

Protection of Intellectual Property (IP) Professional Advice (the protection) from Forcible Disclosure

**Perspective and history of the development of the
protection conducted by and on behalf of the
International Association for the Protection of Intellectual
Property (AIPPI) and AIPPI-Australia (AIPPI-A) from 2003
to 2019 (the privilege project or the project).**

BY

Michael Dowling

IP Lawyer

Executive President of AIPPI – 1998 to 2001

Vice President of AIPPI – 1995 - 1998

Member of Honour of AIPPI since 2001

**Chairman of AIPPI's Committee Q199 on Client Attorney Privilege – 2007
to 2010**

Co-Chairman of Q199 – 2010 to 2016

Consultant to Q199 – 2016 to 2019

Life Member of AIPPI-A since 2015

**Past Chairman of the Intellectual Property Committee (IPC) in the
Business Law Section of the Law Council of Australia (LCA) - 1984 and
1985. Member of IPC – 1983 to 2007.**

Partner, Whiting & Byrne, Lawyers – 1973 to 1982

Partner, Allens Arthur Robinson, Lawyers – 1982 to 2007

Consultant, Allens, Lawyers – 2007 to 2015

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Prelude

This History of the project was partly inspired by a comment made in May 2018 to the author by his friend and IP colleague, Emeritus Professor Sam Ricketson AM, then of Melbourne University. Sam said that the process of the project was hard to define and documents created in the project, were hard to locate. In fact, many (but not all) of those documents are published on either the AIPPI or WIPO (World Intellectual Property Organization) websites. However, those websites (particularly AIPPI's) are not easy to navigate for those not actively working in AIPPI or WIPO.

This History as now updated mainly relates to the 17 years from 1 January 2003 to 31 December 2019. It republishes most of the relevant AIPPI and WIPO documents and provides links to the websites mentioned, including in the List of Attachments in Annex 1. The History also describes those and other documents in the context in which they arose. Much of the History relates to global activities both in relation to AIPPI and WIPO. It is written from an Australian perspective which is not inappropriate because it has Australian origins and involvement. Except as otherwise specified, the Attachments are the works of the author.

To navigate between the History and its Attachments, open the History, then click an Attachment link eg say **Attachment 1**. This opens the respective Attachment in a new tab. When you are finished, close the tab to go back to the History document. You can also access each Attachment as listed in Annex 1 via its number (numeral) in that Annex.

In relating this History, except in headings, it is efficient to refer to names by acronyms or abbreviations. Acronyms of major bodies like AIPPI and WIPO are familiar to those in the world of IP. However, those and all acronyms or abbreviations used, are described where they first occur in the text. There is an alphabetical list of the acronyms/abbreviations used in Annex 2. There is a chronology of main events in Annex 3. There are further acknowledgements in Annex 4.

1 Privilege Project – Introduction and Achievements

- 1.1 This Introduction (Section 1) sets the scene of the history. Further detail of matters related in this Introduction and other matters follow this Section 1.

The problem

- 1.2 What was 'the problem'?

The issues which the project addressed from the start include –

- the lack of the protection in some countries,
- inadequacies in the protection in most countries,
- and where the protection existed to some extent, the loss of that protection or failure to apply it to IP legal advice which had been transmitted cross-border.

The last point has three aspects. The 'loss' or 'failure' could occur in the country from which the advice originated. They could occur in the cross-border country. Or, both those negative effects could occur.

- 1.3 The problem became a stark reality in the period between about 1998 and 2004. There was litigation in that period in which decisions in three common law countries, forced disclosure of non-lawyer IP professional legal advice. Those countries (common law) were - Australia (AU), Canada (CA) and the USA (US). The clients who came off badly by being forced to disclose their legal advice were in civil law countries – France (FR) and Japan (JP).
- 1.4 In common law procedure, the protection is called 'privilege'. In common law countries, non-disclosure of IP professional advice is a 'privilege' because it is an exception to the usual rule that all documents relevant in legal proceedings are to be discovered by the one party to the other. Thus, but for the 'privilege' of non-discovery, the relevant legal advice would have to be discovered. Importantly, privilege is the right of the client not to have to disclose the client's legal advice. However, there is an exception. Privilege in common law does not prevent forcible disclosure of legal advice implicated in fraud or other crime raised in the case.
- 1.5 In civil law procedure, there is no discovery. There is a power inherent in civil law legal process for a judge or tribunal to call for disclosure of specific documents relevant to the case. However, civil law lawyers say that that would not be likely to occur in practice in relation to legal advice unless the advice was implicated in the case – as would be the case in a claim of fraud against the adviser. That position in civil law is very like what applies in common law. Further, in civil law, the IP professional is subject to professional secrecy, the breach of which is a crime. Professional secrecy is an absolute obligation of the professional. Nothing which is communicated between the professional and the client, can be disclosed. That is way wider than common law privilege. That privilege applies only to communications relating to legal advice.
- 1.6 The cross-border aspect of the problem is caused by national law which does not recognise and apply the protection to overseas IP professional legal advice for some reason – like, the overseas IP professionals do not qualify for the protection under the national law. For example, that would be the case if that law did not apply to the clients of those professionals. That is, either the overseas professionals do not have the qualifications which are prescribed by the national law or the national law does not apply to anyone except the client of a national IP professional.
- 1.7 Whilst the form of the protection is called 'privilege' in common law countries, the word 'privilege' when used in civil law countries, does not mean the same thing. When used in those countries, the 'privilege' of non-disclosure of legal advice applies to the professional who has given the advice, not the client. Not all civil law countries have this 'privilege'. The client in civil law countries is not compellable to give evidence anyway and so does not need privilege to avoid being forced to disclose legal advice.
- 1.8 Thus, when dealing with the legal devices applied to prevent forcible disclosure of legal advice in a global context, the term 'the protection' is appropriate because it applies to the outcome (ie no

forcible disclosure) whichever of the two systems of law is involved. The term 'privilege' means something different depending upon which system of law is involved.

1.9 The problem to which this History relates (lack of the protection or inadequacies in some countries, and loss of the protection cross-border), arose or became more acute, for reasons including the following.

- In the case of lawyer/client relationships, most countries have provided the protection for more than 50 years. In some cases, it has been for centuries.
- The rising importance of IP in relation to international trade meant that IP was increasingly owned cross-border by the same or related entities.
- Such owners are bound to assert and defend their intellectual property rights (IPRs), internationally. In doing that, they frequently have to transmit their advice cross-border to inform their advisers and check the correctness of the advice they obtain from one country to the next.
- That advice is bound to reflect differences between the law in the one country and the next and in comparing such advice, one can find good reason for the differences, as well as detect errors in it.
- The transfer of legal advice cross-border invokes the need for the protection to apply cross-border. The law relating to the protection differs from one country to the next.
- A difficult word in this context is 'attorney'. The protection applies to attorneys who are lawyers. The trouble is that there are 'attorneys' who are not lawyers. Leaving aside patent and trade marks attorneys who are lawyers, with the rise and rise of technology over the past 100 years, came the development of IP professional advisers who are not lawyers, who are called 'patent attorneys' or 'patent agents' and the same for trade marks.
- The patent persons had to have scientific qualifications. Both the patent and trade marks persons had to have qualifications in the law relating to patents and trade marks respectively. It was not necessary for them to have the broad learning in law which applies to qualified lawyers. However, they had to give legal advice in relation to IP law as would be required to achieve their functions of registering patents for inventions, registering trade marks, and advising on all manner of issues relating to IPRs with which they deal.
- Whilst the protection was well established for lawyers, curiously it was not generally applied to non-lawyer patent and trade marks attorneys and agents. Where it has been so applied (as it has been in Australia, for example), it has often not been applied as broadly as it applies to lawyers. That was the position in Australia when the project started.
- The sharing of legal advice cross-border has thus been fraught with the risk that the advice to which the protection applies in the country of its origin, will be

passed into the hands of an overseas IP professional to whom the protection either does not apply, or not as adequately as it does for lawyers.

- In this process, in some cases the protection has been lost and the legal advice has become subject to forced disclosure both in the country to which it has been transmitted and consequently, in the country of its origin.

- 1.10 The foregoing provides an outline of the problem. It is by no means an exhaustive description. It suffices however, to set the scene for dealing with the History generally subject to the following point. Some further comments about why the protection exists, are needed.
- 1.11 As will be described in more detail below, the protection exists to serve public and private interests which (as the reader will see) have been described in various ways in the legal literature. The public interest most frequently cited as to common law is the need for the client to be advised correctly. That need is so obvious that there is no need for further explanation of it. In the civil law, the protection has been said to be in aid of the administration of justice. Well, that is a fairly broad category. On its face, it would include the need for the client to be advised correctly.
- 1.12 The protection in common law (as explained in the legal literature) is applied to encourage full and frank communications between the client and the professional adviser. That concept also falls within the civil law category – in aid of the administration of justice.
- 1.13 It is fair to ask whether the protection is effective in getting such full and frank communications. Each case depends upon its own circumstances – like, the quality of comprehension of the advice by the client and the relative skill of the adviser. But overall, IP professionals assume that it is an advantage that the protection applies in aid of getting full and frank communications, knowing that it is better for client and professional to know correctly what the facts are and how the law applies to them.
- 1.14 One feature which has been picked up by the US Supreme Court and which is frequently cited as correct is that the protection does not work if it is uncertain whether it applies. Lack of certainty cannot support full and frank communications. This is the way it was expressed by Justice William Rehnquist of the said court in *Upjohn Co v United States*, 449 US 383 (1981) –
- If the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.
- 1.15 Having touched on the subject in the context of the two systems of law, common law and civil law, one needs at this point to expand on their differences in relation to the protection. Their different histories are dealt with in detail later in **Attachment 35**. That is, in Sections 2 and 3 of the submissions by AIPPI to WIPO on its Preliminary Study SCP/13/4 dated 31 August 2009.
- 1.16 The protection in the common law is effected by 'privilege' applied to clients' legal advice to prevent it being forcibly disclosed in litigation. As previously mentioned, the privilege applies to the client. The IP professional who gives the advice is subject to an obligation of confidentiality

not to disclose the advice to anyone. Further, that person is subject to rules of professional conduct which prohibit disclosure.

- 1.17 Inherent in the common law approach is the obligation in litigation to disclose to the opponent and the court, all documents that relate to the dispute – the process called 'discovery'. There is no discovery in civil law procedure and so, there is no need for privilege that applies in common law. What provides the protection in civil law, beyond 'no discovery'? That is professional secrecy which has criminal sanctions for breach.
- 1.18 So, AU being a common law country, has privilege. FR has civil law and thus, professional secrecy. In both countries, legal advice is protected from forcible disclosure. In effect, all legal advice is in both cases, confidential to the client unless the client waives that.
- 1.19 But what would have happened in AU (prior to a change in our law in 2013) if the AU advice by a lawyer or a non-lawyer patent attorney, was transmitted to a non-lawyer patent attorney in FR? That made the advice subject to discovery in AU because the advice was thereby put in the hands of a professional to whom privilege under our law did not apply. Our law meant that the privilege it applied to the client was limited to patent attorneys registered in AU. This provides an example of the cross-border aspect of the problem.
- 1.20 What would have happened in reverse pre 2013, that is if the advice of a non-lawyer patent attorney in FR was sent to AU? Again, no protection applied to that advice then in AU because privilege only applied to the advice of patent attorneys registered in AU. For the same reason, it would be no better if the advice had been sent to a non-lawyer patent attorney in say the UK (a common law country). The client of the non-lawyer professional was not covered there!
- 1.21 How would AU non-lawyer patent attorney advice be treated if transmitted to the UK? It would be discoverable there. What about to FR? Not discoverable there because basically, there is no discovery. There is however the exception which is described by civil lawyers as being unlikely to be used. That is the power of a civil court judge to call for any document which the parties in dispute may have, to be produced.
- 1.22 A remedy for the AU problem in the UK, would involve AU and the UK expanding the scope of privilege in their countries to include each other's non-lawyer patent attorneys in their privilege regimes. As to FR, in view of the power of the court in FR to require production of documents, it would need to be agreed that AU advice was not to be forcibly disclosed.
- 1.23 Of course, AU and the UK could unilaterally make their protection cover the clients of each other's professionals. However, there were more problems to solve than as between those two countries. If the target is to improve the protection overall, that would involve more common law and civil law countries – a complex issue requiring cooperation through an international agreement. There are about 40 common law countries in the world.
- 1.24 For the purposes of this history, the foregoing description introduces what the author, AIPPI and the Australian government decided to pursue, that is, to make the local law more adequate in

itself including by extending the local protection to advice obtained from IP professionals overseas. The next requirement was an international agreement to get the protection made adequate overseas. There are, of course, other possibilities but as this is a history, they are academic.

- 1.25 The main reason for choosing an international agreement (be it a 'treaty' or 'a multilateral agreement' (**MLA**)) as an add-on to laws in AU being made adequate, was to obtain certainty as to the application of the protection internationally.
- 1.26 Another approach that was later suggested in WIPO in aid of harmonising laws between nations, is called 'soft law'. The so-called 'soft law' approach to solving the problem (it was given an 'airing' in WIPO in the work of its Standing Committee on the Law of Patents (**SCP**) and is described further below), does not provide the certainty which is fundamental if the protection is to work. Nobody can reasonably engage in full and frank communications as an adviser or advisee, unless they know that the protection applies with certainty.
- 1.27 Having said that, as the reader will pick up later, AIPPI would have to confess to having 'flirted' with the concept of 'soft law' itself. Where that occurred however (it was in WIPO), it was thought at the time that the project might come to a halt if AIPPI did not go along with 'soft law' being evaluated. It was thought (perhaps quixotically) that discussing 'soft law' might keep the door open to further discussions in which the doubters would be persuaded as to what is really required – that is, certainty that the protection applies.

The task involved in the project

- 1.28 This History relates to efforts by AIPPI and AIPPI-A in cooperation with, and assisted by other intellectual propriety non-government organisations (**IP NGOs**), to influence developing the law relating to the protection.
- 1.29 From the outset (in 2003), the law needed to be changed nationally and internationally. There were many reasons for this need some of which have already emerged. Another reason needs to be stated now. Every day in common law legal practice, there are huge largely hidden costs incurred by clients involved in their IP professionals evaluating the obligation of disclosure and the risk that the protection will not apply to communications in the particular case. Thousands of IP practitioners around the world give IP legal advice every day which is commercially sensitive to the client.
- 1.30 The hidden costs referred to above are incurred by the IP advisers having to advise in a veritable minefield of possibilities that the advice to be given could be forcibly disclosed. That fact is negative to having full and frank communications between the client and legal adviser. That in turn runs counter to the public interests which the protection is intended to support. Where there is lack of certainty, that makes it certain that the hidden costs are incurred and that the public interests for which the protection exists in the first place, are not supported.

- 1.31 Achieving improvements in the protection faced obstacles and headwinds both nationally and internationally. Efforts to improve law nationally and internationally involved numerous and diverse people and organisations. To persuade them, required winning their involvement, cooperation and collaboration.
- 1.32 The 'Prelude' to this History, refers to it being from an Australian perspective. There is no need to be coy about that. The project was an Australian concept. It was initiated in AU by the author in 2003. It was most fortunate that Dr Francis Gurry (another Australian), was part of its beginning as further described in 9.10 below. Francis was then (in 2003) a Deputy Director General of WIPO. He is now and has been since 2008, the Director General of WIPO. The vision of the author and of Francis for the project went beyond studying the problem, to how it could be resolved internationally. The author was also focussed on improving the law in AU, including by that process, to put AU in a position to lead or join in the leadership of the Member States of WIPO, or some of them, to achieve improvements in the law on the protection both in other countries, and internationally. Francis accepted the project as one worthy for the Member States of WIPO to pursue for study in the SCP where there were issues, at the time, on agreeing what its agenda should be.
- 1.33 If US courts had had better information about the protection in FR and JP in its form and effect which it had had for at least a century before 2000, a diligent reader might question whether the project would have been needed. The 1999 US case – *Bristol-Myers Squibb Company v Rhone-Poulenc Rorer Inc* 95 Civ 8833 – 188 FRD 189, *191; US Dist. Lexis 5950, **6; 52 US PQ2D (BNA) 1897 – exemplifies the cause of the alarm which occurred in civil law countries like FR and JP, that the legal advice of their non-lawyer attorneys could be forcibly disclosed in US proceedings. The US District Court concluded that the submissions for Rhone-Poulenc did not establish that industrial property counsel in FR (civil law), would have an 'evidentiary privilege' comparable to that afforded to attorneys in the US (common law). Thus, the documents in issue were required to be disclosed.
- 1.34 The 'better information' would have been that documents being sought for disclosure were in fact protected from forcible disclosure in FR. The mistake, if it was one, was to ask whether the documents were subject to privilege in FR. Of course, they were not. That is because in a civil law country there is no discovery. Thus, it is not necessary to have something equivalent to common law privilege for the documents to be (as they were), protected in FR from forcible disclosure.
- 1.35 It was not right in the process of analysis to look for the protection on the basis of the question - 'Can evidentiary privilege comparable to that afforded to attorneys be found?' The real issue is whether the protection applies. The problem was that the one country (being a common law country) did not recognise the protection from disclosure which applied to the client and the professional in the other country (a civil law country). That protection came about in effect by the combination of no right of discovery against either the professional or the client and the

prohibition of the professional from disclosing communications with the client under the law of professional secrecy which applies in civil law countries.

- 1.36 To achieve harmony in this context between one country and another, the one needs to recognise the protection which exists in the other if it achieves in the circumstances of the other, the same effect that is achieved in first country. If no disclosure of IP legal professional advice is the effect, that should in itself be enough. In pursuing harmony, one goal we had was to have all countries involved in the debate accept that if non-disclosure of IP legal professional advice applied in another country, that should be supported in their country.

The process of the project

- 1.37 The start-up and early management of the project can be summarised as follows. The detail will emerge in the rest of the History, as related below.

- AIPPI started the process based on its research into the protection carried out in 2002/2003. That research was done by one of its working committees (Q 163) which had identified the problem in the period mentioned above.
- In 2004, Francis Gurry who was then (in 2004) a Deputy Director General of WIPO, took up interest in the project at a meeting with AIPPI in Melbourne.
- In Australia, AIPPI-A, the Law Council of Australia (LCA) through its Intellectual Property Committee (IPC), and other Australian IP NGOs - IPTA (Institute of Patents & Trade Marks Attorneys), FICPI-A (The Australian Chapter of the International Federation of Intellectual Property Attorneys) became engaged in the project. They were pursuing two objectives – **first** amending the Australian law and **secondly**, achieving international changes of law.
- The Australian government was brought into the process by AIPPI-A, and IPC, and the leaders of IPTA and FICPI-A. There were two government departments involved in this process – IP Australia (IPA) and the Attorney General's Department (AGs).
- Urged on by the author and assisted by then incoming President of AIPPI, Ron Myrick, in 2007, AIPPI formed a Standing Committee (Q199 – Client Attorney Privilege) to deal with the problem. The author was appointed as the first Chairman of Q199.
- With the assistance of the international IP NGOs – namely AIPPI, FICPI, and APAA (the Asian Patent Attorneys Association), there was further encouragement to WIPO to study the problem and potential remedies for the problem. WIPO thus became engaged in the process on the basis of the Australian initiative from 2004. That was widened to the Member States of WIPO (virtually all nations) by WIPO and AIPPI in 2007/2008, by their involvement in the WIPO/AIPPI Conference on Privilege which was held in Geneva in May 2008.

- The studies in WIPO which followed that Conference are now for the main part concluded. An international agreement to solve cross-border aspects of the problem, awaits resolution. The governments of some of the developed countries (called in WIPO 'Group B+' (**GB+**) countries) have engaged in the process through the efforts of AIPPI, AIPLA (the American Intellectual Property Law Association) and FICPI, of negotiating an international agreement.

THE ACHIEVEMENTS OF AIPPI (Q199) AND AIPPI-A - what has been achieved in relation to the problem and the protection, by their efforts?

1.38 The following paragraph provides an overview. The History beyond the following paragraph provides more detail of AIPPI's achievements. The first steps in the process were the identification of the need to take action and subsequently, the mobilisation of all parties affected or required to be involved in order to achieve change – WIPO, IP NGOs, and governments around the world.

1.39 The overview of the achievements of AIPPI, follows.

- Through the Intellectual Property Committee (**IPC**), the Law Council of Australia (**LCA**), the Institute of Patent & Trade Marks Attorneys (**IPTA**), AIPPI-A and other Australian branches of international IP NGOs (described in Sections 9, 11, 21, 28, 37, 41 and 50 below), the negotiations with, the guidance to and support of the Australian government in effecting improvements in the protection by amending the Australian Patent and Trade Marks Acts, over the period from 2008 to 2013.
- These amendments put the protection as it applies to the clients of non-lawyer patent and trade marks attorneys on a footing equivalent (as nearly as possible) to that which applies to clients of lawyers.
- Internationally (as led by the Australian initiative, in particular, through WIPO and AIPPI), the laws of the following countries have been amended to improve the protection of confidentiality of the legal advice of IP professionals particularly (but not only) to improve the prospect that such advice will not be forcibly disclosed cross-border.

Australia, Belgium (BE), Canada, Denmark (DK), Spain (ES), Sweden (SE), Switzerland (CH), Netherlands (NL), United Kingdom (UK) and United States of America (US)

- As to the UK, the amendment by statute extended the protection to communications between UK and EU agents and their clients. That is a good start – the wider cross-border issue remains to be resolved.
- As to CA a reservation is required. The amendments do not make certain the extension of the protection to the clients of civil law non-lawyer patent and trade marks attorneys.

- In the US, the change which has occurred involves the rules and the practice of an important tribunal and of the practice in the courts. The United States Patent and Trademark Office (USPTO) has extended the protection to patent owners and patent agents in the US in relation to proceedings in the USPTO, and to their equivalents overseas where the communications are protected overseas. The US courts have reversed the previous practice of not recognising professional secrecy in the civil law context (no discovery) as being equivalent in effect to privilege in the common law. Thus, professional secrecy in civil law applied to non-lawyer patent agents, as well as lawyer patent attorneys, is accepted as having the same outcome as for common law privilege ie no forcible disclosure of IP professional legal advice.
- Internationally (as initiated by the AIPLA, FICPI and AIPPI), the GB+ countries in WIPO (developed countries) have been negotiating for 6 years (2014 to 2019), an international agreement requiring minimum standards of protection for the legal advice of IP professionals, from being forcibly disclosed cross-border. That initiative was led by CH. As well as CH, at its outset, it directly involved the following countries as the then 'Core Group' of the GB+ countries.

Denmark, France, Republic of Korea, Japan, Sweden, United Kingdom and United States of America.

- The form and basis for the international agreement referred to in the previous point, were first proposed by AIPPI-A to the Australian government and WIPO in 2005. The draft agreement proposed then was first developed within AIPPI and then by AIPPI and other IP NGOs, and then by the GB+ countries.
- The engagement of common law and civil law IP professionals in working with their governments around the world to improve the protection. This was obtained through the initiatives of AIPPI, and other IP NGOs, and with the assistance of WIPO. An important factor in achieving that engagement (and a substantial achievement in its own right) was the organisation and holding of the WIPO/AIPPI Conference on Privilege held at WIPO in Geneva in May 2008. That included the organisation of the speakers for that conference by AIPPI. Those speakers were citizens of, and represented, the following countries.

Australia, Canada, Chile (CL), Denmark, France, Germany (DE), India (IN), Japan (JP), Malaysia (MY), Switzerland, United Kingdom and United States of America.

- AIPPI proposed and managed the scope and detail of the topics and the issues with which the speakers had to deal. The WIPO/AIPPI Conference above was a prelude to and provided data on the protection which was useful for WIPO's subsequent pursuit of studying the protection in more than 15 meetings of its SCP. The Conference was also a catalyst for subsequent efforts by WIPO and AIPPI on the protection, generally, The

papers delivered at the Conference are published on the WIPO website (the details of which are provided below in paragraph 9.44).

- Since the WIPO/AIPPI Conference on Privilege, WIPO has published many Reports on the protection, as its research and debates in the SCP on the protection, built up. The Reports are obtainable by this link -
<https://www.wipo.int/patents/en/topics/confidentiality.html>
WIPO has established and maintains a national laws resource relating to the protection – see https://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html.
- AIPPI contributed to the generation of many of the WIPO Reports referred to above by its written Submissions to WIPO and its oral submissions in meetings of WIPO's SCP from SCP 13 to SCP 17 and SCP 20. AIPPI Q199 was represented by the author at each of those seven meetings of the SCP in Geneva.
- The Colloquium on the protection which was held in Paris in June 2013. This Colloquium involved IP experts, government representatives and representatives of AIPPI, AIPLA and FICPI – more than 100 persons attended. The organising committee was led by Danny Huntington of FICPI. AIPPI proposed and managed many of the speakers. WIPO was represented at the meetings. The governments of AU, DE, JP and CH each provided a speaker. There were also speakers from, or attendances by, IP professionals from each of the following countries –

Australia, Canada, Denmark, France, Germany, India, Japan, Netherlands, United Kingdom and United States and America.

The Colloquium was also addressed by Professor John Cross of the University of Louisville, Judge Susan Braden of the US Court of Appeals – Federal Circuit, and Ms Fatima Beattie, then Commissioner of Patents, Australia. AIPPI had the role of setting the legal background on the protection at the Colloquium ie. introducing the topics and issues to be dealt with. The PRIMER which AIPPI produced for this purpose is **Attachment 95** to this history. The author wrote and presented the PRIMER for AIPPI at the Colloquium in Paris.

- The Colloquium was a catalyst for the negotiation by GB+ countries under the leadership of CH, of an international agreement for minimum standards of protection of IP professional advice from forcible disclosure, as previously mentioned.
- What should in one sense be stated first among achievements of AIPPI, but is better said at this point because of the context it has in relation to the other (foregoing) achievements, is – the convocation by AIPPI of WIPO, governments of its Member States, the IP NGOs, individual IP lawyers and non-lawyer specialists from around the world and the positive cooperation engendered between them, to achieve all of the foregoing from 2004 to date.

2 Terminology and the participants

- 2.1 One cannot get far into the history of the project without explaining the terminology further and providing additional introduction to some of the participants.

AIPPI

- 2.2 The International Association for the Protection of Intellectual Property is the leading non-government organisation working on developing and improving laws for the protection of IP. It is a politically neutral, non-profit organisation based in Switzerland (Zurich). It has more than 9,000 individuals as members. They represent more than 125 countries. It is more than 100 years old. Most of its members are IP professionals in practice. They include lawyers and non-lawyer IP specialists. The way in which AIPPI functions is described in paragraph 6.2 to 6.10 below. The Association is represented in most of the countries of the world by a National or Regional Group (**NGs**), each of which responds to its Bureau (in effect, the Board of AIPPI) and its General Secretariat which is in Zurich.

WIPO

- 2.3 The World Intellectual Property Organization is a specialized agency of the United Nations. WIPO provides a global forum for IP services, policy, information and cooperation. It has more than 190 Member States as its constituents. It is based in Geneva. It has a large staff under a Director General elected by the Member States.
- 2.4 WIPO has particular positive features in the context of this history. By its expert staff, WIPO has substantial resources in relation to law and governance of IP around the world. It encourages and respects contributions not only from its Member States, but also from IP NGOs including AIPPI, AIPLA, FICPI and APAA and other relevant NGOs which are identified in paragraph 2.6 and further in this history below. WIPO applies its resources and efforts to the objective of having globally, balanced and effective IP systems that enable innovations and creativity for the benefit of all.

WIPO's Standing Committee on the Law of Patents (SCP)

- 2.5 The SCP is a forum organised and managed by WIPO. It is constituted by a committee comprised of delegates of its Member States. They number more than 125 and its meetings resemble those of the United Nations. In this forum, WIPO and its Member States discuss issues relating to the global systems of patent law, patent registration and the transfer of patented technology. Through the SCP, WIPO facilitates, coordinates and provides guidance concerning the progressive international development of patent law. The manner in which it carries out its work in preparation for and at plenary meetings of the SCP, is described further in paragraphs 6.8 to 6.10 below.

IP NGOs (apart from AIPPI)

- 2.6 Apart from AIPPI (which is dealt with further in Sections 4, 5 and 6 below), the non-government IP associations which have been forward in contributing to numerous aspects of the project including supporting the work of AIPPI and WIPO in developing the protection, are as follows.

LCA – the Law Council of Australia through the IP Committee (IPC) of its Business Law Section.

FICPI – the International Association of Intellectual Property Attorneys.

ICC – the International Chamber of Commerce (particularly its IP Committee).

APAA – the Asian Patent Attorneys Association.

AIPLA – the American Intellectual Property Law Association.

Other contributors to the work in the project which need to be introduced and acknowledged are - the Australian Institute of Patent and Trade Marks Attorneys (IPTA), AIPPI Australia (AIPPI-A), FICPI Australia (FICPI-A) and APAA – Australia (APAA-A). They and some of their members are further acknowledged later in this history for their contributions to the project.

- 2.7 As stated in the previous paragraph, the IP NGOs contribute to the work of WIPO. WIPO also contributes to the work of the IP NGOs. This cooperation happens in many ways including the IP NGOs attending WIPO's meetings on IP specialist topics, providing written submissions for those meetings, by WIPO publishing such written submissions made to it, by WIPO publishing submissions made orally at its meetings in its Reports (in effect a transcript of those meetings), by the IP NGOs' having discussions with WIPO and with delegates of the Member States at those meetings, by having WIPO representatives attend IP NGOs meetings on legal scientific work in which they and WIPO have common interests, and by providing WIPO representatives with the opportunity to address the members of the IP NGOs at those meetings on WIPO's work both specific and general. The role of AIPPI contributing to WIPO's work in relation to this History (including by its representatives as Observers at its meetings), is widely described in this History.

Australian Government

IP Australia (IPA)

- 2.8 IPA is the branch of the Australian government which is responsible for the administration of all Federal IP law – in this context particularly – under the Patents Act and the Trade Marks Acts (the Acts). The Attorney General's Department (AGs) was also involved, particularly in relation to changes required to the Acts.

Australian Legal Firm Input - Allens Arthur Robinson, now Allens (Allens)

- 2.9 In this History, the Australian law firm Allens Arthur Robinson, made substantial contributions to the project through its partners and their connections in the world of IP. Allens supported the efforts of AIPPI Australia and especially those of the author. Supporting the project had particular appeal to Allens as follows.

- 2.10 The legal need for the project was one which affected the firm's clients both in relation to patent lawyer and patent attorney services. It also affected its professionals in their practice of IP law, day to day.
- 2.11 The project involved alumni of Allens' firms. Francis Gurry and the author are both alumni of a predecessor firm of Allens namely, Arthur Robinson & Co. The author is also a partner alumnus of Arthur Robinson & Hedderwicks, and Allens Arthur Robinson and was a Consultant of Allens. These firms are referred to hereafter by name or as '**Allens**'.
- 2.12 The project needed administrative support. That has been supplied by WIPO, AIPPI and Allens over the whole history of the project to date. The author's work in the 5 years from 2003 to 2007, was a **pro bono** aspect of his work as a partner of Allens Arthur Robinson. For 12 years since 2007, the author's work has been **pro bono** as a retired legal practitioner. That work was administratively supported by Allens. Many of the documents which are part of this history, bear witness to the support given by Allens to the project.
- 2.13 Further, for 4 years (from 2014 to October 2018), the present Allens IP Partner, Sarah Matheson, was the Reporter General of AIPPI (that role being the global leader of AIPPI's scientific IP legal work). For those 4 years, Sarah was the AIPPI Bureau's point of liaison for Q199. In doing so, Sarah was continuing the direct reporting connection between Q199 and successive Reporters General of AIPPI – who were, in order - Luis Duran (Spain - ES), Jochen Buehling (DE) and Thierry Calame (CH). As of now, Ari Laakkonen, Second Deputy Reporter General of AIPPI, is Q199's reporting connection with the Reporters General. These connections underscore the importance of the project to AIPPI, and of AIPPI's relationship with WIPO. Sarah is now Vice Chairman of Q199.

3 Attachments

- 3.1 The Attachments to this history include formal submissions by AIPPI to WIPO and less formal communications between AIPPI and WIPO, and by AIPPI with others. They also include AIPPI and WIPO publications. Such Attachments and their internet links to WIPO and AIPPI websites, are intended to assist researchers of the protection in response to Sam Ricketson's comments reported in the Prelude above. For convenience of research, the links to AIPPI and WIPO Attachments and their respective websites, are reported in Annex 1 to this history.
- 3.2 There would be little purpose in repeating in this History what the documents attached describe in detail. Accordingly, the narration in this history focusses on bringing each document into its context in the History including as to subject matter and timing. Further, the narration reflects the efforts of the contributors to whom it refers, beyond the documents themselves.
- 3.3 The foregoing strategy on the Attachments assumes that the reader will consider the Attachments as well as the description of the history of the project. Only in that way can the history of those who contributed to the history, be truly appreciated.

- 3.4 The Attachments contain numerous documents of AIPPI, WIPO and Allens. Whilst for many years the author had the driver's seat for AIPPI and in Allens, the process has also had the benefit of the expertise and goodwill of scores of skilled IP people and administrators, many of whom are mentioned in this History and in its Attachments.

4 Cooperative efforts – more about the participants

- 4.1 As previously mentioned, the project has involved cooperation between and contributions by numerous people. It always risks missing somebody who is deserving of mention, if one mentions some. However, that risk has to be taken because there is a need to recognise many contributors and to link them and their organisations to the project as to which they have in their own way, been rather important. The point is not lost on the author that acknowledgments are not usually at the start of the narrative. In this case, the narrative needs some of the people and their context to be stated up front in order to bring better meaning and effect to the narrative. There are further acknowledgments in Annex 4.

WIPO

- 4.2 In the project, Francis Gurry has always led WIPO's involvement. That comment applies first when he was Deputy Director General of WIPO for the period 2004 to 2008 and since then to date, as Director General of WIPO. Also contributing greatly from WIPO, Philippe Baechtold, who was Head of Patents at WIPO for much of the time and Tomoko Miyamoto who was for many years in the project's history, Philippe's deputy. Tomoko became the Head of Patents in WIPO by about 2009.

CEIPI – Centre for International Intellectual Property Studies

- 4.3 Professor François Curchod, formerly a Deputy Director General of WIPO, a Member of Honour of AIPPI, and the representative of CEIPI in WIPO meetings, should be acknowledged particularly for his counsel to the author in the SCP meetings reported in this history. François (who has been a good friend of the author since 1988) sat with the author and other representatives of AIPPI throughout many day long meetings of the SCP in Geneva, particularly in the period from 2008 to 2015.

AIPPI – Bureaux and its Members

- 4.4 The successive Bureaux of AIPPI but particularly - Presidents Ron Myrick (USA) and Thierry Mollet-Vieville (France), and the Reporters General referred to in paragraph 2.13 above.

AIPPI Members

- 4.5 To achieve advances in and harmonization of IP law internationally, the Bureau has a process by which it can gather information from the members of AIPPI and resolve AIPPI's position on particular issues. The Bureau's process is more complicated than is made out by that statement. However, for the purposes of this history, it is enough to explain that the Bureau appoints the

members of the committee – Chair, Co or Vice Chair, Secretary, members of the committee – who are to lead its particular initiatives on each subject and decides the mandate for their work. The subject they work on is named by the Bureau and each such initiative is allocated a 'Q' number (the next number in the sequence of subjects with which AIPPI is dealing or has dealt).

- 4.6 The questions/committees relevant to this history were Q163 (Attorney Client Privilege and the Patent and/or Trademark Attorneys Profession) which completed its work in 2003 and Q199, which is ongoing. The issue for Q163 was resolved by AIPPI at Lucerne in 2003. Q163 and its Resolution are described further in Section 9 below. Q199 (initially called 'Privilege Task Force') was formed at the AIPPI Singapore (SG) EXCO meeting in 2007. Its leaders are described in Section 5 below and its activities and actions are described generally throughout this History of the project.
- 4.7 The members of AIPPI were regularly consulted by the leaders of Q199 through their representatives in Q199 and in AIPPI meetings. The members approved the work of Q199 after reading its Reports and hearing oral explanation. They also approved and mandated its future work. Remarkably, such Reports were made and approvals given without dissent on any occasion.
- 4.8 There was no moment more telling as to the positive interest of the members of AIPPI in the work of Q199 than at the Congress of AIPPI in Paris in 2010. For that meeting, they had to absorb a Q199 report of more than 100 pages (narrative and data including charts). That Report (which is **Attachment 53** below) proved that the members responding to it had accepted that the current law on the protection around the world was inadequate. There were many more countries represented at the Congress in Paris than had provided information to Q199 for the Report. On the basis of the Report, Members of AIPPI in Paris mandated AIPPI to provide the Report, including the data on which it was based, directly to WIPO. The Report was sent to WIPO forthwith after the close of the Congress so that the Report was available to WIPO for the SCP 14 meeting (January 2010), as information to encourage the Member States to mandate WIPO to study remedies.

5 More information on participants in the project

AIPPI – Q199 (called 'Privilege Task Force' at the beginning, later 'Client Attorney Privilege' (CAP))

- 5.1 The author's positions in Q199 are stated on the title page of this History. Steven Garland (CA) was at first the Co-Chair of Q199 (2008 to 2010), and then Chairman until October 2018, when he stepped down to become Chairman of the Program Committee of AIPPI. Andri Hess (CH) was appointed Chairman in October 2018. Wouter Pors (NL) was a Co-Chair from the start until October 2018. James Tumbridge (UK) was a Co-Chair from about 2010, as were Andri Hess and Luis Amaral (Brazil - BR). As of now, the leaders of the Committee of Q199 are Andri Hess, (CH) Chairman, Robert Mattson (US) Vice Chair, and Sarah Matheson (AU) Vice Chair.

- 5.2 In Q199, apart from acknowledging the office bearers above, persons who were strategic and positive members of Q199 in representing developing countries were Chew Phy Keat (MY) and Pravin Anand (IN). Other significant contributors to the work of Q199 were David Hill (US), Cristobal Porzio (CL) and Jorge Otamendi (Argentina - AR). Each one of the AIPPI persons mentioned is a leading IP lawyer in private practice in the respective country they represent. The representatives of NGs in Q199 have been referred to collectively in AIPPI as 'PTFRs' ie Privilege Task Force Representatives (reflecting the first name given to Q199 – 'Privilege Task Force').

IPC

- 5.3 Successive Chairmen of IPC but particularly Ian Pascarl who was active in supporting the start-up of the project and in relation to liaison with IPA (see below) on changing the Acts. Progress of the project was reported to successive meetings of IPC, and IPC was supplied with copies of many of the AIPPI Submissions to WIPO and all the Submissions to the Australian government which are Attachments to this history.

IPTA

- 5.4 Michael Caine (Davies Collison Cave), particularly on behalf of IPTA and in cooperation with other IP NGOs in obtaining the advice of Neil Young QC (referred to further below) on amending the Acts on client privilege. Also, in dealing with interests of non-lawyer patent attorneys, and in IPTA's substantial role in negotiations with IPA and AGs on the same subject.

FICPI

- 5.5 Greg Chambers (Phillips Ormonde & Fitzpatrick) - as for Michael Caine (above) but on behalf of FICPI-A; also in supporting the efforts of FICPI (the international body) to switch the SCP from studying the problem when that was exhausted in WIPO, to studying remedies; and in supporting AIPPI, FICPI and AIPLA in the establishment and running the Colloquium on the protection which was held in Paris in June 2013 (see Section 62 below).

IPA

- 5.6 Successive Directors General of IPA - Ian Heath, Philip Noonan and Fatima Beattie. Further, Terry Moore who was Director of the Directors' Office, Victor Portelli, General Manager, Patent and Plant Breeders Rights, Keith Porter, International Cooperation, and Adam Wright, Assistant Director International Policy and Cooperation. In particular, in September 2009 Terry Moore attended meetings on IP law at which AIPPI-A's proposals for amending the Australian law on attorney (non-lawyer) privilege were presented and discussed. Further, at that time, she also attended and spoke at the meeting of the Intellectual Property Society of Australian & New Zealand (IPSANZ) – ie Australian and NZ IP lawyers and attorneys, in Auckland, NZ. That meeting is referred to in more detail in Section 16 below.
- 5.7 At that meeting, the author (also a speaker at that meeting) mentioned to Terry that IPA had informed AIPPI-A that amending the Acts had been taken off IPA's agenda going forward. That

news was rather disappointing to AIPPI-A. It was reported as such by the author on behalf of AIPPI-A in the meeting of lawyers and patent attorneys in which Terry was present. Further, in that meeting, the author acknowledged that NZ law was then about 5 years ahead of Australia in widening the scope of privilege applicable in NZ. The scope of the protection in NZ had already been extended to include the clients of overseas equivalents of NZ IP professionals. Through some smart work by Terry Moore, she was able to report, and did so before the IPSANZ meeting ended, that the process of making equivalent amendments to the Australian law, had been put back on IPA's agenda!

