Report of AIPPI Special Committee Q163

Attorney-Client Privilege and the Patent and/or Trademark Attorney Profession

March 2002

1. Introduction

The Committee was established by the Bureau to investigate the question of the applicability of the attorney-client privilege to communications between patent or trademark attorneys and their clients.

As no specific mandate or question was proposed, the Committee devised the following strategy for examination of the issue. Firstly, the Committee members would conduct an informal survey of several large jurisdictions among the membership to determine what prevailing attitudes exist about the issue. If it was determined that the issue was susceptible to and possibly in need of influence by AIPPI, the Committee would then propose a formal Question to be distributed to the Groups to solicit official comments from the Groups and possibly develop a consensus for proposing a formal resolution of AIPPI itself.

2. Results of Informal Survey

The Committee conducted research and several informal surveys and determined that quite a bit of variation exists internationally as to the treatment of the privilege. Major influencing factors seems to include the availability of discovery or forced disclosure in the jurisdiction, the status of the patent or trademark professional in the jurisdiction, and the common law/civil law tradition of the jurisdiction. Also, quite a number of jurisdictions seem to impose criminal penalties on patent or trademark attorneys who reveal their client's confidential information and this also may be a factor in shaping attitudes towards the question.

The following general results obtained from the study and informal survey.

a. Countries which seem to recognize that the attorney client privilege extends to patent and trademark attorneys: United Kingdom, United States, Germany [others]

b. Countries which seem to recognize that no such privilege exists as between patent and trademark attorneys and their clients: France, Italy, Korea, [Others]

c. Countries in which the question is unclear, and which are proposing internal legislation/rule changes to clarify the situation to make it clear that such a privilege exists: Japan, [others]

d. Countries with laws making it a crime or violation of professional obligation rule for a patent or trademark attorney to disclose his clients confidences: Japan, United States, [others]

Background materials supporting the survey results are appended.

3. Committee recommendations

As a result of its deliberations and survey activity, the Committee respectfully suggests that the Question may indeed be suitable for treatment on an international level.

The primary factors for this decision are that: (1) the role of the patent and trademark attorney, regardless of his or her qualification as well as an attorney at law, is an important one and is becoming more important every day; (2) clients, it is believed, on a world wide basis, reasonably expect their communications with their local and international patent and trademark attorneys will be treated with the same respect as to the question of privilege as are their communications with attorneys at law; and (3) as is the case for the attorney-client privilege, the overall intellectual property system will be better served if clients are encouraged by the existence of such a privilege to fully and timely communicate all relevant facts to their respective patent or trademark attorneys.

The committee has thus developed a draft Question 163 for presentation to the Bureau.

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