



Privilege and the IP Professional

Practical Implications

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Practical Implications

- Scenario 1:
 - Client advises patent attorney that competitor has released a product which infringes client's patents in Australia and overseas
 - Client asks patent attorney to provide advice as to whether product would be considered to infringe patents in AU, US and UK
 - Patent attorney and foreign patent attorneys/agents (only some of whom are lawyers) need to communicate to obtain infringement advice and to discuss possible amendment strategy.



...but what can I do now?

- **Action:**

- Consider engaging law firm arm of Australian patent firm (or Australian law firm) to retain foreign patent firms in countries where patent attorneys are not lawyers.
 - Client may engage Australian patent firm to retain foreign patent firms, but uncertainty exists regarding application of statutory privilege in agency situation. [cf s200(2) PA]
- Client should avoid corresponding directly with foreign patent firms (where foreign IP practitioners are not also lawyers) if privilege is to be retained in Australia.



Practical Implications

- Scenario 2:
 - Foreign company (client) instructs foreign patent firm to instruct Australian patent firm to oppose grant of patent to competitor.



...but what can I do now?

- **Action:**

- Australian patent firm passes instructions to Australian law firm.
- Law firm sets up telephone conference with all parties to discuss structure of client, litigation status, objectives etc. It is revealed that:
 - opposition is part of global litigation program to clear way for sale of important product;
 - client is concerned about infringing a patent granted on the application to be opposed; and
 - evidence has been prepared in connection with overseas litigation and client would want to be sure that Australian evidence is not inconsistent with that evidence.





...but what can I do now?

- Agree that:
 - opposition will be filed by law firm on behalf of client;
 - opposition deadlines will be monitored by Australian patent firm;
 - evidence from Australian expert will be gathered by law firm (i.e. communications to Australian expert will be from law firm);
 - law firm will correspond directly with client (or through foreign patent firm as agent for client) in relation to evidence gathering, strategy, prospects of success etc.;





...but what can I do now?

- Australian patent firm will assist law firm in developing strategy and gathering evidence, but avoid giving written advice to law firm or client unless requested;
- any review of evidence of Australian expert by foreign expert will be at request of law firm or client;
- communications with foreign expert will be with client or law firm, possibly through agency of foreign patent firm;
- alternatively communications with foreign expert (after being sent evidence for review) could be conducted orally; and
- where Australian or foreign patent firm is acting as agent (for client or law firm) in respect of communication, that patent firm should not supplement the advice or the instructions.



Practical Implications

- Scenario 3:
 - Client instructs Australian patent attorney to prepare provisional patent application with a view to filing an international patent application in 12 months time.





...but what can I do now?

- **Action:**

- Be practical! Unless client provides information that suggests that the invention is very likely to be embroiled in litigation, do not involve a law firm in preparation and filing of provisional or PCT application
- Be aware that your communications with the client regarding patentability, potential problems to be encountered during prosecution etc may not attract privilege in some jurisdictions, such as the UK





Practical Action

- Mark communications confidential and privileged (or prepared in anticipation of litigation).
- Split up legal and non-legal issues to support dominant purpose test for legal communication or document.
- Avoid putting negative advice in writing where possible.





Practical Action

- When taking instructions in relation to a contentious matter:
 - Ascertain
 - the identity and structure of the client (e.g. relationships between instructor, owner of IP, parent company, subsidiaries etc.); and
 - whether there is any litigation in progress or anticipated.
 - Agree on a chain of communication which
 - minimises intermediate parties between adviser and client; and
 - maintains agency relationship of any intermediate parties e.g. by appropriately addressing and handling correspondence.
 - Consider involving a lawyer or law firm to attract client-lawyer privilege.
 - Be alert, not alarmed.....and don't overreact!



Practical Action

- Take care not to inadvertently waive privilege.
 - Take care with distribution and handling of communications.
 - Do not refer to contents of privileged communications e.g. Letter of Demand: “We have been advised by Senior Counsel that...”.
 - Train patent attorneys/technical assistants.
 - Increase client awareness.



Questions?





THANK YOU

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