



Privilege and the IP Professional

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Would privilege apply?

Consider this scenario:

- ◆ A client advises patent attorney that a competitor has released a product which infringes client's patents in Australia and overseas;
- ◆ The client asks patent attorney to provide advice as to whether product would be considered to infringe patents in AU, US and UK;
- ◆ The patent attorney and foreign patent attorneys (only some of whom are lawyers) need to communicate to obtain infringement advice and to discuss possible strategies

What risk is there that any of these communications would have to be disclosed in any subsequent legal action?





Aims of the Session

- ◆ Provide an understanding of privilege as it applies to IP professionals
- ◆ Outline limitations in the scope of the privilege
- ◆ Provide some practical steps to help minimise the impact of those limitations





What is privilege?

- ◆ A privilege is a right to withhold evidence from a court which would otherwise be required for the determination of issues in proceedings before it
- ◆ Involves weighing public policy considerations
 - Reliable fact finding/ensuring fair trial
 - Countervailing public policy





Rationale

Three broad rationales for professional privileges:

- ◆ Effective and appropriate advice for client
- ◆ Removing personal hardship for advisor
- ◆ Sustaining key institutions in society





Client Legal Privilege

- ◆ *'[L]egal professional privilege is a rule of substantive law which may be availed of by a person to resist the giving of information or the production of documents which would reveal communications between a client and his or her lawyer made for the dominant purpose of giving or obtaining legal advice or the provision of legal services, including representation in legal proceedings....'*
- ◆ Two limbs of privilege: "Advice" and "Litigation" privilege





Privilege and the Patent Attorney

A statutory privilege:

'A communication between a **registered patent attorney** and the attorney's client in **intellectual property matters**, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client':

Patents Act 1990 (Cth) s 200(2)





Privilege and the Trade Marks Attorney

A statutory privilege:

'A communication between a **registered trade marks attorney** and the attorney's client in **intellectual property matters**, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client':

Trade Marks Act 1995 (Cth) s. 229(1)





Scope of the Privileges

- ◆ Privilege protects communications
- ◆ Three classes of communicants at the borders of attorney privilege:
 - Foreign IP professionals
 - Third parties
 - In-house practitioners





Privilege and Foreign IP Professionals

- ◆ IP Lawyers
 - Privilege may apply
- ◆ Patent and trade marks attorneys
 - Privilege not likely to apply to communications with foreign patent attorneys as privilege requires registration of foreign attorney





Privilege and Third Parties

- ◆ IP Lawyers
 - Agents – privilege can apply
 - Non-agents – privilege can apply
- ◆ Patent and trade marks attorneys
 - Communications with either agents or non-agents may not be privileged





Privilege and In-house Practitioners

◆ IP Lawyers

- Privilege can apply as long as advice given is legal advice and the lawyer is sufficiently independent

◆ Patent and trade marks attorneys

- Privilege can apply as long as advice given is patent advice, the attorney is sufficiently independent and the attorney is registered

