

Meeting of the WIPO Standing Committee on the Law on Patents (SCP/13) March 23-27, 2009
Notes on the Client/Attorney Privilege Issue

Drawn up by Ivan Hjertman, member of the ICC delegation at the meeting April 5, 2009

Background

It was decided at the SCP/12 meeting in June 2008 that the WIPO Secretariat would prepare studies on four subjects. One of these subjects was client/attorney privilege. These studies would then be discussed at the SCP/13 meeting March 23-27, 2009.

The study on client/attorney privilege is document [SCP/13/4 dated February 25, 2009](#).

Selected documents:

- [SCP/13/7 dated March 27, 2009: Summary by the Chair](#)
- ICC statement read at the meeting
- Joint Statement AIPPI/ICC made available at the SCP meeting
- [SCP/13/8 Prov., WIPO Draft Report from the meeting \(published after completion of the present notes\)](#)

The **outcome of the discussion** is phrased as follows in item 8, Future work, in the Summary by the Chair, dated March 27, 2009:

the Committee

“b) agreed that documents SCP/13/2, 3, 4 and 5 would remain open for further discussion and comments at the next session of the SCP;

(c) decided that five studies will be prepared as follows, taking into account interventions of Members:

....

“(iii) the Secretariat will expand the preliminary study on the client-attorney privilege (document SCP/13/4), to reflect the current state of play in this area, taking into account perspective of various stakeholders and using external experts, if necessary;”

Thus, the matter will be subject of further study and will obviously be taken up again at the next SCP meeting, which will be SCP/14 to take place November 9-13, 2009.

A great deal of preparatory work was done in the lead up to the SCP meeting by ICC, AIPPI, FICPI and regional patent attorney and business associations, working in collaboration, to sensitize national representatives both in capitals and in Geneva to this issue. ICC and AIPPI prepared a briefing memo that was used to sensitize delegates and which was also circulated at the meeting together with the ICC paper submitted to WIPO earlier in the context of WIPO's consultation procedure before the meeting.

The various associations continued to work together to talk to delegates during the meeting. ICC arranged and invited other associations to participate in a briefing with GRULAC (the group of Latin American and Caribbean countries).

Impressions from the discussion:

A significant number of delegations, including China, Group B countries (developed countries), the Central European and Baltic states, and Russia and CIS countries, indicated interest and understanding of the issue and supported further work by WIPO, and even the creation of a working group.

However, it was quite clear, and expressly stated in a number of submissions from regional coordinators as well as from national delegations, that this was a new item for many members of the SCP and that there was a significant need for further information and clarification.

Among concerns raised were that this was matter which should be left to national law, with reference to the Paris Convention Article 2(3), impact on the public domain by reducing access to information, impact on risk for abuse by withholding prior art from examination in patent applications, impact on public policy issues, impact on patent quality, impact on competition, and impact on costs for developing countries. Many of the concerns raised appeared to arise from a lack of understanding of the issue.

ICC action to be considered:

There is quite obviously considerable need for explanation and clarification of what client/attorney privilege is, what it is not, for whom it is an issue: for those affected by IP/patent rights of others perhaps more than for the owners of rights, what impact there might be in different areas, etc. ICC could not only offer to assist in the continued study to be undertaken by WIPO, where external experts apparently will be invited, but also organize seminars/meetings in collaboration with other organizations such as AIPPI, FICPI etc aiming to clarify /explain/presenting actual experiences.

As it was perceived by some delegations and NGOs as an issue promoted by patent attorneys, there is also a risk that the issue might become politicized due to misconceptions resulting from lack of information. Educational work both in country and in Geneva will therefore be necessary earlier rather than later to clarify any misconceptions.

Selected notes from the discussion:

Among the regional coordinators:

Germany for Group B attached great importance to the issue that it should remain high on the agenda of the SCP, and that harmonization would benefit all stakeholders.

The Czech Republic, for EU and its Member States, supported further work, mentioned EPC 2000 in the context, and welcomed further study which should include feasibility of minimum standards.

Serbia, for the Group of Central European and Baltic States, was in favour of establishing a working group.

Sri Lanka, for the Asian Group, said the report should be more balanced and take into account the impact on patent quality, costs for developing countries, effects on competition, and impact on public policy issues.

China, which forms a “regional group” of its own, said that it fully understands the concerns of many international attorney associations and that today the exercise of patent rights often goes to several countries. It said it was necessary to discuss this issue at SCP meetings. Also to be considered was that that in many countries also patent agents and patent advisors are used, not only patent attorneys. China had revised its law on attorneys; attorneys had a duty of secrecy if the client did not wish disclosure. Exceptions were public security and safety of life.

Among the national delegations:

Argentina considered the issue to be a prerogative in private law and that it should so remain. Reference was also made to the Paris Convention.

Russia was willing to consider minimum standards.

Ukraine was also willing to consider minimum standards.

Korea said it recognized the importance of the issue, that attorney/client privilege is beneficial for developing countries as well as for developed countries, and stressed the importance of participation of patent attorneys in future discussions.

Brazil noted the issue as a rather new issue on the SCP agenda and for members of the Committee, referred to TRIPS Article 1, and looked forward to hearing the contributions of others.

Australia supported Group B and further work, and noted that the Australian Government is considering amendments to its national rules.

Norway also supported Group B and noted that a national scheme was underway: the civil procedures act to be expanded to patent attorneys.

USA noted the several options provided in the study which were not mutually exclusive, that further study was required, and that at a minimum WIPO could prepare a comparative study on different countries.

Iran supported Sri Lanka for the Asian Group and that further study was needed.

Egypt referred to the freedom for countries for their legal system, with reference to the Paris Convention, and noted the study needs further clarification.

Pakistan took up what is the proper forum: WTO? WIPO?

Denmark said it was currently looking at the issue on national level and supported further study.

Japan supported Group B, noted that difference in laws sometimes causes problems, that member states may not have sufficient information, and that a questionnaire was perhaps appropriate.

India supported Sri Lanka for the Asian Group, noted that the study appears to draw heavily on patent attorneys associations, that the public interest should be taken into account, that Paris Convention Article 2 leaves certain aspects to national law, as said in paragraph 16 in the study, that every country should be able to set standards according to its socio-economic status, that the study seems to promote harmonization, that this would leave more information outside the public domain, and supported further study.

Chile considered this to be a very important subject which should be in the international sphere, and that it was important for the Committee to take wide comments.

Of the Intergovernmental Organisations:

the **EPO**, while noting it did not take political standpoint, supported what was said by Germany for Group B and by the Czech Republic for the EU and its Member States.

Of the NGOs:

AIPPI, APAA, ASIPI, ICC, FICPI, GRUR, CIPA/epi, JPAA, and a Canadian organization supported that WIPO should do more work on the issue.

Third World Network raised a number of concerns: the public interest should not be forgotten, the abuse of privilege had not been mentioned, such as a case where the Swedish pharma company Bofors had defrauded a patent office by withholding a prior art reference, and other cases where inventors had not disclosed prior art, the impact needs to be studied further, especially if privilege were to be extended to non-lawyers which was likely to lead to abuse, privilege might be claimed by other professions, like chartered accountants, how would developing countries benefit.