- 5.8 The Acts were subsequently appropriately amended. That included a substantial process of cooperation between the Australian IP NGOs and IPA. The amendments came into effect in April 2013. The process of amending the Acts is described as it progressed, in a number of Sections of this history, below. In relation to the problem as it applied in Australia, it was by the positive cooperation between IPA and the IP NGOs over several years that the remedy for Australia's then inadequate law on the protection, was obtained.

6 AIPPI and WIPO Processes

- 6.1 For the purposes of this history, it is desirable to know how AIPPI and WIPO function as relevant to the project.

AIPPI Process

- 6.2 AIPPI identifies IP subjects worthy of study in a global context. As previously described, the Bureau organises how the studies are to be done and by whom. When Q199 was formed, most countries in which AIPPI then had an **NG** (then more than 100), appointed a representative to be a member of Q199 (a PTFR).
- 6.3 In the case of the project, when the committee for Q199 was established in 2007, as mentioned, it was then called 'Privilege Task Force'. Its name was subsequently changed to reflect the changing focus of the project. It became – 'Client Attorney Privilege'. Even that title is now an anachronism. The subject of its work is now – 'the protection of confidentiality in IP legal advice from forcible disclosure'. It would not be wise to shorten that to 'the protection project'.
- 6.4 AIPPI now holds a Congress meeting annually. Prior to each such meeting, the NGs report in writing on the Questions scheduled for the meeting. The NG Reports are analysed by the Reporter General team in advance of each Congress. The Reports and the Reporter General's analysis are debated in meetings of the designated committee. Usually a form of Resolution is agreed in the committee. That draft Resolution is then proposed to a plenary session of the Congress. Each Resolution so passed, becomes AIPPI's official position on the issue. AIPPI's policy on the protection of confidentiality in the advice of lawyer and non-lawyer IP professionals (Q163), came about in this way (see paragraphs 9.1 to 9.4 below).

- 6.5 The previous paragraph describes what occurs when a legal subject is studied and a position of consensus is reached so that a Resolution can be passed as to what the law should be. Q163 had established that position on the subject of client attorney privilege before Q199 was formed as a Standing Committee (ie long term). The product of Q199's work has arrived at the point where a Resolution is required twice in its history to date. The first Resolution was to get acceptance by AIPPI of Q199's findings on the protection by a Questionnaire process involving its NGs, and authority to supply those findings and the data on which they were based, to WIPO. That Resolution was passed at the AIPPI Paris Congress in October, 2010 – see Section 34 below. The second was in support of the work of the GB+ countries, passed at the AIPPI London Congress in September 2019 (see the Postlude, below).
- 6.6 The 'Q' identifying system is also applied to subjects allocated by the Bureau to Standing or Special Committees of AIPPI which deal with ongoing projects. Such committees are formed ad hoc. The issues and difficulties of running a Standing or Special Committee came under review in 2009. The experience of Q199 in operating as a Standing Committee over the previous year, was contributed to that review at the request of the then Reporter General, Jochen Buehling (see Section 15 below and **Attachment 32** related to that topic).
- 6.7 Standing Committees, including Q199, conduct their business in close co-operation with the Bureau, including through the particular member of the Bureau to whom they report. In the case of Q199, WIPO meetings on the protection attended by the leaders of Q199, were often also attended by one, or even two or more, members of the Bureau. Submissions to WIPO (whether in writing or made orally) on matters relating to Q199, were normally made by the Chairman of Q199 or another representative of Q199's leaders.

WIPO Process

- 6.8 The SCP (comprised of delegates of the Member States of WIPO) determines its agenda for work with the assistance of the permanent staff of WIPO. The SCP likewise determines how the work for each agenda topic is to be done. The topic will be named and the issues around the topic will be identified by WIPO staff or an expert assisting them. WIPO staff prepares meetings of the SCP and conducts those meetings, to carry out mandates formally approved by the Member States of the SCP. So, for example, the issue of CAP has been dealt with at SCP meetings from SCP 12 and onwards by such mandates. Contributions by the Member States on topics dealt with at SCP meetings, are usually made orally but can be in writing.
- 6.9 IP NGOs and other organisations accredited by WIPO are invited by WIPO to contribute their views in writing prior to meetings of the SCP, and orally at such meetings. Such oral submissions are normally made after oral submissions have been made by the delegates of the Member States.
- 6.10 The Secretariat of WIPO often contributes legal reports from its own resources (some of its employees are experts in the subject) or, if so mandated, from independent experts. The

Secretariat also supports the running of the meetings in various ways like preparing the agenda, providing simultaneous translation, keeping the transcript of what is said, including the Chairman's Summary at the end. Ultimately, the Secretariat prepares a Report of each meeting which includes everything that was said. It also produces the official List of Participants which is annexed to the Report. All the documents so produced are published on the WIPO website. They are identifiable by the descriptor of the particular meeting to which they relate (eg SCP 12 for the twelfth meeting of the SCP). Further, for example, the WIPO Special Report on the Client Attorney Privilege issue for the SCP 13 meeting was the fourth item on the agenda of that meeting. So, that particular Special Report has the descriptor – SCP/13/4.

7 Synopsis of the project – The Four Stages

First Stage

- 7.1 Thus far, the project has had four stages. The **first** Stage began in about 2002 in the lead up to the AIPPI Resolution on Client Attorney Privilege - Q163. That Resolution was passed in 2003 at the AIPPI Executive Committee meeting in Lucerne. In effect, that Resolution (dealt with further in paragraph 9.3 below), called for the clients of non-lawyer IP professionals to be protected from having to disclose their professional advice in the same way as for the clients of lawyer IP professionals. The author considered the AIPPI Resolution and thought it should be implemented by changes being made in national laws and by an international agreement, the latter potentially a treaty.
- 7.2 The subsequent efforts of AIPPI and the International Chamber of Commerce (ICC) working with WIPO, led to the main event in the first stage of the project. This was a major international Conference on Privilege which was held in May 2008. That Conference, co-sponsored by WIPO and AIPPI, was held at WIPO's Headquarters in Geneva. The details of that Conference are described in Section 9.
- 7.3 In the same Stage, AIPPI-A brought FICPI-A, LCA and IPTA into the project. Subsequently in and through Stages one, two and three of the project, they and APAA-A engaged with IPA and AGs in the process of amending the Acts on privilege.

Second Stage

- 7.4 The **second** Stage involved studies of the problem with the protection. These studies were principally carried out by WIPO, AIPPI and other IP NGOs - ICC, FICPI and APAA – each of which is an accredited contributor to the work of WIPO. From SCP 12 in June 2008 onwards, there have been numerous SCP meetings dealing (among other things) with the problem of the protection. SCP 12 occurred in June 2008 just after the WIPO/AIPPI Conference in May 2008. Two further SCP meetings in the Second Stage were SCP 13 in March 2009 and 14 in January 2010. CAP was on the agenda in each of these SCP meetings. At those meetings, in dealing with

the CAP issue on their agenda, the delegates of the Member States were focussed on the problem. That was the logical precursor to studying remedies.

Third Stage

- 7.5 The **third** Stage focussed on remedies. It began with SCP 15. The issue of remedies was largely completed by SCP 20 in January 2014. Since then, the SCP has maintained CAP on its agenda mandating WIPO to complete its reporting on the current state of the protection worldwide. The SCP has also been an informal observer of what is going on in the fourth stage of the project. It has also pursued the obtaining of up to date data on the difficulties the Member States would have in implementing remedies.

Fourth Stage

- 7.6 The **fourth** Stage is the negotiation between particular developed countries of a multilateral agreement (**MLA**) to apply minimum standards of the protection nationally and internationally, the ultimate remedy for the problem. The working papers for such an MLA build on concepts and drafting of a formula for the remedy which was first formally proposed by AIPPI to IPA and WIPO, in 2005.

8 AIPPI'S strategy in the project

- 8.1 The strategy adopted by AIPPI in conducting the project was, not surprisingly, reactive to the objective needs of solving the problem and the subjective needs of the numerous organisations and persons who were to be involved.
- 8.2 **First** (on strategy), there were legal issues to be resolved in Australia. AIPPI could not solve a global problem without national and international help. On the national issue, AIPPI-A and the other Australian IP NGOs needed to have an agreed position on resolving the problem in AU and to make a united approach to the Australian government. On the international issue, WIPO as custodian of the existing IP global treaties, obviously had to be engaged in and consulted on solving the problem. Further, the author anticipated that the Australian government would be reluctant to move on amending national law on a subject with international implications unless WIPO was also interested in supporting an initiative for harmonization of the law.
- 8.3 However, Australia had the problem that its own law on the protection, was inadequate. That deficiency was negative to it being able to take the lead internationally. AU could hardly suggest to other countries what they should do to solve the problem if its own laws were at fault unless, it had in hand, at least, serious proposals to amend them.
- 8.4 These problems were worked on by AIPPI-A, FICPI-A, LCA and IPTA from 2007. As to the law in AU, the LCA (its member Warwick Rothnie in particular) saw an issue under the Australian Constitution potentially affecting the scope of the amendments to the Acts. In principle, the clients of patent and trade marks attorneys needed to be brought as nearly as possible onto the same level of the protection as clients of lawyers. Client legal professional privilege is a creature of

common law and statute, whereas client attorney privilege is based solely on statute. You cannot legislate that clients of patent and trade marks attorneys are to have the same scope of protection as those of lawyers. That would give judges the responsibility for determining the law applicable to patent and trade marks attorneys. Under the Constitution, determining the law applicable to those attorneys is the responsibility of parliament, not the courts.

- 8.5 What then could be done (at best) to get the clients of attorneys as nearly as possible onto the same level of protection as clients of lawyers? The Australian IP NGOs instructed Allens to brief Neil Young QC of the Victorian Bar to advise on the form of the amendments including how to avoid the Constitutional issue.
- 8.6 The amendments to be made as proposed by the IP NGOs were of course to be designed to bring the protection of clients of patent and trade marks attorneys as nearly as possible onto the same level as lawyers in relation to their advice. There was surprising ignorance at large in AU at that time that non-lawyer patent and trade marks attorneys actually give legal advice on IP subjects and are empowered to do so by the Acts.
- 8.7 As foreshadowed above, the source of the non-lawyer attorneys' client privilege, is in the Acts. The statutory source for the clients of lawyers is (in this context) the Commonwealth Evidence Act. To that so far is it is consistent with the Evidence Act, you add the common law.
- 8.8 So, in respect of patent and trade marks attorneys, the Allens' view was that the drafting had to limit the scope of patent and trade marks attorney privilege to what it was at the time of each case, for lawyers. Client lawyer privilege would be dictated by statute plus what had been (historically) determined as applicable under the common law. The advice obtained from Neil Young QC in 2007 proposed a form of drafting constructed on what was proposed by the LCA to avoid the Constitutional issue.
- 8.9 At the same time, the amendments would also need to deal with the cross-border problem under AU law. That problem was that the protection as it applied under the Acts was limited to attorneys registered to practise as such in Australia. The protection needed to be extended to overseas equivalents of those Australian attorneys because the same client would often need to consult such overseas equivalents on their Australian legal advice – among other things, to rationalize and justify any differences between their AU and overseas advice.
- 8.10 **Secondly** (on strategy), the trail to substantial activity by IPA and WIPO on amending the law on the protection started by the author with Francis Gurry in 2004, had run cold by 2006. It was welcome indeed that the ICC (Ron Myrick in particular) took up the issue of the protection from forcible disclosure of the advice of in-house counsel with WIPO in 2007. The catalyst for that action by ICC was the decision in the ECJ in *AKZO - Akzo Nobel Chemicals & Akcros Chemicals v Commission (Competition)* [2007] EUECJ T.253/03 (17 September 2007). That was a civil law decision. In effect, the decision was that there is no privilege/protection for the legal advice of employee lawyers. Employment (in civil law) meant that the independence required for the protection to exist, was not applicable. That meant that the legal advice of employee lawyers to

the company by which they were employed, could be forcibly disclosed under EU competition law. The ramifications of the AKZO decision shook the foundations of in-house lawyers and non-lawyer attorneys. It meant in effect that the protection was applied to common law in-house professionals but not to civil law professionals. The complexity of this difference for multinational companies with businesses in both common law and civil law countries, is obvious.

- 8.11 WIPO and AIPPI agreed that the first step in a co-operative process to get the project of studying the problem going was to hold the international conference, in which experience of the protection globally would be pooled and analysed. WIPO would provide the infrastructure and the support of its in-house lawyer staff. AIPPI would propose and organise the program and IP lawyer experts from common and civil law countries around the world.
- 8.12 The WIPO/AIPPI Conference on Privilege in May 2008 was strategic for WIPO in various ways. The SCP was having difficulty in agreeing to meet. A principal reason for that was that the Member States had been unable to agree on an agenda for meeting ie on what should be studied and discussed on the law of patents! The SCP 12 meeting proposed for June 2008 would be informed on the problem relating to CAP, by the findings of the May Conference. Speaking as at that time, AIPPI hoped that the Member States would be persuaded by the outcome of the Conference to accept CAP as a subject for their working agenda in the SCP going forward.
- 8.13 There is little point in anyone studying a problem if there is no intention to solve it. The subject of 'treaties' was not well regarded by the developing countries. AIPPI had already tripped on that obstacle. In 2005, AIPPI had proposed to WIPO the wording for 'a treaty'. As the word 'treaty' was negative in the SCP, the proposal previously made by AIPPI was thereafter described by AIPPI as a 'working paper'. In effect, that concession was not substantial because the proposal made in 2005 was made to indicate that a solution was possible, not as a 'must have'. In any event, the issue of what remedy was appropriate, was premature until the problem had been satisfactorily studied.
- 8.14 **Thirdly**, in the light of the foregoing, the emphasis of submissions by AIPPI (and other IP NGOs) as to WIPO meetings SCP 12 through SCP 14, was on the problem of the protection including the lack or loss of it, and not on remedies. Once the dimensions of the problem had been reasonably assessed, it was AIPPI's thinking that it would then be justifiable to urge the Member States to study remedies.
- 8.15 **Fourthly**, AIPPI knew that there would have to be levers to persuade the Member States to study remedies. To meet that need, AIPPI planned to conduct a major study of remedies through its NGs (hoping to involve around 50 countries) all of which involved persons who were citizens of, if not leaders in, the Member States. The study would be (as often occurs) one involving a Questionnaire to start it up. The process would raise the potential for an MLA, how that could be implemented, and it would seek the NGs' views generally on solving the problem of the protection. The process was also intended to identify any limitations in their national laws on potential remedies. The study had to be designed to allow for computer analysis of the results.

- 8.16 **Fifthly**, as AIPPI (and other IP NGOs) knew that WIPO would not be able to implement any remedy (because the developing countries would not agree to WIPO being involved in that), AIPPI knew it would at least need some of the leading developed countries (**GB+**) to agree to do that. In view of the likely opposition of developing countries, the GB+ countries would have to work on a remedy to be implemented, outside WIPO. As they regularly met in Geneva for their own purposes about the same time as other WIPO meetings in any event, this would provide an opportunity to discuss and negotiate on an appropriate international remedy.
- 8.17 As it turned out, the initiators of the process of promoting the achievement of a remedy were the IP NGOs - AIPPI, FICPI and AIPLA. Together with representatives of some of the GB+ countries, those three IP NGOs devised and proposed to the GB+ countries through the Swiss delegation in the SCP, that a Colloquium be held to discuss remedies and their implementation. The Colloquium was held in Paris in June 2013. That Colloquium duly took place and was successful in arming the GB+ countries with a draft MLA to work on. Since that meeting, the GB+ countries have been negotiating the terms of an MLA. The history relating to the Colloquium is referred to below in Section 63.
- 8.18 As at 31 December 2019, about 6 years have elapsed since the Colloquium. One could reasonably question whether that indicates that the problem is not real? No – it reflects the complexity of the problem, including of how to make and implement an MLA.
- 8.19 The issue of the reality of the problem should be revisited at this point. It remains urgent to solve it. It is part of the force driving the project. Whilst the problem remains unresolved, every day lawyers, patent and trade marks attorneys and courts are spending substantial time around the world analysing, and advising, or getting judgments through the courts, on issues relating to actual or potential forcible discovery of IP professional advice. Nobody can measure the enormity of what these efforts cost.
- 8.20 Another and most important point is that allowing the problem to go on, flies in the face of policies which most governments have accepted and acted on – ie in making national laws establishing the protection, albeit inadequate protection. They have provided the protection with the intention that clients are supported to get correct advice by full and frank disclosures between them and their professional advisers. As well, they accept that the protection supports the functioning and enforcement of the law. What justification can there be for inadequate protection?
- 8.21 In support of its Resolution in Q163 and for the reasons detailed above, AIPPI is actively supporting the negotiations between the GB+ countries to settle an appropriate MLA prescribing minimum standards of the protection which are to apply nationally and as between them.
- 8.22 With the foregoing introduction and overview providing the context of this history, we now turn to particulars of the Four Stages of the project and documents relevant to each of those.

9 Particulars of the Four Stages and documents relevant to those

First Stage

The early efforts of AIPPI and AIPPI-A to develop the protection.

- 9.1 During 2002, the AIPPI NGs prepared responses to the Reporter General of AIPPI relation to AIPPI's Q163 on what protection (if any) their countries provided against forcible disclosure of IP legal advice including to those from overseas countries. They were asked (among other things) what protection was applied to the clients of lawyers on the one hand, and clients of non-lawyers on the other. If there were differences, they were asked whether what was applied to non-lawyers should be the same as what was applied to lawyers.
- 9.2 The NGs' responses disclosed widespread inadequacy of the protection and lack of equality in the protection as it was applied to the clients of those two categories of IP professionals, lawyers and non-lawyers.
- 9.3 At the meeting of the Executive Committee (EXCO) of AIPPI in Lucerne in October 2003, after debate in the committee Q163, and in the EXCO meetings of AIPPI, AIPPI resolved as follows.

Question Q163

Attorney-Client Privilege and the Patent and/or Trademark Attorneys Profession

Resolution

AIPPI

Recognizing:

1. the importance of intellectual and industrial properties to the world's economy;
2. the importance of the role of patent and trademark attorneys and registered agents to the world's intellectual property systems for the benefit of their clients and society;
3. that clients and legal systems are both well-served by maintaining in strict confidence and protecting from disclosure to third parties, communications between the clients and their attorneys made for the purpose of obtaining and providing legal advice; and
4. that such communications between attorneys and clients regarding technical matters are as deserving of protection as are communications involving purely legal matters due to the fact that technical and legal matters are often closely interrelated in regards to intellectual and industrial property rights.

Resolves:

That AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize that the protections and obligations of the attorney-client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not

qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.

- 9.4 This Resolution established AIPPI's policy that the protection of clients from forcible disclosure of legal advice should be the same whether the advice comes from lawyer or non-lawyer IP professionals. The position around the world at that time included some countries that provided no protection nationally of non-lawyer professional advice. Internationally, there was little or no certain protection in any given country, of overseas non-lawyer professional advice.
- 9.5 After Lucerne, as outlined above, the author decided there was a need to develop Australia's national laws on the protection which they provided. The Australian law did not comply with the AIPPI Resolution Q163. It was lacking in various ways. For example, the protection provided by the Acts was potentially limited to attorneys (both patent and trade marks) registered in AU. Further, no protection was provided where Australian attorney advice was sent to overseas equivalents of Australian attorneys. The transmission of IP attorney advice by or on behalf of clients from one country to another was, and remains, routine in IP legal practice. Clients (particularly, but not only, corporate ones) are required to rationalise any differences in their IP attorney advice on the same subject, as obtained in one country and another.
- 9.6 The concept of gaining practical effect around the world for Resolution Q163 of AIPPI was an attractive objective. It required that those countries which did not provide the protection should do so. It did not directly focus on the loss of the protection cross-border, but it did so indirectly.
- (1) It required the provision of laws on practice throughout all the national jurisdictions. That would include laws maintaining in confidence and protecting from disclosure, communications for obtaining and providing legal advice.
 - (2) This implied that such laws would apply so that the protection would be effective internationally ie would not be lost cross-border.
- 9.7 To reach that standard would not be easy to achieve in all nations, let alone internationally. It was clear from the start that the problem could not be solved globally without some sort of international agreement, that is, unless all countries individually had complementary laws on the protection – a highly unlikely proposition.
- 9.8 The Australian position was adverse to Australia's ability to negotiate for something better internationally. The legal fact that the Australian patent law on the privilege of clients of patent attorneys was limited to registered patent attorneys in Australia, was made clear by the decision of Heerey J in 2004 in *Eli Lilly v Pfizer Ireland Pharmaceuticals (No 2)* [2004] FCA 850.
- 9.9 Strategically for AIPPI, it seemed to AIPPI-A that there was no point in trying to persuade WIPO or the Australian government to solve the problem unless there were, at the end of the day, a possible international remedy. Thus, whilst working on amendments to the Acts for the LCA and

AIPPI-A, the author also worked on the potential wording of a treaty providing for minimum standards of the protection against forcible disclosure of IP professional advice.

2004

The visit of Dr Francis Gurry (then Deputy Director General of WIPO) to Melbourne in April 2004.

9.10 Fortunately for the process, Francis Gurry visited the offices of Allens in Melbourne in April 2004, on a visit to Australia for other purposes. The author discussed (among other things) the following topics with Francis endeavouring to persuade him to pick up the ball in WIPO and to work particularly on the need for compatible national and international laws (minimum standards), in cooperation with AIPPI and other IP NGOs.

- The problems of the Australian national law.
- The cost of the problem and its potential adverse effects on international trade.
- What AIPPI-A planned to do about obtaining national and international improvements.
- How the international process would be assisted by study of the problem and remedies in the SCP of WIPO.
- The wording of a potential treaty.
- The failings of the protection in Australia and other countries – US, FR, JP and the UK.
- The adverse impacts of the protection failing – in particular, by pulling the rug from under the public interests which the protection was supposed to support, particularly the obtaining by clients of correct legal advice.

Francis was positive about the proposal for cooperative work between AIPPI and WIPO on the problem. He suggested that AIPPI should make a written submission to WIPO for the problem to be studied in WIPO including how the problem could be resolved. So, if the problem was to be solved, the device involved had to be applicable in both common and civil law countries.

9.11 AIPPI's work on the concept of a treaty was informed (at the start) as to professional secrecy and other civil law matters by a visiting German law student, Catharina Mes, daughter of the then President of the German Group of AIPPI, Professor Peter Mes, a good friend of the author. Catharina had been working in Allens for 2 months gaining work experience in common law IP litigation. That happened in April 2004 prior to the visit of Dr Gurry. Confidentiality of legal advice was identified as the factor common to both systems of law (common law and civil law) on which a putative treaty or international agreement, could pivot.

9.12 By July 2005, the author had prepared and obtained approval from the Bureau of AIPPI for a Submission by AIPPI to WIPO - **Attachment 1**. It was co-signed by Luis Duran (ES), the then Reporter General of AIPPI. That Submission was duly sent by AIPPI to WIPO. The Submission

identified the problem of the inadequacy of the protection, related the Q163 Resolution of AIPPI to that (pointing out the limitations of that Resolution), named and detailed relevant authorities in Australia in the context of describing the problem as it applies in Australia, and proposed the solution by treaty requiring minimum standards of the protection (including the text of the draft treaty). As stated above in the description of AIPPI's Strategy, the point of proposing a draft treaty at that stage, was to indicate that the cross-border aspect of the problem did have a potential solution.

2005

The legal and drafting challenges of section 200(2) of the *Patents Act 1990* and section 229 of the *Trade Marks Act 1995*.

- 9.13 By 2005, further pressure had come onto IP lawyers, patent attorneys and trade marks attorneys in Australia to improve the protection of clients of attorneys. In addition to the scope of the relevant provisions in the Acts being limited to attorneys registered in Australia, there were other issues. For example, whether the scope of privilege under the *Patents Act* was as wide as that applicable to lawyers under the *Evidence Act* combined with the common law (the two prime sources of client lawyer privilege). Probably not. Attorney privilege only extends to what the relevant Act prescribes. Further, the common law by that time had confirmed that the client/lawyer protection extended to third parties (like technical experts) with whom lawyers communicate in order to advise their clients. The *Patents Act* did not extend the protection it provided to clients of overseas non-lawyer patent attorneys and patent agents. Nor did it extend the protection to third parties (like technical experts) with whom local and overseas non-lawyer patent attorneys/agents had to deal in order to advise their clients.
- 9.14 To improve the law on the protection relating to non-lawyer patent attorneys, involved (ie in prospect at that time) having to obtain cooperation between the following.
- Legal and patent attorney IP professionals through the LCA and IPTA, respectively.
 - The same professionals through the Australian chapters of the respective IP NGOs – AIPPI-A and FICPI-A.
 - The relevant professionals in the Commonwealth government through IPA and AGs.
- 9.15 In May and July 2005, the LCA and IPTA prepared and sent Submissions to IPA explaining the problems and proposing amendments – the LCA Submissions are **Attachment 2**. The Submissions and covering letter were prepared by the author in consultation with Ian Pascarl the then Chairman of IPC. It was signed and sent to the Australian government by Ian.
- 9.16 The principal Submission was expressed thus –
- 1.3 Therefore in the interests of obtaining a more equitable and effective regime of privilege in relation to patent advisers (lawyers, patent attorneys and patent agents) and to reduce the high cost of discovery of documents in Australian

patent litigation caused by the difference referred to in 1.2(iv) above, **we submit that urgent action be taken to amend the Act to extend patent attorney privilege to foreign patent attorneys and patent agents and to ensure that the privilege afforded to patent attorney communications is to the same extent as that afforded to lawyers.**

- 9.17 The Submissions outlined the inadequacies of patent attorney privilege in Australia. They identified those as including that the privilege only applied to clients of patent attorneys registered in Australia. Further, that it did not (like client lawyer privilege) apply to third parties. It pointed out the Constitutional limitation that flows from patent attorney privilege being sourced solely from statute and not also from common law. It named and detailed the authorities relating to limitations of the protection in Australia. It provided grounds justifying the need for the amendment of s 200(2) of the Patents Act. And, it proposed drafting for that amendment.
- 9.18 In August 2005, IPA published an Issues Paper reflecting on the problems and the Submissions made to it by the LCA and IPTA – **Attachment 3**. IPA raised numerous questions and issues. This was a constructive process for defining what changes in the law would be required. There were differences between the LCA and the IPTA in some matters of detail but not in what they both saw as the main issues – making the Australian law on the protection adequate nationally and as to the protection of overseas IP advice. IPA called for comments on its Issues Paper by interested persons. FICPI-A responded to the IPA Issues Paper in October 2005, and the LCA in December 2005. The response of the latter is **Attachment 4**.
- 9.19 The LCA response foreshadowed the need for Australian reform first and international reform to follow. The LCA observed in paragraph 5.4 of its response as follows:

5.4 The Committee also considers that Australia should show leadership by applying what is a proper standard to achieve the rationale referred to in Section One above which flows from the application of privilege. As the Committee has previously acknowledged, it will be desirable to have a Treaty involving all the major industrialised nations to formalise international recognition of privilege as between them. Australia will come to the process of negotiating such a Treaty from high ground if the privilege applied here (in Australia) already extends to foreign patent attorneys and patent agents.

2006 & 2007

- 9.20 There were understandable differences between the LCA, IPTA, and FICPI-A, as to the potential wording of amendments to the *Patents Act* including in section 200(2). In late 2006 the LCA, IPTA and FICPI-A agreed to obtain the advice of Senior Counsel. Then, and in early 2007, they developed a brief drafted by the author for Neil Young QC to advise on the Constitutional validity of their proposals, including providing advice on the preferred wording – **Attachment 5**.
- 9.21 Mr Young was briefed by Allens *pro bono* acting on behalf of LCA, IPTA and FICPI-A. Thus, the brief reflected the views of all those who had contributed to proposals for the amendment. The

particular persons were Michael Caine, patent attorney, of Davies, Collinson and Cave, representing IPTA and Greg Chambers, lawyer and patent attorney, of Phillips, Ormonde & Fitzpatrick representing FICPI-A, and the author (Allens) as the instructing lawyer representing the LCA and AIPPI-A.

- 9.22 The advice of Mr Young - **Attachment 6**, in particular the wording of section 200(2) which he proposed, became the template used by the IP NGOs for their view on the main amendment going forward. In short, Mr Young advised that the amendment proposed by the sponsors of his brief was valid because the court was in effect bound to decide the scope of privilege of attorneys based on the law of lawyer privilege as it stood when the decision on the attorney's scope of privilege was made, instance by instance. Mr Young preferred the LCA wording (IPTA and FICPI-A suggested different wording) and said the following (cited from his opinion).

56. In summary, I prefer the amendment proposed by the LCA, subject to minor revisions. As revised, the proposed amended section would read:

"A communication to or from, or for the purposes of providing information to, a registered patent attorney or a patent attorney or patent agent of another country in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged as at the date at which privilege is claimed in the same way and to the same extent as a communication to or from, or for the purposes of providing information to, a legal practitioner."

57. In my view, this is the most robust form of amendment. It has the virtue of simplicity, and I consider that the words 'in the same way and to the same extent' are sufficient to allow a court to introduce all of the purposive tests that govern the availability of privilege for communications under the common law.

- 9.23 It is convenient now to jump ahead to 1 April 2013. The wording of section 200(2) of the *Patents Act* which became law on 15 April 2013 is set out below in paragraph 9.25. That was the date when amendments called 'Raising the Bar' made to the Acts generally, came into force. The process of getting the wording right was an extended one as the History below will show. As well, there was a 'battle' at the last moment before the amendments were passed in the House of Representatives, to get the wording which the IP NGOs had proposed to IPA accepted by the parliamentary draftsman. In the end, with help from IPA, the wording which was applied avoided an outcome that could have compromised the effects intended by the IP NGOs including the important point of extending the protection to overseas attorneys.
- 9.24 The promoters of the amendment of section 200(2) – LCA, IPTA and FICPI-A - were rightly pleased with this outcome. They had been consulted by and worked very closely with the then Director General of IP Australia, Mr Philip Noonan, in settling the final wording of section 200(2). The same applied to the equivalent provision in the *Trade Marks Act*, namely section 229(1).
- 9.25 It is interesting to compare section 200(2) of the *Patents Act* before and after amendment. Before amendment, the subsection read as follows.

- "(2) 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."

The new section 200(2) reads as follows.

- "(2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.
- (2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.
- (2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.
- (2C) ***Intellectual property advice*** means advice in relation to:
- (a) patents; or
 - (b) trade marks; or
 - (c) designs; or
 - (d) plant breeder's rights; or
 - (e) any related matters."

9.26 Thus, the new subsection widened the scope for clients of patent attorneys to include records or documents made for the dominant purpose of providing intellectual property advice (ie third party communications as well as those between client and attorney), it extended the protection to an individual authorised to do patents work under the law of another country but limited the protection to what that individual is authorised to provide by way of intellectual property advice, and it provided a definition of intellectual property advice which extended to the usual activities of patent attorneys in Australia. The dominant purpose test 'introduced', used wording in line with that used in the *Evidence Act* 2009. The wording included the formula advised by Neil Young QC that the subjects be privileged in the same way and to the same extent as applied to a legal practitioner. That was designed to bring the scope of client patent attorney privilege as close as it could be to client lawyer privilege.

The intervention in support of the project made by Australian users of the IP system arranged by and through the IP NGOs – the first meeting with the Australian government

- 9.27 Whilst this History has dealt (above) in one hit with the amendments made to the Acts (a process stretching as it did from 2005 to 2013), as at 2006 there had been little progress with the Australian government on actually amending the Acts. A reasonable observer at that point in time, would be excused having the impression that the government might have been thinking that the problem was more one for IP professionals than it was for their clients. To counter the possibility of that impression being right, the author proposed to the IP NGOs that the views of Australian clients be obtained in the form of proofs of evidence, and that those should be tabled in, and in relation to, a meeting with the government attended by the clients. The IP NGOs agreed, and this is what happened.
- 9.28 During the first half of 2007, the IP NGOs supporting change in the law of privilege for clients of IP non-lawyer professionals, brought representatives of corporate users of the IP system into the project. The IP NGOs then engaged in this process were AIPPI-A, FICPI-A, LCA and IPTA. Allens Arthur Robinson acted for the IP NGOs (as it had in relation to Neil Young QC's brief) *pro bono*.
- 9.29 Submissions were prepared and made in writing (dated 7 August 2007) to the Director of IP Australia (then Dr Ian Heath), and to the Commonwealth Attorney-General (then Philip Ruddock) – **Attachment 7**. Those submissions were supported by signed statements made by the persons on behalf of the companies stated below, respectively - **Attachment 8**.
- Jeays Lilley – Director of AstraZeneca Pty Ltd (wholly owned by AstraZeneca PLC).
- Simon Tucker – Vice President, Research, Biota Holdings Limited
- John Cox – Intellectual Property Consultant, CSL Limited
- Jackie Fairley – CEO, Starpharma Holdings Limited
- Jane Perrier – General Counsel, IP, Telstra Corporation Limited
- 9.30 In each case, the representatives of IP users stated their support for the IP NGOs' submissions including the particular submissions that had been made as follows.
- AIPPI to WIPO dated 26 July 2005 (which is **Attachment 1** above).
 - LCA to IP Australia dated December 2005 (which is **Attachment 4** above).
 - LCA, FICPI-A and IPTA to IP Australia dated 5 July 2007 (which is **Attachment 6** above).
 - AIPPI-A, LCA, FICPI-A and IPTA to the Commonwealth Attorney-General dated 7 August 2007 and the supporting statements by users of the IP system (which are **Attachments 7** and **8** above).

- 9.31 Taken overall, the IP users' submissions asserted as to non-lawyer patent attorney privilege, that as it only extended to communications between clients and Australian registered patent attorneys, it was insufficient. They supported the IP NGOs proposals for the extension of privilege to third party communications involved in the advising process. They also supported Australian privilege applying to overseas equivalents of Australian patent attorneys. They further supported the AIPPI proposal for a treaty agreeing on minimum standards of privilege. All this was urged on the Australian government to achieve a better and more secure regime for getting IP professional advice in Australia. The IP users stated their need for client privilege of wider scope (as above) to better provide for open and frank exchanges of information and advice between them and their IP professional advisers, here and overseas.
- 9.32 In relation to the submissions and statements referred to above, a meeting was held between representatives of the IP NGOs, some of the IP users (referred to above) and representatives of AGs and of IPA at the offices of Allens Arthur Robinson in Melbourne on 31 August 2007. The persons who attended for AGs included Chis Creswell (IP Consultant to the AGs), and for IPA – Philip Spann – then Assistant General Manager, Patents and Plant Breeders Rights, Opposition, Hearings and Legislation and Jeff Carl – Assistant Director, Domestic Policy Section. The purposes of this meeting from the IP NGOs' points of view, included the following.
- It enabled the government representatives to experience firsthand that the problem was one of substantial practical concern to IP users.
 - The government representatives were able to discuss with IP users the way the problem was impacting on the businesses of IP users.
 - It enabled the IP NGOs to establish that AGs and IPA were on the same page as the IP NGOs in relation to the need for national and international changes.
 - It allowed the Australian government representatives to outline for the understanding of the IP NGOs and the IP users alike, what limitations and hurdles lay in the way of the government making the changes advocated by the IP NGOs.
- 9.33 The last point draws in two matters. First, Chris Creswell had had as a previous employee lawyer in AGs, substantial experience in negotiating changes of international law (particularly in copyright) in WIPO. He outlined to the IP NGOs the challenges he thought would be expected in dealing with WIPO. As the project would inevitably involve working with WIPO, that was valuable input for the Australian IP NGOs none of which had persons with firsthand experience of working with WIPO (except the author in relation to the WIPO/AIPPI Conference in May, 2008) described in paragraph 9.36 and following, below.
- 9.34 Secondly, AGs was then some way down the track in making extensive amendments to the Commonwealth Evidence Act including as to client lawyer privilege. The AGs' representatives warned of the need they had to coordinate the amendments which the IP NGOs were proposing in the Acts, with the Evidence Act amendments.

- 9.35 The work in the lead up to this meeting including the submissions to Ian Heath and Philip Ruddock, interviews with and preparation of statements of senior executives of client users of the IP system, invitations to and securing the attendances of all those who attended the meeting at Allens Arthur Robinson and the meeting itself, were an experience of one aspect of the complexity for the project in achieving change and an example of the positive cooperation between the IP NGOs and the Australian government which occurred in relation to the project. This positive cooperation was to occur repeatedly as described later in this history.

The WIPO/AIPPI Conference on Privilege – Geneva, 22 and 23 May 2008

- 9.36 As related in paragraph 8.10 above, it was ICC's intervention with WIPO following up on the adverse effect of the AKZO decision (September 2007) which played an important part in causing WIPO to join with AIPPI in holding the May 2008 Conference on Privilege. At the AIPPI SG EXCO meeting in October 2007, Ron Myrick, then President of AIPPI and Chairman of the IP Committee of the ICC, had moved the Bureau of AIPPI to constitute Q199 (Privilege Task Force) and to appoint the author as its Chairman, and the Bureau set up Q199 accordingly. About that time, Ron Myrick had met with Francis Gurry at WIPO in Geneva, and subsequently, he informed Q199 on the basis for making preparations for the Conference, as follows.

- WIPO would provide its facilities and services for the Conference. It would in effect be like a mini meeting of the Member States, joined by the IP NGOs. Member States would be invited by WIPO to attend but it was not expected that they would attend in the numbers they would normally for meetings of the SCP. WIPO would provide simultaneous translation, permanent recording of the proceedings and would share with AIPPI the responsibility for chairing the sessions.
- AIPPI would draft the Program, arrange the speakers and chairmen and settle the papers to be in harmony and of even quality. The papers could not be too subjective in their content – they needed to produce a comparable outcome. (Thus the author produced an objective template for the papers. Following this enabled reasonable comparison.)
- AIPPI would be responsible for achieving by the speakers chosen, a balance between common and civil law expertise, lawyers and attorneys, developed and developing countries, countries with the protection, and some whose law on the protection was less than adequate, and so on.
- WIPO and AIPPI would publish the papers on their websites. (WIPO did more than that. It published a CD of all the presentations. Ron Myrick distributed the CD to about 300 US companies – **Attachment 9.**)

- 9.37 In November 2007, the author devised with Reporter General Jochen Buehling a Questionnaire addressed to NGs of AIPPI. This was sent out to more than 70 of its PTFRs in Q199 - **Attachment 10.** The brief for answering the Questionnaire included aspects of the project's history to date – Q163 Resolution, the AIPPI treaty proposal, a Provisional Program for the

WIPO/AIPPI Conference, the agenda for the AIPPI-A and LCA et al meeting with the Australian government on 31 October 2007, details of the companies' representatives at that meeting including their statements identifying the failings of Australian law on the protection and how that impacted on them. **Attachment 10** includes a copy of each of the foregoing documents except the AIPPI treaty proposal. That proposal is **Attachment 1**.

- 9.38 The purposes of the brief for answering the Questionnaire included the following.
- To provide papers to be used by the PTFRs in engaging and updating their governments on the project.
 - To encourage the PTFRs to 'buy into' the project and get their governments to do so as well.
 - To clarify for the PTFRs and their governments the purpose of the cooperation between AIPPI and WIPO in relation to scoping the problem (ie a principal objective of the AIPPI joint Conference with WIPO) and achieving a mandate for WIPO to lead the Member States in studying the problem.
- 9.39 Reporter General Jochen Buehling and the author were responsible for all aspects of quality in the preparations for and presentations at the WIPO/AIPPI Conference.
- 9.40 The Conference was duly held in Geneva. There were more than 70 participants from more than 40 countries. The speakers were from 15 countries – 6 from civil law and the rest from common law countries. Three of the common law speakers were from developing countries – namely, lawyers Dato Kandan and Chew Phye Keat (both from MY) and Pravin Anand (IN). The List of Participants at the Conference is **Attachment 11**.
- 9.41 The Program of the Conference is **Attachment 12**. It raised subjects including the following – the problem, the scope of the protection under both systems of law, pitfalls and obstacles for clients operating in multiple jurisdictions, the public interests involved in the protection being made good, what had happened to the protection in litigation, changes of law caused by experiences adverse to the protection, the status of the protection in the context of in-house counsel, and prospects for improving the protection.
- 9.42 The author chaired the session on 'Scope of privilege and issues in some law systems'. He presented on the Australian aspects of 'Outcomes of litigation' and 'Needs arising in relation to client/IP professional privilege in particular countries: AU, CA, UK, US'. His slides on 'Outcomes of litigation' are **Attachment 13**, and his paper on prospects for improvement is **Attachment 14**. The author was also a panellist in formal discussions with Conference attendees under the chairmanship of AIPPI's then Assistant Reporter General, Thierry Calame (a lawyer from CH). The other panellists represented FR, MY, CL, CA and the UK.
- 9.43 The Conference was praised by Philippe Baechtold of WIPO as 'an unqualified success'. One of the measures of its success was what it contributed in the restarting meetings of the SCP in WIPO. The data it produced on the inadequacies of the protection was a substantial make weight

for WIPO in persuading the Member States to mandate WIPO to begin studying the problem. That was put to the test one month after the Conference was held, at the WIPO meeting SCP 12 in June 2008 (see paragraphs 10.2 to 10.10 below). The author received a very positive letter of thanks dated 4 June 2008 from Francis Gurry. That letter and the author's report dated 24 June, 2008 to the PTFRs about the Conference (for their respective NGs) are **Attachment 15**.

