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**RESPONSE TO IGE/IPI QUESTIONNAIRE REGARDING CROSS-  
BORDER ASPECTS OF CLIENT / PATENT ATTORNEY  
PRIVILEGE (CAP)**

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The Faculty of Advocates is the professional body to which advocates belong. The Faculty welcomes the opportunity to provide a written response to the Intellectual Property Office in relation to the questionnaire on Cross-Border Aspects of Client / Patent Attorney Privilege (CAP).

The following is a response to the IGE / IPI Questionnaire. Responses are set out in italic script under each question.

**A. General Aspects**

1. In your opinion, is there a need to protect communications between IP professionals (non-lawyer / lawyer) and clients in cases having cross-border aspects?

Notably:

- Please explain why / why not
- Please define the kind of communication that should be covered by that protection

*There is such a need. Clients should feel confident that any communications they have with their IP professional advisors (whether they be lawyers or non-lawyers) are protected not only under Scots law but also under the law in other jurisdictions. As the potential for cross-border disputes concerning intellectual property increases, clients should not be hampered in obtaining proper legal advice because of concerns as to whether their communications will be properly protected or not.*

*In Scots law communications between IP professionals (both non-lawyers and lawyers) and clients are protected by legal professional privilege in the following way:*

*(1) At Scots common law, there is a right of absolute privilege in respect of (i) communications between a solicitor (or advocate) and client relating to legal advice (sometimes known as “confidentiality”) and (ii) in respect of documents prepared for the purpose or in anticipation of litigation (sometimes known as “communications post litem motam”) [Narden Services Ltd v Inverness Retail and*

*Business Park Ltd 2008 SC 335*]. *Post litem motam* privilege is not limited to documents between solicitor and client but extends to all documents prepared for the purposes or in anticipation of litigation e.g. reports by third party experts.

- (2) Various statutory provisions extend the common law privilege to patent attorneys and trade mark attorneys in respect of specific communications. For example, as regards the confidentiality privilege attaching to solicitor / client communications, s. 280 Copyright, Designs and Patents Act 1988 provides that communications, documents, materials or information between a patent attorney and a client concerning matters relating to the protection of any invention, design, technical information, trade mark or any matter involving passing off are privileged as if the patent attorney had at all material times been acting as the client's solicitor. Similarly s. 87 Trade Marks Act 1994 provides that communications, documents, materials or information between a trade mark attorney and a client relating to the protection of any design or trade mark or any matter involving passing off are privileged as if the trade mark attorney had at all material times been acting as the client's solicitor.
- (3) In addition, s. 105(1) Patents Act 1977 confirms that *post litem motam* privilege applies to communications, reports or other documents made for the purpose of patent proceedings. "Patent proceedings" include proceedings before the Court, the Comptroller (at the UK IPO) and before the European Patent Office, whether contested or not, and include applications for patents. A similar provision does not exist for trade mark proceedings.
- (4) The terms "patent attorney" and "trade mark attorney" are defined in the relevant legislation. It is necessary for the patent / trade mark attorney to be a registered patent or trade mark attorney within the UK or a patent or trade mark attorney on the European list. A registered patent or trade mark attorney within the UK is one whose name has been entered on the relevant statutory register which is kept by the relevant professional body: in the case of patent attorneys, the relevant body is the Chartered Institute of Patent Attorneys ("CIPA")<sup>1</sup> and, in the case of trade mark attorneys, it is the Institute of Trade Mark Attorneys ("ITMA")<sup>2</sup>. Article 134 of the European Patent Convention provides for the European Patent Office to keep a list of persons who have the relevant criteria to be entitled to represent clients at the European Patent Office. A similar provision in respect of trade mark attorneys is found in Article 93 of Council Regulation (EC) No. 207/2009 on the

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<sup>1</sup> s.275 Copyright, Designs and Patents Act 1988

<sup>2</sup> s.83 Trade Marks Act 1994

*Community Trade Mark.*

*The public policy underlying the principle of legal professional privilege is that clients and their legal advisors should be able to communicate with complete candour (e.g., Lord Hope in R v Special Commissioner of Income Tax [2013] UKSC 1 at paragraph 100). It is obviously desirable that this be the case whether or not they anticipate the possibility of a cross-border dispute.*

2. Have you been confronted with situations where the client attorney privilege was an issue?

Notably:

- Please describe the circumstances (countries / sender and recipient of communication / kind of communication etc. involved)
- Please describe the reasons, why the issue arose.
- Please describe the solution of the issue.
- If yes, how often in the last 5 years?
- How many times since you started practicing (if applicable)?

*No.*

3. Is your interaction with your clients (e.g. communication, decision making process) influenced by the differences in national approaches to client attorney privilege issues?

*No – as a member of a referral profession, all interaction with clients is via solicitors, rather than with the client directly.*

4. In connection with the cross-border client attorney privilege, what do you think is essential to be regulated by a multilateral agreement?

