



21 August 2020

epi Comments on the Draft proposal for a multilateral agreement on cross-border aspects of client/patent attorney privilege (CAP) (version of February 2020)

About epi

The Institute of Professional Representatives before the European Patent Office (**epi**) is the professional body representing all European Patent Attorneys. Currently the Institute has about 12,600 European Patent Attorneys as members coming from each of the 38 Contracting States of the European Patent Convention who work either in industry or in private practice. European Patent Attorneys help their clients and employers, which include international big corporations, SMEs and private inventors, to create value out of their inventive ideas, thus providing jobs and strengthening the local economy.

epi as an organisation deals primarily with the development and implications of patent law. **epi** is at the forefront of patent law developments and regularly serves public policy leaders by issuing legal opinions and highly specialised advice.

Opening remarks

epi welcomes the initiative of a draft multilateral agreement on cross-border aspects of client/patent attorney privilege (CAP) presented by the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK. We recognise the importance of a harmonised minimum standard of protection against disclosure of confidential communication related to IP advice. **epi** appreciates the opportunity to provide comments on the draft agreement.

We would like to propose the following amendments to the draft agreement text. It would be appreciated if these suggestions could be considered in the next Group B+ meeting.

With the current wording of the definition of “patent advisor”, we are concerned that qualifications under regional/international regimes, such as the European Patent Convention (this may also apply to other regional qualifications e.g. under the Eurasian Patent Convention), could be regarded not to be covered by the proposed text. We would like to draw your attention to the fact that the European Patent Convention includes an Attorney-client evidentiary privilege (see R. 153 EPC), which in our firm view should be covered by any envisaged international instrument on a Client/Patent Attorney Privilege. European Patent Attorneys are responsible for a large part of



patent advice globally and an international agreement on CAP should not exclude communication between these professionals and their clients. We think that our proposed wording would address this issue.

We also note that the term “Nation” as used in Art 5 and Art 6 of the draft text is not defined in the definition. When considering to include a definition of Nations, we would suggest to clarify that also international/regional organisations, such as the European Patent Organisation, could be included in the definition of the term “Nation”.

For purposes of better reading and to emphasise the limits of the privilege with regard to raw data and statements of mere facts, we suggest to dedicate a separate Article on raw data and mere facts instead of including this in the definitions of Art 1.

In Art 2, we propose to include the term “privileged” with the wording “confidential and [...] protected from any disclosure to third parties” as a definition. We believe that privilege should be mentioned explicitly since it is the subject matter of the proposed multilateral agreement.

We have suggested a few more small changes for editorial reasons or for the sake of consistency.

We thank you for this opportunity to comment on the draft and are looking forward to further steps and occasions to assist you towards a more harmonised approach to secure a Client/Patent Attorney privilege across jurisdictions.

Article 1

In this Agreement,

'**patent advisor**' means ~~an advisor~~ person who is authorised to act before a competent administrative or judicial authority in a jurisdiction of a signatory State or to which a signatory State participates, and officially certified to provide professional privileged advice concerning patents. The criteria of qualification and the categories of certification are defined by national and international law.

'**communication**' includes any oral, written, or electronic record.



'**professional advice**' means advice given on patent law within the patent advisor's area of expertise, as defined by the national or international law that stipulates the professional qualifications, whether it is transmitted to another person or not.

"**advice**" means the subjective or analytic views and opinions of the patent advisor. ~~Raw data and mere facts are not privileged in and of themselves unless:~~

~~o they are communicated with the "dominant purpose" of seeking or giving advice; or~~

~~o they are contained in a document containing privileged information and they are related or connected to the privileged information and have been communicated with the "dominant purpose" of seeking or giving advice.~~

Article 2

A communication made for the dominant purpose of a patent advisor providing professional advice to a client or or any other person having requested professional advice, shall be privileged, i.e. it shall be confidential and shall be protected from any disclosure to third parties, unless it is or has been disclosed with the authority of that client or other person having requested professional advice.

Article 3

This Agreement applies to communications between a patent advisor and his client or any other person having requested professional advice regardless of the territory of the signatory State in or on behalf of, which the patent advisor is officially recognised and certified, and regardless of the territory of the signatory State in which the communications take place.

Article 4

Raw data and mere facts are not privileged in and of themselves unless:

o they are communicated with the "dominant purpose" of seeking or giving advice; or

o they are contained in a document containing privileged information and they are related or connected to the privileged information and have been communicated with the "dominant purpose" of seeking or giving advice.



Article 5

In case a document containing privileged and not privileged information has to be disclosed, the privileged information must be blacked out.

Article 56

Nothing prevents Nations from extending unilaterally or on the basis of reciprocity the scope and effect of this Agreement on their territory to other areas of intellectual property law and to advisors other than those defined in Article 1.

Article 67

Nations may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in Article 2, including specific requirements which a patent advisor must meet in order for Article 2 to apply to them, provided that such requirements, limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of Article 2 having due regard to the recitals to this Agreement.