- 9.44 The papers and slides of the speakers at the Conference are published on the WIPO website – https://www.wipo.int/meetings/en/details.jsp?meeting_id=15183&la=EN
- 9.45 To draw wider attention to the outcome of the Conference, the Conference was reviewed in a report by the author which was published in the July/August 2008 edition of Patent World, under the title '**A matter of privilege**' - **Attachment 16**.
- 9.46 The report in Patent World specifies the key points which were established in the Conference. In short, it concluded that the Conference had substantiated the need for changes to national laws and for the making of an international agreement to give practical effect to the protection of IP professional advice from forcible disclosure (including as to such advice from overseas. That practical effect was needed (it was said) in support of public interests – one example of which was cited as the need to support the obtaining of correct legal advice. The report asserted that both public and private interests underlie the need for the protection. The Patent World report also commented on the need for harmonisation of laws relating to the protection and on how the process of reform of laws relating to same, could proceed.

10 Second Stage - Studies of the problem

Following the May 2008 WIPO/AIPPI Conference – Q199's activities up to and including the WIPO SCP 13 meeting in March 2009

- 10.1 The outcome of the Conference was reported to the PTFRs in Q199 on 24 June 2008 - **Attachment 17**. That report provided a snapshot of the Conference and went on to promote the PTFRs' attendance at the then forthcoming Congress of AIPPI in Boston in September 2008. Workshop VI of that Congress was scheduled to be on the work of Q199 – in effect, an interactive seminar on the protection and on the project going forward.

WIPO Meeting SCP 12: 23 to 27 June 2008

- 10.2 As already said, this meeting in June 2008 was positive for WIPO and the Member States. For some time, the SCP had been missing in action. For this meeting, WIPO had previously produced and provided a Report to the Member States – 'Report on the International Patent System' – updating them on current issues relating to the patent system. WIPO provided AIPPI with a copy of this Report. Part of the Report (paragraphs 259 to 262) referred to '**Professional Privilege**' - **Attachment 18**.
- 10.3 In paragraphs 259 to 262, WIPO acknowledged the problem in some detail, ie lack of the protection and where it exists, the potential for loss of the protection. In paragraph 262, WIPO

acknowledged AIPPI's Resolution Q163 supporting the provision of attorney-client privilege for patent and trade marks attorneys generally.

- 10.4 After the SCP 12 meeting, AIPPI received an invitation from WIPO dated 24 July 2008 to make submissions on the WIPO Report referred to above. AIPPI accepted that invitation and followed up as related below.
- 10.5 The input requested from the PTFRs dated 28 August 2008 is **Attachment 19**. The report to the PTFRs went into detail on a number of topics. The brief to them was informed (among other things) by the WIPO/AIPPI Conference and discussions at that Conference between the author, Philippe Baechtold of WIPO, and numerous colleagues of the author in AIPPI.
- 10.6 Referring to the request for input, it requested, for example –
- on prospects of a treaty, whether a Recommendation (an alternative strategy to a treaty) would be enough instead of a treaty,
 - if a treaty was required, how the differences between common law and civil law could be managed,
 - on overseas professional advisers (an aspect of the scope of the protection), what if anything should be required beyond being qualified in the place where the advice was given, and
 - on national laws, whether third parties involved in the advising should be included in the scope of the protection.
- 10.7 The subsequent submission was settled by a sub-committee comprising the author and experts from CN, CL, UK, FR and DE with further input by the Reporter General Jochen Buehling. That submission dated 31 October 2008 - **Attachment 20** was sent by AIPPI to WIPO.
- 10.8 The submission of 31 October 2008 in summary asserted –
- most countries provide the protection,
 - mostly it was not adequate in scope,
 - the national protection of IP professional advice was often lost by cross-border transmission,
 - there was a need for the protection to be made adequate nationally and internationally, and
 - WIPO should be mandated to study how harmonised national laws (with international support), could be made to achieve for IP professional advice, national and international protection from forcible disclosure.
- 10.9 The SCP 12 meeting was positive for AIPPI (as well as for WIPO and its Member States). As related above, it was AIPPI's main aim at this stage in the project that WIPO should be mandated to study the problem of the protection. In paragraph 8(c) of the Summary by the Chair (SCP/12/4 Rev) **Attachment 21**, the Chairman identified four issues on which the WIPO

Secretariat was mandated to prepare preliminary studies. The fourth topic specified was 'Client-Attorney Privilege' (CAP). The **Attachment 21** contains the Agenda, the part of the WIPO Report on the International Patent System which deals with Professional Privilege (259 to 262) and Annex pages 57 to 62 in which AIPPI's Submission for SCP 12 is recorded.

- 10.10 In the second half of 2008, there was an encouraging level of activity on CAP both for AIPPI and for WIPO. Whilst AIPPI was preparing its submission on what arose out of the SCP 12 meeting and in advance of the SCP 13 meeting, WIPO's Secretariat was preparing (as mandated at SCP 12) its preliminary study of CAP. This became the published WIPO document SCP/13/4. At about the same time, Q199 was preparing for, and then holding, a Workshop at the AIPPI Boston Congress the latter in September 2008.

Workshop VI – Boston Congress, September 2008

- 10.11 For this Congress, a paper was published by AIPPI. It was sent to all the PTFRs (representatives from more than 70 countries). At the Congress, the author presented on the paper and topics using slides entitled 'Workshop VI – Privilege Treaty'. The paper addressed the topics – first, the Australian position on client privilege and secondly, the outcome of the WIPO/AIPPI Conference. The slides are **Attachment 22**. The paper is **Attachment 23**.
- 10.12 The meeting was attended by around 40 persons and was moderated by the then President of AIPPI, Ron Myrick (US). There were four speakers including the author – lawyers Cristobal Porzio from CL, John Bochnovic from CA and Buckmaster de Wolf from US and representing the multinational GE Company. So, in effect, three of the speakers were from common law countries, and one was from a civil law country.
- 10.13 A report of the proceedings in the Workshop was prepared by Ron Myrick and the author. It is **Attachment 24**, and that report was published by email to the PTFRs. The report records in summary form, the presentations of each of the speakers including the Australian position. There was substantial support from the floor at the meeting for both the analysis of the speakers and their recommendations for action in developing the protection.

11 Second Meeting of IP Users in Melbourne with IPA and AGs organized by the IP NGOS – 19 February 2009

- 11.1 Towards the end of 2008, there was a need to refresh the connection made between the Australian government and the Australian corporate users of the IP system. There were a number of reasons to seek this meeting as follows.
- **First**, WIPO was urging AIPPI to request its NGs to engage in the SCP process in support of WIPO being mandated to study the problem. In Australia, the corporate users were additionally credible with the IP NGOs in seeking such Australian government support. This issue (WIPO's mandate) was not a live one at the time of the previous meeting between the Australian government and IP users (31 October 2007).

- **Secondly**, there had been a change of government (Howard to Rudd) with the inevitable changes in the Ministers responsible for policy and action on IP law reform. The AG was now Robert McClelland and the Minister for Science was Kim Carr.
 - **Thirdly**, there had been changes in the relevant staff of IPA - Dr Ian Heath was being succeeded by Mr Philip Noonan and in AGs, Chris Creswell had retired and Catherine Fitch and Kim Williams had been appointed to represent AGs in relation to the Project.
- 11.2 Accordingly, the IP NGOs represented by Michael Caine for IPTA, Greg Chambers for FICPI-A and the author representing LCA and AIPPI-A organised a second briefing meeting to bring the Australian government representatives together with the users.
- 11.3 The proofs of evidence provided by the corporate users for the first meeting were updated including their requests for government action by amending the Acts, their support for WIPO being mandated to study the problem, and the AIPPI treaty proposal.
- 11.4 On 19 February 2009, a meeting was held with Australian government representatives at the offices of Allens Arthur Robinson in Melbourne. Some of the users were represented, and each of the IP NGOs. A copy of the brief supplied to the Australian government for this meeting is **Attachment 25**. The representatives of IPA at the meeting were Philip Noonan - (Director General), Philip Spann - Assistant General Manager, Patents et al and Jeff Carl - Assistant Director, Domestic Policy Section.
- 11.5 The brief contained (among other things) a memorandum (Attachment 5 to the brief) explaining the protection.
- 11.6 A similar brief was sent to all the NGs in AIPPI (ie to more than 70 countries). The version sent to the AIPPI representative for China is **Attachment 26**; as it states, apart from the first paragraph, the email was standard for all PTFRs. Some of the NGs (particularly in civil law countries) needed further information on how loss of the protection overseas could impact on their clients and the IP professionals in their countries. The memorandum provided further information on that issue. There was a further purpose of preparing this brief.
- 11.7 AIPPI needed to provide its NGs (through the PTFRs, Presidents and Secretaries of same) with guidance as to how to go about engaging with their governments, to get the support needed in WIPO for the Member States to mandate WIPO to study the problem. The fact that in Australia, the IP NGOs were in the process of updating the Australian government, was a convenient opportunity to give the NGs encouragement as to what they might do (adapted to their circumstances) to engage with their own governments.

12 **WIPO Meeting - SCP 13: 23 to 27 March 2009**

- 12.1 This was the first SCP meeting at which Q199 was represented. To enable all readers to appreciate the process, some explanation is necessary.

- 12.2 Each SCP meeting followed a particular format. In a rather vast room at WIPO like the General Assembly meeting of the UN, the delegates of the Member States are seated in alphabetical order of the names of their countries, with the flags of the respective nations on the desk in front of them. The meetings are run from the podium by the Chairman chosen by the Member States, and officers of WIPO who assist the process. The IP NGOs are arranged in a single row behind the many rows of the delegates. After the meeting is opened by the Chairman and a WIPO representative, the delegates make their oral submissions on general matters. Then follow the oral submissions by the NGOs on such matters. Simultaneous translation makes for rather slowly conducted proceedings.
- 12.3 After that, the meetings proceed in accordance with the Agenda which had been adopted by the SCP. The delegates speak first, one by one, on the respective topic, followed likewise by the representatives of the NGOs. The records kept by WIPO include the Agenda, any WIPO reports or expert reports on particular topics which are to be dealt with in the meeting, and a Summary of the Chair which includes any agreed directions on the way forward following the meeting. A most important record created and maintained, is the WIPO Report of the meeting. This is in effect an edited transcript of what is said. An annexure to the Report is the List of Participants at the meeting. The records of the meeting can be located on the WIPO website by searching using the particular descriptor of the meeting, such as for this meeting - 'SCP 13'. Submissions made in writing by invitation prior to the meeting, are recorded on the 'SCP Electronic Forum' and can be located by searching under that description. Other written submissions are published on the WIPO website – see the link in 9.44.
- 12.4 For SCP 13, **Attachment 27** includes the Agenda, pages from the Report including all those on CAP (67 to 80) which record AIPPI's oral submissions on CAP at page 75 and 72 and the List of Participants. For subsequent SCP meetings attended by AIPPI reported in this history, the attachments for WIPO meetings are limited as far as possible to the Agenda, and an extract from the Report of the meeting on CAP which includes AIPPI's oral submissions, and in some cases, the Summary of the Chair.
- 12.5 Apart from the formal side of these meetings, at each SCP meeting reported in this history, the AIPPI representatives had numerous discussions on the law of the protection and the proceedings of the meeting, with WIPO lawyers, leaders of the other IP NGOs and the delegates of the Member States, including those opposed to AIPPI's views.
- 12.6 Naturally, there was close cooperation between the representatives for AIPPI and the representatives of IPA. The close relationship between AIPPI and the former Deputy Director General of WIPO, Professor François Curchod (formally representing CEIPI) in these meetings, was helpful to AIPPI in developing strategies, obtaining introductions to WIPO representatives and particular delegates of the Member States. Such relationships and cooperation were indeed positive to the progress AIPPI was able to make on the project through the SCP process.

- 12.7 The background for AIPPI at SCP 13 included, it will be recalled, the revival at SCP 12 of the holding of SCP meetings after a substantial break with no such meetings. Other positive features of the meeting were a forward Agenda projected from the SCP 12 meeting which included the mandating of WIPO by the Member States at that meeting to prepare a Preliminary Study of CAP. The publication by WIPO of its study SCP/13/4 had occurred shortly before the SCP 13 meeting. Further, AIPPI had provided written submissions to WIPO in relation to CAP for SCP 13, on the outcome of SCP 12. Those Submissions are **Attachment 20** to this History.
- 12.8 At SCP 13, there was a wide range of views expressed from positive to negative as to CAP being studied in the SCP. AIPPI was not distracted by this wide range of commentary. The strategic aim of AIPPI (and other IP NGOs) was to promote and support a mandate for WIPO to study the problems of CAP until they could be fully understood by both delegates of the Member States and the IP NGOs. Only then, could the issue of remedies be pursued.
- 12.9 The oral Submissions made for AIPPI reported in **Attachment 27**, included these elements.
- The problems are present and real – courts in AU and CA had recently (2003 and 2004) forced disclosure of non-lawyer patent advice.
 - The WIPO/AIPPI Conference had established that the protection from forcible disclosure included public interests in enforcing the law and in supporting the giving of correct advice.
 - One should not be negative about laws needed to support public interests. It is not surprising that many countries already have law supporting the protection and thus, the public interests involved.
 - In the absence of the protection, the adoption by IP professionals around the world of strategies to avoid the adverse effects of forcible disclosure, were wasteful (in terms of cost and delay) and adverse to full and frank communications between IP professionals and their clients.
 - Thus, more detailed studies of the problems were needed.
- 12.10 The outcome of SCP 13 was positive for WIPO and for the project. WIPO was mandated to do further studies of CAP. AIPPI and other IP NGOs were invited by WIPO to join in the process for SCP 14. These matters were duly reported to the NGs in the author's Report on SCP 13 - **Attachment 28**.
- 12.11 Subsequent to the report on SCP 13, the then President of AIPPI, Thierry Mollet-Vieville, a French lawyer, strongly engaged with Q199 on the need for study of the difference between lawyer professional privilege and litigation privilege. One of his concerns was that merging the two categories of privilege would mean that the exceptions and limitations that apply to lawyer professional privilege, would be applied by the proposed international agreement to litigation privilege to the detriment of that category of privilege if it was to be part of the minimum standard.

12.12 At this stage in its development, the project had not reached the point of studying whether, and if so how, exceptions and limitations would impact on any international solution. That issue was recognised by Q199 as needing study as part of the subject of remedies. This point (the need to allow common law countries to have exceptions and limitations) is one to which we will come in this history when the intervention in the project by Professor John Cross of the University of Louisville Law School is described (see Section 13 below). The publication of Professor Cross's helpful critique of the AIPPI proposal for a treaty at the meeting on INTA in April 2009, was imminent but unknown at this time (March 2009).

Updating the leaders of Q199 following SCP 13

12.13 Following SCP 13 the report to the leaders of Q199 as to the leadership and activities of Q199 as follows.

- The author said he would step down as Chairman of Q199 at the end of the Paris Congress in September 2010 and recommended that Steven Garland (CA) be appointed Chairman to succeed him. The author stated that he was prepared to continue in the committee as a Co-Chair to assist Steve in the role of Chairman.
- Q199 had to be represented at two AIPPI meetings before the Paris Congress – an AIPPI Executive Committee (**EXCO**) meeting in Buenos Aires and in November 2009, and a meeting of the Korean Group of AIPPI.
- The author was not going to be able to attend the BA meeting and there was a clash between the Korean meeting and the WIPO SCP 14 meeting then scheduled to be held in Geneva in November 2009.

12.14 It was agreed that Steven Garland would cover both of the AIPPI meetings (BA and Korea). The author would prepare the Q199 papers for BA and Steven Garland for Korea. The author would prepare the AIPPI submission for and attend the WIPO meeting SCP 14 in Geneva, for AIPPI.

12.15 In relation to the submissions for SCP 14, Q199 was requested by Philippe Baechtold of WIPO, to investigate further and update WIPO on the differences between civil and common law in relation to the protection.

12.16 Further, the author accepted an invitation about this time by the Intellectual Property Society of Australia and New Zealand (**IPSANZ**) to speak at its conference on IP in Auckland, NZ in September 2009.

12.17 For the SCP 14 meeting, Q199 needed to respond to all points raised by the Member States at SCP 13, which were adverse to WIPO continuing to study the problem. Q199's position was that by the end of SCP 14 meeting, WIPO and the Member States should have sufficient information on the problem to move to the next phase of work in WIPO, ie studying remedies.

12.18 The foregoing matters (among others) were dealt with in the Q199 Chairman's Report to the Reporter General (Jochen Buehling) on 18 May 2009 - **Attachment 29**.

13 The intervention in the project by Professor John T Cross – University of Louisville School of Law – International Trade Marks Association (INTA) meeting in April 2009

- 13.1 This intervention was welcome – at last, academic professional interest in the drafting of AIPPI's treaty proposal! John Cross's paper entitled 'Evidentiary Privileges in International Intellectual Property Practice' was delivered by him at the annual meeting of INTA in April 2009 - **Attachment 30**.
- 13.2 At that point in time, there had been no interest in AIPPI's treaty proposal, published by any third party. The treaty proposal had been made by AIPPI to WIPO in 2005. Those in action on the project (principally WIPO, governments, AIPPI and the IP NGOs) were focussed on studying the problem. AIPPI was (as suggested by WIPO) keeping the lid on mentioning remedies generally, and anything called a 'treaty', in particular.
- 13.3 In his paper, Professor Cross acknowledged the problem in detail. As to the international solution, he concluded that AIPPI's proposal was 'a first positive step towards solving the problem'. He said the proposal needed to be developed to make provision for the application of existing exceptions to privilege preventing disclosure of legal advice, such as, if the case involved crime or fraud.
- 13.4 Professor Cross was correct – AIPPI's proposal was a first step and did not purport to be complete. As well as the issue of allowing for exceptions raised by John Cross, there were other issues – like whether limitations should apply. Such a limitation could be whether the subject claimed to be privileged had been prepared for the 'dominant purpose' giving legal advice.
- 13.5 Professor Cross's comments were taken up by Q199 when AIPPI became able to raise in WIPO the issue of studying remedies (after SCP 14). Later, Professor Cross made further contributions to the project as a speaker at the Colloquium organised by the IP NGOs - AIPPI, AIPLA, and FICPI, which was held in Paris in June 2013 – see Section 63 below.

14 The Chairman's Report to the Bureau for Q199 for the AIPPI EXCO meeting in Buenos Aires – 10 to 15 October 2009

- 14.1 This Report is dated 16 June 2009 - **Attachment 31**. Steven Garland attended that meeting and spoke to this Report (among other things) at that meeting.
- 14.2 Particular points made in the Report were as follows.
- The issue being studied in the SCP at this time was the problem – nature of, and scope. Member States needed to be brought onto a similar level of understanding of the problem.
 - Further submissions in writing had been invited by WIPO for the SCP 14 meeting, with a 31 August 2009 deadline. AIPPI would respond to that invitation. By its submissions,

AIPPI would deal with some of the difficulties raised by the Member States at the SCP 13 meeting which included the following.

- Common law and civil law differences.
- Reality of the problem as it applies in civil law countries.
- Why the problem affects IP professional advice in particular.
- The balance to be achieved between the need for disclosure and prohibiting disclosure.
- What exceptions should apply.
- The notion of the protection as expressed in the acronym CAP was by now rather too narrow as a title for the work.

15 Review of the working structure of Special and Standing Committees of AIPPI - 19 June 2007 - Attachment 32

- 15.1 The reader of this History may have cause to wonder at the detail and diligence of AIPPI's work. The work of AIPPI is analytical and seeks to provide the basis for carefully thought out practical solutions. As it involves many countries, such solutions need to be created by a process which is open to input from all of its members.
- 15.2 Q199 is a Standing Committee which in this context is the same as a Special Committee, just one with a longer term. Following a meeting of the leaders of the WIPO Standing and Special Committees at the AIPPI Congress in Boston, as previously mentioned, the author was requested by the then Reporter General, Jochen Buehling, to write a Report on this topic. What did this request have to do with the project?
- The reasons stated by the Reporter General for the request included the level of activity of Q199 as an SC and the process which was applied by its leaders in dealing with its mandate and business.
 - The process of setting up and operating a Special Committee of whatever term was, as the reader might expect, one involving due diligence at every level, as follows.
 - Each Special Committee has to have a mandate and protocol on how it is to operate.
 - The relationship of the Special Committee with the Bureau is vital; the Bureau can and should contribute to the work of the Special Committee.
 - It is normal that the main work will be done by a few people but they need to reach out both to the committee members (as in Q199) and members of AIPPI at large, to get their 'buy-in' as to what the Special Committee is doing.
 - Performance of the Special Committee and its leaders should be continuously assessed by the Bureau through the appointed Bureau contact.

15.3 The review acknowledged other points made by the leaders of Special Committees who had attended the meeting of Special Committees in Boston. Whilst nothing can substitute for reading the comments in the review in full, two of the points stand out to be mentioned here.

- The work of Special Committees needs to be periodically, and on a timely basis, reported to the members of AIPPI.
- Any sign that a Special Committee is treating its mandate as something it owns (including by being unresponsive or being moribund), should involve immediate replacement of the relevant personnel.

16 23rd Annual IPSANZ Conference – Auckland, New Zealand, September 2009

16.1 The paper presented for AIPPI at this Conference was entitled 'Privilege in IP Litigation Practice' - **Attachment 33**. The slides which the author prepared and used in support of the presentation, are **Attachment 34**. Information about the relative positions of Australian and NZ law was required, and the paper was intended to supply that.

16.2 The attendees at this meeting (more than 100) included Australian and New Zealand IP lawyers, patent and trade marks attorneys, Lord Hoffman - from the House of Lords in the UK, and government representatives including from the NZ IP Office and IPA.

16.3 The objectives of AIPPI's support for this IPSANZ Conference were as follows.

- To update the attendees on progress of the AIPPI project in WIPO and encourage all attendees to get the delegates of their governments in WIPO, to 'stand up' in WIPO in support of WIPO study of the problem and to allow it to then study remedies.
- To encourage AIPPI's NZ members to make further progress in amending their law on the protection particularly in relation to its extension to third parties involved in the process of giving legal advice.
- To emphasise the fact that NZ was ahead of AU in reform of the protection and point out the detail of that in order to encourage Australian attendees to urge the Australian government to catch up by putting the Australian IP NGOs proposals for changing the Acts into action. The Australian progress on effecting the amendments needed, was described in the AIPPI paper presented at the meeting as 'disappointing' (see 7.8 in the paper).
- To learn more about the effects of legal process in NZ from the experience of NZ IP professionals and to share with them the experience on equivalent matters in AU.

16.4 The conference was a turning point in Australian government activity in moving on the amendments proposed by the IP NGOs, to the Acts. That was effected by Terry Moore of IPA who has already been mentioned for this event above in relation to IPA in paragraphs 5.6 and 5.7.

- 16.5 There is an inclination, if not policy, on both sides of the Tasman to cooperate in trying to have the respective IP laws of NZ and AU, in harmony. Where AU was then in relation to client privilege in IP professional advice, was short of the mark, as follows.
- 16.6 NZ was ahead of AU (since 2006) by applying privilege where the adviser was an overseas equivalent of an NZ attorney.
- 16.7 Australia was then nominally ahead of NZ in recognising that privilege applied to communications with third parties (like technical experts) where those communications related to the IP professionals giving legal advice. The reason that it was only 'nominally' ahead, is that the Australian law was a common law decision (of Federal Court judges in *Pratt Holdings v Commissioner of Taxation* (2004) 136 FCR 357) and it was at that stage uncertain whether that approach would remain the law. In NZ, there was the distinct possibility that this principle would be applied there too – it just needed an NZ case to be decided on the point.
- 16.8 In the context of this meeting, it was very helpful to the author to have discussions around how the relevant law on privilege was developing, with two of the leading authors in NZ on the topic – Andrew Brown QC and Rosemary Wallis – their published works on the topic are acknowledged in paragraph 1.4 of **Attachment 33**.
- 16.9 Turning to AIPPI's paper (**Attachment 33**) – it has two parts. The first is about the problem. The second is about reform of the law in NZ, AU and internationally by the IP NGOs cooperation with WIPO.
- 16.10 Paragraph 7.14 of the paper described the strategy of studying and defining the problem first, then the remedies. Then, in paragraph 7.15, the paper identified where the study of the problem in WIPO was headed at that time and the topics with which AIPPI's next submission to WIPO (for SCP 14), would have to deal, as follows.
- 7.15 As the chronology in 7.13 indicates, the delegates of the Member States raised a number of issues for expansion of the WIPO Report SCP/13/4 at their meeting in Geneva in March 2009. The following needs or issues were raised by the Member States in particular.
- Expanded commentary on civil law protection.
 - Expanded commentary on common law protection.
 - Comparison of the civil law and common law forms of protection.
 - Scope of protection by common law privilege explained.
 - Justification of the 'public interest' being paramount.
 - The relevance (if any) of Articles 2(3) of the Paris Convention, Article 3 of TRIPS, and GATS Mode 4.
 - The potential demand for expansion of privilege to other professionals, if it is applied to IP professional advisers.

- Exceptions to professional secrecy and privilege.
- Effect (if any) which the introduction of privilege may have on free assistance offered by National Offices to users.

AIPPI will make a submission to WIPO to deal with each of these issues (among others).

16.11 The foregoing description links neatly to the next step in Stage Two which was the AIPPI submission to WIPO for SCP 14, dealing (among other issues) with most of those specified in the previous paragraph.

17 The AIPPI Submission dated 31 August 2009 for SCP 14 (25-29 January 2010)

- 17.1 The AIPPI Submission dated 31 August 2009 for this meeting - **Attachment 35**, involved more reactive collaboration between AIPPI members than occurred for most of its submissions to the SCP. It was a Submission invited by WIPO.
- 17.2 The Submission was drafted by Steven Garland, Wouter Pors and the author (the then leaders of Q199). It included contributions from President Thierry Mollet-Vieville (France), Reporter General Jochen Buehling (Germany) and PTFR David Hill (USA). When the Submission was sent to WIPO, there was an immediate reaction – Tomoko Miyamoto (then assistant Head of the Patent Section) sent an email to Messrs. Buehling and Dowling on 2 September 2009 - **Attachment 36**. That email stated that the commentary on WIPO document SCP/13/4 in the AIPPI submissions would be published on the WIPO SCP Electronic Forum, which it was.
- 17.3 The Submission explains its context in the Opening. A vital function of the Submission was to update WIPO and its Member States on AIPPI's learning on privilege in civil law. 'Privilege' is a rather different device in civil law than privilege is in common law. This learning was vital because (among other matters) the study of remedies could not proceed without first fully understanding what privilege meant in civil law as compared with common law.
- 17.4 A further vital function of AIPPI's Submission was to inform the Member States on points they had raised as 'problems' in the SCP 13 meeting. To an outsider, it would be frustrating that the Chairman of an SCP meeting did not rule as 'out of order', repetition by a delegate of a Member State of what had been proven wrong by data previously provided to the SCP, including data provided by WIPO itself. Those who read the WIPO Report of this and other SCP meetings may be surprised at this (apparent) lack of intellectual discipline. The answer is that diplomacy requires that such repetition be tolerated. Further, those attending such meetings, are delegates of the Member States and are often not qualified patent lawyers or patent attorneys. Further, most of those attending know what is technically right and are used to ignoring expressions of political dogma.
- 17.5 The AIPPI Submission answered issues raised by the Member States directly, that is, AIPPI took each issue as a seriously made point requiring rational explanation even where the point was evidently being made for a tactical reason rather than a rational one.

17.6 Among the topics dealt with in this Submission are the following.

- Common law privilege and civil law privilege are different. The history of each and the differences in them having regard to their different origins were explained.
- Scope and rationale of the protection and its basis in public interests, were explained.
- Whether the AIPPI proposal would expand privilege or just be the same privilege but including clients of other IP legal advisers, was explained.
- The place of exceptions and limitations was conceded as a matter for study.
- The difference between legal advice privilege and litigation privilege in common law was explained.
- The extension of privilege in common law to clients of non-lawyers was explained.
- In Section 6 of the Submission, whether the Paris Convention, TRIPS Treaty or the GATS agreement have any relevance to harmonising the protection, was discussed – in short, they do not.
- Whether the adoption of the AIPPI proposal would open 'floodgates' – ie whether the extension of privilege to clients of non-lawyer patent and trade marks attorneys, would cause demand for expansion to clients of other professionals. This was discussed – in short, there is no experience of this happening anywhere.

18 Drafting problems with IPA's proposals on amendments to the Acts – November 2009 (Attachment 37)

- 18.1 The history turns again to the problems previously raised by the IP NGOs with amendments proposed by IPA on behalf of the Australian government. These are related to the IPA proposals in the Attachment which is IPA's working draft. The IP NGOs proposals were based on the advice of Neil Young QC referred to above in **Attachment 6**. The IP NGOs proposals did not have any of the following problems each of which applied to the drafting which IPA was considering at that time.
- 18.2 The first problem was that third party communications were only covered in the IPA proposals if contained in a confidential document. That seemed to the author to be unintended and to owe its origin in the IPA drafting to the formula in section 118 of the *Cwth Evidence Act 2009* which had the same deficiency.
- 18.3 In the case of lawyers, that deficiency would be overcome by common law following the *Pratt Holdings* case, but not so for patent attorneys who draw the scope of privilege that applies to them, entirely from statute.

- 18.4 A second problem was that the regime for patent attorneys was fixed in time and would not change as common law decisions changed the law applicable to lawyers in the future.
- 18.5 A third problem was that the proposed definition of 'patent practitioner' including those overseas was limited to those permitted to engage in IP practice before the IP office here or in another jurisdiction. That was too narrow to deal with reality because in some places overseas, those permitted to engage in IP practice before the IP office are not required to have any qualifications to do so. The author sent comments to his IP NGO colleagues (Michael Caine and Greg Chambers) on these matters from overseas (London) where he was working with AIPPI on the UK position as to the protection. IPTA and FICPI-A took these issues up with IPA.
- 18.6 The drafting problems being experienced at this time were in some cases influenced by amendments which the government had processed in the *Evidence Act 2009*. In general, those amendments were appropriate for lawyers but aspects of them were not so for patent attorneys.
- 18.7 Subsequently in the New Year (2010), there was a further meeting between IP NGOs and the Director General of IPA on the amendments to the Acts, which is referred to below in Section 28.

19 Q199 Progress Report and Request for Action – 27 October 2009

- 19.1 At the end of October 2009, it seemed likely that the final version of the updating by WIPO of its Report SCP/13/4 would be published before the SCP 14 meeting and that that would end the phase of WIPO studying the problem, making way for it to study of remedies. As it turned out, events took a slightly different course. The WIPO Report SCP/13/4 was supplemented by WIPO by a new WIPO Report - SCP/14/2 (see below).
- 19.2 WIPO asked AIPPI whether it could get the support of the Member States to move WIPO on to studying remedies. AIPPI's progress report to the PTFRs of 27 October 2009 – **Attachment 38**, alerted the PTFRs to the need for an international investigation by members of AIPPI into remedies. This would be analogous to the investigation which had previously been made by AIPPI into the process when WIPO was commencing its studies of the problem.
- 19.3 As to WIPO's request or support from the Member States, AIPPI first needed to get data on remedies and then to make that data available to WIPO. That process was driven by the underlying need for objective data on remedies drawn from as many countries as possible including common law and civil law, developed and developing countries.

20 Preparations for the WIPO meeting SCP 14 in Geneva – issues in obtaining the mandate for WIPO to study remedies

- 20.1 These matters were reflected in an email exchange dated 18 January 2010 - **Attachment 40**. There were two issues relating to WIPO's mandate going forward. **First**, as noted above, the Secretariat of WIPO had suggested that AIPPI should encourage support from the Member States including particularly from developing countries. **Secondly**, the Secretariat indicated that it

might need to establish a Working Group within the SCP, to take the SCP's work on the protection (in particular, on remedies) forwards.

- 20.2 As will be seen in the email exchange attached in **Attachment 39**, AIPPI thought these two avenues would not work. Reality was that nobody from the developing countries being a delegate representing the Member States had sufficient qualifications (common law and civil law), knowledge of the problem and of potential remedies, to 'stand up' to advocate and influence other Member States to support the mandate for WIPO. That was AIPPI's position on the first issue.
- 20.3 On the second issue of establishing a Working Group, such a Group could only be established by a vote in the SCP. Again, that seemed to AIPPI to be too hard to achieve because there was insufficient understanding among the delegates of the Member States as to where the work of such a Working Group might lead.
- 20.4 AIPPI's position was that the study of the problem had been organised and directed rather well by the Secretariat of WIPO, so following that course again in studying remedies, was likely to be successful.
- 20.5 The author recommended that AIPPI through the Reporter General should report AIPPI's views to Francis Gurry in accordance with the foregoing, and submit to him that AIPPI should be permitted by the Secretariat to address the Member States (meaning at SCP 14) on the investigation of remedies which AIPPI proposed to carry out through its own resources. Further, AIPPI would report to the Member States that the results obtained would be made available to WIPO before SCP 15 (which was then scheduled to be held in October 2010).

21 The joint submissions of AIPPI-A & APAA-A to IPA on the amendments proposed to the Acts in January 2010 - Attachment 40

- 21.1 As described in Section 18 above, the amendments which IPA was proposing appeared to the IP NGOs to be affected by amendments made by the *Evidence Act 2009*. The IP NGOs regarded the IPA's proposals as problematical.
- 21.2 The author discussed these issues with Terry Moore of IPA in late 2009. She had suggested that the IP NGOs should submit their positions to IPA in writing.
- 21.3 As the **Attachment 40** shows, AIPPI was unable to coordinate all the Australian IP NGOs into making the one submission on behalf of all of them, on this occasion. AIPPI-A was joined by APAA-A in making the submission attached. The submission attached was intended to influence changing the IPA proposals for amending the Acts for a number of reasons, among them the following.
- 21.4 It was submitted that the drafting instructions by IPA to the parliamentary draftsman should require amendments which applied privilege to oral communications with third parties as well as documented ones. Further, wording should be used (it was submitted), to obtain for clients of attorneys the benefit of common law decisions made from time to time. Further, the wording

should include the established dominant purpose limitation. These proposals, it was pointed out were in accordance with the advice on drafting by Neil Young QC (see **Attachment 6** above).

- 21.5 Further, it was submitted, the wording proposed by LPA in providing the standard for inclusion of persons (including those overseas) in the Australian regime for client patent attorney privilege – "... permitted to engage in intellectual property practise [sic] before the Intellectual Property Office of Australia or other jurisdiction", was inappropriate because there were some countries which did not limit who could act before their IP Office. As privilege in common law requires a relationship of reliance, trust and confidentiality, the inclusion of persons without any formal qualifications, would be contrary to the spirit of our law.
- 21.6 The IP NGOs thus regarded the formula for inclusion as proposed by IPA, to be too wide. The submission made jointly to IPA by AIPPI-A and APAA-A also provided proof from Germany and the UK that each of those allowed persons without qualifications applicable equivalent of those in Australia, to act before their IP Offices – see attachments 2 and 3 within **Attachment 40**.

22 Q199 Questionnaire dated 19 January 2010 – Remedies to protect the right of clients against forcible disclosure of their IP professional advice - Attachment 41

- 22.1 This Questionnaire was drafted by Steven Garland (CA), Wouter Pors (NL), Reporter General, Jochen Buehling (DE), and the author. It sought data relating to potential remedies which might be adopted. The Questionnaire was essentially addressed to NGs of AIPPI. As the invitation in the Attachment shows, it was circulated not only to the PTFRs, but the Presidents and Secretaries of the NGs, the Bureau and other leaders of AIPPI.
- 22.2 The process of answering the Questionnaire attached was aided by Working Guidelines (**WGs**) dated 15 January 2010 (which are part of **Attachment 41**). The WGs were also drafted by the author and contributed to by others as described in the previous paragraph.
- 22.3 The Questionnaire (read in light of the WGs), first dealt with categories related to remedies that could be relevant starting with the 'Present Position' – and dealing with –
- what protection was then provided,
 - whether overseas communications were protected
 - what the scope was of the protection as related to professional qualifications of the adviser,
 - whether and, if so, what limitations and exceptions were applied.

Then there was a rather critical issue – whether the protection thus provided was adequate when related back to the answers in each of the categories of question under the 'Present Position'.

- 22.4 After the 'Present Position', the Questionnaire turned to 'Remedies', and the NGs were asked what should be applied looking forwards. Particular questions asked were –

- What limitations (like dominant purpose) and exceptions (like crime/fraud) should be allowed?
 - Whether there should be judicial discretion?
 - What qualifications should the IP advisers have?
 - Whether and if so, what differences between lawyer/client and client privilege should be acknowledged?
- 22.5 In Section 5 of the WGs, an alternative to AIPPI's treaty proposal was described. That proposal originated from the ICC. The NGs were asked – which of the two proposals (AIPPI's or ICC's) they preferred.
- 22.6 The NGs were also asked if they had another proposal for a remedy which they preferred. They were further asked, whether they had any general comments on remedies for the problem.
- 22.7 The questions were designed to enable computer analysis of the answers. This enabled the outcome to be presented in graphical format which was rather effective as shown in **Attachment 53** below.
- 22.8 The Questionnaire was reissued by Jochen Buehling and the author on 3 February 2010 - **Attachment 42**. This was an update of the earlier mailout by email of 19 January 2010. The update was necessary and its predecessor has been included in this history, for the following reasons.
- 22.9 At SCP 14 (which occurred in Geneva in late January 2010 and is reported in Section 23 below) some of the Member States raised concerns that further studies by WIPO might be incomplete if they did not deal with potentially adverse effects of the expansion of privilege to non-lawyer IP advisers. The first version of the Questionnaire preceded SCP 14. In the second version, AIPPI added two further questions to the Questionnaire in order to garner information to deal with this issue. These matters were reported by Jochen Buehling and the author in their reissue email of 3 February 2010 accompanying the reissued Questionnaire.
- 22.10 In particular, the NGs were asked to provide details of any adverse effects they had experienced or expected they might in the future experience from introducing or expanding protection against forcible disclosure of IP professional advice. As will be later reported in **Attachment 53** below, the response across the NGs was that no adverse effect had been experienced or was expected.

23 AIPPI's contributions to the WIPO meeting SCP 14

- 23.1 The documents in **Attachment 43** are on the WIPO website. They record (among other things) the interventions made on behalf of AIPPI at this meeting. The author was AIPPI's Q199 representative at this meeting.
- 23.2 The documents from SCP 14 attached comprise the Agenda which states as Item 7(c) 'Client Attorney Privilege' and refers to WIPO Reports on CAP - SCP/13/4 and SCP/14/2. The

attachment also includes a number of pages from the meeting Report which is WIPO document SCP/14/10. These pages show the representations of Member States and IP NGOs at the opening of the meeting including in paragraph 57 of the Report, the author's opening statement on CAP on behalf of AIPPI at the meeting. Paragraphs 115 to 145 which comprise all the further oral submissions on CAP, are included as is the List of Participants at the meeting.