*The following aspects should be covered by the agreement:*

*(1) The identities of the professionals covered by the agreement:*

- a. How are IP professionals to be defined?*
- b. Will only independent IP professionals be covered or will communications with in-house IP professionals also have the benefit of the privilege?*
- c. Does the privilege apply to communications only with individuals or with a partnership or other body that carries on business as an IP professional?*
- d. If the latter, is it necessary for the particular communication to be with a*

*fully qualified IP professional or would a communication with a trainee be covered?*

*(2) The types of communication that will be covered by the agreement:*

- a. Will the agreement only cover communications entered into for the purposes of obtaining legal advice or will it also extend to documents prepared in anticipation and for the purposes of litigation?*
- b. If the latter, will it cover documents prepared by third parties and, if so, will it be limited to documents prepared at the request of the client and/or IP professional advisor or could it extend to documents prepared independently of the litigation?*

*(3) The extent of the protection:*

- a. Will it cover specific types of advice or provide blanket protection to all types of advice given by the IP professional? For example, if the agreement specifies that privilege should attach to advice given by trade mark attorneys, will it only cover advice given in relation to trade mark protection or would it also cover advice given in relation to related issues, e.g., copyright / ownership / assignment etc.?*
- b. Related to the foregoing, will the extent of protection differ depending upon the identity of the IP professional? For example, will wider protection attach to communications with lawyers as compared to communications with a trade mark attorney?*

*(4) Waiver of protection:*

- a. Is it possible for a client to waive privilege?*
- b. If a client does waive privilege, what is the extent of that waiver?*

5. In your opinion, what are possible reasons against adopting a multilateral agreement?

*In principle, a multilateral agreement would be a good thing. However, there are a number of potential pitfalls. The following points would have to be carefully worked through before an agreement of real utility could be formulated:*

- (1) The multilateral agreement ought to clarify, not obscure, matters. The driving force behind a multilateral agreement would be to give certainty to clients as to the circumstances in which their communications would be protected. It is therefore essential that agreement resulting from negotiations be clear and easy to apply;*
- (2) The protection conferred by a multilateral agreement ought not be so limited in scope that it effectively erodes protection under national law. On the assumption*

*that the purpose of the multilateral agreement is to define the circumstances in which one signatory state will treat communications between a client and its IP professional in another signatory state as privileged (as opposed to attempting any form of harmonisation), the agreement may be disadvantageous if it provided for only a very limited form of cross-border protection. That is because clients with an eye to cross-border litigation would be advised to arrange all their affairs so as to ensure they fell within the protection provided by the agreement. This could be detrimental to clients if they effectively prevented themselves from taking advantage of the more favourable rules of privilege provided under national law.*

*(3) The multilateral agreement ought not provide a bar to relevant documents being disclosed in appropriate circumstances. There is a balance between ensuring that appropriate protection is put in place and also ensuring that relevant documents are available where appropriate in cross-border litigation. Any multilateral agreement ought to carefully define the type of communications that are protected and the professionals covered by it to avoid the potential for clients to arrange their affairs in such a way that relevant documents would always be protected from rules requiring their production.*

## **B. Specific Aspects on the proposed multilateral agreement**

1. What professionals should be covered by the agreement?
  - By what criteria should the professionals be identified?
  - What definition should be used to ensure that the professionals covered are defined sufficiently clearly?
  - How should the different terminology in different jurisdictions be taken into account?

*The following professionals should be covered by the agreement:*

- *Lawyers (solicitors and advocates);*
- *Patent attorneys;*
- *Trade mark attorneys.*

*The criteria used to identify the professionals covered by the agreement should be tied to each signatory's national laws regulating such professionals. For example under the relevant UK legislation, patent attorneys are identified by reference to their registration on the CIPA Register. See also a similar provision identifying who can*

*appear before the European Patent Office (Article 134 European Patent Convention).*

*One benefit of this approach would be certainty. It would be easy to check whether a particular person met the relevant criteria. The problem with a more general description would be determining whether a particular individual fell within that description or not.*

*Another benefit would be that it ought also to avoid the problem of different terminology being used in different jurisdictions. Instead of having to incorporate into the multilateral agreement a long list of different terminologies used in each state (which would be likely to change and therefore require amendment with time), by identifying the professional by reference to national laws, it ought to be simpler to come up with a workable definition.*

*It may be useful to note that it appears that those working on the draft Unified Patent Court rules have adopted this type of approach. For example, Rule 287(6) of the current draft Rules of Procedure<sup>3</sup> defines a “patent attorney” as a “person who is recognised as eligible to give advice under the law of the state where he practices in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice”.*

2. What advice should be covered by the agreement?

- What definition should be used to ensure that the advice covered is defined sufficiently clearly?

*As a minimum, the agreement should cover legal advice relating to the protection of any intellectual property rights including, but not limited to, inventions, designs, copyright, trade marks (both registered and unregistered) and trade secrets. Consideration should also be given as to whether the agreement should also cover advice relating to issues such as ownership and/or licensing of intellectual property rights.*

*In addition to covering legal advice between the IP professional and client, it would also be desirable for the agreement to extend to documents created for the purpose of or in anticipation of litigation.*

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<sup>3</sup> available at <https://www.unified-patent-court.org/sites/default/files/UPC-Rules-of-Procedure.pdf>

3. Should there be a provision in the agreement that stipulates a certain flexibility for the participating countries?

*It all depends upon what type of provision is envisaged. Generally speaking, the purpose of a multilateral agreement would be to give clarity and certainty to clients. Any provisions that detracted from such clarity and certainty and/or which gave potential for confusion, would be of considerable concern. On that basis, any such provisions would have to be scrutinised with care before being incorporated into the agreement.*