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

A. General aspects

1. In your opinion, is there a need to protect communications between IP professionals (nonlawyer/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.

Yes, there is definitely a need to protect communications between IP professionals (in the following: representatives, including patent attorneys and lawyers/attorneys at law) and clients in cases having cross-border aspects. The same rules are to be applied to all types of the above IP professionals since they are acting in this sub-area of law and there is no difference between these professions with regards to the necessity of safeguards of CAP.

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 practising (if applicable)?

The question of CAP arises very frequently in everyday correspondence, especially in each case relating to infringement and clearance opinions. A general policy is to indicate CAP at the beginning of the letters to make (possible future) use of CAP as much as possible.

As we see, cross-border type CAP situations emerge mainly with the USA.

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.

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

Protecting communications between representatives and clients against discoveries in cases having cross-border aspects should be regulated by such a multilateral agreement (see in details in point 2 below).

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

There are no such meritorious reasons.

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?

We think that the approach applied in the Rules of Procedure of the Agreement on a Unified Patent Court (RoP) can be the starting point in this discussion (see Rules 286 and 287). Please note that during the elaboration of the CAP part of the RoP all the national differences were intended to be taken into consideration. The above questions will be touched at the end of our proposal given in point 2 below.

2. What advice should be covered by the agreement?

~~At least all kinds of communication having/touching litigation aspects are to be covered.~~

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

As it was mentioned above, here we would also start from Rule 287 (in combination with Rule 286) of the RoP. However, due to the length of the long compromising procedure resulting in the actual wording of the RoP, the wording of these rules is fairly complicated having sometimes a bit illogical structure. In our following proposal we formulated it into a more concise wording. Moreover, the wording is adapted to the present situation, i.e. it is does not refer to the special legal instruments of the UPC system. So, our proposal reads as follows:

1. The attorney-client privilege prevents the representative instructed in a professional capacity and his client from being questioned or examined about the contents or nature of their communication, accordingly the communication is privileged from disclosure in any proceedings before any Court or Authority, including arbitration or mediation proceedings.

2. The communication of point 1 comprises especially the followings:

- seeking advice by the client from representative, in connection with proceedings before the Court or Authority, including arbitration or mediation proceedings, or otherwise;

- any confidential written or oral communication between the client and the representative**;**

- any work product or record made in connection with the communication**.**

3. This privilege applies also to communication between a client and a representative employed by the client and to communication between representatives employed in the same firm or entity.

4. This privilege extends to further patent attorney, lawyer ***and any other employee*** involved by the representative into the procedure before the Court or Authority, including arbitration or mediation proceedings**.**

[Our note to the highlighted part relating to employees: it broadens the privilege to other employees who are involved into the work. We think that it has a real practical importance. Please note that involvement of employees of the representatives is present in the Hungarian laws relating of lawyers and the same can be found in the law relating patent attorneys.

5. This privilege may be expressly waived by the client.

6. The expressions representative relates to lawyers and patent attorneys with the following definitions:

a) "lawyer" shall mean

- a person who is authorised to pursue professional activities under a title referred to in Article 1 of Directive 98/5/EC and by way of exception a person with equivalent legal professional qualifications who, owing to national rules, is permitted to practice in patent infringement and invalidity litigation but not under such title;

- and any other person who is qualified to practise as a lawyer and to give legal advice under the law of the state where he practises and who is professionally instructed to give such advice;

b) the expression "patent attorney" shall mean

- a person who is recognised as eligible to give advice under the law of the state where he practises 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.

- a professional representative before the European Patent Office pursuant to Article 134 European Patent Convention.

The above wording is relatively clear and overtakes the problems coming from the different terminology in different jurisdictions.

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

If possible, not. Equal treatment would be advisable.