- 23.3 The List of Participants shows the range and depth of participation in the CAP issue in WIPO, in particular, many of the persons with whom the author engaged in the proceedings of this meeting.
- 23.4 As to CAP, the first oral intervention for AIPPI (at page 57) occurred during the 'General Discussion' which normally occurs at the opening of each SCP meeting. The author first cited the standing of AIPPI - 8,000+ members, representing more than 60 countries. He pointed out that the 'CAP' acronym as a subject is narrower than the topic being dealt with under that heading. He explained that the subject had by then become in effect 'the protection' ie the provision of measures against forcible disclosure of IP professional advice. Lack and loss of the protection comprise 'the problem', he said. He then pointed out that AIPPI had contributed to the pursuit of solving the problem in WIPO by its support for the WIPO/AIPPI Conference and by the two (written) submissions of October 2008 and August 2009 (which are **Attachments 20 and 35** to this history).
- 23.5 Further, AIPPI's work in preparing a Questionnaire to obtain data from AIPPI members around the world for the study of remedies, was reported. The author outlined what had to be taken into account. He hoped that AIPPI would be able to present its data to WIPO (and thus to the SCP) by SCP 15. (AIPPI in fact achieved that, as related below in Section 32.)
- 23.6 When the subject of CAP was reached in the meeting, there were second and third oral interventions on behalf of AIPPI, as follows.
- 23.7 **First**, as described in paragraph 134 of the WIPO Report, the author pointed out the futility of an argument that had been put forward in the meeting against WIPO studying the problem. That argument was that 'the protection' is a matter for private law (ie national law) not public law. The author submitted the argument to be futile because national law cannot (on its own) solve the problem. Both national and international law are involved in any global solution, he said. AIPPI needed the international (cross-border) problem to be resolved. AIPPI's efforts to come up with data on the status quo of the problem and how it can be resolved nationally and internationally, were based on a remedy involving both national and international law. The author stated that AIPPI would be obtaining data on remedies from its NGs and that data would be shared with WIPO.
- 23.8 **Secondly**, at paragraph 144, the third oral intervention for AIPPI is recorded. The first point dealt with was a claim made in the meeting that the protection would draw a veil over information that should be public, like information related to the validity of an application. On that, the author pointed out that the protection from disclosure is narrow – only communications between client and lawyer or attorney on legal advice for the client. So, facts such as prior use, prior publication,

lack of title and so on, would not be under the protection from disclosure, he submitted. Not only was the protection narrowly applicable to legal advice, but that same protection had been provided for clients of lawyers for many decades without causing the 'veil' issue which had been raised. The author pointed out that what is changing is not the nature of the protection itself but a widening of the category of persons qualified to advise the clients to whom the protection would apply. The creation of non-lawyer IP professionals was a national economic development which should be supported, he said. He pointed out that the same advice that has been given by lawyers and the experts whom they have had to engage, is now frequently being given by attorneys who have both legal and scientific qualifications, and by the experts they engage.

- 23.9 The second point in the third AIPPI intervention dealt with another argument raised in the meeting against WIPO studying the problem. That point related to the Paris Convention and the TRIPS Treaty. It was said by some developing countries that the reservations in Paris and TRIPS that they do not affect national procedural law (which continues to apply), meant that as 'the protection' is a procedural matter, WIPO has no right to be studying remedies for the problems.
- 23.10 On this point, the author submitted that reserving procedural matters to be dealt with under national law in the implementation of those treaties, did not relate to making laws to secure the protection of clients in relation to disclosure of their legal advice. The reservation in the treaties is about national laws being applied in implementing those treaties – by contrast, the investigation of CAP is about having national and international laws as necessary to resolve the problem of lack and loss of protection from forcible disclosure of legal advice. That was a different matter, he said. He further pointed out that, in any event, the reservation of the right to make procedural laws nation by nation, assumed that such laws would be effective. In this case, they would not be effective because national laws could not on their own solve the cross-border adverse effects of the problem.
- 23.11 After that, AIPPI's further work on the problem was foreshadowed including studies of remedies, limitations and exceptions. The author indicated that there would be substantial and necessary future work for the SCP on CAP which would have nothing to do with the procedural reservations in Paris or TRIPS.
- 23.12 The author observes that the misunderstanding or adopted posture involved in the Paris/TRIPS argument by some developing Member States, falls at the first hurdle. As a matter of categorisation (ie of recognising what the reservations related to), the reservations apply to management of the implementation of those treaties. Further, it would indeed be surprising if the argument raised was right because it would prevent WIPO from studying the problem and its remedies. WIPO did not acknowledge the problem they raised. Further, if the argument was right, that would mean that by making of those treaties (Paris and TRIPS), the signatories had limited their rights to make law on subjects different from those dealt with by the treaties. AIPPI was suggesting that that could not be right.

- 23.13 The Summary by the Chair item on page 63 in **Attachment 43**, shows that no mandate was in fact agreed by the Member States for WIPO to study remedies at this point (29 January 2010). Subsequently on 14 April 2010, WIPO invited AIPPI (among others) to send written submissions on its Report SCP/14/2 by 31 July 2010. Thus, whilst there was no mandate to study remedies, there was ongoing work on CAP in relation to WIPO's Report SCP/14/2.

24 The Terms of Reference (ToR) of Q199

- 24.1 In May 2010, with the approval of the Bureau of AIPPI, the leaders of Q199 proposed updating the ToR of Q199 – see **Attachment 44**. The attachment shows the size of the committee comprising Q199 and its breadth of representation. It reflects the nature of its work and the change of its name proposed at that time to reflect the wider scope of its activities. Those activities had become such that the title 'Client Attorney Privilege' was inappropriate. It was then thought that the title 'Client Privilege in IP Professional Advice' was more appropriate.
- 24.2 The author observes even this 'new' description is now out of date. The appropriate title is one and the same as the definition of 'the protection' ie 'Protection of Confidentiality in IP Professional Advice'. The name of Q199 in its ToR has not as yet been brought up to date.

25 AIPPI Asian Group's Meeting – Pusan (Korea) (6-9 May 2010)

- 25.1 The author attended this meeting of AIPPI Asian Groups organised by the Korean Group of AIPPI. For that he prepared and spoke to a paper on the then current work of Q199 - **Attachment 45**.
- 25.2 This paper provides a snapshot of the position AIPPI had reached on the project at this point in time. It urged the AIPPI Asian Groups to get involved in persuading their governments to assert in WIPO (in the SCP) that there is no counter (or bargaining chip) which opponents of the mandate to study remedies could credibly 'trade' for their agreement in the SCP to WIPO studying remedies. The reason was that developing and developed countries already provided the protection nationally, albeit in many cases, inadequately. Very few countries extended the local protection to cover advice obtained overseas. Thus, failure to remedy the problem would mean that for both developing and developed countries, the protection they were providing locally would not extend to cross-border advice. So, improving the law on the protection would in most cases, make good both for developed and developing countries, the law which they already had.

26 Interim comment on Responses to the AIPPI Q199 Questionnaire on Remedies

- 26.1 By the end of June 2010, the responses of the NGs to the Questionnaire had started to flow in. As one might expect, many of the NGs had to be contacted on more than one or two occasions by the leaders of Q199 in order to get the Responses needed for the database on the status quo of the protection and how the countries could legally implement reform. The process of getting reliable responses in such an exercise is not an easy one. Each NG had to canvas its membership on all the questions. The subjects were challenging!

26.2 Q199 decided that the message to be conveyed to AIPPI at its forthcoming Congress in Paris and then (if so resolved in Paris) to WIPO, would have greater impact if reported by numbers and graphs. To achieve that type of presentation, the Responses had to be epitomised. A protocol was agreed between Steven Garland and the author. They split the Responses between the two of them to draw down the data required to fulfil the protocol. The epitomes they made are in **Attachment 53** which is referred to in Section 34 below. The protocol by which the Responses would be epitomised is also contained in **Attachment 53**.

26.3 The results of the Questionnaire are dealt with later in this history in the papers for the Paris Congress below – see Section 34 below.

27 Strategy with Asian NGs of AIPPI and APAA in pursuing mandate for WIPO to study remedies

27.1 Q199's efforts to garner support for the Member States in the SCP to mandate WIPO to study remedies included raising awareness and getting the active involvement of the NGs of the APAA, as well those of AIPPI and FICPI in Asia. The way AIPPI connected with the NGs of APAA was through APAA-A. Chris Owens of APAA-A drove the process for APAA-A. There was also cooperation with by AIPPI with APAA (the international body) in Geneva – see **Attachment 46**.

27.2 The reader will rightly have cause to wonder why Q199 pursued these developing countries to 'stand up' for a mandate for WIPO to study remedies if the author (as explained above and in **Attachment 39**) thought that this strategy would not succeed. The reason for this effort was that WIPO had not given up on it succeeding. Thus, AIPPI and other IP NGOs felt obliged to do their best to get support from particular developing countries for the mandate required for WIPO to study remedies, notwithstanding that they thought the 'stand up' would not happen.

28 Further progress on amending the Acts

28.1 Towards the end of May 2010, IPA drew the IP NGOs into its process, again in relation to instructing the parliamentary draftsman on the form of the amendments. Terry Moore, as Director of the Director-General's office, was involved in obtaining for IPA, the commentary of the LCA and AIPPI-A. The author's response to Terry in that context is **Attachment 47**.

28.2 Two main issues were emerging. **First**, getting the phrase 'in the same way and to the same extent' established in the Bill. That was the phrase recommended by Neil Young QC to get clients of attorneys as nearly as possible onto the same level of the protection of clients, as for lawyers. **Secondly**, the description of overseas attorneys had to be vetted internationally to see whether it was (as proposed) in accordance with the reality of those persons overseas who are not lawyers but are qualified to give legal advice to clients in patent and trade marks matters.

28.3 The IP NGOs (namely LCA, AIPPI-A and APAA-A) each of which Allens was then representing in relation to submissions to IPA, thought the Australian law providing the protection should not be extended to the client of an overseas person who had no formal qualifications to act for that

client. This point had been made to IPA previously. The explanation was expanded but the end point remained the same. The precept for that view was that the protection exists in our law partly on the basis of the trust which exists between the client and the IP professional adviser. If the adviser has no qualifications to advise, there is, in our law, no basis for any trust which is required for the protection.

28.4 The history will return to this topic again, later – see Section 37 below.

29 Further efforts to persuade governments – India, Pakistan (PK), Thailand (TH), Malaysia, Singapore, Indonesia (ID) and Philippines (PH) – on mandating WIPO to study remedies

29.1 On 12 July 2010, Q199 sent a brief by email to the PTFRs for each of these countries - **Attachment 48**. The objective of this mailout was to assist the addressees to make co-operative efforts with their IP NGO colleagues to have successful connections with their respective governments. The success which Q199 wanted them to achieve through those contacts, was persuading their governments to mandate WIPO to study remedies.

29.2 The email in the attachment pointed out that the study of the protection currently 'survived' on the SCP agenda but that mere 'survival' on the agenda was inadequate to enable WIPO to carry out studies on remedies. Among the points made in the brief (suggesting what the PTFRs might submit to their governments), were the following.

- Failure to support the mandate for WIPO would mean failure to support their own law. The effect of that would be that local protection would continue to be lost when local advice was sent overseas.
- Not one country in the SCP had advanced any reason to justify risking a damaging or negative effect on its own law relating to the protection.
- Technical legal issues advanced by some of the Member States against the studying of the problem and remedies, had been shown to be wrong. Thus, continued adherence to those 'technical legal issues' should be seen for what they are – an attempt to provide a plausible sounding pretext for saying that WIPO should not invest time and effort in studying remedies – but in fact, a pretext without merit. If it had merit, WIPO would have had to take notice of it. WIPO was silent on these pretexts.
- The brief supplied directions to the PTFRs of each of the countries in the heading of this paragraph. As the author attended both SCP 13 and 14 (both referred to in the brief), Q199 was specific in directing the PTFRs on what (if anything) the delegates of their respective governments had done or said in those meetings.

29.3 There is no report on the outcome of this effort by AIPPI, nor should that be expected. The relationship between the citizens of other countries and their governments about their governments' policies internationally, are not often published. Perhaps a good reason for that is

that such lobbying is not likely to be effective if made public. One can only observe that at SCP 15, there was no veto of WIPO studying remedies. That is part of what the IP NGOs wanted to achieve. The second part (which was also achieved) is reported below (in Section 35); WIPO was enabled to study remedies.

30 July to December 2010 – preface

- 30.1 There was something of a crescendo in these months of 2010. The main coming events were the AIPPI Paris Congress - 3 to 10 October and WIPO's SCP 15 meeting which followed immediately after that – 11 to 15 October.
- 30.2 For Q199, the Congress and SCP 15 were a watershed for AIPPI in persuading WIPO through the SCP, to study remedies. At the Congress, Q199 was to report the outcome of its Questionnaire on remedies to AIPPI members, and to get an AIPPI Resolution to provide the results of Q199's Questionnaire to WIPO, including for the SCP 15 meeting and beyond that.
- 30.3 As part of the drive by Q199 to get support for WIPO being mandated to study remedies, Q199 had decided (notwithstanding its misgivings about the strategy) to get its PTFRs in particular developing countries, including Asian ones to make special efforts to win support for WIPO being mandated to study remedies. Q199's thinking was that the developing countries might be persuaded to abstain from voting against it at best, but even that was unlikely. They might vote for it but certainly they would not advocate for it. No delegate would have the background sufficient to explain or defend such a position. That was fully understandable because the issue of the protection was highly technical, legal, and involved both systems of law. By and large, the delegates of the Member States were not trained in either of the two systems of law, let alone both.
- 30.4 Further, post the study of remedies, in Q199 we foresaw the likely outcome to be that WIPO could not be mandated by the SCP to implement any solution. What then could happen to take AIPPI's project forward?
- 30.5 It seemed to us that the most likely positive outcome would be that some leading developed countries could take up the need for an MLA. They would then negotiate that between themselves. Hopefully that could be negotiated and agreed between a mix of civil and common law countries. In Q199, we identified a WIPO mandate to implement a remedy as – 'Plan A', and implementation of a remedy between some developed countries as – 'Plan B'. AIPPI-A began the process of getting 'buy in' to Plan B by reaching out to IPA on this topic, about this time (the latter half of 2010).
- 30.6 The recurring needs for submissions by AIPPI to SCP meetings applied to SCP 15 as well. Thus, Q199 decided to work on promoting the results of the Questionnaire process, and to report that at the Congress in Paris and at the SCP 15 meeting.
- 30.7 About this time, the appeal decision in the ECJ case on AKZO decision was delivered (*Akzo Nobel Chemicals & Akros Chemicals v Commissions & Ors (Competition)* [2010] EUECJ

C-550/07 (14 September 2010)). This was a blow to corporates – the appeal decision confirmed that inhouse counsel could not (in the EU) have the independence from their employer necessary for privilege to apply to their legal advice to their employer.

- 30.8 That seems to be the end to this issue for all European countries. There is a strong cultural element in the decision. Notwithstanding that in common law countries such advice can be privileged – ie it depends upon the circumstances as to whether independence from the employer has been maintained in giving the advice - that is not the position in civil law countries. In those countries, mere employment means there is no possibility of independence.

31 Responses to the Q199 Questionnaire on Remedies

- 31.1 In relation to epitomising the Responses to produce data that could be compared and presented graphically, over 2-3 months before July 2010, the author and Steven Garland (then Co-Chair of Q199) developed a template for epitomising the Responses. They split the Responses between them and, prepared the epitomes for each individual Response, as previously described – the template is **Attachment 49**.
- 31.2 The epitomes are referred to and attached to the Q199 Report to the Bureau in Section 34 below. The results of the epitomes were analysed and converted into graphs and pie charts which comprise part of Q199's Report to the Bureau for the AIPPI Congress in Paris.

32 AIPPI's Submissions for SCP 15

- 32.1 AIPPI and others were invited by WIPO's email of 14 April 2010 to lodge Submissions for SCP 15, by 31 July 2010. AIPPI's objective was to have WIPO expertise applied to studying remedies for the problem. Q199 could not present WIPO with the results of its Questionnaire on remedies before they were presented to the Bureau and before AIPPI resolved to provide that data to WIPO. Knowing that the data would only get to WIPO (if so authorised at the AIPPI Paris Congress) a few days before the start of SCP 15, it was clear that the full impact of AIPPI findings would come later than the SCP 15 meeting. It was however, desirable to support WIPO by giving the SCP a 'heads-up' on the findings which supported the study by WIPO of remedies.
- 32.2 Thus, in Section 4 of the Submissions for SCP 15, AIPPI reported in a preliminary way on the outcome of its Questionnaire. The WIPO invitation of 14 April 2010 and the AIPPI Submissions for SCP 15, are **Attachment 50**.
- 32.3 First, Q199 explained what the questions were, then how the responses were treated (as described in paragraphs 31.1 and 31.2 above), and then after observing that the full results would come later, in paragraph 4.6 it was stated, as follows.

- 4.6 For the purposes of these Submissions in support of WIPO being mandated by the SCP to conduct further studies of CAP in particular in relation to remedies, two numbers stand out to be reported now.

What percentage of the countries represented by the 47 Responders, provide the protection (in some form) – **96%**

What percentage of those countries which provide the protection (as above) consider the protection (i.e. of local and overseas communications) which they provide, to be **inadequate** – **73%**

And, AIPPI submitted in paragraph 4.7, as follows.

4.7 AIPPI submits for the reasons specified in these Submissions including the percentages stated in the previous paragraph, that the good cause for the SCP to mandate WIPO to conduct further studies of CAP, particularly in relation to options for remedies, has been established without doubt.

- 32.4 By any measure, the finding that IP professionals of 47 (later 48) countries had reported that 96% of them had the protection in some form and 73% of the 96% reported that the protection they had was inadequate – identified a serious deficiency.
- 32.5 The Submissions of AIPPI also itemised those IP NGOs which supported studies of remedies at SCP 14, explained why AIPPI was disappointed with the lack of an SCP mandate for WIPO to study remedies, and dealt with (explaining what was wrong with) the 'issues' raised by IN, PK, Argentina (AR) and Venezuela (VE) at SCP 13 and 14.

33 Publications supporting the study of remedies

- 33.1 There were (at least) two audiences outside WIPO which Q199 needed to reach in its efforts to support WIPO being mandated to study remedies – first, in AIPPI itself and secondly, in the IP professions generally around the world.
- 33.2 For those two audiences, we arranged two publications in September 2010. First, the AIPPI News (an online service to the 8,000 members of AIPPI) published on page 3 the serious finding of the Q199 Questionnaire process the 73% of 96% of Responders (48 countries) saying that the protection from forcible disclosure of IP legal advice their countries provided, was inadequate - **Attachment 51**. Further, the AIPPI News invited members of AIPPI to come to Paris for the forthcoming debate on CAP.
- 33.3 The second publication was an article by the author and Isaac Lowrie then a lawyer in Allens, published in the September 2010 edition of Intellectual Property Magazine under the title – 'Privilege at the crossroads' - **Attachment 52**. The article reported the good progress of studies of the problem in the SCP but asked – would it go further than that? Was the process at a crossroad because the SCP had not mandated WIPO to study remedies?
- 33.4 The article further reported on AIPPI's answers on issues raised in the SCP by IN, PK, and VE. It then provided a preliminary look at the IP professionals' thoughts in many countries about the protection their countries provided. If remedies were to be applied, what were those to be? The article provided the following guidance.

- The need for one country to recognize and respect what constitutes effective protection from forcible disclosure in another.
- The need to identify and study, in the context of potential remedies, the inadequacies and the anomalies of the protection which currently applies.
- Limitations, exceptions and waivers: how do they fit into a harmonized protection regime?
- The need for "certainty" of protection to achieve the confidence necessary for full and frank transfer and sharing of information between clients and their IP professional advisers including third parties involved in the clients being advised.
- The qualifications required of IP professional advisers for their recognition in countries beyond their home jurisdictions.
- What should be the nature of protection to be applied internationally? How is it to be obtained and is a minimum standard required? If so, what will be its scope?

34 Q199's actions in relation to the AIPPI Congress in Paris – 3 to 6 October 2010

- 34.1 The Report to the Bureau on the outcome of Q199's Questionnaire sent to members of AIPPI, was prepared by Q199, approved by the Bureau and in the EXCO of AIPPI, and the Resolution sought by Q199 authorising the Report to be provided to WIPO, was passed. The Report is **Attachment 53** and the Resolution is **Attachment 54**.
- 34.2 The Report was in effect an up to date 'wrap up' of the work which had been done by AIPPI and WIPO on the protection. It described the negative position in WIPO (no mandate to study remedies) and the consequent delay from February to September 2010 in its process of studying the protection. A positive element reported was the work which Q199 had done in that period by its Questionnaire process. That work should be valuable to WIPO, the Report predicted.
- 34.3 The Report then identified the Responders (48) and the non-Responders (7). Section 6 reported Q199's analysis of the Responses, by graphs. In Section 7, Q199 described the indications for the study of remedies that it considered should be referred to the SCP, including the following.
- The need for countries to recognise (meaning respect) the protection provided in other countries.
 - The need to deal with the inadequacies and anomalies of the protection as it then stood.
 - Limitations, exceptions and waivers (which were part of established law) for which allowance needed to be made.
 - 'Certainty' as the standard to be achieved to make the protection workable.
 - What qualifications should be required of overseas professionals for recognition of the protection applicable to their IP legal advice.
 - How the protection to be agreed as 'standard', should be defined.
- 34.4 The Report also described Q199's efforts to reach out to APAA and FICPI in particular developing countries so that a coordinated approach could be made by the local IP professionals in those countries to persuade their governments to support WIPO studying remedies in the SCP.

- 34.5 Finally, the Report proposed the Resolution required to enable AIPPI to provide WIPO what was called 'the AIPPI Resources' (ie the documentation of the Questionnaire process detailed in paragraph 9.2 of the Report in **Attachment 53**).
- 34.6 The Report in **Attachment 53** states that it has nine attachments to it. In this History, the documents provided do not include the Report's attachments 2 and 3. They are AIPPI's Submissions to SCP 13 and SCP 14 which are already attached to this History as **Attachments 20** and **35**. Nor do they include the Report's attachment 5 which comprises the raw Responses received from the NRGs – they are voluminous and, in any event, their effect is conveyed by the epitomes in Attachment 6 to the Report which are included.

35 WIPO's SCP 15 meeting – 11 to 15 October 2010

- 35.1 This meeting in Geneva was attended by the author for Q199, particularly to advocate in support of a mandate for WIPO to study remedies. In **Attachment 55** relating to this meeting, the WIPO documents included are the Summary by the Chair and the WIPO Report of the meeting (limited to the part of it which relates to CAP) to which, as usual, there is attached the official List of Participants which shows the international substance of the audience.
- 35.2 The Chairman of the SCP meeting provided a positive outcome on the mandate for WIPO to study remedies by having that approved in the form – 'the Secretariat were to prepare a study taking into account the comments made by Member States'. There were of course those whose 'comments' were in favour and those that there were against. A study of remedies would have to deal with the pros and cons of remedying the problem. The Chairman's intervention was a sophisticated way of handling opposition to WIPO being mandated to study remedies.
- 35.3 As for the Report, the oral submissions made on behalf of AIPPI occurred both in the 'General Declarations' which opened the matters being debated (see paragraph 33 of the Report) and in the 'Client-Attorney Privilege' item (see paragraph 128 of the Report).
- 35.4 The first submissions made for AIPPI dealt with the big picture – the future on the CAP issue of the SCP's agenda. It referred to the SCP having made great progress in studying the problem, and the fact that it had baulked at the prospect of studying what to do about it. This put the SCP at a crossroad as to its future in dealing with the protection. This was frustrating. The SCP's own good work had established that the protection existed widely but was inadequate. The factor of loss of the protection for legal advice sent overseas through non-recognition of the qualifications of overseas legal advisers, could only be resolved internationally, it was said. The new non-lawyer IP profession was unable to get the support needed to function properly by having the 'full and frank disclosure' principle applied to it. This position was contrary to the intention of existing national laws, it was said. AIPPI's Questionnaire process on remedies had produced data valuable for the study of remedies by WIPO and AIPPI had supplied that data to WIPO. AIPPI urged the Member States to mandate the Secretariat of WIPO to conduct the necessary studies.

35.5 The second submissions dealt with more specific issues relating to the studies of remedies. First, there was no basis to deny further study on the argument that application of privilege from disclosure supported fraud (as it was said by the opponents). It was pointed out that the two (existing) WIPO studies (namely SCP/13/4 and SCP/14/2) had dealt with that issue. Secondly, the outcome of the AIPPI's Questionnaire showed that there is a serious deficiency in the protection – ie the 73% statistic that the protection is inadequate. To that, should be added the 22% statistic for non-recognition by countries of other countries' non-lawyer IP advisers - breathtakingly short of the mark. Qualifications of IP advisers, limitations, exceptions and waivers needed to be studied and included in the remedy adopted, it was said. It was submitted further that WIPO and the Member States should use the results of the work carried out by AIPPI in its studies.

36 Recognition by WIPO of AIPPI's contributions to the work of WIPO on CAP - Attachment 56

- 36.1 By letter of 6 October 2010 (which was the last day of the Paris Congress of AIPPI), AIPPI sent the 'AIPPI Resources' to WIPO under the hand of Jochen Buehling (then the outgoing Reporter General of AIPPI) and the author as Chairman of Q199. This occurred just before the SCP 15 meeting which commenced on 11 October.
- 36.2 Following SCP 15, by letter of 5 November 2010, Francis Gurry thanked Jochen Buehling and the author for the valuable contributions AIPPI had made to the work of the SCP on CAP.
- 36.3 Further, Francis acknowledged AIPPI's cooperation with WIPO in these words –

I should also like to take this opportunity to express my appreciation for the excellent cooperation existing between AIPPI and WIPO. I look forward to its continuation and further development.

37 Further efforts on amending the Acts - March 2011

- 37.1 In about March 2011, IPA invited interested parties to make submissions to IPA on an Exposure Draft of the Intellectual Property Laws Amendment (Raising the Bar) Bill of 2011. Allens again acted **pro bono** for the five IP NGOs in dealing with this request as it related to CAP. The submissions sent to IPA on behalf of AIPPI-A, APAA-A, FICPI-A, IPC and IPTA dated 16 March 2011 are contained in **Attachment 57**.
- 37.2 In summary, those submissions asserted as follows.
- The current drafting of the amendments did not meet the requirement for certainty.
 - It did not achieve a regime for client/attorney privilege equivalent to that of lawyers.
 - It did not extend the protection to communications with third parties.

- The requirement of 'sole and dominant' as to IP professional advice for the purpose of communications to be protected, was different from what applied to lawyers – the word 'sole' was an 'add on' which would have a substantial adverse effect compared with the 'dominant' standard applied to lawyers.

37.3 There were other problems as **Attachment 57** shows. The submissions of the IP NGOs took IPA through the law and experience in practice which was driving the IP NGOs' views and concerns with the current drafting. They explained the Constitutional issue and what Neil Young QC had recommended to overcome the problems arising in relation to that issue. They set out the law relating to the 'sole purpose' test. The IP NGOs urged the need for the drafting to make it clear that the 'communications' to which privilege would apply, would include both oral and documentary ones. The submissions made extensive proposals for changes in the drafting of the Bill to produce what the IP NGOs desired to achieve certainty on each of these points.

37.4 IPA subsequently appointed a meeting on 24 May 2011 to discuss the IP NGOs concerns and proposals with IPA. Unfortunately, that meeting occurred when the author was in London working on the privilege project with the UK Group of AIPPI (see the following Section). The meeting between other representatives of the IP NGOs (including Richard Hamer of Allens for IPC and Michael Caine of Davies Collison Cave for IPTA) was constructive. As a result, the IP NGOs had to sit back and await the outcome of IPA's subsequent discussions with the parliamentary draftsman.

38 AIPPI preparations for SCP 16 – scheduled for 16-20 May 2011 in Geneva

38.1 During the WIPO meeting SCP 15, it became apparent to the author from discussions with delegates of the Member States that AIPPI submissions for SCP meetings were not getting through to the delegates of the Member States. AIPPI had wrongly assumed that delegates would read submissions it made to WIPO because they were routinely posted by WIPO on the SCP Electronic Forum (part of the WIPO website), or in another part of the WIPO website.

38.2 Q199 submissions made by AIPPI to WIPO had been through an approval process in AIPPI. That is, they were regularly sent in draft form for approval, first by the leaders of Q199, and then after any amendments were made, they were sent to the NGs for approval usually through the PTFRs. Q199 decided after SCP 15 that proposed submissions should thereafter be sent to the NGs' Presidents and Secretaries as well as to the PTFRs for approval, and if so approved, they should then be submitted to their governments. They were asked to get their governments to support AIPPI's position when their delegates had the opportunity to do so in the SCP meetings.

38.3 Thus, by way of example, see **Attachment 58**. This contains the email which the author sent to the NGs after approval by the leaders of Q199, with the draft of AIPPI's submissions for SCP 16. It requested their action as described above. This particular example contains an acknowledgement of the work of Q199 by the PTFR for Bulgaria (BG) who was Olga Sirakova, and confirmation of her request for action by the government of BG.

- 38.4 As to AU, the Australian government's positive response to AIPPI-A's request for its support in the SCP for WIPO to study remedies, is contained in Philip Noonan's email to the author of Tuesday 8 February 2011 – **Attachment 59**.
- 38.5 The Submissions of AIPPI for SCP 16 are in **Attachment 60**. The subjects of the Submissions are summarised in paragraph 1.5 of that document. They were AIPPI's views expressed in Sections on – Primer, Disclosure, the Development Agenda, WIPO document SCP/15/6 PROV, Remedies and WIPO's mandate. The making of AIPPI's Submissions for SCP 16 was well received by WIPO – see the letter dated 15 March 2011, from Francis Gurry to Thierry Calame and the author, which is included in **Attachment 60**.
- 38.6 The Submissions made the following points (among others).
- Only one country in the world at that time recognised and provided the protection as applied in its own country for the clients of specialist IP legal advisers overseas – that was **NZ**.
 - Some delegates thought that the protection would potentially obscure data which should be disclosed to government patent offices. The mistake in this thinking, is explained in Section 3.
 - In previous SCP meetings, some delegates had asserted that treaties like TRIPS and Paris made the protection a matter for national law. Why this proposition is wrong is explained in Section 3.
 - The fact that privilege does not affect an applicant's disclosure obligations is also explained in Section 3.
 - The Development Agenda Group (**DAG**), a developing countries' group in the SCP, had raised the issue whether the study of CAP was inconsistent with the DAG manifesto. In Section 4 of **Attachment 60**, AIPPI explains why the study of CAP by the SCP is consistent with the DAG manifesto.
 - In Section 5, AIPPI explains why the views expressed by BR and IN in SCP/15/6 PROV, are incorrect. In short, BR's assertion that the study of remedies could not have a positive outcome was a subjective prediction by it as to what the studies would show. AIPPI suggested that no such conclusion was reliable without the studies being carried out. IN had raised arguments that TRIPS or Paris treaties prescribe that the study of CAP is a matter for national law, that you cannot fix the problem without involving law dealing with subjects other than patents, and that better application of the protection would only better obscure what should be disclosed. AIPPI responded in Section 5 of **Attachment 60** to each of these points.
 - And finally, in Section 6, AIPPI summarised from WIPO reports and AIPPI's previous submissions, what needed to be investigated by WIPO in relation to remedies – thus, in effect, supporting the studying of remedies by WIPO.

The Guiding Principles of the DAG are included in **Attachment 60**.

- 38.7 Further in relation to improving the impact of AIPPI's Submissions, Q199 reported by email of 1 March 2011 to the PTFRs (**Attachment 61**) on the process of them contacting their respective governments. The first step in relation to AIPPI's proposed submissions for SCP 16 (then forthcoming in May 2011) was to get the NGs' approval of the proposal which had been sent to them in draft form. As **Attachment 61** shows, there were already 50 positive responses by AIPPI NGs.
- 38.8 The second step was to obtain their action in advocating the submissions to their respective governments. The letter said that Andri Hess (Q199 Committee) would track their reports as to their briefing of their governments. A protocol was set for the timing of the brief to the governments, meetings with governments and reports on their governments' positions.
- 38.9 The detail of this process enables the reader to see that submissions made by AIPPI in WIPO in this instance, had been approved in advance by the members of AIPPI. In the run up to the SCP 16 meeting, that process was taken to a higher level by including the requirement of connecting with their respective governments. In effect, following this protocol meant that the submissions of AIPPI in WIPO had been approved by numerous persons who were, of course, both members of AIPPI and citizens of their respective countries. In many cases, they had connected with their governments about AIPPI's respective Submissions.
- 38.10 The 'connection' made with the Australian government – by email of 15 March 2011 in **Attachment 62**, was made following the protocol outlined above. Through those submissions to the Australian government, AIPPI informed the Australian government on, and supplied it with, its Submissions to WIPO for SCP 16. As well, AIPPI-A urged the Australian government to support the AIPPI Submissions in the SCP process. That protocol was carried out from country to country where there were NGs of AIPPI.
- 38.11 In April 2011, WIPO published its Report SCP/16/4 REV on CAP. That Report was directed to the confidentiality of communications between clients and their patent advisers.
- 38.12 The Report followed on the decision at SCP 15 (October 2010) that the WIPO Secretariat should prepare a study which took into account comments made by the Member States during SCP sessions. The Introduction to the Report, directs the reader to take WIPO's previous Reports on CAP (SCP/13/4 and SCP/14/2) into account with this new Report.
- 38.13 The Report thus created a basis for the suggestion in the Introduction, that the Committee could come to some common understanding as to the basis 'for pursuing the topic further'. The study presented a non-exhaustive list of subjects 'that may be relevant to discussions on this subject at the international level'.
- 38.14 Following the usual protocol for approval of Submissions to WIPO, AIPPI generated Submissions in respect to SCP/16/4 REV dated 4 May 2011 and sent them to WIPO in time for SCP 16. The AIPPI Submissions are **Attachment 63**.

38.15 In the introduction to its response, AIPPI congratulated WIPO for its Report, highlighting these positive points made in the Report.

- The focus on confidentiality at the centre of both common and civil law on the protection, was helpful.
- The purposes of the protection are common to both systems of law – obtaining correct advice, enforcing the law, efficiency in the administration of justice.
- Potential future studies include – problems caused by failing to protect legal advice from forcible disclosure.
- Mechanisms to be applied in solving the problems.

As to the last two points, AIPPI supported further study on mechanisms and options for solving the problems. Further, AIPPI urged that the SCP needed to decide how to determine which of the potential mechanisms should be preferred for solving the problems of CAP.

38.16 AIPPI observed that the protection had a 500 year history in the common law and a 200 year history in civil law. That is the backup to AIPPI's points that the protection is long established and is not contested. So, the problem relates to how the protection should be deployed so that it is effectively applied to current conditions – not whether the protection should exist. Thus, AIPPI made the following submission –

The acceptance and application by nearly every country on the basis of laws that have been in existence for between 200 and 500 years and the absence of any proposal to abrogate those laws means that the right starting point for the work of WIPO and the SCP should be – how the problems of these laws should be solved so that the laws are made effective in relation to international transmissions of IP professional advice.

38.17 In its Submissions (see paragraph 3.3), AIPPI commented and asked – as follows.

It is not a question of having a fair balance of the views of those who are in favour of the protection on the one hand and those who are not in favour of it on the other. What is the logical basis for the protection not being applied to patent advisers (ed ie non-lawyer patent attorneys and agents) when that same advice will continue to be protected in the case of patent lawyers?

And later –

The failure to take the long history of the protection into account in favour of maintaining the protection of clients whose protection has been reduced by the development of a new category of professional legal advisers, produces in the SCP a negative bias against the protection for which there is no proper foundation.

38.18 In 'Matters of detail', AIPPI dealt with other matters including in the following.

- The public interest bases of privilege and professional secrecy.
- Passages in SCP/16/4 REV which in effect supported AIPPI's submissions to the SCP.

- The point for which some developing countries had argued that the protection originated through rights to appear in court and obligations which lawyers have under codes of ethics, is wrong from the start. The protection was introduced in both systems of law, to give clients better prospects of getting correct legal advice.
- The need for the client and the IP adviser be certain that the protection would apply was vital for the protection to have its intended effect, ie to encourage full and frank disclosure between client and the IP professional adviser.
- The abuse of the ratio of the *Nobelpharma* case by opponents of the protection being extended to non-lawyer patent attorneys or agents, was explained. That case was about fraud, not privilege. The suggestion made by that particular opponent of CAP (the Third World Network) was that privilege might cause or be a catalyst for fraudulent behaviour.
- AIPPI said (in paragraph 3.19 of the Submissions) that many things can be used in crime or fraud – 'like money for bribery and corruption, the pen to carry out counterfeiting or fuel to drive the getaway car in a robbery'). As a matter of common sense, we are not going to deny ourselves the benefits of money, pens or fuel because of the possibility that someone else might use them in aid of crime.
- The same applies to protection from forcible disclosure of professional legal advice – there is a powerful need to secure the benefits which flow from having that protection.

38.19 In Section 4 of its Submission, AIPPI dealt with the significance of the protection for all countries including the DAG. The issue of the existence of the protection is relevant to trade. Will a person contemplating trading cross-border prefer to trade with those that provide the protection locally and cross-border?

39 WIPO Meeting SCP 16 – 16 to 20 May 2011

- 39.1 The WIPO documents relating to this meeting (Agenda, pages selected from the Report that relate to CAP, List of Participants, and Summary of the Chair) are **Attachment 64**.
- 39.2 AIPPI took the opportunity in 'General Declarations' at the opening of the meeting to summarise the progress made by WIPO from the WIPO/AIPPI Conference in May 2008 up to SCP 16, May 2010. The speech on behalf of AIPPI is recorded in paragraphs 36 and 37 of the Report. Having established the position which AIPPI had reached, AIPPI submitted that WIPO should now be mandated to gather further information on how to solve the problem (the mechanisms) and to study and report on which mechanism should be preferred and why.
- 39.3 When the Agenda item of 'Client-Patent Adviser Privilege' was reached, on behalf of AIPPI, the author expanded on the speech he made at the opening, providing detail on issues as recorded in paragraph 314 of the Report, including the following.

- Correct legal advice is the aim of the protection in both common and civil law systems. That is the fundamental public interest.
- The concept of 'assisting the administration of justice' mentioned in writings in relation to professional secrecy includes in aid of negotiated settlements. That is supported by having correct legal advice.
- An important outcome of WIPO's work was that it had identified mechanisms for solving the problem which would have minimal effects on present national law and which would allow for differences between that law from one country to the next.
- WIPO had also established that there is no conflict between obligations of disclosure in the patent law and the protection. The references to AIPPI's Submissions to WIPO of 28 February 2011 and WIPO's study in document SCP/14/2, were stated.
- The proposition of the delegate for IN that AIPPI had had the same problems with the concept of applying privilege to the clients of non-lawyer patent attorneys as IN was now expressing, was in effect, an anachronism – it overlooked the fact that all such issues raised in AIPPI and debated in the process of deciding what to resolve, were subsumed in its subsequent Resolution Q163 which recommended applying privilege to non-lawyer patent attorneys.
- The proposition of the delegate for IN that the GATS treaty prevented WIPO from working on harmonizing laws relating to privilege affecting IP legal advice was a legal mistake – GATS relates to services of employees not protection of IP legal advice from forcible disclosure.
- Even those Member States opposed to WIPO being mandated to study the problem further, had indicated that the process thus far had provided information which was useful to them. WIPO's further study would have the same positive effect for them.

39.4 The outcome of the meeting on WIPO's mandate was that CAP remained on the SCP's agenda, and that the Secretariat should gather information about national and regional practices and report that to the next session of the SCP.

40 AIPPI UK: Presentation on privilege in London, Monday 23 May 2011

40.1 The author was invited by AIPPI UK to make this presentation. The subject was delivered in the context of a conference dealing with 'National and International Dilemmas' affecting IP legal practice. **Attachment 65** contains the slides the author prepared and used in making this presentation. **Attachment 66** is the flyer related to the meeting. The meeting was attended by around 60 IP lawyers and patent attorneys and was held at the offices of Linklaters, one of the leading law firms in London.

- 40.2 As to the slides, the reader will see that the presentation was in two parts – the **first** dealt with basic law (common and civil law) relating to the privilege applying to IP clients and tensions that had arisen in that context in practice, and the **second**, with the efforts by AIPPI (and other IP NGOs) to solve the problems nationally and internationally. The latter included AIPPI's Plans A and B and as to Plan B, the prospects for achieving an international agreement.
- 40.3 The meeting was lively. After the presentations, there was a lengthy Q&A process on the problem and the protection. **Attachment 67** is an email dated 29 July 2011 from Nick Cunningham, a partner of Wragge & Co (a leading IP firm in London and elsewhere) thanking the author and saying how successful the meeting was based on formal feedback of those attending the meeting. (Ed. The UK government had taken something of a back seat in relation to the SCP's pursuit of the studying the protection. After the Colloquium which is reported in Section 63 below, the UK became a key player in the process of GB+ countries studying an international agreement.)

