



Questionnaire regarding cross-border aspects of client/patent attorney privilege

Comment of the Patentanwaltskammer

In dem Rahmen der WIPO wollen die Mitgliedstaaten der Gruppe B+, d.h. die (erweiterte) Gruppe der Industrieländer, die rechtlichen Rahmenbedingungen harmonisieren, mit denen die Vertraulichkeit der Kommunikation zwischen Patentanwälten und Mandanten (so genanntes „Client Patent Attorney Privilege“, CAP) gewährleistet wird. Zur Vorbereitung der weiteren Arbeiten wurde ein Fragebogen erarbeitet, den die Patentanwaltskammer wie folgt gegenüber dem Bundesministerium der Justiz und für Verbraucherschutz beantwortet hat:

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.

The confidentiality of communication between a patent attorney and a client is an important precondition for a trusting and open discussion of all circumstances of a case or a mandate and therefore is indispensable for providing appropriate legal advice. This confidentiality has been established by regulations in procedural law, professional law and criminal law in Germany. According to these regulations, patent attorneys, lawyers as well as members of certain other professions, are bound to secrecy with regard to everything that has come to their knowledge in performing their profession and they have a right to refuse to give evidence. Revealing of a secret of another person, which was confided to a patent attorney in his professional

capacity, is to be punished according to the German Criminal Code.

If such confidentiality and a respective attorney/client privilege is not accepted by authorities or courts in other countries and the client is required or ordered to disclose documents or other information about his communication with his patent attorney, no secrecy can be maintained. This would lead to a very unsatisfactory situation in which by the absence of appropriate regulations for a client/ attorney privilege in one country, the legal provisions in another country are invalidated.

While it is our experience that the legal provisions in Germany are extensive and accordingly a privilege has been accepted for German patent attorneys even by the very strict courts in the United States, it seems nevertheless desirable to provide for internationally harmonized privileges for patent attorneys in a regulated profession according to national standards.

Patent applicants from Germany as well as patent applicants from abroad usually seek a more or less international protection for their inventions. Accordingly, also their business activities are usually not restricted to one or a few countries, but rather have highly international dimensions. A confidential client relationship with an attorney in one country requires that such confidentiality must not be lost if another country becomes relevant due to similar activities and/or if advice by an attorney in such other country is required.

All kinds of communication between a client and attorneys acting on his behalf or advising him should be covered independent of whether this is direct communication between the client and the attorney or whether the communication is effected via an attorney in another country; i.e. confidentiality should not only apply for client to (local) attorney communication but also for client to (local) attorney to (foreign) attorney communication and vice versa.



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

As the professional association for German patent attorneys, the Patentanwaltskammer does not have direct contact with clients of our members. Our members, however, observe major concerns from clients with regard to confidentiality due to negative experience with a lack of an attorney/client privilege in various other countries, and clients as well as attorneys from other countries very often inquire into the applicability of an attorney/client privilege for German patent attorneys.

- 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?

The confidentiality of communication of a German patent attorney with his client is protected by the German legal provisions. Accordingly, no additional measures seem applicable.

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

Professional obligation to secrecy for patent attorneys and lawyers as well as a right to refuse to give evidence are essential minimum elements of a multilateral agreement in order to ensure that the courts in member states to such a multilateral agreements have to accept the attorney/client privilege.

In a multilateral agreement it should be ensured that parallel obligations and privileges apply to patent attorneys and lawyers.

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

None

B. Specific aspects on the proposed multilateral agreement

- 1) What professionals should be covered by the agreement?

Patent attorneys with a qualification according to national regulations and subject to the presence of a regulated professional title in such country should be included in the list of professions for the agreement. These persons should be entitled to the same privileges as lawyers in the respective country.

Further, assistants and persons taking part in the professional activity in preparation for the profession shall also be included as far as a right to refuse to give evidence is concerned.

- 2) What advice should be covered by the agreement?

According to § 39a section 2 of the German Patent Attorneys' Act, a patent attorney shall be bound to secrecy. The obligation includes everything that has come to his or her knowledge in performing the profession. It shall not be applicable to facts which are obvious or need not be kept secret, considering their meaning. Further, a refusal to give evidence should be included (see e.g. § 383 ZPO and § 53 StPO). A similar definition seems desirable for the multilateral agreement and should also cover assistants of patent attorneys and patent attorney trainees.

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

While a multilateral agreement which leaves some discretion to the participating countries might be easier acceptable, we feel that the basic elements of the attorney/client privilege should be set without providing flexibility. Flexibility would again lead to legal uncertainty and would not improve the present situation.

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