicitly mentioned in the specification. The number and nature of data and examples provided in the application should not be determinative in this respect.
- 8) If plausibility is considered, it should be assessed, in consideration of the claimed subject matter, in particular by taking into account whether the claimed invention is characterized (i) only by structural features or (ii) also by functional features or a use. Under (i), it should not be critical for the purpose of assessing plausibility to disclose its technical effect or use. Under (ii), it should be plausible that the technical effect of this use or function can be obtained.

- 9) It should not be presumed that if an effect is found plausible to the skilled person at the priority date based in part on the common general knowledge, then the invention would necessarily lack inventive step. In the assessment of plausibility the teaching of the patent is taken into account.
- 10) Plausibility considerations should not prohibit the presence of prophetic examples in the specification.

Relevant date and burden of proof

- 11) If plausibility is to be considered, it should be evaluated as at the priority date.
- 12) If plausibility is challenged with respect to a given validity/patentability requirement, the burden of proof should be that of said requirement under consideration.

Miscellaneous

- 13) Patent offices should agree on the basic principles and issue guidelines regarding possible issues of plausibility.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Study Reports](#)

(All documents can be found on www.aippi.org)

Resolution

2019 – Study Question

Consumer survey evidence

Background:

- 1) This Resolution concerns consumer survey evidence only in the context of trade mark proceedings.
- 2) This Resolution seeks to establish whether consumer survey evidence should in principle be admissible in trade mark proceedings, and if so, in what types of proceedings. It furthermore explores what subject matter the consumer survey evidence should encompass and whether there should be specific requirements or guidelines. It also addresses whether courts or administrative authorities (i.e., the triers of fact) should be involved in the survey's set-up and what weight or value should be attributed to consumer survey evidence.
- 3) 41 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 4) At the AIPPI World Congress in London in September 2019, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) Consumer survey evidence should be admissible but not mandatory in trade mark proceedings.
- 2) Consumer survey evidence should be admissible in any type of trade mark proceedings, including administrative and court proceedings.
- 3) Consumer survey evidence should be admissible to prove or help prove any facts or circumstances relevant in trade mark proceedings, in particular reputation, distinctiveness and confusion.
- 4) There should be non-binding guidelines for the set-up of consumer surveys which should address items such as aim of the survey, methodology, number and selection of respondents and form and order of the questions.
- 5) There should be no predetermined percentage of responses required to have a fact or circumstance deemed as sufficiently proved by a consumer survey.
- 6) Courts or administrative authorities (i.e., the triers of fact) should not be involved in the set-up of a consumer survey.

- 7) The weight or value of consumer survey evidence should be assessed on a case by case basis and taking into consideration, at least, the following factors:
- a. a. relevance of the survey to the issues to be decided,
 - b. reliability of the consumer survey, in particular the neutrality, representativeness and formulation of the questions;
 - c. all other evidence submitted by the parties;
 - d. all relevant circumstances of the case.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Study Reports](#)

(All documents can be found on www.aippi.org)

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 advisors. 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

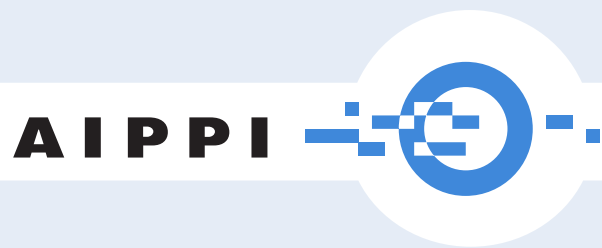
In case a document containing privileged and not privileged information has to be disclosed, the privileged information must be blacked out.

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.



www.aippi.org

LinkedIn, Facebook and Twitter keep AIPPI members up to date about AIPPI activities, initiatives and industry news. Follow AIPPI now!



AIPPI (Association Internationale pour la Protection de la Propriété Intellectuelle)
International Association for the Protection of Intellectual Property