41 Further IP NGO Submissions to IPA on the proposed amendments to the Acts – June 2011

- 41.1 After the meeting in the UK referred to in the previous Section, Submissions were prepared in Melbourne - **Attachment 68**, following up the meeting which had occurred in his absence between IPA and the IP NGOs on 24 May 2011. The author was involved in a telecon with Philip Noonan on 1 June 2011. Accordingly, the Submissions were additionally informed by the author's discussions with Philip Noonan on that occasion. Essentially, the IP NGOs thought that good progress had been made in previous discussions between IPA and the IP NGOs but the trend of the amendments being considered at government level since then (not necessarily or only in IPA), was seriously wrong.
- 41.2 Submissions made were first settled with representatives of the IP NGOs. Allens was again acting for them **pro bono**.
- 41.3 In summary (see Section 2 of **Attachment 68**), the points in issue were as follows.
- The IP NGOs and IPA had a common objective to get the clients of non-lawyer patent attorneys to a level of protection as near as possible to that which applied to the clients of lawyers. The drafting proposed by IPA (not necessarily its own drafting) was short of that mark at this stage.
 - IPA had used the formula that privilege should apply to the clients of patent attorneys 'in the same way' as applied to lawyers but it had not adopted the additional requirement 'and to the same extent' as had been recommended by Neil Young QC. Thus, the privilege which was going to be applicable in the case of clients of patent attorneys, could in fact exceed that which applied to the clients of lawyers.

- IPA was in the course of referring issues of drafting to the parliamentary draftsman and at this stage, the outcome of that process was not yet available; there were other issues of principle and drafting – see Sections 3, 4, 5 and 6 in **Attachment 68**. In particular, drafting was required to determine the timing of deciding the scope of the protection ie to be when the claim to privilege was made from case to case so that the scope could vary over time to take into account common law changes which could have been decided in the meantime by judges as to patent lawyer privilege.
- In Section 7 of **Attachment 68**, the author described the importance of these amendments to the Acts to other common law countries which were eyeing the Australian proposal. In effect, the author thereby drew the Australian government's attention to the need for the amendments to be made right because the government (and AIPPI-A) clearly wanted Australia to be in a position to lead the rest of the common law world (CA, US, UK, NZ, MY, SA, IN etc) on how to get their national laws on CAP, right.

41.4 By email dated 15 June 2011 (**Attachment 69**), the author provided comments to AGs on the process between the IP NGOs and IPA relating to the proposed amendments, with a view to influencing an Australian government outcome by having the drafting in line with the goals held in common by the IP NGOs and IPA.

42 The Annual Report of Q199 in September 2011

42.1 This Report to the Bureau of AIPPI (**Attachment 70**) was prepared by Steven Garland as Chairman of Q199, and the author as Co-Chairman. It reflects a number of matters, including the following.

42.2 **First**, Steve had adopted a new title for Q199. The title had changed from 'Privilege Task Force' to 'Client Privilege in IP Professional Advice – CPIPPA'. This reflected the changing focus and scope of the privilege project but even that was out of date. As previously mentioned, the subject of Q199's work was by now – protection of IP legal advice from forcible disclosure.

42.3 **Secondly**, the activities of the committee reported in items (ii), (iii), (iv), (vi) and (vii) of the Report were matters for which (with support by Steven Garland in particular) the author was principally responsible.

43 More focus on the activation of AIPPI's Plan B

43.1 In September 2011, there was a meeting between representatives of the Swiss Group of AIPPI and the Swiss IP Office. The meeting is referred to in Felix Addor's letter to Konrad Becker of AIPPI Switzerland dated 30 September 2011 (**Attachment 71**). The meeting was instigated by the Swiss Group of AIPPI. This was the first time AIPPI had formally approached a government to take an active role in AIPPI's Plan B. Delegates of the Swiss government had been very positive

in the SCP in support of the studies of the problem and the protection by WIPO. In Q199, we thought that the Swiss government would be positive on Plan B and that proved to be correct.

- 43.2 The author reported on Plan B to the PTFRs of Q199. The **Attachment 72** contains that report and follow up correspondence between the author and Steven Garland on Plan B. This was just a start on what has been (as it turns out now) a rather lengthy process for AIPPI in getting its Plan B considered.

44 The AIPPI Submissions on cross-border aspects of confidentiality of communications between clients and their IP Advisers

- 44.1 In August 2011, WIPO invited submissions on this topic. AIPPI's Questionnaire/Response process in 2010 for the Q199 Report to the Paris Congress provided a substantial background for AIPPI's response to WIPO's invitation on this occasion. The Submissions reported in this Section were mainly drafted by Chairman Steven Garland. The author provided comments which were taken up by Steve in settling the draft – see **Attachment 73**. The Submissions so prepared by Steve Garland with input from the author, were sent by AIPPI to WIPO in September 2011 in anticipation of SCP 17 (December 2011).

- 44.2 In the context of remedies (see Section 5 of the Submissions), the Submissions made the following points on the main issue – loss of the protection cross-border.

- Only two countries, NZ and AU had targeted this issue in their law, or in Australia's case, by proposals for change.
- NZ had successfully extended its local protection to overseas non-lawyer patent attorneys equivalent to NZ patent attorneys. Reciprocity was not required.
- AU was on the same track in drafting proposals for a Bill, with no requirement of reciprocity.
- Neither NZ nor AU had as yet secured the protection for their own non-lawyer patent attorneys, overseas.
- An international minimum standard of protection would have to be agreed in effect to fix the obtaining of the protection overseas for local non-lawyer patent attorneys.

- 44.3 The extension of local protection to overseas equivalents of local patent attorneys without requiring reciprocity, is interesting. This feature was advocated by AIPPI-A to IPA in relation to amending the Acts. The reasoning of AIPPI-A was that the Australian clients needed certainty in AU if the protection was to work in AU. Waiting for another country to agree on extending its protection to Australian patent attorneys would mean that the uncertainty would continue as to what the protection was that applied in AU. Bargaining as to positions overseas (including requiring reciprocity) was irrelevant to establishing the position which the IP NGOs wanted to make certain for clients in AU. That was to have as nearly as possible for clients of non-lawyer patent attorneys qualified in AU, the same protection as they had with Australian lawyers, and to

have Australian courts bound to recognise and apply the protection which applied to patent attorneys in AU, to their equivalents overseas (i.e. overseas non-lawyer patent attorneys).

45 Aspects of the preparations by AIPPI for the WIPO meeting SCP 17

45.1 By email of 18 October 2011, Q199 leaders updated the PTFRs on prospects for continuing the study of CAP at SCP 17 - **Attachment 74**.

45.2 Issues which that email raised included the following.

- The prospects of getting the SCP to continue the studies of CAP at SCP 17 in view of the negative influence of the DAG by its embargo on WIPO 'norm setting'.
- The overreaching of that influence seeing that nobody was proposing that WIPO should be 'norm setting' as to CAP.
- The interim results of AIPPI's inquiries of its NGs into the effectiveness of the protection currently provided.
- The need for further submissions to WIPO at SCP 17.

46 Protocols for WIPO and AIPPI acting in cooperation – the limitations

46.1 Soon after the filing of AIPPI's Submissions for SCP 17, WIPO queried whether they were in some respects worded too strongly for some developing countries. WIPO was worried about publishing them on the WIPO website. The role of an IP NGO as an invited participant in WIPO meetings, can be legally sensitive as the following description outlines.

46.2 When the cooperation between AIPPI and WIPO on the privilege project began to get momentum in 2007, the reader will recall that the first main event was the WIPO/AIPPI May 2008 Conference. At that time, it was 'all hands to the pump' for the particular individuals in WIPO and AIPPI involved in the setting up and running of that Conference.

46.3 As part of that, quite appropriately, documents drafted for the Conference were pooled and exchanged between AIPPI and WIPO to obtain input required to achieve appropriate substance and quality. Individuals in the two organisations – at that time principally for AIPPI – Jochen Buehling, Steven Garland and the author and for WIPO – Philippe Baechtold and Tomoko Miyamoto, cooperated widely. They used their collective experience in organizing events and their legal experiences in common and civil law. This cooperation was extremely helpful leading in due course to high praise from WIPO as to the success of the Conference. The subjects dealt with in the Conference were then, of course, rather apolitical and particularly so as this was a meeting of legal experts from around the world with WIPO legal experts on subjects such as - what is the law, what is the problem, what are the options for dealing with the problem and so on.

46.4 As from SCP 12 in June 2008, AIPPI's written Submissions were inspired and directed by its leaders based on their knowledge of the problem and the protection, and their desire for

improvement of the protection. It was 'early days' for AIPPI in the SCP process. At that time, AIPPI shared some of its views with WIPO on the drafting of its Submissions. However, that could not last. From AIPPI's point of view, it needed to be at arm's length with WIPO to be credible including to the delegates of the Member States. And AIPPI anticipated the same need would apply to WIPO in reverse, for its part.

- 46.5 From and including SCP 13, AIPPI was represented by the author at all six SCP meetings until SCP 17, and also later at SCP 20. Gradually, AIPPI's Submissions became focussed on numerous specific legal issues and the general one of supporting WIPO to be mandated to study and report as needed. As the reader will have observed, the legal issues were not only numerous but various – including the differences between common law and civil law, the meaning of the national laws and their limitations, the meaning of the TRIPS and Paris treaties and so on. Further, the differences between developing and developed countries on the need to study the protection and remedies for the problem, had emerged.
- 46.6 For all these matters, AIPPI could only meaningfully represent particular views for AIPPI after sounding out all of its NGs. This it routinely did through the PTFRs as previously explained, also as described above, the process of getting authority to present the Submissions of AIPPI had been expanded to include the NGs connecting with their governments with a view to the delegates of the Member States being better informed on and to support AIPPI's written Submissions to WIPO, in the meetings of the SCP.
- 46.7 By the time of the writing of AIPPI's submissions for SCP 17, not only did AIPPI need its Submissions to be read by some of the more important delegates from the Member States but it needed its PTFRs, particularly those from developing countries, to meet with and persuade their governments to change from opposing a mandate for WIPO to study remedies, to be in favour of it or, at least, neutral.
- 46.8 Thus, AIPPI's Submissions for SCP 17 which WIPO questioned had been approved by the NGs in draft form. There was no dissent. When they were sent to WIPO, the final form was sent to all PTFRs and the leaders of the NGs in their respective countries including developing countries and even ones which were members of the DAG in the SCP, requesting them to advocate the Submissions to their governments. In some cases, the NGs had reported to Q199 that they had done that.
- 46.9 The Bureau of AIPPI and the leaders of Q199 were thus effectively bound by this approval process to the arguments which had been defined and to advocate strongly in support of the principal submission in SCP 17 – that WIPO should be mandated by the delegates of the Member States to study remedies.
- 46.10 The WIPO query whether AIPPI's Submissions might be too tough on developing countries such that AIPPI might lose ground in its relationship with the governments of those countries, while obviously well intended, was an issue for which AIPPI's process had made due allowance. When this was pointed out to WIPO, that is, that citizens of developing countries as members of AIPPI

were already involved with their governments and had approved AIPPI's Submissions, WIPO immediately saw the point and agreed that the AIPPI's Submissions would be published by WIPO. Further WIPO acknowledged that it was not WIPO's place to influence AIPPI's Submissions – it was kindly acknowledged by WIPO that this was a 'no-go area' for WIPO.

- 46.11 It is rather fundamental, of course, that AIPPI in the SCP represents views of persons who as well as being members of AIPPI, are citizens of the Member States of WIPO, albeit for the main part, lawyers and patent attorneys of those Member States. Fortunately for all including WIPO, WIPO has no role in resolving differences that there may be between governments of Member States and their own citizens.

47 WIPO meeting SCP 17, 5 to 9 December 2011 - AIPPI documents relating to this meeting

- 47.1 This meeting was again critical from AIPPI's point of view to get the mandate required for WIPO to continue its work on the protection and in particular, on remedies to solve the international issues.
- 47.2 A major effort had been made by AIPPI in the six months of lead up to the meeting to get the NGs particularly some of those in developing countries opposed to WIPO studying remedies, to support WIPO's further work. The written Submissions AIPPI had previously made which were relevant for this meeting were those dated 28 February 2011 and 4 May 2011, both of which are attached to the fresh Submissions written for this meeting dated 1 November 2011 - **Attachment 75**.
- 47.3 The latter Attachment and the discussions referred to in it were informed by WIPO's report SCP/17/5 which drew on the responses by Member States and Observers to WIPO's inquiries on cross-border protection and remedies.
- 47.4 In its 'Further Submissions' - **Attachment 76**, after asserting that the issue at hand was the mandate for WIPO on future work on CAP, AIPPI commented thus.
- If no such mandate was forthcoming, the Member States would have to solve the problem outside WIPO.
 - Why study the problem unless you also aim to solve it?
 - The line drawn in the SCP by developing countries against WIPO being involved in 'norm setting' had not been reached – remedies still remained to be studied.
 - AIPPI then specified (see paragraph 2.4 of the Submissions) the benefits where all Member States were involved in the study of remedies.
 - AIPPI then described how the stage had been set for WIPO to study remedies, and in Section 4 of the Submissions, AIPPI specified where in WIPO's reports SCP/13/4, SCP/14/6 and SCP/16/4, subjects for study were specified in relation to remedies.

47.5 In Section 5 of the Submissions, AIPPI focussed on the needs of the users of IP systems in the DAG countries (including BR, IN, MY, PH and ID). Users of IPRs in those countries (as elsewhere) needed local and overseas advice on IPRs. Thus, the users needed correct legal advice and so they would need full and frank communications to get that advice. It was pointed out that the protection supports achieving the desired outcome of correct advice. That objective was not contrary to the objectives of the DAG. Therefore, AIPPI concluded that the DAG countries should not exclude themselves from the process of studying remedies.

47.6 In relation to the SCP 17 meeting itself, the usual meeting papers are **Attachment 76**. As the author's written Submissions and the oral presentation he made for AIPPI in paragraph 187 in **Attachment 76** show, the main points made by AIPPI were as follows.

- The responses which WIPO had received from the Member States were consistent with the responses by NGs of AIPPI made to AIPPI's questionnaire which was reported in the Paris Congress of AIPPI. Both AIPPI and WIPO had inquired as to whether the protection was available and applied and if so, whether it was adequate. The responses said it was not.
- Where the protection existed, it was not adequate, particularly as to non-lawyer IP advisers and in cross-border circumstances.
- In most cases there were no remedies proposed for this situation so the problem of lack of adequate protection was lingering on.
- AIPPI supported the WIPO SCP process as the preferred one to study remedies particularly because of the potential it had of getting input from all of the Member States.

47.7 The AIPPI Reporter General, Thierry Calame, wrote a report to the Bureau of AIPPI as to what occurred in the first two days of the SCP 17 meeting – **Attachment 77**. His report captures the strong support there was for AIPPI's position that WIPO should be mandated to study remedies, as follows.

The Swiss delegation took the lead and expressly mentioned AIPPI's Submissions several times ... the US Group specifically supported AIPPI's position ... FR, EU, SE, Denmark (DK), AU and JP also supported continuing CAP.

47.8 The Summary of the Chair (**Attachment 77**) records the successful outcome on CAP. The study in document SCP/17/5 was to be expanded to explain approaches to cross-border issues and possible remedies identified in the area of confidentiality of communications between clients and patent advisers.

48 The outcome of WIPO meeting SCP 17

48.1 In December 2011, Q199 reported the outcome of this meeting to Reporter General Thierry Calame (**Attachment 78** – email dated 13 December 2011) and then to the PTFRs and the Presidents, Secretaries of the NGs of AIPPI (**Attachment 79** – email dated 14 December 2011).

- 48.2 As to both reports, the centrepiece was, of course, the success in getting the mandate for WIPO required for it to study remedies.
- 48.3 The other important feature was the effect which the efforts of AIPPI's representatives had had with their governments in the lead up to SCP 17. The submissions in the SCP of many of the GB+ countries were forceful. Their recognition of and support for the submissions of AIPPI, were clearly made out.
- 48.4 It was also fortunate that Albert Tramposch had been appointed Chairman of the meeting. Albert had previously been employed by AIPLA, and was at the time of the meeting employed by the US Patent and Trademark Office (**USPTO**). Albert was clearly sensitive to the strength of the submissions of the many leading GB+ countries which supported the mandate for WIPO as well as the submissions of AIPPI and other leading IP NGOs. The GB+ countries had been influenced by submissions made to them by the AIPPI NGs (and by other IP NGOs) in their countries, respectively.
- 48.5 The author's email to Reporter General, Thierry Calame, acknowledged these matters and as invited by Thierry, suggested matters that he might wish to raise with Philippe Baechtold in expressing AIPPI's gratitude for such a favourable outcome.
- 48.6 The report to the NGs (after describing how the meeting was successful for AIPPI and WIPO in getting WIPO mandated to study remedies), congratulated and thanked the NGs for their efforts with their governments.
- 48.7 The author received many expressions of thanks from around the world (including from the UK and USA) for AIPPI's part in achieving the mandate for WIPO. The expression of thanks received from Sweden (Margareta Linderöth) which is **Attachment 80**, specified the effective role which the NGs had played in the outcome in saying –
- I must congratulate you for having continue (sic) to remind everybody to carry out their tasks in each country.
- 48.8 The strategy of connecting AIPPI NGs with their governments and requiring them to report in Q199 on their making those connections, made a difference in the dynamics in the SCP 17 meeting. There were many speeches by delegates in support of the continuation of studies. The weight of the GB+ countries in favour of the mandate for WIPO to continue its studies, had been overwhelming.

49 The Q199 meeting with Tomoko Miyamoto of WIPO on implementing WIPOs mandate to study remedies

- 49.1 In January 2012, the author sent WIPO a proposal for this meeting - **Attachment 81**. The making of this request had been approved by the Bureau of AIPPI and was made on behalf of Steven Garland and the author as the proposed participants for AIPPI at the meeting. The object

of the proposed meeting was to share AIPPI's information with WIPO which could be relevant to the report which the SCP at SCP 17 had mandated WIPO to prepare.

- 49.2 WIPO agreed to the meeting and it was scheduled for 6 March 2012. On that day, WIPO had other meetings which would be attended by AIPPI Bureau Members. The author was to be in Europe on other business then. The author prepared and proposed a draft Agenda for the meeting – **Attachment 82**. The draft became the Agenda which was used when the author met with Tomoko at WIPO in Geneva on 6 March.
- 49.3 One of the many important issues for the meeting harks back to Section 1 (see 1.33 and following) of this history where the author commented on the adverse effects of the *Rhone-Poulenc* decision in the US. That case was the apparent cause of changes subsequently made to the law in France. A similar effect had occurred in Japan by another US decision adverse to the protection being recognised, this time for the advice of Japanese non-lawyer patent attorneys. The changes in the law in France and Japan, generally speaking, better applied professional secrecy to the communications (including documents) relating to the advice given by non-lawyer patent attorneys. Subsequent to the changes in the law in France and Japan, US decisions were favourable to recognising the protection. However, there were still lingering doubts as to the protection being reliably applied in the US for Japanese non-lawyer patent attorney advice.
- 49.4 One of the factors driving that uncertainty was that whilst the change from non-recognition of the protection to recognising it, was desirable, that change did not seem justifiable by the changes that had been made in the laws in France and Japan. In particular, the US courts had previously held (in separate cases) that the professional secrecy applied in France and Japan, did not produce a protection equivalent to privilege. The strengthening of professional secrecy did not logically mean that a protection equivalent to privilege had been achieved.
- 49.5 Steven Garland (of the firm of Smart & Biggar) in CA, arranged for his lawyer assistant, Eve Heafey, to produce a memorandum on the changes in professional secrecy laws in France and Japan. Whilst the memorandum produced by Eve is marked as a draft, Steve had in fact settled it as 'final' – **Attachment 83**. The author also contributed to the substance and form of this report. The 'Heafey report' was supplied to WIPO before the author's meeting with Tomoko on 6 March.
- 49.6 At that meeting which was held in Geneva, Tomoko and the author discussed all items on the Agenda which the author had prepared. Tomoko stated that the outcome of the discussions would be reflected in WIPO's forthcoming report on cross-border remedies.
- 49.7 Both WIPO and AIPPI inferred as to the US position on the protection in France and Japan (described above) that it did not overcome the need for an international solution involving the US i.e. an agreement between the US and other countries on minimum standards which when implemented would provide the protection cross-border, and be recognised by all signatories. The essential driver for these positions of WIPO and AIPPI was that the US legal position was not certain.

50 The 'Raising the Bar' Bill amending the Acts, passed by the Australian parliament – 20 March 2012

- 50.1 On 20 March 2012, the Acts were amended in a form which overcame the issues which the IP NGOs had had with the drafts they had commented on to IPA, as previously reported in this history. The amendments (in the main) were to come into force on 17 April 2013.
- 50.2 Importantly, the Constitutional and timing issues (the latter being the date for determining the scope of the protection) had been dealt with in the manner which the IP NGOs had submitted they should be, based on the advice of Neil Young QC in 2007. Further, a workable formula was to be implemented to recognise the protection of advice given by overseas equivalents of Australian patent attorneys. Oral and written communications were covered by the protection, that is, in relation to advice given to clients by Australian patent attorneys and their overseas equivalents.
- 50.3 There was positive correspondence - **Attachment 84**, over the notification received from Terry Moore and Philip Noonan about the passage of the Bill and the substantive changes which had thus been achieved in the Australian law, in this aspect of the privilege project.

51 Colloquium in relation to Plan B – Preparatory meeting in Melbourne – 16 April 2012 (FICPI Congress)

- 51.1 The preparatory meeting mentioned in the heading was proposed by FICPI and held in Melbourne coinciding with a FICPI meeting and the presence there of Eric Le Forestier from FR (FICPI CET President – i.e. leader of FICPI's professional education function) and Stephan Freischem from DE (Secretary General of AIPPI). Eric Le Forestier had been a co-speaker with the author in one of the sessions of the WIPO/AIPPI Conference in May 2008. The Agenda for the meeting (aimed at putting discussion of the Colloquium in context with the AIPPI privilege project) was proposed by the author, as follows.
- Potential remedies
 - The likely outcome in WIPO
 - AIPPI's Plan B (failing resolution of the problem in WIPO)
 - The FICPI/AIPLA/AIPPI Colloquium proposal
 - Anything that FICPI would like to add
- 51.2 An additional subject suggested by Eric was a joint paper by FICPI and AIPPI for the SCP for developing awareness in view of, as he put it – 'a lot of misunderstanding around!'. This paper did not eventuate; it would have been eclipsed by the Colloquium.
- 51.3 In addition to the persons referred to above, the meeting was attended by Todd Dickinson (Director General of AIPLA) and Danny Huntington (FICPI) both of the US, Leo Jessen (FICPI) of NL, Greg Chambers of FICPI-A, and Stephan Freischem and the author, for AIPPI. It was

decided to hold a Colloquium on privilege somewhere in Europe, possibly Paris, in June 2013. About 10 of the GB+ countries would be invited to the Colloquium. The aim of the Colloquium was to support GB+ countries interested in assessing an international agreement. Such an international agreement was to solve the problem, including in particular, the cross-border aspect of it.

- 51.4 One of the issues was – who should lead the organisation of the Colloquium. The author resisted stepping up to that plate as he had already organised the WIPO/AIPPI Conference in May 2008 and had written all of AIPPI's many Submissions to WIPO on the protection, since then. He thought that the organiser of the Colloquium should be someone else and probably from FICPI. The author did, however, accept to be a speaker at the Colloquium.
- 51.5 As it turned out, Danny Huntington took the role of organiser and did a fine job. On the legal side, the international agreement or treaty was again being studied in AIPPI among other things to adapt the existing AIPPI proposal to include the 'dominant purpose' standard and other limitations, and also to include exceptions. Thus, AIPPI was now moving to take up suggestions that had been made on limitations and exceptions by Professor John Cross referred to previously in this History.
- 51.6 The day after the FICPI/AIPLA/AIPPI meeting in Melbourne, WIPO announced the availability of particular WIPO documents on the SCP Electronic Forum. Those documents included its Report SCP/18/6 – entitled 'Approaches and possible remedies to cross-border aspects of confidentiality of communications between clients and patent advisers'.

52 The 'library' of WIPO and AIPPI resources on 'the problem', 'the protection', and remedies

- 52.1 At the FICPI/AIPLA/AIPPI meeting in Melbourne, Danny Huntington amusingly asked the author to supply to those involved in the organisation of the Colloquium, 'the library' of WIPO Reports and AIPPI Submissions on those Reports. It is doubtful that 13 documents would make 'a library' but **Attachment 85** is the email which the author subsequently sent to Danny on 20 April listing 7 AIPPI and 6 WIPO documents in the category requested by him, and sending those documents to him.
- 52.2 All the AIPPI Submissions in the list in **Attachment 85**, are attachments to this History.

53 Common law and civil law differences, and the remedy

- 53.1 A matter of concern to Leo Jessen (as it had been to Thierry Mollet-Vieville and others as previously reported in this history) was any remedy that might require a civil law country to adopt aspects of common law privilege, or which might compromise the absolute effect of professional secrecy. Under the common law, the privilege of non-disclosure of IP legal advice belongs to the client. Under civil law, there is no obligation of discovery. The issue of a forced or even voluntary disclosure in the civil law, relates to the IP professional. The protection under the civil law is a

combination of the laws of professional secrecy and the fact that there is no disclosure forcible against the IP adviser or the client that person advised. A remedy proposed to a civil law country involving an embargo on the client having to make discovery, would be irrelevant. Further, a remedy which imported limitations and exceptions to professional secrecy, would not be acceptable.

- 53.2 The end point of the remedy which AIPPI had proposed to WIPO since 2005 would not require civil law countries to adopt any aspect of common law privilege. As explained in the author's email to Leo Jessen dated 18 April 2012 - **Attachment 86**, the minimum standards suggested by AIPPI would protect communications in the advising process from being forcibly disclosed by deeming them to be confidential and requiring them to be not subject to disclosure unless so authorised by the client. As civil law countries already regarded such communications as confidential and they were not subject to disclosure, the AIPPI proposal was in harmony with the civil law. However, the cross-border element involved a requirement to apply confidentiality and an embargo on forcible disclosure as to overseas non-lawyer patent and trade marks attorneys' advice. No civil law country had previously raised that aspect of the proposed protection as being a problem. In one sense, it could not be in conflict with civil law – it was dealing with a problem with which civil law had not previously dealt. As well, it was not established law under the common law. It too had not identified such advice as being confidential and not to be forcibly disclosed. In reality, the proposal arose from the problem which applied to both common and civil law systems. The solution would require new law in each system for the benefit of clients in both systems.

54 The AIPPI Report of 20 April 2012 to the PTFRs of Q199 on WIPO study SCP/18/6 and the FICPI/AIPLA/AIPPI proposed Colloquium

- 54.1 The publication by WIPO of its Report SCP/18/6 – 'Approaches and Possible Remedies to Cross-Border Aspects of Confidentiality of Communications between Clients and Patent Advisors' - on 2 April 2012 (about a month before the SCP 18 meeting) and the meeting to 'start up' the planning of the FICPI, AIPLA, AIPPI Colloquium, were reported by the author to the PTFRs by email dated 20 April 2012 - **Attachment 87**.
- 54.2 As the reader will see, that Report brought together for the benefit of the PTFRs the point relating to avoiding requiring any civil law country to adopt common law privilege, referred to in the previous Section.

55 The WIPO meeting SCP 18, 21-25 May 2012

- 55.1 AIPPI's approach to this meeting was as follows. The meeting would be focussed on remedies and on the WIPO Report SCP/18/6, in particular. AIPPI had already outlined its position on remedies in many submissions including the Submissions drafted and settled by Steven Garland and submitted to WIPO in September 2011 - **Attachment 88**.

- 55.2 AIPPI did not respond to WIPO's Report SCP/18/6 in preparing for SCP 18 – it decided to wait until the meeting and react to the Report in the light of what occurred there. The Section in SCP/18/6 on rules for recognising foreign patent adviser privilege is rather complex. AIPPI thought it would be difficult for delegates in the SCP to understand. Most of the delegates were not lawyers. Indeed, that part of SCP/18/6 is more complex than each of - the law in NZ, the then forthcoming law in AU, and AIPPI's proposal for an international agreement.
- 55.3 The author did not attend the SCP 18 meeting. The submissions of the delegates amounted to encouragement by developed countries for WIPO to continue to study remedies and discouragement of the same by some of the developing countries – the latter adopting the view that what is treated as confidential in any country differs from one country to the next and is thus a matter to be decided under national law.
- 55.4 The outcome of the meeting as to CAP was that the Committee agreed (item 13 of the Summary of the Chair) to carry on discussions at the next meeting on the same agenda as for SCP 18 - **Attachment 88**.

56 Preparations for the Colloquium in Paris Scheduled for June 2013 – the implementation of AIPPI's Plan B

- 56.1 Following SCP 18 in which further studies in WIPO on remedies and the issues of their implementation were sidelined by the developing countries, AIPPI turned to the start of implementing its Plan B. The main focus was on the organisation of the Colloquium on the protection. The sponsors of that meeting were to be AIPLA, FICPI and AIPPI. The Colloquium would bring experts on the protection together with government representatives. The countries which the relevant IP NGOs had in their sights were AU, US, UK, CA, FR, DE, NL, CH and JP.
- 56.2 After a series of telecons between the principal organisers, the representatives of AIPLA, FICPI and AIPPI for the organisation and running of the Colloquium, were settled as follows.

AIPLA (US)

Todd Dickinson, Director General of AIPLA

Meghan Donohoe, Chief Operating Officer of AIPLA

Bill Schuurman, Lawyer (US)

Jeff Lewis, Lawyer (US)

FICPI

Julian Crump, Secretary General of FICPI (US)

Francesco Paolo Vatti, Deputy Secretary General of FICPI (Italy)

Danny Huntington, Lawyer (US)

Eric le Forestier, Patent Attorney (FR)

Leo Jessen, Patent Attorney (BE)

AIPPI

Thierry Calame, Reporter General of AIPPI, Lawyer (CH)

Stephan Freischem, Secretary General of AIPPI, Trade Marks Attorney (DE)

Steven Garland, Chairman Q199, Lawyer (CN)

Michael Dowling, Co Chairman Q199, Lawyer (AU)

Fabienne Martin, General Secretariat (CH)

- 56.3 As one would expect, a pivotal document to be prepared for the Colloquium was the Program. Once drafted, the proposed Program would have to go through a process of approval. Steven Garland and the author decided that AIPPI should launch this lengthy process by preparing a draft Program. The author prepared two draft documents for this – the Scheme for the Program and the Program. This history does not need to be burdened by the many drafts of the Program that were produced. The final version of the Program is attached below. The Scheme for the Program was set out in an email by the author to Steven Garland dated 16 July 2012 – **Attachment 89**.
- 56.4 The Scheme was in effect a brainstorm providing a view into how to decide the content of the Program and how the event should be organised. Initially the drafts of the Scheme were shared by Steven Garland and Michael Dowling. Then, after adaptation to take into account their views, they were shared by AIPPI (for comment and approval) with AIPLA and FICPI.
- 56.5 Looking at a few points made in the Scheme, it stated that those involved in the Colloquium would need a common base (background) from which to move forward to discuss in the Colloquium what needed to be identified as the ways to remedy the problem and to implement the appropriate solution.
- 56.6 The Scheme forecast that the common background would involve acceptance of the following main points.
- IP lawyer advice is widely protected already in both common and civil law systems as being confidential.
 - The previous point ie the protected confidentiality, is the foundation for an international agreement on the protection of the IP professional advice, that is, for clients of lawyer and non-lawyer IP advisers.
 - The problem of the lack/loss of the protection for clients of IP professionals is caused by national laws not keeping pace with the development of non-lawyer IP professionals and by increasing trade involving increasing need for advice on IPRs.
- 56.7 The principal objective of the Colloquium was to encourage the negotiation of an international agreement which would cause the signatories to adopt in their laws, minimum standards for the protection to apply to the advice given by contemporary IP professional advisers. By the word 'contemporary', attention was drawn to the fact that it was by now long established that there are

lawyers and non-lawyers who are qualified to give legal advice about patents. To assist the Colloquium to focus on achieving its principal objective, the author perceived that there would have to be a Primer (a fundamental explanatory memorandum). Beyond the Primer, it would be desirable to have an Agenda which took the participants directly onto discussing issues involved in solving the problem.

- 56.8 Within AIPPI, the starting point for the Colloquium from its previous work, was the author's 2005 proposal to WIPO for a Treaty or international agreement, sometimes referred to in the documents of AIPPI as 'a multilateral agreement' or 'MLA'. That proposal would have to be updated to make provision for limitations and exceptions and other issues. The update would need to be explained in an Explanatory Memorandum (**EM**). The proposals for both those documents would have to pass the usual AIPPI process of approval – Q199 PTFRs and the Bureau first, and then the AIPPI Executive Committee (**EXCO**) comprised of delegates of each of the NGs. The next EXCO to be convened at that time was to be at the AIPPI Congress in Seoul – October 20-23, 2012. Having obtained such approval, the EM (to which the MLA update was attached), would then be brought into the process of the team from AIPLA, FICPI and AIPPI which was planning and organising the Colloquium.
- 56.9 It cuts a long story short (roughly 5 months of work) to jump to the EM proposed to and approved by the AIPPI Congress in Seoul in October 2012 – **Attachment 90**. That proposal was explained by Steven Garland and the author in Seoul in meetings with representatives of Q199 and to a wider audience of members of AIPPI in the EXCO. It was unanimously approved.
- 56.10 The 'Summary' in the EM in **Attachment 90**, explained that it was addressing the need for an international agreement to solve the problem. Such an agreement would require the signatories to provide the protection to a minimum standard, by their national laws.
- 56.11 The 'Background to the proposal' in **Attachment 90** explained the background to changes made in updating AIPPI's 2005 draft MLA, particularly, but not only, in reaction to the suggestions by Professor John Cross.
- 56.12 Section 3 of the EM reminded the readers of the learning of the protection which had come about through the WIPO SCP process on CAP and the contributions which AIPPI and other IP NGOs had made to that process.
- 56.13 The international agreement proposed at this stage is Attachment 4 to the EM. Section 4 of the EM explains how that draft agreement came about.
- 56.14 Finally, in the Postlude (Section 5) of the EM, the EM explains that the international agreement does not require civil law countries to adopt common law privilege. In this regard, the draft international agreement was not different from the 2005 draft. AIPPI had known from the start of the privilege project in 2003 that it would not be practical to require any substantial change in national laws and particularly so, if the change was as fundamental as requiring a civil law country to adopt a common law principle when that was not necessary. Thus, AIPPI's proposals

required that national laws would provide protection from forcible disclosure. Civil law countries already provided that. Some also provided privilege (from forcible disclosure) to IP professional advisers. That is, of course, not equivalent to common law privilege because that privilege applies to clients, not the IP professionals.

57 The Rules of the Unified Patents Court (UPC) of the EU

- 57.1 The Rules of the UPC first came into the history of the project in July 2012. In the context of deciding which government organisations should be invited to be represented at the Colloquium, it was drawn to the organisers' attention that the UPC was currently being established. It was potentially a relevant consideration for the Colloquium what the UPC Rules of Procedure would provide as to the protection.
- 57.2 The first draft of the UPC Rules sighted by Q199 was described as 'Draft 8'. That number indicated that a lengthy process on drafting the Rules was underway. Stephan Freischem, then Secretary General of AIPPI, informed the author (and others) that the drafting committee for the Rules was chaired by Kevin Mooney of the London firm of Simmons & Simmons – see **Attachment 91**. Kevin Mooney was, and still is, a friend of the author in two ways – as an IP lawyer with whom he had worked in major patent litigation, and personally. Another member of the Rules committee – Pierre Véron – was also a friend of the author through AIPPI. Both Messrs. Mooney and Véron were members of AIPPI (of the UK and French Groups, respectively).
- 57.3 A number of possibilities struck the author as to the relevance of Messrs. Mooney and Véron to the Colloquium. Apart from being members of AIPPI, they were expert IP litigators – the one in common law and the other in civil law. They had both been deeply involved in the formulating of the UPC Rules. They would be excellent candidates to address the Colloquium, as indeed they subsequently turned out to be.
- 57.4 More to the point of the legal science being considered for inclusion in the Colloquium was the question – where had the UPC Rules got to in providing 'the protection' for the clients of IP professionals? The relevant Rules (in Draft 8) were 361-363.
- 57.5 Interestingly, the Draft Rules did not make any express provision for any of the following features being considered for the international agreement proposed by AIPPI – limitations, exceptions, communications with third parties engaged locally to assist in giving legal advice, and communications with overseas patent attorneys.
- 57.6 Further the Draft Rules as published in the then most recent draft (287 to 289 in Draft 18 – **Attachment 92**), had not changed in relation to privilege since Draft 8.
- 57.7 The presently proposed Rules should be adequate in the civil law context of the UPC. In that context, there is no need to make provision for the 'features' of the AIPPI proposed international agreement, referred to above. That is because like professional secrecy, the UPC protection is absolute. Presented, as Kevin Mooney concedes, with a 'blank page', the Rules could be written without limitation by civil or common law precepts. Privilege from disclosure applies under the

Rules to any confidential communication (written and oral) between client, lawyer, or patent attorney whilst it remains confidential. The privilege extends to the work product of the IP professional. It is also provided that the privilege prevents the client, lawyer or patent attorney from being questioned or examined about the contents or nature of their communications. Confidential communications with third parties for the purpose of obtaining information or evidence for proceedings in the UPC are also subject to the privilege to be created by the UPC Rules.

58 Preparations for and decisions made at AIPPI Congress – Seoul, 20-23 October 2012

- 58.1 By email of 8 October 2012, the author thanked Stephan Freischem for the good news that the GB+ nations had decided to work between themselves outside the SCP, on harmonising the law on the protection. That email also summarised AIPPI's position and strategy and sought the Bureau's involvement in other work using Q199's approach to problem solving.
- 58.2 In view of the decision referred to in the previous paragraph, one might ask – did that GB+ proposal to 'go it alone' on implementation of minimum standards of the protection mean that AIPPI accepted that nothing positive could come from the SCP process then or into the future on the protection? The answer is an emphatic – **NO!** The proposition involved in that question is wrong.
- 58.3 The SCP process and the six SCP meetings involving CAP at which AIPPI at that time had been represented (SCP 13 to 18), had allowed AIPPI to present its position first on the protection, the problem and remedies and secondly, on why the points made by the opponents of WIPO being mandated to carry out studies on those subjects, were wrong. By its involvement in that process (including, of course, the WIPO studies and all the written and oral submissions made by delegates of the Member States and representatives of the other IP NGOs), AIPPI had a substantially better understanding of the protection, the problem and the potential for resolving the problem. It is fair to apply that effect of WIPO's process to everyone else involved, that is, to the delegates of the Member States, the representatives of institutions including the IP NGOs and WIPO itself. Even the GB+ nations were in a better position for concluding (as they did in principle) that the problem was capable of resolution by international agreement on minimum standards supporting the protection, made between some of them (in the first place).
- 58.4 At the meeting of AIPPI in Seoul Korea – Q199's proposal for the Colloquium including the drafts of the Explanatory Memorandum and the international agreement, were approved by AIPPI. Those documents (attached previously in this history) were attached to the Annual Report of Q199 for 2012 which is **Attachment 93**.
- 58.5 As to approvals of AIPPI's intended activities through Q199, the Bureau approved of Q199's approach of continuing to support WIPO in the SCP in its studies of possible remedies whilst at the same time, supporting the GB+ countries in negotiating on Plan B.

- 58.6 For Q199, the Seoul Congress also involved meetings with the Japanese representatives in Q199, Yuzuru Okabe and Shoichi Okuyama, in relation to preparing for the Colloquium to be held in Paris. Japanese law, the reader will recall, had been found in the US to be short of the then US standard for recognizing the protection overseas. That required that the overseas protection of IP professional legal advice had to amount to something equivalent to privilege. The Japanese law on professional secrecy had been amended to extend professional secrecy to non-lawyer patent attorneys. However, the Japanese position in the US was still uncertain for the reason outlined in 49.4 above – in short, was the need to be 'equivalent', met?

59 The Q199 Annual Report 2012

- 59.1 The Q199 Annual Report for 2012 (ie **Attachment 93**), was written by Steven Garland and contributed to by the author. The Report refers to the numerous activities during 2012 of Steven Garland and the author, many of which have already been described in this history – eg the author's meeting with Tomoko Miyamoto in Geneva in March 2012, the meeting which Stephan Freischem attended with the author in Melbourne with representatives of FICPI on the proposed Colloquium in Paris, the WIPO SCP meeting of May 2012, other meetings and actions related to the Colloquium and so on.
- 59.2 Steven Garland and the author addressed the meeting of Q199 in Seoul (this was attended by Thierry Calame, Reporter General of AIPPI and Sarah Matheson and about 20 PTFRs) on future work in the SCP on the protection, work with GB+ on Plan B including the AIPPI proposal for an international agreement (as updated), and the Colloquium.

60 Further preparations of the IP NGOs for the Colloquium on the protection – experts, and government representatives – August 2012 to June 2013

- 60.1 The three documents which were central to these preparations were the Program, the Primer and the Protocol (known by the organisers of the Colloquium as the '3Ps'). The Program contained guidance for the speakers on the topics which they were to address. The Primer was an explanation of the legal background of the protection, the problem, remedies and implementation of any remedy. The author prepared all three, obtaining input from the representatives of all three IP NGOs comprising the committee charged with making the arrangements.
- 60.2 The full name of the Protocol was 'Protocol for Presentation by Government Representatives' which explains its purpose. The organisers needed an instrument to guide the government representatives as to the context of the Colloquium itself, and the content of their presentations. For the author, this exercise harked back to the WIPO/AIPPI Conference of May 2008 for which the author had been responsible for guiding the speakers as to the context and content of their presentations. For the Conference, the main need had been to produce comparable content. For the Colloquium, that need also applied but in most but not all cases, there was an additional need to draw out from each of the national speakers, what they could contribute to solving the problem.

- 60.3 To the 3Ps above, the organisers added a document called 'Subjects for the Invitation'. This provided a common text for use in inviting particular people to attend the Colloquium. The document was a guide. The process for inviting government representatives required that each invitation would be made personally by the particular representative of the IP NGOs who had an established relationship with the person to be invited.
- 60.4 The author drafted the invitation to the Australian government representative (initially made to Phillip Noonan) based on the common text referred to in the previous paragraph. That draft, redacted as to expressions subjective to Australia, was also supplied by the author to others in the team of organisers to adapt for the invitations they were responsible for managing. An example of the invitations so made is the one dated 4 March 2013 addressed by the three IP NGOs to the author himself as an invitee – **Attachment 94**.

61 Further work of WIPO on the protection at SCP 19 and onwards

- 61.1 Q199 was not directly represented at SCP 19. It was represented by Steven Garland and the author at SCP 20 (January 2014). Since then, Q199 has been directly represented at SCP 21 and SCP 28.
- 61.2 AIPPI has continued to support the efforts of WIPO in studying the protection which the SCP has continued to mandate. Those efforts by WIPO have resulted in a rounding out of the studies of remedies for the problem including implementation. AIPPI has remained in touch with WIPO through the published work of the SCP. Details of the further work of WIPO are reported below. Client Attorney Privilege moved on in the SCP to be called – Confidentiality of Communication between Clients and their Patent Advisers: Cross-Border Issues.
- 61.3 The discussions in SCP 19 were based on the WIPO document SCP/18/6 (referred to in 54.1 above). This document was widely supported by the delegates in WIPO as a good overview of the discussions of the committee. It was decided at SCP 19 that the Secretariat would prepare - '... a document compiling laws and practices on, and summarising information on experiences relating to, the issue of confidentiality of communications between clients and their patent advisers, received from Member States.' – see 79.3 below). At SCP 19, it was forecast that a presentation by the Secretariat and discussion on that would occur at the next session of the SCP.

62 Further commentary on the preparations in the run up to the Colloquium

- 62.1 The preparation of the Program for the Colloquium was a lengthy process taking more than eight months in the making. That was always going to be the case with such a range of topics and speakers. The organisers needed the speakers to start from or involve the problem and the protection and what AIPPI had proposed as a solution and how that solution had been developed since 2005 when it was first proposed by AIPPI to WIPO. The Primer was aimed at putting all

speakers and participants at the same starting point on these issues – the Primer is **Attachment 95**.

- 62.2 The organisers decided that slides were preferred to papers in the presentations because the Colloquium (as its name implies) was to provide a forum for discussions. Further, the organisers decided that first on the podium would be representatives of the IP NGOs who were to welcome the participants and explain the role of their NGO in the Colloquium. Following that, the author was to be the next on the podium and to deal with the Primer on the problem and the proposed AIPPI solution. The author's slides are **Attachment 96**.
- 62.3 The Primer on the protection was provided to everyone who attended the Colloquium. It provided the background starting from the WIPO/AIPPI Conference in May 2008 and ran through the SCP meetings 12 to 18 in dealing with the studies of WIPO on the protection. It explained the separate histories of professional secrecy (civil law) and privilege (common law). It explained the function of confidentiality which is common to both legal systems and the public interests they both pursue. It then outlined the AIPPI solution to the international aspect of the problem (of the failure by the one country to respect and give effect to the protection as it is applied in another country).
- 62.4 On the WIPO studies and the AIPPI submissions relating to those and the relevant SCP meetings, the Primer identifies the particular documents recording the studies and submissions in Appendix 1 of the Primer.
- 62.5 The author's slides also provided a roadmap dealing with the protection in the context of professional secrecy. In that context, confidentiality is not in fact an upfront requirement as it is with privilege, but it is an effect of professional secrecy because adherence to secrecy and the fact of no forcible disclosure of IP advice in civil law, confines such IP advice to the adviser and advisee making it in effect, confidential.
- 62.6 In the lead up to the Colloquium, the author assisted the speakers with the topics with which they would deal. For example, David Hill and Bill Schuurman, both patent lawyers from USA, had asked the author for guidance on how to divide the subjects between them on which they would speak. The author suggested dividing them by describing the subjective approaches of the two organisations they were representing – David Hill for AIPPI US and Bill Schuurman for FICPI US. Part of the email exchange relating to this (30 April 2013 by Bill, 30 April by the author, and 1 May by Bill) is **Attachment 97**.
- 62.7 Professor John Cross also tested some of his thoughts with the author and required some updating information on CA, and other common law countries. The professor's email to the author dated 30 April 2013 and the author's reply of 1 May, are **Attachment 98**.
- 62.8 As to CA, the remedy which AIPPI proposed could have been acceptable to CA already, but for a turf war which was going on between the IP professions there (ie between lawyers generally not just IP lawyers, and non-lawyer patent agents); the lawyers were resisting privilege being applied to non-lawyer patent agents with whom they were competing.

- 62.9 AIPPI's remedy was not acceptable at this time to IN because IN (as the author knew from discussing AIPPI's proposals with delegates for IN in WIPO), was not 'conceptually ready' to apply the protection to non-lawyer patent attorneys. The author was able to relay this information and that in the previous paragraph to Professor Cross.
- 62.10 Over around eight months in the run up to the Colloquium, there was massive correspondence and many telecons involving the members of the organising committee and speakers they were representing, working on the preparation for the Colloquium. The most interesting subjects and challenges arose out of the official documents – the Program and the Primer in particular. Numerous drafts were made and exchanged. Guidance was given to the representatives of governments on the content of their speeches.
- 62.11 One of the challenges affecting the form of the Program was caused by inevitable changes to the availability of particular speakers, particularly US judicial representation (not at all surprising). The organisers were anxious to have US judicial representation for two main reasons – first, it was US decisions (common law) adverse to the protection cross-border which had caused the French and Japanese governments to change their respective laws. Secondly, if the remedy was to be effected by an international agreement, the US could not easily sign up to that because privilege, even privilege as related to IP lawyers, is a matter for State law. How would the protection be improved in the US?
- 62.12 The changes which occurred in relation to US judicial representation, involved at first acceptance and then subsequent disengagement through lack of availability by Chief Judge Randall Rader, then Chief Judge of the United States Court of Appeals for the Federal Circuit, and after him Judge Timothy B Dyk, Judge of the US Court of Appeals for the Federal Circuit. Fortunately, the attendance of Judge Susan Braden of the US Federal Court of Claims was secured. The author assisted Danny Huntington by email on 27 May 2013 on briefing Judge Dyk with the Program, the Primer, the Cross Paper, and on matters of background that he might need – see **Attachment 99**. The author understands that a similar brief was given to Judge Braden by Danny.
- 62.13 The Colloquium is best understood by perusal of the Program and the Transcript of its proceedings – the Program is **Attachment 100**; the Transcript is **Attachment 101**. At the Colloquium, the attendees were provided with a Presentation Book and a List of Participants. The Presentation Book contained the Welcome, the Program, the CVs and Slides of most of the speakers. The Presentation Book with the exception of the Program (already attached) is **Attachment 102**. The List of Participants is **Attachment 103**. As a representative of AIPPI (which is based in Zurich, CH), amusingly, the author was categorised as Swiss and listed under CH.

63 The Colloquium – 26-28 June 2013 at Hotel Lutetia, Paris

- 63.1 Taking a view of the Program from above, the Colloquium had these elements.

- The main goal of the Colloquium was to obtain a framework for solving the problem of the protection internationally, in particular by agreeing on a minimum standard of protection for IP professional advice from forcible disclosure both nationally and overseas.
- The speakers included government representatives (Officials of national Patent Offices) of both common and civil law countries, representatives of industry, the professions (lawyer and non-lawyer IP specialists), a senior judge and an academic lawyer, both from the US.
- The three IP NGOs which organised the Colloquium set the scene by explaining the Primer, including AIPPIs suggested international agreement, and the goals of the Colloquium.
- The AIPPI proposed solution was peer reviewed by Professor of Law, John Cross.
- Between each topic, there were breaks for comments and discussions between the participants.
- Country by country, the national representatives dealt with the protection their country had, what issues they had at that time and what stood in the way of, and how they would go about securing, their protection in their countries and overseas.
- A resumé of national positions and overview of the way ahead, including discussion with the participants.
- A presentation on the proposed Rules of the EU Unified Patent Court.
- The US and other countries' problems in harmonising the protection so that the protection is not lost cross-border.
- A communiqué settled by the participants summarising the positions reached at the Colloquium.

63.2 The countries whose governments were represented by speakers at the Colloquium were – AU, DE, JP, CH and the US – two from common law countries and three from civil law countries.

63.3 The Colloquium was a watershed as to how countries could take the learning of the SCP forward by agreement between the developed countries which (as represented in GB+) wanted to overcome the loss of the protection which applied nationally but failed overseas.

63.4 Australia was part of the organisational leadership of the Colloquium – Greg Chambers and the author being members of the organising committee. The author set the technical side of the Colloquium in motion by presenting on the Primer which was its technical foundation. Greg was a discussion leader on what would be recommended as a result of the Colloquium. He was also involved in the process of settling the Communiqué. Fatima Beattie, then Commissioner of Patents Australia, presented on client attorney privilege in Australia, how Australia had changed its laws on the protection and what was left to be achieved.

63.5 The Transcript of the proceedings of the Colloquium is a record of the contributions made by individuals generally and for developing the AIPPI model in particular. Points made which AIPPI could adopt in relation to its draft international agreement, were as follows.

- The definition of intellectual property rights should include trade secrets (Prof. Cross p.22) and be aligned with the definition of those rights in the TRIPS Treaty (Philippe Baechtold – WIPO).
- In relation to the qualifications of advisers, the qualification 'where the advice is given' should be changed to 'where the advice applies' (Prof. Cross p.22).
- On the same subject, as to the wording 'qualified or authorised', it was accepted that there needs to be an indication of 'in what sense' – something like 'who is qualified or authorised by the law of the nation to which the advice applies, to give that advice' (Prof. Cross p.66) – and there were many other contributions – see pages 80 to 90 of the Transcript.
- There should be an express provision to the effect – the agreement has no effect on any obligation which applies, requiring disclosure of prior art (Michael Jewess on behalf of ICC – see p.80 of the Transcript).

63.6 As to the UPC Rules on privilege, Kevin Mooney pointed out that the drafting committee had a blank page on which to prescribe the Rules. That was, of course, in contrast to AIPPI's international agreement which requires the drafting to take into account the existing law on and its requirements for, the protection.

63.7 Using the liberty to select the Rules they would like to have, Kevin said, the UPC committee targeted neither the client nor the IP professional – confidential communications were the target. Those involved in the communications – IP professionals and the client – would be privileged - that is, not to be forced to disclose the communications. That principle was extended to third parties where the communications with them occur in relation to litigation.

63.8 The reader will see that the UPC solution passes the Rehnquist test of certainty with flying colours. However, it is not a route down which GB+ can travel in resolving the problem of the protection because the potential signatories to an international agreement require their existing laws on the protection to be adapted with as little change as is possible.

64 The Communiqué from the Colloquium - Attachment 104

64.1 The Communiqué was straightforward. It said that the Colloquium dealt with the protection. The two major problems were identified – inadequate local protection and the same as to overseas advice.

64.2 The presenters were from countries identified as being AU, DE, JP, CH and the US.

64.3 The conclusion was that there are viable options to remedy the problem. It was generally agreed that the protection should be expressed not to extend to underlying facts such as prior art.

64.4 The way forward was a subject for international discussions.

65 The WIPO meeting SCP 20 – 27 to 31 January 2014

- 65.1 As predicted in the Future Work category of the Summary by the Chair at SCP 19 in November 2013, WIPO published a Report to be dealt with at SCP 20, namely SCP/20/9 entitled – 'Confidentiality of Communications between Clients and their Patent Advisers: Compilation of Laws, Practices and Other Information'. This Report was the main focus for the CAP aspect of the SCP 20 meeting. SCP 20 was attended by both Steven Garland and the author.
- 65.2 In preparing for this meeting, the author drafted the Submissions by AIPPI and included Steven Garland's contributions. That document was dated 16 December 2013 – **Attachment 105.**
- 65.3 There were four Sections in this paper dealing with the topics as set out below. For the history of the project, the author has respective comments on each topic as stated below.

1. The positive roles of the SCP and WIPO in the study of CAP.

The particular subjects which mark the progress of the SCP, are listed in this Section.

2. The AIPPI Primer on the protection which was published at the Colloquium.

After the Colloquium, Q199 updated the Primer particularly on the proposal for an international agreement (Appendix 5 of the Primer). The updating included changes to the definition of 'professional adviser' the effect of which is specified in Section 2 of the Primer.

3. Assessment of the current problems of the protection.

A document on this topic was updated after the Colloquium. There had been requests in the SCP for comments on questions related to the current problems of the protection, like –

Specify the problem of cross-border CAP by means of a) concrete examples of impediments in the daily business of a patent attorney, b) explanations why and where these impediments occur and c) indication of decisions by different courts and based on different legal backgrounds.

The people who understand how the problem adversely affects IP professionals and their clients best, are those that have to deal with the problem in legal practice every day – the IP professionals themselves. Even Sam Ricketson had cause to wonder whether the problem was substantial. In paragraphs 1.29 and 1.30 above, the adverse daily effects of the problem are described. What it costs in the economy is not capable of being measured but obviously there is an enormous amount of time (and thus, cost) spent in dealing with it. If the protection applied with certainty, there would be very little such cost.

Section 3 of the paper also dealt with the following issue.

Describe possible remedies to overcome the established difficulties including an analysis of their respective advantages and disadvantages based on your professional experience and expertise. While doing so, please, do also consider the political implications of and the expected time for enforcement procedures.

This issue is dealt with in the second half of Section 3, focussing on the updated international agreement proposed by AIPPI (Appendix 5 of the Colloquium Primer). The description concludes in a way that neatly leads into Section 4 (see below) which compares AIPPI's proposal with the draft Rules of the UPC.

3.18 Thus the protection applies to clients as well as IP advisers. As it applies to IP advisers, it is much narrower than professional secrecy (which continues to exist, of course). Professional secrecy is absolute as to all that passes between a client and the professional but, of course, that only applies to the professional.

3.19 The AIPPI proposal was first made to WIPO in July 2005. It has been developed to its present form over 8 years since then. The focus or fulcrum of the AIPPI proposal is confidentiality in the instructing / advising process of clients and their IP professionals.

3.20 The same fulcrum has subsequently been applied in the draft Rules of Procedure of the UPC. In both cases (i.e. the AIPPI and UPC proposals) confidentiality can only be waived by the client.

4. Section 4 of the Submissions in **Attachment 105** as they deal with AIPPI and UPC proposals, concludes in 4.4 as follows.

4.4 The AIPPI and the UPC proposals are based on or assume that the existence of communications which are 'confidential' is definitive of a legally enforceable right or status and that that right or status will have the same, or a materially similar, effect from one nation to the next.

This statement is correct but it needs the following qualification to give it more accurate effect.

Whilst the AIPPI and UPC proposals are both effectively based on protecting the confidentiality of communications, the AIPPI proposal is confined to the protection of legal advice ie 'advice on or relating to intellectual property rights'. The UPC protection would be much wider than that: it applies to any confidential communications.

66 Paris, TRIPS and GATS – in WIPO Report SCP/20/9

66.1 In this Report, there is a detailed analysis of the potential application of these treaties to any proposed treaty on minimum standards for the protection. In paragraph 12, WIPO states as follows.

12 The issue of client-patent adviser privilege is not expressly regulated by any international intellectual property (IP) treaty. However, the provisions of the Paris Convention for the Protection of Industrial Property (Paris Convention), the Agreement on Trade-Related aspects of Intellectual Property Rights (TRIPS Agreement) and the General Agreement on Trade in Services (GATS) of the World Trade Organization (WTO) have some relevance to the issue at stake.

- 66.2 In the description of the application which the treaties may have to any proposed treaty, WIPO does not meet head on the proposition asserted by some developing countries in the SCP, that Paris and TRIPS reserve privilege for national law and consequently that WIPO has no role in studying privilege. This proposition is in effect an assertion that any such work by WIPO would be beyond its power, known in the common law as 'ultra vires'.
- 66.3 The author observes as to WIPO's comment that Paris and TRIPS have some relevance to the making of an international agreement of privilege is curious. WIPO's action in studying the problem of the protection, is consistent with the opposite view being right – ie that Paris and TRIPS are not relevant. Its diligent research and reporting to the SCP on CAP, stand in stark contrast to the developing countries' suggestion that it has no power to do that work.
- 66.4 The WIPO Report contains detailed descriptions of the laws relating to the protection as it applies in 42 of the Member States. This is a most valuable resource.

67 The Australian and New Zealand laws on IP Privilege

- 67.1 In developing laws relating to the protection, both of these countries have extended the protection which applies nationally to clients of overseas equivalents of Australian and NZ IP professionals, respectively. That brings the clients of overseas lawyer and non-lawyer patent and trade marks attorneys under the umbrella of privilege in each of those countries. Neither country has sought reciprocity from overseas countries in relation to the protection of their own IP professionals, overseas.
- 67.2 If every country in the world did what AU and NZ have done as described above, there would be no problem to be solved by an international agreement as proposed by AIPPI. The problem goes on in most countries because the protection is still inadequate or is at risk of being lost cross-border, or both.
- 67.3 The Australian and NZ laws mean that a client's IP legal advice from overseas, is protected from disclosure in each of those countries.
- 67.4 Why was reciprocity in other countries not required in exchange for the grant of privilege to the clients of overseas IP non-lawyer professionals? The history has already commented on this issue (in 44.3 above) but it deserves further comment in support of other countries following suit.
- 67.5 In Australia, the IP professions (lawyers and patent attorneys) wanted to improve the protection in Australia. As part of that they wanted to rid court cases of expensive and time wasting disputes

as to whether privilege applies to documents subject to discovery, whether those documents are local or from overseas.

- 67.6 It was unreasonable to expect that Australia could get the law on the protection improved overseas, by requiring reciprocity. All that Australia could reasonably do was to improve its own law and leave that as an example for others to follow if they would. The prime concern was the inefficiency and uncertainty in determining what was or was not under the protection in Australian courts.
- 67.7 Those negative qualities – inefficiency and uncertainty – show up in lengthy and expensive time lost in court in arguments over what is and what is not privileged. This is, of course, a negative feature of common law process, not civil law.
- 67.8 One might ask – when would a case on intellectual property rights be properly decided by knowing what the parties' legal advice was as to those rights? The answer is – rarely, if ever. Yet, disputes as to privilege do occur in IP litigation and thus, contribute quite unjustifiably to the costs of dispute resolution in this category where in so many cases, much depends upon what is or is not in the public domain, not what is in the mind of the client or the mind of the client's IP professional adviser.
- 67.9 In short, in Australia, the IP professions wanted certainty on the applicability of privilege and thus to avoid expensive side issues (disputes) on the right to discovery.

68 The WIPO meetings SCP 20 – 27 to 31 January 2014

- 68.1 The usual papers for this meeting are **Attachment 106**. The focus of the meeting as to the protection was on WIPO's Report SCP/20/9. The papers include the oral submissions, the material for which was a collaboration between Steven Garland and the author. The oral submissions for AIPPI at the meeting, were made by Steven Garland.
- 68.2 The outcome of the meeting as to the protection was, as explained by the Chair in 'Future Work' – that SCP/20/9 would be published on the SCP electronic forum and that the SCP would conduct a half-day seminar on the confidentiality of advice from patent advisers and practical experiences of clients as well as patent advisers, at the next meeting of the SCP.

69 The meeting of AIPPI with Core Group of Group B+ representatives (CH, DE, JP, KR, SE, UK and US) – contemporaneous with SCP 20

- 69.1 Messrs. Garland and the author were invited to attend this meeting which occurred alongside SCP 20 in January, 2014. The representatives were considering the AIPPI/AIPLA/FICPI joint proposal for an international agreement following on from the Colloquium.
- 69.2 The GB+ meeting was a meeting of a particular sub-group of GB+ called 'the Core Group' – at that time comprised of representatives from CH, DE, JP, KR, SE, UK and US. Steve Garland reported the names of the participants, as follows.

Michael and I on behalf of AIPPI, and Leo Jessen on behalf of FICPI were invited to a "GB+ Core Group" meeting on CAP hosted by Alex Pfister (Head, Patents and Designs Legal Services, Federal Institute of IP, Bern). The other attendees included two others from the Swiss group (Alexandra Grazioli - IP Counsel, Permanent Mission – Geneva); Marie Kraus (Legal Counsel, Law and International Affairs Division, Federal Institution of IP, Bern)), two from the UK (Phil Mountjoy (Senior Policy Advisor – Patents, Designs, TMS Directorate); Nick Smith (same title)), two from the US (Soma Saha (Patent Attorney, USPTO, Policy and External Affairs); Paul Trevisan (same title)), three from Japan (Hara Shinichiro (Japan Patent Office, Ass. Director Patent Attorney Affairs); Kenji Saito (Japan Patent Office, Deputy General, Multilateral Policy Office)) and three from Korea (Bong Hoon Lee (Korean IP office, Deputy Director, Patent Examination Policy Bureau); Jaehong Baek, Korean IP office, Senior Deputy Director, Multilateral Affairs); Shi-Hyeong Kim, IP Attaché, Permanent Mission – Geneva)). Michael believes that Sweden is also part of the "Core Group".

- 69.3 Naturally, there were many queries and caveats. The JP and KR representatives asked for more information on actual problems which had occurred in the past. The US representatives made it clear that the US would never be in a position to sign an MLA for Constitutional reasons. They thought the same outcome could be achieved by changing the US approach to the problem at the 'administrative level'. There were comments about 'soft' law - like adopting a 'declaration' instead of 'hard' law ie an MLA. We explained that the protection cannot work unless there is certainty that it applies.
- 69.4 The representatives informed AIPPI that the Swiss, Swedish and UK representatives had prepared a draft based on the joint proposal of the IP NGOs and that this would be discussed outside WIPO but at the same time as the General Assembly meeting of WIPO proposed for September 2014.
- 69.5 Steven Garland and the author had discussions with the delegates on a wide range of issues relating to the protection and how to implement any remedy for the problem.

70 The activities of the SCP on the protection of confidentiality of IP professional advice, since WIPO meeting SCP 20

- 70.1 There have been many meetings of the SCP since SCP 20. AIPPI has been represented at each one of them. As previously mentioned, Q199 was directly represented at SCP 21 and SCP 28.
- 70.2 On 15 November 2018, WIPO published the document SCP/29/5 which is its update of its Report SCP/20/4 entitled – 'Confidentiality of Communications between Clients and their Patent Advisers: Compilation of Laws, Practices and other Information'. This information update is a history, description and commentary on what the SCP had achieved in relation to study of the protection. AIPPI and Q199 in particular, can be well pleased with the outcome reported here. The work of the SCP is still ongoing in relation to the protection.
- 70.3 Some attention needs to be paid to the SCP meetings – SCP 21 to SCP 28.

70.4 These meetings are summarised on page 6 of the Report SCP/29/5, as follows. Further comments on each meeting from AIPPI's point of view, follow below.

20. Between its twentieth session and the current session, the Committee held the following activities with respect to the agenda item on the confidentiality of communications between clients and their patent advisors:

SCP/21: Seminar on the Confidentiality of Advice from Patent Advisors;

SCP/22: Continued discussion on the topic;

SCP/23: Sharing session among Member States concerning confidentiality protection applied to different types of patent professionals and to national and foreign patent advisors;

SCP/24: Continued discussion on the topic;

SCP/25: Document SCP/25/4 (Compilation of Court Cases with Respect to Client-Patent Advisor Privilege);

SCP/26: Continued discussion on the topic;

SCP/27: Sharing session on the experiences of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues;

SCP/28: Sharing session on the experiences and court cases of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues.

In addition, information on national/regional laws and practices, found on the dedicated website "Confidentiality of Communications between Clients and Their Patent Advisors", has been regularly updated based on the inputs from the Member States.

70.5 From the foregoing, it is reasonable to infer that WIPO has considered the topic of the protection to be worthy of its own section in WIPO's website.

71 WIPO meeting SCP 21 – 3 to 7 November 2014

71.1 For this meeting, WIPO asked AIPPI to provide the speakers for a seminar on the protection. Steven Garland, Chairman of Q199, Jeff Lewis, Member of Q199, and Wouter Pors, Co-Chair of Q199, spoke to the delegates in the SCP meeting, during the time allotted for the seminar process. Jeff Lewis made the oral submissions for AIPPI in the meeting dealing with protection of confidentiality as on the Agenda.

71.2 The matter remained on the Agenda of the SCP but WIPO was not mandated to carry out further work.

72 WIPO meeting SCP 22 – 27 to 31 July 2015

- 72.1 Discussions of the protection continued. The outcome was a decision to hold an information sharing session at SCP 23.

73 WIPO meeting SCP 23 – 30 November to 4 December 2015

- 73.1 The discussions focussed upon the protection as it applied from country to country, as it applied to different categories of IP professionals, and whether provision was made for foreign patent advisers.
- 73.2 The Swiss delegate reported on Swiss federal law dealing with patent agents, by amendments making that category of IP professional subject to professional secrecy.

74 Q199: Changes in the leadership of the Committee

- 74.1 The author retired as Co-Chairman of Q199 on 31 December 2015. He thereafter remained an ad hoc consultant in Q199 to Steven Garland as Chairman until October 2018, when Steve stepped down to be Chairman of AIPPI's Program Committee.

75 WIPO meeting SCP 24 – 27 to 30 June 2016

- 75.1 The discussions continued. The future work required the Secretariat to compile court cases on the protection and its application.

76 WIPO meeting SCP 25 – 12 to 15 December 2016

- 76.1 The Secretariat of WIPO published its Report SCP/25/4 – Compilation of Court Cases with respect to Client Attorney Privilege. At this time, the Report was confined to the US and CA. There were however, reports on litigation made orally in the meeting, by a number of delegates dealing with a position of the protection in their countries, including – the UK, CH and JP.
- 76.2 As to the outcome of the meeting, the discussions on the Report and the data coming forward from delegates of the Member States were to be continued at SCP 26.

77 WIPO meeting SCP 26 – 3 to 6 July 2017

- 77.1 The discussions on court cases continued. The Japanese delegate urged opponents of the study of remedies to be more objective about further studies in the SCP. The delegate pointed to the progress that had been made by the SCP on CAP. The delegate encouraged further work on the compilation of cases, and discussion on how patent professionals 'could receive protection of professional secrecy at national level and abroad'.
- 77.2 As to the outcome of the meeting, the information sharing on experiences with court cases, was to be continued at the next meeting.

78 WIPO meeting SCP 27 – 11 to 15 December 2017

- 78.1 The information sharing of court cases, that is, in relation to implementing confidentiality of communications between clients and their patent advisers continued. In particular, it involved looking into national legislation and cross-border issues.
- 78.2 AIPPI urged the Member States to continue this information sharing in SPC 28.
- 78.3 The meeting decided as to future work that the studies would be continued.

79 WIPO meeting SCP 28 – 9 to 12 July 2018

- 79.1 The focus for this meeting was to be on information sharing as described above. However, that was not limiting. The usual documents for this meeting are **Attachment 107**.
- 79.2 At this meeting, Q199 was directly represented by Chairman Steven Garland. AIPPI was also represented by John Osha, then First Deputy Reporter General. This was John Osha's first SCP meeting on CAP. Steven Garland made oral submissions on behalf of AIPPI. He spoke widely on the SCP role, the problem, and aspects of the process and problem which were ongoing. Among the points he made were the following.
- The SCP's continuing efforts over several years and currently its sharing information on confidentiality relating to the protection were acknowledged.
 - The two elements of the problem – first, lack of adequate protection 'domestically' and second, lack/loss of protection cross-border, were acknowledged. There had been progress on the first but not the second, Steven Garland noted.
 - It was submitted that it was now timely to make progress on the cross-border aspect of the problem.
 - The SCP was reminded that the problem had been added to by the development of the non-lawyer category of IP professionals. In particular, that category had not been recognised (as it should be) in relation to the protection.
 - This lack of recognition results in forced disclosure of confidential communications between clients and their IP professional advisers.
 - Among the negative outcomes – clients are discouraged from seeking IP legal advice from the newer IP professionals.
 - Unilateral efforts to improve the protection were noted. The **UK** has provided the protection to European Patent Agents and their clients, but there has been no improvement on the cross-border situation. **NZ**, **AU** and **CA*** have each gone a step further than the UK on recognising non-lawyer IP professionals, by providing the same protection for advice from overseas equivalents of the domestic IP professionals. Courts in the **US** now recognise professional secrecy in civil law as in effect an equivalent of common law privilege. The **USPTO** now has a rule that for the purpose of proceedings before the Patent Trial and

Appeals Board, communications between patent agents and patent owners are privileged.

- Other jurisdictions now protecting communications between clients and non-lawyer patent agents are **DE, ES, JP, FR, NL, SE, and CH**. They too deal with the first aspect (domestic) but not the second aspect (cross-border).
- The **UPC** Rules will make confidential communications between clients and their IP professional advisers (including non-lawyer patent attorneys and agents), privileged from discovery.

* The progress in CA is described below in Section 82.

- 79.3 All of the updating of laws relating to the protection referred to by Steven Garland except for NZ, has occurred since AIPPI commenced working with WIPO in the SCP following the WIPO/AIPPI Conference on Privilege in May 2008. In all, at last count, 10 nations have improved their laws on the protection since the Conference. These improvements have plainly been influenced by the work of WIPO and AIPPI (and other IP NGOs such as AIPLA, FICPI and APAA) on improving the protection. In 2018, WIPO published a major Report on 'Confidentiality of Communication between clients and their Patent Advisors' – (https://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html) - another important outcome of the Project.
- 79.4 This is a very satisfactory outcome from AIPPI's point of view. It means that the SCP's contributions to the project (which have indeed been substantial, and much appreciated by AIPPI) of studying all aspects of the protection, have been effective. Pleasingly, the SCP's work is ongoing – the establishment of the protection globally at an appropriate level locally and overseas, is the aim.
- 79.5 AIPPI has always considered the problem of the protection to be an issue which can only be resolved in the long term. Hence Q199 is a Standing Committee of AIPPI.
- 79.6 Even as it is unlikely that the Member States in the SCP will agree to make and implement an international agreement under the guidance of WIPO, it is positive that the issues relating to the protection can be aired in the leading IP global forum on patent law which WIPO provides by its SCP process.
- 79.7 Satisfaction of the need for an international agreement has been pursued by the GB+ nations in parallel with the SCP process. Support for the GB+ process is very much part of AIPPI's privilege project. This History now picks up AIPPI's work alongside and in support of the GB+ process, as from the time of the Colloquium (June 2013).

80 Group B+ countries and their efforts to establish an international agreement

- 80.1 AIPPI is limited in relation to describing the lengthy history on this topic from mid-2013 (the Colloquium) until the end of 2019. AIPPI was not directly involved in these negotiations. Over that period, there were substantial efforts by the GB+ countries to develop an MLA. However, the GB+

countries under the leadership of representatives of the Swiss government, particularly Alex Pfister, continually engaged with AIPPI and FICPI, and sought information and assistance from both.

- 80.2 The author was in or near the front line of working with the GB+ countries after the Colloquium until 2015. After that, it was Steve Garland's responsibility (as Chairman of Q199) until October 2018. Since October 2018, Andri Hess has been Chairman of Q199. More recently, Sarah Matheson has become Vice Chairman of Q199. To complete the picture, there are in fact two Vice Chairmen of Q 199, the second one being Robert Mattson (US). A reasonably complete picture emerges from these connections and connections between the IP NGOs with Alex Pfister in particular, including documents on the GB+ deliberations and proposals which Alex helpfully supplied to the IP NGOs. The History as it relates to this topic is told on the basis of those connections.
- 80.3 We should start by identifying the GB+ countries in WIPO. They are essentially the developed ones, namely – Austria, Australia, Bulgaria, Belgium, Canada, Croatia, Czech Republic, Denmark, Finland, France, Germany, Greece, Hungary, Iceland, Italy, Japan, Korea, Latvia, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malta, Monaco, New Zealand, Norway, Portugal, Romania, San Moreno, Spain, Sweden, Switzerland, The Netherlands, Turkey, United Kingdom, and United States of America.
- 80.4 After the Colloquium, the Swiss government representatives took the lead. That was when what became known as the Core Group of the GB+ countries emerged to deal with the detail involved in negotiating an MLA. That occurred at or just after the September 2013 meeting of the GB+.
- 80.5 Following the Colloquium and after much emailed consultation between the IP NGOs, they proposed that the IP NGOs' draft of the MLA, be amended in two respects. Those two changes are reflected in the blackline and clean versions of the Primer which Q199 updated post Colloquium – **Attachment 108**. The updated Primer (in its blackline and clean versions) was prepared by Q199 and sent via AIPPI's General Secretariat to Alex Pfister. Alex's main aim, at that time (he said), was preparing for the next meeting of the GB+ countries which was to be held in Geneva on 23 September 2013. The same updated Primer was sent by AIPPI-A to Fatima Beattie, the Australian Commissioner of Patents – **Attachment 109**.
- 80.6 The email in the **Attachment 109** described for Fatima issues which AIPPI had with the drafting of the MLA eg the definition of 'intellectual property advisor', the words 'authorised to receive such communication' and 'professional advice' and how drafting changes in the MLA related to the Primer. The intention of these 'alerts' was to forewarn IPA on what might come up for decision at the next meeting of the GB+ countries.
- 80.7 The amendments to the MLA in the Primer were first, in the definition of 'communication'; and secondly, in the definition of 'professional advice'. These amendments were straightforward. As to the definition of 'communication' - the words – 'authorised to receive such communication' were deleted as being unnecessary, and complicating. As to the definition of 'professional advice', the

exception from its scope of 'facts' was better defined as including those 'objectively relevant to determining issues relating to intellectual property rights (for example, the existence of relevant prior art)'. This change was made to reassure those in the SCP concerned about the disclosure of prior art being obscured.

- 80.8 Civil lawyers have looked upon the proposed MLA with understandable concern as to its apparent limitations on the protection, like its limitation in Article 2 to communications relating to the providing of professional advice. They start from the proposition that professional secrecy is absolute. That means that nothing is discoverable. Thus, they naturally expect there will be no limitation on the prohibition of disclosure. What tends to be overlooked in that analysis is that the MLA provides (in Article 2) for a minimum standard which allows limitations, variations and exceptions to that standard but does not mandate them. If the law in any country is wider in scope than the standard required in Article 2, that country should not be concerned that the protection it has, will be compromised. The limitations, variations and exceptions are needed for common law precepts and so, they should be of no adverse consequence to civil law countries which would not need or want them.
- 80.9 The definition of 'intellectual property advisor' includes lawyers, patent attorneys, patent agents, trade marks attorneys and agents in the scope of the minimum protection. It also includes 'any person' – but all the aforementioned must be officially recognised in a particular country as eligible to give professional advice on IPRs. Thus, it includes local and overseas persons so qualified and so, overseas IP advice is required to be protected from disclosure by both common and civil law country signatories.
- 80.10 One might ask – why if civil law countries already prohibit (by professional secrecy) any disclosure of communications relating to IP legal advice, do they need to sign up to the proposed international agreement? The **first** point is that, civil law countries do not absolutely protect IP professional communications in an overseas country which clients have obtained from IP professionals equivalent to their own. A civil law judge has power to call for any document to be disclosed. It makes no difference to the correctness of the previous sentence that the power may be rarely used. The **second** point is that civil law countries need common law countries (with the exception of AU, NZ and US) to change their law so that it protects client advice of civil law IP professionals from forcible disclosure. If civil law countries are not prepared to vary their law to prevent forced disclosure of common law advice, on what basis do they expect common law countries to change their law to protect civil law advice? This is one example of the need for the MLA.
- 80.11 As to common law, common law privilege does not certainly extend to the advice of overseas IP lawyers or the advice of non-lawyer IP professionals, unless that is legislated.
- 80.12 The transmission of IP professional advice overseas is thus at risk of forcible disclosure in both common and civil law countries. This undermines the security needed against the possibility of

forcible disclosure for clients and their IP professional advisers if the public interest in supporting the giving of correct legal advice is to be achieved.

- 80.13 The astute reader will observe that Article 2 of the draft MLA did not pick up the wording 'professional advice'. This is a treaty not a contract but even so, it would (if this Article were to remain in the treaty to be signed) be improved by inserting 'professional' before advice in Article 2.
- 80.14 On 22 October 2013, Alex Pfister asked AIPPI to provide him with a concise assessment of the problem (if possible, with several court cases from several jurisdictions) by the end of October 2013.
- 80.15 Historically in the context of the privilege project, the GB+ countries have held plenary meetings in Geneva coinciding with WIPO meetings in September/October. There have been other meetings between some of the GB+ representatives and Q199 representatives in Geneva, usually coinciding with SCP meetings.
- 80.16 Following the GB+ meeting of 23 September, 2013, Alex called for further information on the problem to be supplied by AIPPI. This came as a surprise to the author because the SCP (in which all GB+ countries were represented) had by this time thoroughly studied the problem for 4 years and it was the subject of a number of Reports published by WIPO. The author's guess is that the representatives of the Member States constantly change and that one should not assume that the successors are as fully briefed on what has happened in the past as their predecessors have been. Accordingly, in response to the Swiss government request, the author wrote a (further) work describing the problem etc under the title – 'Assessment of the Current Problems of the Protection' – **Attachment 110**. That too was sent to Alex on behalf of AIPPI.
- 80.17 Then, the relevant NGs of AIPPI were asked by the Q199 leaders to transmit the 'Assessment' document to the government representatives for each of the countries in the whose representatives attended the meeting with Steve Garland and the author – CH, DE, JP, KR, SE, UK and US, ie the Core Group. The author also sent the 'Assessment' document to Fatima Beattie for the Australian government, as to its interest in the work of the GB+ countries.
- 80.18 As to the Assessment document itself, its text reacted to what Alex Pfister had said that he needed – in particular – 'a precise assessment of the problem'. The Assessment first described its context including the need for the protection to apply with certainty if the protection is to work. It then described the problems including the legal cases in which the problem had had adverse effects – citing those in AU, CA, FR, and JP. The Assessment also urged the GB+ countries to accept the existence of the problem (much studied in the SCP) and to focus on remedies. It referred them to AIPPI's submissions to WIPO and WIPO's reports from October 2008 to April 2012, all of which had been published on AIPPI or WIPO websites.
- 80.19 A major effort was made by AIPPI in 2014 in the lead up to the GB+ meeting which was then to be held on 23 September, 2014. The author sent the updated Primer to the PTFRs for each of the

countries in the Core Group so that they could brief their respective governments with the update. This was to support the Swiss leaders in their efforts with those countries, to get the proposed MLA onto the working agenda of the GB+.

- 80.20 To assist Alex Pfister (as he had suggested), Steve Garland first settled with the author the amendments AIPPI proposed to make to the Swiss draft of the MLA. That went through the usual AIPPI process of seeking comments from the NGs through the PTFRs. The PTFRs were also requested to approach their governments' representatives with AIPPI's proposals and requesting them to take those into account in their planning for the September 2014 meeting.
- 80.21 In Australia's case, AIPPI-A brought IPTA and FICPI-A into the process after first identifying who were to be Australia's representatives at the September 2014 meeting. IPA provided those details. The representatives were to be – Patricia Kelly, Director General, Robyn Foster, General Manager Policy & Governance Group, and Jessica Allen, Director of IPA's International Policy & Cooperation Section.
- 80.22 The brief of AIPPI-A for IPA was prepared and sent to Jessica Allen, by email of 27 August 2014. That email and Jessica's positive response to it of 10 September 2014 are **Attachment 111**.

81 Publicity on the Outcome of the AIPLA, AIPPI, FICPI, Colloquium – Paris – 26-28 June 2013

- 81.1 To obtain and promote connection with the world of IP professionals generally on the outcome of the Colloquium, a review of the Colloquium was prepared for publication. This was published in the October, 2013 edition of Intellectual Property Magazine, at pp 44-46 – **Attachment 112** under the title – 'Protecting confidentiality in IP professional advice: an effective way is established'.
- 81.2 The review provided a rundown on what had happened. The organising IP NGOs were described. The remedy which was debated was defined. The presenters and their qualifications were identified. The introduction to the topic by the Primer, was described. The transcript of the meeting was recommended for its detail. The nub of each of the presenter's subjects was reported. The EU's proposals for the protection in the Rules of the Unified Patents Court were outlined. Further, the review pointed out that the AIPPI draft treaty/international agreement had stood up well to the test of peer review in the Colloquium.
- 81.3 Reflecting on what occurred at the Colloquium, the review commented on contributions to the debate by government representatives as very positive. Each of the government speakers was identified by name and country – which were – AU, CA, CH, DE, FR, NL, UK and US.
- 81.4 As to the impact of the Colloquium into the future, the review stated that amendments to the MLA suggested at the Colloquium were for the GB+ countries to consider as part of their process in solving the cross-border aspect of the problem.

82 Developments to improve the protection in Canada

- 82.1 A pleasing development for AIPPI emerged in October 2013 in CA. The IP Institute of CA (IPIC) is the Canadian equivalent of Australia's IPTA. IPIC sought through the author, the LCA's permission to use the LCA submission to Dr Ian Heath in 2005 (which is **Attachment 2**). IPIC needed to consider and use that submission in aid of a submission which it proposed to make to the Canadian government on the need to extend privilege to cover the clients of local non-lawyer IP professionals and their overseas equivalents. Permission was readily given by the LCA. IPIC's subsequent submission to the Canadian government and the follow up by IPIC, Steve Garland and others in CA, ultimately led to Canadian law on privilege being extended. That is, in 2016, it was proposed by a Bill to be extended to the clients of Canadian non-lawyer patent attorneys, and to the clients of the equivalents of Canadian IP professionals overseas with the rider however that the communications to be protected had to be subject to privilege overseas. This progress in CA (though weakened by the requirement that the overseas advice had to have been subject to privilege overseas) was welcome indeed.
- 82.2 Along the way to gaining this change in Canadian law, AIPPI-A, IPTA and FICPI-A co-operated to arrange a Minister to Minister (Australian Minister to Canadian Minister) exchange involving the Australian government in pointing out the changes already made in Australian law to the advantage of Canadian clients and formally urging CA to do likewise to the advantage of Australian clients in CA. An email of 27 October 2013, **Attachment 113**, to Michel Gérin, the Executive Director of IPIC states that IPA gave a direction that a Minister to Minister request was required. A subsequent email to Michel reported that LCA and IPTA would need to initiate that process and gave further directions. That email 29 October 2013 is **Attachment 114**. Those further directions included commentary on the Australian law of privilege as it affects IP professionals, background to the submission by LCA to Dr Heath (which was being considered for use in IPIC's submission), how the Australian amendments had worked out, and the remaining need being to get other countries to do the same so that Australian clients could rely on that protection for the advice they obtained overseas.
- 82.3 The LCA submission to the Australian government urging Minister to Minister exchange is dated 13 November 2013 and is **Attachment 115**.
- 82.4 The LCA, IPTA and FICPI-A with support from IPA, were successful in arranging the Minister to Minister communication in which the Australian Minister, Ian Macfarlane, Minister for Industry, urged his counterpart in CA, James Moore, Minister for Industry, to progress the Canadian protection towards the level which had been achieved by the amendments made in Australia.
- 82.5 On 9 December 2013, Michel Gérin informed the author that the Minister to Minister communication had been received by the Minister in CA and thanked him for the assistance which the LCA had given to the process of reform of the law on the protection, in CA.

82.6 Steve Garland described the amendments to the Canadian Patent and Trademarks Acts to WIPO in SCP 28 (July 2018) this way.

- They create protection from forced disclosure of communications with agents similar to that with lawyers.
- They extend to communications between IP owners and their foreign agents.
- Statutory protection has in part led to plans for a **more robust regulation** of Patent and Trademark agents in Canada through the creation of a fully regulated College of Patent and Trademark Agents.

82.7 This substantial progress was won over the period 2008 to 2013 through the tenacious and diligent efforts of AIPPI CA (Steve Garland in particular) and IPIC, and the same for the LCA and AIPPI-A which in the case of AIPPI-A supported AIPPI-CA throughout, and in the cases of AIPPI-A and LCA, brought Australian government support to the Canadian government just when it was most needed.

82.8 The Canadian government's understanding of the problem over many years had undoubtedly been compromised by local noise in CA against the changes which was driven by a turf war between lawyers and non-lawyers who were IP professionals. The important element forgotten in that war, was the client. The protection exists in common law countries to prevent the client from being forced to disclose legal advice. The public policy which that serves is now a well-worn track of this History – ie, to support the obtaining of correct advice.

82.9 The author had discussed the need for change with Canadian delegates in the SCP many times from 2008 to 2012. After such discussions over those four years, a chink of light emerged from an otherwise dark space when the Canadian delegate said to the author – **'I get it now!'**

82.10 Later in October 2017 at the Sydney Congress of AIPPI, Steve Garland said in the context of Q199 representatives reporting on any national successes in developing the protection –

It is certainly true that the recent success in Canada in having a statutory CAP provision added to the Canadian Patent and Trademark Acts was to a great extent the result of the work of AIPPI.

82.11 The reader will rightly conclude, however, that the amending process in CA, is an unfinished symphony. Greg Chambers (for FICPI-A) and the author (for AIPPI-A) independently pointed out the following issues with the amendments when their detail was first published in 2016. Greg wrote to the Australian government and the author to Steve Garland. Steve said that he was aware of these points but that the Canadian process would not allow him to get them fixed during the Bill stage. From the IP professionals' points of view, he said, it was better to get the proposed changes made with imperfections, and to improve the law by amendments made later. The author inferred that Steve did not want to risk the amendments being delayed to make amendments. The issues so raised are specified in paragraph 82.13 below.

82.12 The views of AIPPI-A and FICPI-A on the Canadian Bill were expressed in emails – by AIPPI-A to Steve Garland dated 14 May 2015 (**Attachment 116**) and by FICIP-A to Adam Wright of the Australian government which, of course, was taking interest the Canadian developments as previously described.

82.13 As the reader will see from **Attachment 116**, the issues AIPPI-A had with the Canadian proposed Bill were as follows:

- Under the Canadian proposal, protection would not cover documents created as part of the work process of the IP professional but not communicated: this would potentially allow forcible discovery of part of the IP adviser's work product.
- Further under the Canadian proposal, an overseas agent's communications must be privileged overseas before they can be protected from forcible discovery in CA. Thus, no communications between clients and their overseas equivalent agents in civil law countries, can be subject to privilege in CA.
- Therefore, the Canadian proposal does not (as, for example, the Australian law does) provide protection from forcible disclosure irrespective of whether privilege would apply in the overseas country.

82.14 Steve Garland recently commented to the author on the foregoing to the following effect:

- The work product in the IP professional's brief would be covered by the common law/statutory privilege in CA.
- The requirement that the overseas agent's communications must be privileged overseas, stands. Steve maintains that the issue of protection from forcible disclosure in CA will be decided by common law or statutory interpretation.

Thus, the second point is at best uncertain and at worst, the requirement that the overseas agent's communications be privileged overseas (which does not apply in any civil law country) will compromise solving the cross-border problem in relation to civil law advice. AU and NZ avoid this outcome by deeming **their** privilege to apply to the overseas legal advice of overseas IP professionals equivalent to their own, respectively.

83 Review of the outcomes of SCP 20 and GB+ meetings (both January 2014)

83.1 These two meetings have been reported in Sections 68 and 69 above. They both had positive outcomes. First, in the GB+ meeting, there was interest in the study of remedies. At the SCP 20 meeting, the committee enabled WIPO to study remedies.

83.2 Stephan Freischem (Secretary General of AIPPI), John Bochnovic (President) and Thierry Calame (Reporter General) recorded their thanks to Steve Garland and the author for their efforts and work in the interests of AIPPI at the two meetings. The relevant messages are in **Attachment 117**.

84 The proposals for an MLA to the GB+ countries led by the Core Group

- 84.1 As the GB+ countries only meet in plenary sessions once a year, progress was per force slow. Whilst the issues they had been dealing with as to drafting are rather few (the MLA is after all a short document), the issues were not easy.
- 84.2 Looking at the MLA as it started out – **Attachment 118**, the reader will see that as compared with AIPPI's proposed MLA (post Colloquium), 'trade marks attorneys' are omitted from the definition of 'intellectual property advisor'. AIPPI's position based on the Resolution in Q163, is that trade marks attorneys should be included. To this the Swiss government responded that the words 'or other person' in the definition of 'intellectual property advisor', could be the basis for trade marks attorneys to be included by any country that wished to include them.
- 84.3 To that AIPPI responded that if 'or other person' means that trade marks attorneys are covered too, it must mean that for every signatory. Thus, CH would have to opt out under Article 4 if trade marks attorneys were not to be included in CH. Further, AIPPI responded that if 'or other person' means that trade marks attorneys are covered too, there is no point in omitting them by name.
- 84.4 This exchange of views led to some GB+ countries which (like CH) had a problem with including trade marks attorneys, favouring omission of the words 'or other person', from the definition.
- 84.5 As to the reasons for CH not being in favour of including 'trade marks attorneys', Alex Pfister explained that the persons practising in CH as to trade marks are mainly lawyers. They are, of course, already subject to regulation. However, there is a minority of practitioners using the name 'trademarks attorney' who are neither formally trained nor regulated. CH did not want to regulate them. These circumstances are subjective to CH. AIPPI maintained its view that including 'trade marks attorneys' with the right to opt out, was the appropriate solution.
- 84.6 Apart from the reasoning which is expressed in the previous paragraph, and the policy of Q163, AIPPI's reasons (which have been stated to Alex) for inclusion of trade marks attorneys are as follows.
- The legal position of the clients of trade marks attorneys is the same as it is for patent attorneys – they need local protection from forcible disclosure and protection from forcible disclosure of their overseas IP legal advice.
 - Given that CH has a subjective problem with the inclusion of trade marks attorneys, CH cannot be bound to include them – but provision is made for that in the AIPPI proposal by the right, to 'opt out'. CH could sign the MLA but 'opt out' as to protecting trade marks attorneys under Article 4 of the AIPPI MLA.
 - In view of the need to include trade marks attorneys for many countries, it seemed to AIPPI that CH what was proposing was excessive and unfair to the clients of trade marks attorneys.

Thus, AIPPI was not in favour of removing 'trademarks attorneys' from the definition of IP professional advisors. It would have been acceptable to AIPPI to strengthen the right for a

signatory to 'opt out' under Article 4 as to 'trademarks attorneys'. AIPPI suggested adding wording to the second line of Article 4. AIPPI's proposed amendments are shown in **Attachment 118**.

- 84.7 To secure the effect of the MLA cross-border as to those countries that did opt out as to 'trademarks attorneys', AIPPI further suggested adding another sentence to Article 4 as shown in **Attachment 118**. That addition would mean that the MLA would continue to apply to prohibit forcible disclosure of the advice of overseas trade marks attorneys, even if a country opted out as to its own trade marks attorneys.

85 Q199's work with GB+ in 2014 following the SCP 20 and GB+ meetings in January 2014

- 85.1 The relationship between Alex Pfister as the leader of the GB+ countries on the issue of the protection and Q199, was always positive. GB+ had asked for details of the problem 'in action'. AIPPI provided GB+ with AIPPI and WIPO publications on this topic. Steve Garland sent Alex a message by email on 8 February 2014 referring to the Assessment document (which is **Attachment 110**), as follows.

I understand from speaking with Michael that you had asked that we provide some further details on the adverse effects on IP owners (clients) and IP practitioners. Accordingly, Michael has asked that I provide the following in response.

For your ease of reference, I attach a copy of our written submissions to WIPO that were filed in December of 2013 and Attachment 2 (Assessment document). The Assessment document sets out in some detail the problems that have been previously encountered in different jurisdictions as a result of a lack of adequate protection both nationally and in respect of cross-border situations.

To summarize, the problem is the lack of protection in some countries and where the protection exists, the non-recognition and loss of that protection cross-border. In this regard, the Assessment document refers to the resulting behavioural effects on practitioners in paragraph 1.8 and in paragraph 1.7 to the need for certainty that the protection will apply if the obtaining of correct legal advice is to be supported by the protection.

There is another serious effect which occurs for every practitioner starting out on a new matter or a new aspect of an old one. In particular, it pertains to the nature of assurance, if any, that a practitioner can provide to the client that the confidential instructions/advice will be protected from forcible disclosure, including in respect of disclosure in another country. It will be recalled that the giving of such an assurance is desirable to encourage the client and the practitioner to be frank with each other and thus to support the giving of correct advice. For the protection to be effective there has to be certainty on non-disclosure. In the current state of the protection, the answer as to what, if any, assurances the practitioner can provide, is at best complex. This is further discussed in paragraphs 2.7, 2.8 and Section 3 of the Assessment document.

Overall, in view of the above it is clear that an international agreement is necessary to give better effect or at least better support to the public interest in correct IP advice being obtained.

- 85.2 Alex had also requested the description of an experience in practice which might assist the GB+ countries to understand the seriousness of the problem. AIPPI provided an example of a serious breakdown in communications involving patent litigation in UK, AU, US and some European countries. The outcome of that breakdown was contrary to public policy supporting the obtaining of correct legal advice. The message from the author back to Alex dated 11 February 2014 was as follows.

I was the source of the example to which Alex refers. I provide the following text for you to work into your proposal with such amending as maintains the meaning but makes it effective in your context.

Another example of the behavioural dilemmas which practitioners have experienced in practice is as follows.

A multinational originator pharmaceutical company was conducting infringement proceedings against a generic pharmaceutical company in the UK, Australia, the USA and some European countries. The main legal instructions were sent from the US external lawyers to the company's external lawyers in other countries. The source of scientific instructions was the UK. The Australian lawyers read affidavits filed by both the originator (their client) in the UK and the USA. The Australian lawyers needed to question their US instructions on title and validity.

The US instructors were easy about discussing title with the Australian lawyers but flatly refused to discuss validity. Their reasons were that title was unlikely to be controversial but validity would be fiercely contested all around the world. The last thing they wanted (they said) was that their advice in the US could be forcibly disclosed in another country. As the opposition would leave no stone unturned to get their advice disclosed, they simply could not justify the risk of disclosure to the client – ie disclosure arising from them sharing their advice on validity with overseas lawyers. There were in their view too many possibilities of unprotected sharing of the advice with patent attorneys or agents overseas.

It is greatly to the disadvantage of the client that there cannot be full and frank communications between a client and its IP lawyers – in particular, this situation compounds the risks of the client getting incorrect legal advice.

- 85.3 The author briefed AIPPI-CA on the process by which Australia had achieved amendments to the Acts. That was provided by email of 3 April 2014 a copy of which is **Attachment 119**. The parts of **Attachment 119** most positive for the Canadian approach to its government, were those on page 1 under the heading 'Canada' and on page 2 reporting the assistance AIPPI-A had obtained by meetings between government and users of the patent system. The reader will see that AIPPI-A sent Steve the statements made by users of the patent system in support of securing the

protection. As previously reported, these were made by executives of AstraZeneca Australia, Biota Holdings Limited, CSL Limited, StarPharma Holdings Limited and Telstra Corporation.

- 85.4 An email by Stephan Freischem to Q199 leaders also dated 3 April 2014 is included in **Attachment 118**. The reader will see Stephan's concern that Germany would have to opt out of any aspect of the MLA which compromised the absolute effect of professional secrecy. The MLA does not do that because it proposes a minimum standard adopting the elements of confidentiality and no forcible disclosure which are existing elements of both systems of law. It does require each system to vary its own law to obtain harmony between them but not to adopt an element of the other's system.
- 85.5 To obtain harmony, the civil law power of the judge to call for any document, would need to apply only to documents relating to a claim of crime or fraud. That would remove the uncertainty of the power being exercised to force disclosure of legal advice on any other subject relevant in an IP case. The civil lawyers in AIPPI say that that is how the power would be exercised if it were used at all.
- 85.6 Likewise for common law, the common law country would have to forego the power to force disclosure of the IP professional advice of non-lawyer patent attorneys in civil law countries, except in a case relating to crime or fraud.
- 85.7 As at 31 December 2018, the GB+ countries were continuing negotiations on an MLA. AIPPI hoped that the solution which it had proposed, would assist in that process. In particular, the solution which it had proposed would avoid compromising existing law bearing in mind the established positions of both civil and common law as described in 85.4 and 85.6 above.
- 85.8 Continuing on the theme of Q199 assistance to GB+ countries, in early April 2014, Alex Pfister sent AIPPI a draft MLA for comment. On 7 April 2014, Steve Garland sent AIPPI's comments to Alex by email. The problems AIPPI was dealing with included the omission of trademarks attorneys and a suggestion that IP professional advisers might be described as those 'authorised to perform patent work before a court'. That would not work in AU or CA, and many other countries. The following is quoted from Steve Garland's email referred to above.

AIPPI has reviewed both the explanatory memo and the Annex III attachment and is very pleased with the contents. However, we do have a few comments for your consideration.

- (i) We appreciate the reasons for the GB+ initiative focussing on non-lawyer patent attorneys (NLPA). However, as you know, AIPPI is of the view that any solution would preferably address both NLPAs and non-lawyer trade mark attorneys (NLTMA). Indeed, as one example, in Germany NLPAs are responsible for all IP prosecution before the German PTO, including in respect of trade marks. Accordingly, in AIPPI's view, the difficulties that may arise as a result of non regulated NLTMA's in some jurisdictions would be better addressed not by

excluding them from any agreement but by permitting such jurisdictions to opt out of having the agreement pertain to NLTMA's.

- (ii) In the second paragraph at page 4 of the explanatory memo, it is suggested that the Professionals to be covered are those described as being 'authorised to perform patent work before a court'. This description will prove quite problematic as it will exclude all NLPAs in jurisdictions which do not accord to NLPAs the right to perform patent work before a court. Canada would simply be one such example. AIPPI would suggest that this be amended to read 'authorised to carry out patent work and to give advice related to that work'. This should be acceptable as the draft makes it clear that the protection extends only to what is within the scope of the adviser's authority under national law.
- (iii) We would also suggest that the parenthetical example provided in Annex III of the kind of IP advice that would be covered should include a specific reference to "patent infringement and/or validity opinions".

85.9 In early July 2014, AIPPI commented to Alex Pfister on a draft Explanatory Memorandum which he was proposing to use to explain the draft MLA to the GB+ countries at their meeting proposed then, for September 2014. The Summary extracted from the draft Memorandum acknowledged the IP NGOs work as a base from which the GB+ countries could go forward in their consideration of the MLA – **Attachment 120**.

85.10 Also in July 2014, Alex asked AIPPI to brief its NGs in AU, CA, DE, KR, JP, FR and the US on AIPPI's views on the proposed MLA in order to gain their support for the MLA process he was leading. Through Terry Moore in IPA, AIPPI-A identified Jessica Allen as leader of the IPA team preparing for the September meeting of GB+ in Geneva.

85.11 Then, as requested by Alex, AIPPI-A contacted Jessica Allen by email of 27 August 2014 – **Attachment 121**. The report in that email describes AIPPI-A's position on the limitation of the MLA to patent attorneys, in these terms.

AIPPI Australia supports the proposed agreement as in 3 above. In particular, if implemented in this form, the proposed agreement would gain between the signatory nations, law which is consistent with the client attorney privilege amendments which have already been made in Australia.

Such an agreement would in effect provide for the clients of Australian patent and trade marks attorneys, reciprocity in the signatory nations for the protection they have in Australia. The amendments proposed by AIPPI in attachment 3 are required to obtain that level of protection.

The proposed agreement (ie as in attachment 1) is limited to clients of patent attorneys. That format is influenced by a view of the position of clients dealing with trade marks attorneys in Switzerland. Trade marks attorneys there are not regulated 'as such'. However, (Ed. - most) trade marks attorneys in Switzerland are lawyers the clients of whom have the protection of confidentiality and professional secrecy.

AIPPI considers that the limitation to patent attorneys in the proposed agreement, overlooks first the need in Switzerland for clients of the lawyer trade marks attorneys to be protected from forcible disclosure in common law nations (local confidentiality and professional secrecy are possibly not enough to prevent forcible disclosure by a client in common law nations of the advice of a civil lawyer acting as a trade marks attorney), secondly the similar need for clients in other nations of non lawyer trade marks attorneys to be protected from such forcible disclosure, and thirdly, the need for clients in all nations for the protection so achieved in any particular nation to be recognised in other nations (such 'recognition' meaning – to have effect in all other signatory nations).

Even so, AIPPI-A commended the MLA as a whole to the Australian government. Jessica Allen responded that IPA - 'sees value in finding a solution to cross-border aspects of client attorney privilege'. The matter was being progressed with government, she said. And further, she said - IPA had briefed Alex Pfister on how Australia makes treaties. These messages were positive.

86 AIPPI's support for WIPO at SCP 21 meeting (November 2014)

- 86.1 At about the time of the meeting of GB+ in September 2014, Marco Aleman, Director, Patent Law Division of WIPO, requested AIPPI to contribute speakers to a half day seminar on CAP (foreshadowed at SCP 20), to be part of the SCP 21 meeting. The potential views of AIPPI for this seminar were expressed in an email by the author to Steve Garland of 2 October 2014 – **Attachment 122**.
- 86.2 In particular, the Member States had been addressed by AIPPI previously on various aspects of CAP (including the problem, the remedy and details of an MLA). A fresh approach by AIPPI in its presentation, was needed. The second half of the email attached, related to how that new approach could be achieved. The Seminar in WIPO on CAP (5 November) was presented by AIPPI, AIPLA and FICPI representatives.
- 86.3 AIPPI maintained its position that a 'soft law' approach would not solve the problem. However, AIPPI also maintained its position that further work on the protection in the SCP, should be supported. It accepted (at that stage) that the SCP might need to consider 'soft law' further.

87 The USPTO Roundtable Conference on the Protection – 18 February 2015

- 87.1 In January 2015, AIPPI-A received notice of this Conference. The notice was published in the US Federal Register. The notice is **Attachment 123**. This was welcome news and it indicated support by the US government for the aim of the privilege project to have changes made that were positive to the widening of the protection globally. As part of that 'support', it foreshadowed the making of administrative changes in the US which its representatives at the GB+ meeting in January 2014 had indicated would be considered by it.
- 87.2 The Summary in the notice on the US Federal Register caught the attention of the author. AIPPI-A thought that AIPPI should be involved, and that it should make oral and written

submissions, if allowed. The notice allowed for written submissions to be filed after the meeting, ie by 25 February 2015. AIPPI-A also thought that IPA should make a submission on behalf of the Australian government. The notice itself referred to the fact that AU and NZ had passed laws 'extending privilege to foreign practitioners who are authorised to provide patent advice in other countries'. AIPPI-A also thought that the LCA should make a submission to the USPTO.

87.3 The proposals made to inform and encourage submissions to the USPTO are in the following documents and are attachments to the history, as indicated below.

- As to AIPPI – emails to Steve Garland of 9 and 11 February 2015 – **Attachment 124**.
- As to IPA – email to Jessica Allen of 11 February 2015 – **Attachment 125**.
- As to LCA – email to Richard Hamer of 13 February 2015 – **Attachment 126**.

Taken overall, these emails suggested that the following points should be made out in submissions to the USPTO Roundtable inquiry.

- How the problem plays out in practice against the public policy of supporting the obtaining of correct legal advice.
- The lack of coordination between countries which defeats the protection internationally.
- The need for certainty of outcome for the protection to work.
- The gap between effective and ineffective protection was narrowed by the Australian amendments but it remains because of negative cross-border effects.
- The gap can only be fully closed by an international minimum standards agreement (an MLA).

87.4 Steve Garland attended the meeting for AIPPI. Written submissions were made to the USPTO inquiry by AIPPI. Submissions were made by IPA; they were in effect government to government communications and not published. The IPC submission of the LCA of 27 February 2015 is **Attachment 127**. In short, the IPC submissions supported US legislation being made to underpin the protection nationally and extending (as the Australian Acts do) to IP advice obtained overseas, and supported the AIPPI, FICPI and AIPLA proposed MLA. A copy of this LCA submission was sent to IPA.

87.5 Referring to the US Register announcement of the USPTO Roundtable – **Attachment 123**, the reader will see that Soma Saha is visible in the US process of reform, this time as the information contact (or one of them) for the Roundtable process. Soma attended the meeting in Geneva in January 2014. She was always positive and encouraging as to how the USPTO would be able to get USPTO law and US legal practice in the right place.

88 Further action of the GB+ countries on the MLA – 2015

- 88.1 During early 2015, AIPPI made further attempts to turn the GB+ process away from omitting trademarks attorneys. AIPPI tried to do this by engaging the Swiss and UK groups of AIPPI to make representations to their respective governments to this effect – **Attachment 128** (emails as to CH) and **Attachment 129** (an email from Q199 to AIPPI-UK dated 19 February 2015).
- 88.2 These efforts were largely unrewarded though one would not question that they were treated seriously by the leadership of GB+. By these emails, Q199 helped the respective NGs by informing them of the Swiss government proposals for the MLA which could have the adverse effect on them of omitting trade mark attorneys.
- 88.3 On Monday 23 February 2015, the author met with representatives of IPA at the offices of IPA in Canberra. The persons attending for IPA included Jessica Allen, Terry Moore, Greg Vuckovic and Keith Porter. The subjects for the meeting were submissions of IPA to the USPTO Roundtable and the GB+ proposals for an MLA. IPA was not aware of any additional reason behind CH's intention to exclude 'trade marks attorneys' by name.
- 88.4 That is, not beyond knowing that CH had unregulated trade marks attorneys and was against having to regulate them. In relation to the issue of CAP in the SCP, AIPPI stressed the need to keep GB+ connected with the study of the protection in the SCP. At that time, remedies were being studied in the SCP. IPA was supportive of AIPPI's views. In relation to the issue of the MLA extending to trade marks attorneys, AIPPI maintained its support for the MLA to include them.
- 88.5 AIPPI tried to get AIPPI-UK to engage with the UK government (one of the members of the Core Group). The UK government would not give AIPPI UK a satisfactory answer on the potential exclusion of trade marks attorneys from the MLA.
- 88.6 As to DE, Q199 called on Jochen Buehling (a member of AIPPI-DE and Reporter General of AIPPI) to engage with the German government to support the MLA. The representatives for Germany had been less than positive and apparently did not see the risks to German clients of non-lawyer attorneys of forcible disclosure in common law countries, at that time in all of those except AU and NZ. The Q199 brief to Jochen is dated 6 May 2015 and is **Attachment 130**.
- 88.7 The outcome was that the German government in effect denied being less than positive and said that it had let other countries more affected by the problem than Germany, take the lead. It mentioned 'countries more affected' in the context of 'common law countries'. This plainly misunderstood the problem. True, the problem is caused by the long-established law in common law countries but they do not have the problem; civil law countries do in relation to the advice of their non-lawyer attorneys. The German government said that it remained supportive of the MLA. It asked for more direct communications by the CH government on what input was needed from the German government.
- 88.8 A further development as to Germany was Jochen Buehling's view that Article 4 of the MLA (as it stood) would not be seen as sufficient for the MLA to be in harmony with German law on in-house

counsel. In DE, privilege does not apply to in-house IP lawyers (ie employee lawyers). He said that the German government would need the MLA to specify that in-house lawyers and attorneys could be excluded.

- 88.9 On the same reasoning, the author notes, Article 4 would need to specifically provide for the exclusion of trade marks attorneys (both private and employed) in the case of DE. However, the foregoing makes assumptions as to how the drafting of the MLA will be settled. All one can say now is that these are matters for the GB+ countries to resolve in their drafting of the MLA.
- 88.10 Q199 had been considering changes to Article 4, even the concept of dropping it. Jochen's intervention (and other considerations) meant that dropping Article 4 was simply not possible. Q199 corrected its position on Article 4 – see the email of 6 July 2015 to Andri Hess of CH in **Attachment 131**. The references to US law in this email are to its law as it was then, ie unchanged as to requiring equivalence of civil law with common law on the protection. Of course, we know now that that has changed for the better but there are still numerous (about 36) common law countries which if required to decide an issue of forcible discovery, could adopt the US position as it was then and call for disclosure of overseas legal advice on the basis that the protection overseas only applies if it is equivalent to common law privilege. Apart from that, the email explains the reasons for having Article 4 and the balancing of common law and civil law which is involved in the MLA.
- 88.11 Further, as to DE, Q199 requested Jochen to follow up with the DE government further. Q199 supplied further commentary by its email to Jochen of 6 July 2015 on the importance of this action – see **Attachment 132**.
- 88.12 As to JP, there was little progress in resolving its difficulties at this time. This observation does not reflect in any way negatively on the efforts of Q199's representatives in JP - Shoichi Okuyama and Yuzuru Okabe. In July 2014, Shoichi had been appointed as a Co-Chair of Q199. He reported then that the Japanese Patent Office (JPO) was still considering a 'soft law' approach to the problem. The response to that by the author is in an email of 24 July 2015 – **Attachment 133**. As previously said, soft law produces uncertainty – the reverse of what is required to solve the problem. It was very welcome to have Shoichi join the leadership of Q199. He and his colleague Yuzuru Okabe, are both long-time IP professional friends of the author. In August 2015, Shoichi reported in Q199 that the JPO said that it had no outstanding matter in its contacts with Alex Pfister. That is very puzzling because Alex had said he had outstanding matters with JP. A further part of the puzzle for Q199 was that Alex reported that JP and the US were requesting 'further study' and data. This confusion indicates the difficulty of the GB+ process for the IP NGOs and of trying to make sense of it when not directly involved in it.
- 88.13 By email of 12 August 2015 to IPA, AIPPI-A provided a 'roundup' to IPA of its views on the negotiations on the MLA by GB+. This dealt with the situations of DE and JP, and the drafting changes being considered as to Article 4 of the MLA by the GB+ Core Group. This email was intended to inform IPA on the issues which were going to be debated at the upcoming (then

October 2015) meeting of the GB+ countries in Geneva. The AIPPA-A briefing was received well by IPA. The roundup of 12 August 2015 and IPA's response of 24 August 2015, are

Attachment 134.

- 88.14 As part of the preparations for the October meeting, Alex Pfister asked for further data on the main differences in the protection between countries. AIPPI was, of course, surprised about that. AIPPI had supplied CH with the report made by Q199 to the Paris Congress meeting of AIPPI in October 2010. That report is included in this history – see **Attachment 53**. The reader will recall that that report had already been provided to the delegates in WIPO. Thus, this was the second time that AIPPI had supplied to representatives of the Member States of WIPO with this (same) data – see the email of Q199 to Alex Pfister of 18 August 2015 - **Attachment 135**. So, the GB+ process was actually going over old ground. Nevertheless, AIPPI supplied the same material again guessing that the Member States representatives in GB+ were probably not the same as the delegates in WIPO and thus not aware of AIPPI's comparative law work on the protection in WIPO.
- 88.15 Steve Garland was to be AIPPI's representative at the GB+ meeting in October 2015. In the lead up to it, the author related his views to Steve on AIPPI's expectations of the MLA, that being the main focus of debate on the protection at that meeting. These views are expressed in an email to Steve dated 5 October 2015 – **Attachment 136**. This message dealt with the difficulty of a suggestion that 'all other persons' be omitted from the definition of IP adviser. Those words were being considered as the basis for countries to include trade marks attorneys in the protection under the MLA. It was also pointed out that using the word 'privilege' in the MLA would be awkward because privilege means protection of the client from forcible disclosure in a common law sense, whereas it means protection of the professional adviser in the civil law sense, and the civil law category of privilege does not apply in every civil law country.
- 88.16 The representatives of GB+ countries decided at their meeting in October 2015 to have a further round of consultation between them, on the MLA. This consultation was to be assisted by a Questionnaire issued on behalf of the Core Group leaders by Alex Pfister.
- 88.17 Alex needed the IP NGO's support to get the GB+ countries to focus on the reasons why the MLA was needed. AIPPI agreed to follow that up through its NGs for the respective countries. The critical countries as identified by Alex were – DE, FR, JP, KR and US.
- 88.18 The Core Group Questionnaire (which is **Attachment 137**) invited the GB+ countries to go back over issues which had been studied and decided in the SCP, that is, by delegates in the SCP including those from the GB+ countries. For example, the Questionnaire asked –
- is there a need to protect communications between IP professionals (non-lawyer/lawyer) and their clients in cases having cross-border aspects?
- and

- have you been confronted with situations where the client attorney privilege was an issue?

- 88.19 As to the first question, the representatives of the developed countries might know the answer if their countries were ones which already provided the protection locally. Thus, it was reasonable to expect that they would not accept the protection being negated by the advice being sent cross-border. The need for the loss of the protection cross-border had previously been established in the SCP as part of the SCP's study of the problem.
- 88.20 As to the second question, it was highly unlikely that any bureaucrat working in government would have had experience of, let alone have been 'confronted with', situations where client attorney privilege was an issue. The right persons to ask would have been, of course, the IP professionals. Their answers were already on record in the SCP. That information is already described in this history. As the readers of this history already know, the problem is an 'every day' one for IP practitioners. Their diversion into considering the risks of the lack or loss of the protection from other more fruitful tasks, quite obviously causes enormous cost globally. In many cases, the applicability of the protection would be uncertain. The effect of uncertainty is that the relevant public policy in favour of efficient communications between clients and their IP advisers to get correct advice, is compromised.
- 88.21 On 31 December 2015, the author stood down as Co-Chairman of Q199. He remained connected with Q199 as an ad hoc consultant to Steve Garland who was continuing as Chairman. The same type of relationship applied between the author and AIPPI-A. The 'handover' Memorandum dated 23 December 2015 to Peter Franke (et al) who became the AIPPI-A PTFR for Q199, reflects on the GB+ situation. On pages 3 and 4 of the Memorandum, background was supplied to Peter Franke for contacting IPA on answering the Questionnaire (the answers were due by 31 March 2016). The handover Memorandum is **Attachment 138**.
- 88.22 The Memorandum made the following points (among others).
- The communications which are protected are not 'at large' – they are those related to the giving or obtaining of legal advice.
 - All IP professionals are affected by the problem.
 - The questioning by GB+ countries of the existence of the problems shows failure to understand the ubiquitous nature of the problem – as soon as the IP professional has to give attention to it, the cost of it begins.
 - Asking what should be essential to be regulated by an MLA, fails to take into account that the draft MLA already targeted what should be regulated.

AIPPI decided that the Core Group leaders had been caused to wind back their starting point for the Questionnaire because the GB+ representatives needed to go through a similar process to the one that the delegates went through in the SCP.

- 88.23 As to AU, AIPPI-A and LCA answered Alex Pfister's call to brief the national governments, by briefing IPA - **Attachment 139**. That brief included drawing IPA's attention to the sorry state of the GB+ process. The brief was read and supported by IPTA and FICPI-A in their reports to IPA.
- 88.24 During the remainder of 2016, there was little activity involving action by AIPPI in support of GB+. There was, however, a decision of the Federal Court of Australia on the amended S 229 of the Trade Marks Act - dealing with the client privilege of trade marks attorneys, which should be mentioned. S 229 is the equivalent for trade marks attorneys as S 200(2) is for patent attorneys the text of which is stated in paragraph 9.25 above.

89 Titan Enterprises (Qld) Pty Ltd v Cross [2016] FCA 1241 – Logan J

- 89.1 The author was approached by Michael Caine and Greg Chambers for his comments on this decision. Greg suggested that the Court seemed to be of a mind which might 'undo' some of the good work done by the IP NGOs in relation to the amending of the Acts, by defining 'advice' rather narrowly in the context of the Trade Marks Act. Michael Caine's query was the same.
- 89.2 This case involved a dispute about a claim to client privilege asserted to exist in particular documents in a trade mark attorney's file. The case was decided on lack of proof that the documents were in fact subject to privilege. In response to Michael and Greg's request, the author sent a Memorandum to them. This was prepared by him as an academic (not practising) lawyer. That reservation was expressed in the Memorandum. The Memorandum dated 24 October 2016 is **Attachment 140**.
- 89.3 The case causes problems for attorneys in the Judge's comments about what part of their work product will be protected from forcible disclosure. Essentially, that issue should be the same as between lawyers and patent attorneys. There is authority for protecting lawyer's work if it is 'related to' the advice given. That is not surprising seeing that the public policy aim is to protect by privilege in a way which will support the giving of correct advice. If discovery is required of work product which could allow the opposition to get even some hint of the actual advice given, it would be contrary to that public policy.
- 89.4 The Judge has caused some angst for IP professionals which was unnecessary as the comments he made were not essential to the point on which the case was decided. He did not seem to realise that the Act was changed to increase the likeness between the protection of clients of attorneys with the protection of clients of lawyers. So, one would expect that attorney communications 'related to' the advice given would be privileged even if they were not the actual advice. It will endanger the certainty required for privilege to be effective if the protection does not extend to all documents the disclosure of which might provide insight into the advice which was given. The reader will recall that the position of attorneys was to be aligned with that of lawyers by requiring that the privilege of the former would apply 'in the same way, and to the same extent' as for a lawyer.

- 89.5 That said, 'advice' including work product related to the communication of such advice, is a specific and narrow subject. The reader will recall that AIPPI had asserted that very point in the SCP where some developing nations thought that privilege could be so wide as to obscure facts that it was desirable to know in the case. The subject covered by the protection is just the legal advice including what is related to it and that would include anything indicative of what that advice may be.
- 89.6 It remains to be seen where the interpretation of S 229 of the Trade Marks Act will go in detail. However, the Titan Enterprise case is not a reliable guide on its own because the commentary it makes on the scope of 'advice' of attorneys which is protected, is obiter.

90 GB+ in 2017

- 90.1 In May 2017, Sarah Matheson and Steve Garland met with Alex Pfister in CH. Steve reported to the PTFRs on that meeting, thus.
- Alex confirmed that GB+ was moving forward on the proposed MLA.
 - AIPPI confirmed its support for this GB+ initiative.
 - Alex asked AIPPI to continue its support through its NGs on this occasion mentioning the US, KR and JP AIPPI Groups in particular.
- 90.2 The annual plenary meeting of the GB+ was held in Geneva in October 2017. Steve updated the PTFRs on this in December that year when he also reported on the meeting of Q199 at the Sydney Congress (which was also in October 2017).
- Alan Kasper of the US Group had attended the October meeting and had said that it was positive on CAP. The MLA was still being pursued, he said.
 - The summary of the October meeting prepared by the GB+ Secretariat said that the Group was supportive of the work of CH as leading the work on CAP and that the focus would now be on the definition of 'professional advice'.
 - Further, the summary said, a draft agreement would be submitted to the plenary meeting of GB+ in 2018.

91 GB+ in 2018

- 91.1 In April 2018, Q199 became aware that the leaders of the GB+ were considering confining the definition of 'professional advice' in the MLA to 'patent advice'. That change would add to changes already suggested (referred to above) which effect the exclusion of trade marks attorneys from the MLA. In view of AIPPI's policy that the MLA should be in harmony with AIPPI's Resolution Q163, Steve Garland submitted to Alex on AIPPI's behalf as follows.
- 91.2 If trade marks attorneys' advice was to be excluded by confining 'professional advice' to 'patent advice', the MLA should have a further provision which allowed for any country which wanted to include its trade marks attorneys as to the minimum standard locally and as to cross-border,

advice by overseas equivalents of its own attorneys, they should be permitted to do so, by an 'opt in' process. This proposal did not bear fruit.

92 Developments of the protection in the USA – as reported at 30 June 2018

92.1 In June 2018, Steve Garland called on the PTFRs to update Q199 on all developments of the protection over the last two years. The response of the US Group (Jeff Lewis, with the support of David Hill) was enlightening.

92.2 Jeff Lewis reported on the USA as follows.

- The decision of the US Court of Appeals for the Federal Circuit – *In re Queens University at Kingston* 820 F. 3d 1287 (Fed. Cir. 2016) – that attorney client privilege extends to confidential communications with non-attorney, ie non-lawyer, patent agents when acting within the agent's authorised practice of law before the Patent Office.
- The new rule of the USPTO commencing 7 December 2017 that attorney client privilege applies essentially to all trials before the USPTO's Patent Trial and Appeal Board (82 Fed. Reg. 51570).
- 23 February 2018. The Texas Supreme Court held that privilege applied for the purposes of Texas law (which does not recognise common law privilege) to confidential patent agent communications within the authority of the agent.

These matters provide further affirmation of the change of practice in the US from non-recognition of the protection in relation to non-lawyer patent agents to recognition that privilege applies to same in the US.

92.3 This History previously reports in Section 87 on the proposed changes of law - (USPTO Regulations) and in the practice of US courts. In effect, those changes now made have corrected the mistake in US law in questioning equivalence of professional secrecy (civil law) with privilege (common law) instead of assessing whether the outcomes of those principles (ie no forcible disclosure) were the same. This is a dramatic change for the better and must stand as one of the important achievements of the privilege project.

92.4 However, as usual, nothing would have been so achieved except for the amazing cooperation of like - minded people in Australia and overseas, in this case in the US. Referring back to the first meeting Q199 leaders had with representatives of the US government – that was at the GB+ meeting in January 2014, the US persons with whom we met at that time were Soma Saha and Paul Trevisan both from the USPTO. They have fortunately remained in the space in the US government in which the protection can be improved. When amending the law, continuity of the government representation is highly desirable.

92.5 The US 'solution' is a rather clever way around the US Constitutional impediment that privilege is generally a matter for State not Federal law. The USPTO is a Federal institution which subject to having regulations in place, runs its own process. Thus, it can within its own process, recognise

the protection from forcible discovery overseas and refuse forcible discovery of documents which are subject to that protection. One may then ask - what reasonable Judge in a US court recognising the error of past US decisions and seeing the USPTO regulated protection of overseas advice, is going to force discovery of IP legal advice which is subject to the protection overseas? The US Court practice is now in line with the USPTO's process. This meets the Rehnquist J requirement for certainty.

93 Japan and Germany – the MLA – the way forward

- 93.1 The author observes that this history has already related some of AIPPI's thinking as to the difficulties of JP and DE with Alex Pfister's proposals for an MLA confined to patent attorneys in Section 85 above. What follows in this Section applies AIPPI's thinking on its Plan B since its outset in 2013. That thinking has its origins when the MLA was first devised by it in 2004.
- 93.2 AIPPI observes that JP supported the study of the problem and remedies throughout the SCP process, and AIPPI's views in particular. It recognised the problem and indicated by its support for AIPPI in the SCP that it wanted to be part of getting the problem solved. DE was less up front in the SCP as to its position but nonetheless, it was supportive of solving the cross-border aspect of the problem.
- 93.3 During 2014, the GB+ countries continued their negotiations on how to protect clients exposed to forcible disclosure of their IP professional advice in some (but not all) common law countries. Leaving aside – AU, NZ and US – each of which has changed its law to avoid the problem – we are speaking of about 36 countries. Most of them are relatively small economies but some are not – like CA, IN, MY, SG and UK.
- 93.4 So, if a client in a civil law country, say DE or JP, obtains legal advice from a non-lawyer patent or trade marks attorney or agent there, that advice remains subject to forcible disclosure in every common law country other than AU, NZ, and US and as to UK, with the exception of DE but not JP.
- 93.5 The usual rule for having to disclose documents requires that the documents be in possession or under the control of the respondent. If the advice is by a Japanese or German lawyer, there is a fair chance that the advice would be protected by comity in the common law countries, from disclosure.
- 93.6 The reader will recall the observation in the US Supreme Court by Rehnquist J that 'uncertainty' makes whatever putative protection to which it applies – 'worthless'. The situation in any civil law country which is not a party to the MLA or such like, is one of certainty in a negative sense – certainty that non lawyer IP professional advice is subject to forcible disclosure in most common law countries, with the exception of those specified in 93.4.
- 93.7 It should also be a substantial consideration for governments considering an MLA to take into account that if advice is forcibly disclosed anywhere as it may be in a common law country, it is in

effect no longer confidential and not subject to any protection anywhere, including in their own countries.

- 93.8 Clients in common law countries are not immune from the problem referred to in the previous paragraph. Such a loss of privilege can occur as to common law advice. If common law privileged advice is sent to a non-lawyer patent agent in a civil law country, say in DE or JP, it is no longer protected from disclosure because the advice would then be in the possession of a person to whom privilege does not apply. The advice is then not subject to the protection anywhere. So, for example, the advice of a client obtained in SG, IN or MY which is transmitted to a non-lawyer patent attorney in JP, could then be forcibly disclosed in each of those countries. And, once it is so disclosed, it would then be subject to forcible disclosure in every common law country, including AU, NZ and the US.
- 93.9 AIPPI was sensitive to the needs of civil law countries considering the proposed MLA. AIPPI wanted them to obtain protection that was certain for the clients of non-lawyer attorneys. Along with that objective, AIPPI wanted them to avoid having to adopt any common law concept which was not already part of civil law.
- 93.10 The civil law power for a judge to call for any documents is an unfortunate source of uncertainty. How can a common law adviser know whether common law advice will not be forcibly disclosed by the use of this power?
- 93.11 Another issue being considered by the Group B+ countries was the possibility that the MLA might cause other professions to call for similar protection to be extended to their clients. This is known in common law as a 'floodgates' argument - ie in this context, a change in the law on the protection of IP professional advice which causes other professions to demand similar protection for their clients. This issue was raised in the SCP. It was not supported there by any of the GB+ countries, including JP. This floodgates argument in the SCP was not raised again by its proponents there, after AIPPI made the following points.
- This 'floodgates' risk has not been realised anywhere in the world even though the law has been continually changed to improve the protection in many countries over decades.
 - The position of the protection in IP law is unique. Who else has a situation like IP does of the qualifications of those in practice changing - lawyers first, to lawyers and non-lawyers, where the clients of lawyers had the protection but the clients of the non-lawyers did not?
 - What other professions which already have the protection have had economic and scientific changes which required new IP professionals with scientific qualifications and special IP legal qualifications.
 - Governments around the world have accepted and regulated the 'new' IP professionals. Failure to support such professionals to give advice subject to the protection on the same basis as lawyers is not only irrational but it denies the

support which clients of the 'new' IP professionals, need for them to engage the new IP professionals.

- 93.12 As the protection which now applies in JP (professional secrecy which is absolute, and no discovery) is already way wider than the minimum standard that the MLA proposes, that protection would be unchanged by signing the MLA. Thus, the MLA should not pose a problem for JP and for other civil law countries generally.
- 93.13 The benefit of the MLA for clients in civil law countries is the protection in common law countries for the advice given by their non-lawyer IP professionals. Of course, the MLA will only apply to those countries which sign it. The AIPPI concept is that GB+ countries should establish a workable MLA in action between them, which they would then promote to other countries.
- 93.14 The MLA being proposed requires **first** that a minimum standard be achieved nationally, and **secondly**, that that protection will not be lost cross-border. The national standard is that the advice is confidential and not to be disclosed. The cross-border standard is that overseas advice is to be treated the same way as it is, nationally.
- 93.15 No common law country has raised any objection to the concepts described in the previous paragraph. As at this time in the History (end 2018), civil law countries were still considering the need for the MLA and the balance of that need in relation to the potential effects which the MLA would have in their law.
- 93.16 It is true that the common law system has created a problem for civil law countries by forcing disclosure. It is not true that that was targeted against civil law. The positions as to the protection which apply to both systems and as between them, are an accident of their independent development over centuries. As to the tension between them (ie as to forcible disclosure), common law is not the only contributor to that tension. Civil law countries also contribute to the tension by having forcible disclosure by judges and that power is absolute ie far wider than common law judge's power to force disclosure which is limited to crime or fraud.
- 93.17 The MLA proposed would create reasonable harmony between civil and common law signatories on these issues.

94 Prelude to closure

- 94.1 Since 31 December, 2018, the negotiations on the proposed MLA by Group B+ countries have continued effectively. To leave the History as at 31 December, 2018 without acknowledging the positive progress of those negotiations in 2019, could leave a wrong impression as to how the Group B+ negotiations are travelling.
- 94.2 The reader will know that by the end of 2018, the privilege project had had about 14 years in the running. Through the Group B+ negotiations since the Colloquium in 2013, the objective of harmonising the protection globally by an MLA, has come within sight. The Postlude below provides substance for that objective being realised.

- 94.3 The process by which the privilege project has been progressed continuously since 2004, has involved a great deal of effort by many people – in WIPO, AIPPI, and other IP NGOs, FICPI and AIPLA in particular, and in governments of Member States in WIPO, including in Group B+. It is remarkable that the original research into the problem by WIPO following on the WIPO/AIPPI Conference on Privilege in 2007, has gone on being developed and updated even until now.
- 94.4 AIPPI has continued its efforts to assist in reaching a harmonised outcome particularly by supporting the work of the Group B+ countries under the leadership of Alex Pfister of CH. The Group B+ countries' work on the MLA is clearly the main focus now for substantial progress to be made in solving the problem.

95 The Changing of the Guard: the Future of the privilege project

- 95.1 As previously indicated, the AIPPI Q199 guard was changed towards the end of 2018. As this is a history, the future is out of order. For its history from this point onwards, the reader will have to await the outcome of two matters – **first**, further changes being made by governments to update their own laws and **secondly**, the MLA of GB+ being completed as to its form, signed and then put into effect by laws made nationally (where that is required).
- 95.2 It is undeniable that the changes already adopted by common law countries – AU, CA, NZ, UK and US and civil law countries – BE, CH, DK, NL, SE, and ES are real progress in improving the protection. As the Postlude relates below, the progress of the GB+ countries' negotiations on the MLA, is encouraging to those who, like AIPPI and other IP NGOs such as FICPI and AIPLA, are strongly supporting the obtaining of the MLA in action.

Postlude

It is pleasing to update the History from 31 December 2018 by reporting two major events which have occurred in the privilege project, since then. One of these events reflects positive efforts by Group B+ in advancing the privilege project. From this one may reasonably infer that the process in Group B+ is progressing well. The other event is the Resolution which was passed by AIPPI at its Congress in London in September 2019, further supporting the work of the Group B+ countries.

As to the **first** event, the Core Group (now AU, CA, JP, KR, SE, ES, CH, and UK) led by Alex Pfister of the CH government has developed an update of the draft MLA (the B+ Draft). The Core Group is seeking input on that draft from other Member States in Group B+, and from other interested parties including AIPPI. At the time of writing this Postlude, the deadline for that input was the end of February, 2020.

The text of the draft is set out below.

Cross-border aspects of client/patent attorney privilege (CAP) – Draft proposal for a multilateral agreement presented by the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK.

RECOGNISING THAT

1. Intellectual property rights (IPRs) exist globally and are supported by treaties and national laws and that global trade requires and is supported by IPRs.
2. IPRs need to be enforceable in each jurisdiction involved in trade in goods and services involving those IPRs, first by law and secondly, by courts which apply due process.
3. Persons need to be able to obtain advice in confidence on IPRs from IP advisors nationally and transnationally. Therefore communications to and from such advisors and documents created for the purposes of such advice and other records relating to such advising need to be confidential to the persons so advised and protected from forced disclosure to third parties (the protection) unless and until the persons so advised make public such communications, documents or other records.
4. The underlying rationale for the protection of confidentiality of such communications, documents or other records is to promote information being transferred fully and frankly between IP advisors and the persons so advised.
5. The promotion of such full and frank transfer of information supports interests which are both public and private namely in the persons so advised obtaining correct legal advice and in their compliance with the law. However, in order to be effective this protection needs to be certain.
6. Nations need to support and maintain confidentiality in such communications including said documents or other records and to extend the protection that applies nationally to IP advice given by IP advisors also in other nations. This is to avoid causing or allowing confidential advice on IPRs by IP advisors to be published in another jurisdiction and thus, the confidentiality in that advice to be lost everywhere.
7. The adverse consequences of such loss of the protection include owners of IPRs deciding not to trade in particular nations or not to enforce IPRs in such nations where the consequences of doing so may be that their communications relating to the obtaining of IP advice get published and used against them both locally and internationally.
8. National laws are needed which, in effect, provide the same minimum standard of protection against disclosure for communications to and from IP advisors in relation to advice on IPRs. Such laws should also apply the protection to communications to and from overseas IP advisors in relation to those IPRs including their overseas equivalent IPRs.
9. The minimum standard of protection needs to allow for nations to have limitations, exceptions and variations provided that they are of specific and limited effect and do not negate or substantially reduce the effect of the protection required by the minimum standard.

IN ORDER to give effect to the statements recited above, the nations cited in the Schedule to this Agreement have executed this Agreement on the dates stated respectively in that Schedule.

The nations so cited AGREE as follows.

Article 1

In this Agreement,

"patent advisor" means an advisor who is authorised to act before a competent administrative or judicial authority in his/her own jurisdiction, and officially certified to provide professional privileged advice concerning patent. The criteria of qualification and the categories of certification are defined by national 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 law that stipulate the professional qualifications whether it is transmitted to another person or not.

“advice” means the subjective or analytic views and opinions of the advisor. Raw data and mere facts are not privileged in and of themselves unless:

- they are communicated with the “dominant purpose” of seeking or giving advice; or
- 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 an patent advisor providing professional advice to a client, shall be confidential and shall be protected from any disclosure to third parties, unless it is or has been made public with the authority of that client.

Article 3

This Agreement applies to communications between an patent advisor and his client regardless of the territory of the signatory State in 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

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

Article 5

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 6

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 an intellectual property 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.

As to the **second** event, in the recitals to the Resolution passed by AIPPI at its Congress in London in September 2019, AIPPI expressed its appreciation of, and support for, the B+ Draft. It further recorded in those recitals, that the proposal of the Resolution to the members of AIPPI at the Congress, was supported unanimously by AIPPI's Standing Committee on CAP (ie Q199). The countries represented in Q199 were cited in recital 13 of the Resolution. The text of the Resolution, is set out below.

Resolution

Standing Committee on Client Attorney Privilege

Draft proposal for a multilateral agreement on client attorney privilege presented by the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and the UK

Background:

- 1) It is well accepted that legal advisers can only properly perform their function if their clients can rely on absolute confidentiality. If clients were not confident that their confidential information and the instructions given to their advisers will not be disclosed, they may withhold relevant facts and thus make it impossible for their advisers to effectively represent and protect their interests. Equally, if legal advisers could not be sure that the advice they give remains absolutely confidential and safe from disclosure, any advice given would necessarily need to be curtailed so that any subsequent disclosure does not cause prejudice to the client.
- 2) Client attorney privilege (in this Resolution, “**Privilege**”) is a ground for resisting the disclosure of any communications – whether oral or written – between a client and their legal advisors. Privilege exists for the purpose of allowing those seeking advice and those giving advice to be fully frank with each other, enabling the client to receive legal advice which best protects their interests, and in turn ultimately serves the public interest.
- 3) Privilege can be invoked as a ground for resisting documentary disclosure in systems of law that have discovery obligations. Privilege might also be invoked in connection with a witness giving oral evidence in court who is being cross-examined, or in connection with a witness being deposed and giving oral evidence.
- 4) The person entitled to claim Privilege is the client. In addition, a client's lawyer may claim privilege on behalf of the client.
- 5) AIPPI believes that with respect to advice sought and given in respect of intellectual property rights (IP rights), the same rules on Privilege should apply irrespective of whether the person providing the advice is a lawyer admitted to practice within a regulated legal profession or an IP adviser who is not a lawyer but is admitted or permitted to practice as an IP professional. At its EXCO meeting in Lucerne in 2003, AIPPI passed the following Resolution:

“That AIPPI supports the provision throughout all of the national jurisdictions of rules of professional practice and/or laws which recognize that the protections and obligations of the attorney-client privilege should apply with the same force and effect to confidential communications between patent and trademark attorneys, whether or not qualified as attorneys at law (as well as agents admitted or licensed to practice before their local or regional patent and trademark offices), and their clients, regardless of whether the substance of the communication may involve legal or technical subject matter.”

- 6) In 2005, AIPPI submitted to WIPO a proposal for the study of a treaty establishing minimal standards on privilege and protection from disclosure of communication relating to IP rights (AIPPI Submission to WIPO for a treaty to be established on Intellectual Property Adviser Privilege):
- “A communication to or from an intellectual property adviser which is made in relation to intellectual property advice, and any document or other record made in relation to intellectual property advice, shall be confidential to the person for whom the communication is made and shall be protected from disclosure to third parties, unless it has been disclosed with the authority of that person.*
- ‘intellectual property advice’** is information provided by an intellectual property adviser in relation to intellectual property rights.*
- ‘intellectual property adviser’** means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person qualified under the law of the country where the advice is given, to give that advice.*
- ‘intellectual property rights’** includes any matters relating to such rights.”*
- 7) In subsequent years, AIPPI actively supported the work of the Standing Committee of Patents (SCP) of WIPO regarding the confidentiality of communications between clients and their IP advisers with numerous submissions and presentations.
- 8) In 2013, AIPPI along with FICPI and AIPLA, hosted a Colloquium with the purpose of reaching a consensus on a global framework to protect confidential intellectual property advice given to a client by lawyer and non-lawyer IP advisors, and this led to the issuance of a Joint Proposal for a multilateral agreement on Privilege, including cross-border aspects of the same.
- 9) In September 2019, the Core Group of B+ delegations of Australia, Canada, Japan, Korea, Sweden, Spain, Switzerland and UK presented a Draft proposal for a multilateral agreement on Cross-border aspects of client/patent attorney privilege (**“B+ Draft Agreement”**), a copy of which is annexed to this Resolution, and which is largely based on the AIPPI/FICPI/AIPLA Joint Proposal.
- 10) AIPPI welcomes and appreciates the B+ Draft Agreement. It establishes, on an international level, minimum standards on Privilege and protection from disclosure of privileged materials.
- 11) Privileged advice within the B+ Draft Agreement only includes “advice given on patent law.” AIPPI welcomes the “opt in” provision foreseen in Article 5 of the B+ Draft Agreement providing for the ability of signatory countries, at their choosing, to extend the protection beyond patent law advice. Nevertheless, in due course, AIPPI would also welcome the general extension of the arrangements to include other fields of IP than patent law.
- 12) AIPPI sought the opinions of its National and Regional Groups of AIPPI on the B+ Draft Agreement.
- 13) This Resolution was proposed by AIPPI’s Standing Committee on CAP, and supported unanimously by the committee. The committee’s members are from the following countries: Argentina, Australia, Austria, Canada, Belarus, Brazil, Chile, China, Colombia, Croatia, Czech Republic, Egypt, Estonia, Finland, Iceland, Indonesia, Italy, France, Georgia, Germany, Greece, Hungary, India, Ireland, Israel, Japan, Lithuania, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Pakistan, the Philippines, Poland, Portugal, Romania, Russia, Serbia, Singapore, South

Africa, South Korea, Spain, Sweden, Switzerland, Thailand, Ukraine, the United Kingdom, the United States of America and Venezuela.

AIPPI resolves that:

- 1) AIPPI supports and welcomes the adoption of the B+ Draft Agreement.
- 2) AIPPI would also welcome the extension of the B+ Agreement to cover other types of IP, and specifically those types of IP in respect of which there exist professional advisers qualified to advise on, for example, trade marks and designs.
- 3) In AIPPI's view, the specific requirements set by any nation under Article 6, which an intellectual property advisor must meet, should:
 - a) be made available by that nation in a public register, so that it is possible to easily verify whether a specific communication with an adviser in that nation is a communication to or from a qualifying individual;
 - b) not include any limitations which would have the effect of denying protection simply because the adviser is not domiciled in or a national of that nation.

The B+ Draft is subject to further refinement by Group B+.

It should also be observed that Article 2 of the B+ Draft is the main operative provision. That Article prescribes the minimum standard required. It requires that there be two essential elements if the minimum standard is to be achieved. They are to be achieved by having laws which apply both confidentiality and protection from forcible disclosure, to the professional advice in question. Those are, of course, the two elements which make up the protection which is applied in each of the two systems of law - common and civil law.

The prescription in Article 2 has been long established now. It was first proposed by AIPPI in 2005. It was accepted by FICPI and AIPLA in 2013 as well as by AIPPI, at the Colloquium. Since 2013, that prescription of the minimum standard, has also been used in drafts of the MLA which the Core Group of the Group B+ nations, have shared with AIPPI.

Protection of Intellectual Property (IP) Professional Advice (the protection) from Forcible Disclosure

Perspective and history of the development of the protection conducted by and on behalf of the International Association for the Protection of Intellectual Property (AIPPI) and AIPPI-Australia (AIPPI-A) from 2003 to 2019 (the privilege project or simply, the project).

Annex 1

List of Attachments to the History of AIPPI's development of the Protection of IP Professional Advice from Forcible Disclosure Project – 2003 to 2019.

In the following List:

- Where the cited document is published on the AIPPI or WIPO website, this link is marked below **A** or **W** respectively and the link is stated. Access by **A** or **W** or the link.
 - Unless stated otherwise or contrary to the context, each of the documents is one written or co-written by the author.
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- 1 The AIPPI Submissions to WIPO dated 25 July 2005 on the inadequacy of the protection. **A** (<https://aippi.info/wp-content/uploads/2016/02/Submission-to-WIPO-July-2005.pdf>)
 - 2 The LCA Submissions to IPA under cover dated 19 May 2005 explaining the problems with the Patent and Trade Marks Acts (the Acts) and proposing amendments.
 - 3 Issues Paper published by IPA dated August 2005.
 - 4 LCA Response to the IPA Issues Paper in 3, dated 21 December 2005.
 - 5 The Instructions dated 22 May 2007 by Allens Arthur Robinson to Mr Neil Young QC for advice to LCA, IPTA and FICPI-A on amending the Acts.
 - 6 The Memorandum of Advice of Mr Neil Young QC dated 15 June 2007.
 - 7 The Submissions of Allens Arthur Robinson to IPA and AGs dated 7 August 2007 prepared on behalf of the LCA, IPTA, FICPI-A and AIPPI-A.

- 8 The Statements on behalf of AstraZeneca Pty Ltd, Biota Holdings Limited, CSL Limited, Starpharma Holdings Limited and Telstra Corporation Limited in support of Submissions made by IP NGOs (attached above) to WIPO and the Australian Government (IPA and AGs).
- 9 Acknowledgements of the distribution of 300 CDs of the WIPO/AIPPI Conference on Privilege in May 2008 to corporate leaders around the world, and by Philippe Baechtold of WIPO of the success of the Conference.
- 10 AIPPI Questionnaire (November 2007) and its accompanying brief devised by Jochen Buehling and the author and sent to PTFRs of Q199, as part of the preparations made by AIPPI for the WIPO/AIPPI Conference on Privilege – May 2008 (the WIPO/AIPPI Conference).
- 11 The List of Participants at the WIPO/AIPPI Conference.
- 12 The Program of the WIPO/AIPPI Conference. [W](https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_inf_1.pdf)
(https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_inf_1.pdf)
- 13 Slides on Outcomes of Litigation on Privilege in Australia used at the WIPO/AIPPI Conference. [W](https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_www_100285.pdf)
(https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_aippi_ip_ge_08/wipo_aippi_ip_ge_08_www_100285.pdf)
- 14 AIPPI paper – Prospects for Improvement: What are the options? – presented at the WIPO/AIPPI Conference. [A](https://aippi.info/wp-content/uploads/2016/02/Michael-Dowling1.pdf) (<https://aippi.info/wp-content/uploads/2016/02/Michael-Dowling1.pdf>)
- 15 Francis Gurry's letter to the author dated 4 June 2008 and the Q199 Report to PTFRs dated 24 June 2008.
- 16 The report – 'A matter of privilege' – published in the July/August 2008 edition of Patent World.
- 17 The report dated 24 June 2008 to the AIPPI PTFRs on the WIPO/AIPPI Conference.
- 18 The part of the WIPO 'Report on the International Patent System' SCP 12/3 Rev. 2 (particularly paras 259 to 262) on Professional Privilege. [W](https://www.wipo.int/edocs/mdocs/scp/en/scp_12/scp_12_3_rev_2.pdf)
(https://www.wipo.int/edocs/mdocs/scp/en/scp_12/scp_12_3_rev_2.pdf)
- 19 The Request to the AIPPI PTFRs dated 28 August 2008 on scope of the protection, and its four attachments.
- 20 The AIPPI Submissions to WIPO on WIPO Report SCP/12/3 for SCP 13 dated 31 October 2008. [W](https://www.wipo.int/export/sites/www/scp/en/meetings/session_13/pdf/aippi.pdf) (https://www.wipo.int/export/sites/www/scp/en/meetings/session_13/pdf/aippi.pdf)
- 21 WIPO – Summary of the Chair dated 27 June 2008 - SCP/12/4 Rev – mandate for WIPO to prepare preliminary studies including on client attorney privilege. [W](https://www.wipo.int/edocs/mdocs/scp/en/scp_12/scp_12_4_rev.pdf)
(https://www.wipo.int/edocs/mdocs/scp/en/scp_12/scp_12_4_rev.pdf)
- 22 Slides on 'Privilege Treaty' used in Workshop VI of the AIPPI Congress, Boston, September 2008.

- 23 The AIPPI paper for Workshop VI of the AIPPI Congress, Boston, September 2008 on 'The Australian position on client privilege in IP professional advice and the outcome of the WIPO/AIPPI Conference'. [A \(https://aippi.info/wp-content/uploads/2016/02/Michael-Dowling.pdf\)](https://aippi.info/wp-content/uploads/2016/02/Michael-Dowling.pdf)
- 24 The Report of Workshop VI of AIPPI Boston Congress, on Client Privilege in IP Professional Advice Treaty – September 2008.
- 25 The brief dated 2 February 2009 to the Australian government updating the Submissions of users of the Australian IP system, for the meeting of Australian IP NGOs with the Australian government on 19 February 2009.
- 26 Email to PTFR for China dated 20 January 2009 including message as sent by Q199 to PTFRs, Presidents, and Secretaries explaining the protection and proposing that they should make proposals to their respective governments.
- 27 WIPO records of the SCP 13 meeting (March 2009) including the part of the WIPO Report containing oral submissions made for AIPPI. [W \(https://www.wipo.int/meetings/en/details.jsp?meeting_id=17448\)](https://www.wipo.int/meetings/en/details.jsp?meeting_id=17448) and link to AIPPI Submissions on WIPO Report SCP 13/4 made (as invited by WIPO) subsequent to this meeting - [A https://aippi.info/wp-content/uploads/2016/02/Submission-to-WIPO-SCP-13-4-August-2009.pdf](https://aippi.info/wp-content/uploads/2016/02/Submission-to-WIPO-SCP-13-4-August-2009.pdf)
- 28 The Q199 Report dated 15 April 2009 to the NGs of AIPPI on the outcome of WIPO meeting SCP 13.
- 29 The Q199 Chairman's Report to the Reporter General of AIPPI and to the leaders of Q199 on its leadership and activities dated 18 May 2009.
- 30 The paper of Professor John Cross - 'Evidentiary Privileges in International Intellectual Property Practice' – INTA, April 2009.
- 31 The Report of Q199 to the Bureau at the EXCO meeting of AIPPI in Buenos Aires – 10 to 15 October 2009. [A \(https://aippi.info/wp-content/uploads/committees/199/Report199Report+ExCo+Meeting+Buenos+Aires+2009English.pdf\)](https://aippi.info/wp-content/uploads/committees/199/Report199Report+ExCo+Meeting+Buenos+Aires+2009English.pdf)
- 32 The Report dated 19 June 2009 by the Chairman of Q199 requested by and made to Reporter General, Jochen Buehling, on the working structure of Special Committees of AIPPI.
- 33 The AIPPI and Allens paper - 'Privilege in IP Litigation Practice' – presented at the 23rd Annual IPSANZ Conference – Auckland, New Zealand, September 2009. (**IPSANZ NZ Conference**).
- 34 The slides – 'Privilege in IP Litigation Practice' – used at the IPSANZ NZ Conference.
- 35 AIPPI's Submissions dated 31 August 2009 for WIPO meeting SCP 14 (25-29 January 2010). [W https://www.wipo.int/export/sites/www/scp/en/meetings/session_14/studies/aippi.pdf](https://www.wipo.int/export/sites/www/scp/en/meetings/session_14/studies/aippi.pdf)
- 36 Tomoko Miyamoto's email of 2 September 2009 to AIPPI (Buehling and Dowling) that AIPPI Submissions would be published on the WIPO SCP electronic forum.
- 37 IPA's proposals on amendments to the Acts – November 2009.

- 38 Q199 Progress Report and Request for action – 27 October 2009.
- 39 AIPPI preparations for WIPO meeting SCP 14 – critique dated 18 January 2010 on the WIPO issues of 'stand up' support by developing countries and whether an SCP Working Group should be established.
- 40 The AIPPI-A and APAA-A joint submission to IPA on the amendments proposed to the Acts – 18 January 2010.
- 41 Q199 Working Guidelines and Questionnaire to PTFRs on Remedies – 19 January 2010, using the Questionnaire to Argentina as an example. [A \(https://aippi.info/wp-content/uploads/committees/199/QS199argentina.pdf\)](https://aippi.info/wp-content/uploads/committees/199/QS199argentina.pdf)
- 42 Q199 Revised Working Guidelines and Questionnaire for PTFRs on Remedies – 3 February 2010.
- 43 AIPPI's oral submissions at WIPO's meeting SCP 14 – see the WIPO Report. [W \(https://www.wipo.int/meetings/en/details.jsp?meeting_id=17461\)](https://www.wipo.int/meetings/en/details.jsp?meeting_id=17461)
- 44 Terms of reference (c. March 2010) of Q199.
- 45 Paper on the work of Q199 for the meeting of AIPPI Asian Groups in Pusan, Korea 6-9 May 2010.
- 46 APAA email dated 21 December 2009 – indicating the cooperation between AIPPI and APAA.
- 47 Response to Terry Moore of IPA on amendments proposed by IPA to the Acts – May 2010.
- 48 Q199 brief dated 12 July 2010 to PTFRs in India, Pakistan, Thailand, Malaysia, Singapore, Indonesia and Philippines on mandating WIPO to study Remedies.
- 49 Q199 template dated June 2010, for epitomising the Responses to produce data to be presented graphically.
- 50 The AIPPI Submissions dated August 2010 for WIPO meeting SCP 15. [A \(https://aippi.org/wp-content/uploads/2016/02/Submission-to-WIPO-SCP-15-17-August-2010.pdf\)](https://aippi.org/wp-content/uploads/2016/02/Submission-to-WIPO-SCP-15-17-August-2010.pdf) and [W \(https://www.wipo.int/export/sites/www/scp/en/meetings/session_15/studies/aippi.pdf\)](https://www.wipo.int/export/sites/www/scp/en/meetings/session_15/studies/aippi.pdf).
- 51 AIPPI News of September 2010 – including report on the results of the Q199 Questionnaire on Remedies.
- 52 Article co-authored with Isaac Lowrie – 'Privilege at the crossroads' – Intellectual Property Magazine – September 2010.
- 53 Q199 Report (edited) to the Bureau on the outcome of Q199's Questionnaire on Remedies – Paris Congress, 3 to 6 October 2010. The Link contains the Report in its entirety. [A \(https://aippi.info/wp-content/uploads/2016/02/AIPPI-support-for-WIPO-SCP-15-17-August-2010.pdf\)](https://aippi.info/wp-content/uploads/2016/02/AIPPI-support-for-WIPO-SCP-15-17-August-2010.pdf)
- 54 AIPPI's Resolution of 6 October 2010 authorising Q199 to provide its Report to the Bureau in Paris to WIPO. [A \(https://aippi.info/wp-content/uploads/committees/199/RS199English.pdf\)](https://aippi.info/wp-content/uploads/committees/199/RS199English.pdf)

- 55 WIPO meeting SCP 15, 11 to 15 October 2010 including AIPPI's oral submissions in the Report. [W](https://www.wipo.int/meetings/en/details.jsp?meeting_id=19684) (https://www.wipo.int/meetings/en/details.jsp?meeting_id=19684)
- 56 WIPO's recognition of AIPPI's contributions to its work on CAP - Francis Gurry's email of 5 November 2010.
- 57 The submissions sent to IPA on behalf of AIPPI-A, APAA-A, FICPI-A, IPC and IPTA dated 16 March 2011.
- 58 Email of Olga Sirakova (BG) including the email (February 2010) which the author sent to the NGs (after approval by the leaders of Q199), seeking approval of the draft of AIPPI's submissions for SCP 16.
- 59 Philip Noonan's email to the author dated 8 February 2011.
- 60 The Submissions of AIPPI for SCP 16. [A](https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions_16-4-Rev_040511.pdf) (https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions_16-4-Rev_040511.pdf) and [W](https://www.wipo.int/export/sites/www/scp/en/meetings/session_16/studies/aippi_scp_16_4r.pdf) (https://www.wipo.int/export/sites/www/scp/en/meetings/session_16/studies/aippi_scp_16_4r.pdf)
- 61 Q199 email dated 1 March 2011 to the PTFRs, reporting interim results of responses to the Q199 Questionnaire on approval by NGs of proposed Submissions to WIPO for SCP 16.
- 62 Email connection with the Australian government dated 15 March 2011.
- 63 AIPPI Submissions to WIPO re SCP/16/4 REV dated 4 May 2011. [A](https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions_16-4-Rev_040511.pdf) (https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions_16-4-Rev_040511.pdf)
- 64 WIPO documents for SCP 16 including AIPPI's oral submissions in the Report. [W](https://www.wipo.int/meetings/en/details.jsp?meeting_id=22164) (https://www.wipo.int/meetings/en/details.jsp?meeting_id=22164)
- 65 Slides in Presentation on privilege to AIPPI UK in London, Monday 23 May 2011.
- 66 Flyer related to the AIPPI UK meeting on privilege in London, Monday 23 May 2011.
- 67 Nick Cunningham email dated 29 July 2011.
- 68 IP NGO Submissions to APA on proposed amendments to the Act, June 2011.
- 69 Email comments to AGs dated 15 June 2011.
- 70 Annual Report of Q199 to the Bureau of AIPPI, September 2011.
- 71 Felix Addor letter to Konrad Becker of AIPPI Switzerland dated 30 September, 2011.
- 72 Email report to Andri Hess dated 11 October 2011 – as sent to the PTFRs of Q199, on AIPPI's Plan B.
- 73 AIPPI Submissions to WIPO on cross-border aspects of confidentiality of communications between clients and their IP advisers, September 2011. [W](https://www.wipo.int/export/sites/www/scp/en/meetings/session_17/cap/aippi.pdf) (https://www.wipo.int/export/sites/www/scp/en/meetings/session_17/cap/aippi.pdf) [A](https://aippi.info/wp-content/uploads/2016/03/AIPPI-Subm-to-WIPO-on-Confidentiality-of-Comm-Clients-and-their-Patent-Advisors-6Sept2011-FINAL-doc.pdf) (<https://aippi.info/wp-content/uploads/2016/03/AIPPI-Subm-to-WIPO-on-Confidentiality-of-Comm-Clients-and-their-Patent-Advisors-6Sept2011-FINAL-doc.pdf>)

- 74 Email dated 18 October 2011 by Q199 to the PTFRs on prospects for continuing the study of CAP at SCP 17.
- 75 AIPPI Submissions to WIPO for SCP 17, dated 1 November 2011. [A \(https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions-to-WIPO_1Nov-2011.pdf\)](https://aippi.info/wp-content/uploads/2016/02/AIPPI-Submissions-to-WIPO_1Nov-2011.pdf)
- 76 WIPO Meeting Papers for the SCP 17 meeting including AIPPI's oral submissions in the Report. [W \(https://www.wipo.int/meetings/en/details.jsp?meeting_id=22209\)](https://www.wipo.int/meetings/en/details.jsp?meeting_id=22209)
- 77 Thierry Calame (Reporter General of AIPPI) – Report to the Bureau of AIPPI on WIPO Meeting – dates 5 and 6 December 2011.
- 78 Q199 email Report to Reporter General Thierry Calame on SCP 17 dated 13 December 2011, and his response dated 14 December 2011.
- 79 Q199 Report to the PTFRs Presidents, Secretaries of the NGs of AIPPI dated 14 December 2011.
- 80 Email dated 15 December 2011 from Margareta Linderöth on behalf of the Swedish NG, referring to the Q199 report to PTFRs on WIPO meeting SCP 17.
- 81 Proposal by Q199 for meeting with Tomoko Miyamoto of WIPO, January 2012.
- 82 AIPPI proposed draft Agenda for the meeting with Tomoko Miyamoto at WIPO in Geneva on 6 March 2012.
- 83 Emails and memorandum of March 2012 on changes in professional secrecy laws in France and Japan – Eve Heafey of Smart & Biggar.
- 84 Email correspondence on the passage of the 'Raising the Bar' Bill – including from Terry Moore and Philip Noonan of IPA.
- 85 Email by Q199 to Danny Huntington dated 20 April 2012 listing (the 'library' of) historic AIPPI and WIPO documents on CAP.
- 86 Q199 email to Leo Jessen dated 18 April 2012.
- 87 FICPI, AIPLA, AIPPI Colloquium – Report to the PTFRs by email dated 20 April, 2012.
- 88 SCP 18 – Summary by the Chair of 25 May 2012 – Agenda Item 13 on the future of CAP.
- 89 Scheme of the Program for the Colloquium dated 16 July 2012.
- 90 Explanatory Memorandum approved by the AIPPI Congress in Seoul, October 2012.
- 91 Drafting Committee for the UPC Rules of Procedure.
- 92 Draft Rules of Procedure of the UPC.
- 93 Q199 Annual Report for 2012.
- 94 Example of invitations issued for the Colloquium.
- 95 PRIMER dated 17 December 2012 - published for the AIPLA/AIPPI/FICPI Colloquium.
- 96 Slides relating to the presentation of the primer at the Colloquium.

- 97 Q199 email exchanges (July 2012) with AIPPI US and FICPI US in relation to the Colloquium.
- 98 Email exchanges (April/May 2013) with Professor John Cross.
- 99 Q199 email 27 May 2013 to Danny Huntington – example for brief to US Judiciary on the Colloquium.
- 100 Program of the Colloquium, dated 14 June 2013.
- 101 Transcript of the AIPLA, AIPPI, FICPI Colloquium (Paris) – 27-28 June 2013.
- 102 Presentation of the Book of the Colloquium.
- 103 List of participants at the Colloquium.
- 104 Communiqué from the Colloquium.
- 105 Submissions by AIPPI dated 16 December 2013 for WIPO meeting SCP 20.
- 106 WIPO Meeting documents SCP 20 including AIPPI's oral submissions in the Report. [W](https://www.wipo.int/meetings/en/details.jsp?meeting_id=30925)
(https://www.wipo.int/meetings/en/details.jsp?meeting_id=30925)
- 107 WIPO Meeting documents SCP 28 including AIPPI's oral submissions in the Report. [W](https://www.wipo.int/meetings/en/details.jsp?meeting_id=46439)
(https://www.wipo.int/meetings/en/details.jsp?meeting_id=46439)
- 108 PRIMER (post Colloquium) dated 28 August 2013 **W**
(https://www.wipo.int/export/sites/www/scp/en/meetings/session_20/comments_received/aippi_attachment_1.pdf)
- 109 Brief to Fatima Beattie on updated PRIMER, 28 August 2013.
- 110 Assessment of the current problems of the protection, 8 November 2013. [W](https://www.wipo.int/export/sites/www/scp/en/meetings/session_20/comments_received/aippi_attachment_2.pdf)
(https://www.wipo.int/export/sites/www/scp/en/meetings/session_20/comments_received/aippi_attachment_2.pdf)
- 111 Email exchange with Jessica Allen – August/September 2014.
- 112 'Protecting confidentiality in IP professional advice: an effective way is established' – Intellectual Property Magazine, October 2013, 44-46.
- 113 Email of 27 October 2013 to Michel Gérin, IPIC.
- 114 Email of 29 October 2013 to Michel Gérin, IPIC.
- 115 LCA Submission to the Australian Minister urging Minister to Minister exchange dated 13 November 2013.
- 116 AIPPI-A email to Steve Garland on Australian issues with proposed Canadian legislation on the protection – 14 May 2015.
- 117 AIPPI emails of Thierry Calame (Reporter General) and John Bochnovic (President) – January 2014.
- 118 GB+ proposed MLA for plenary meeting 23/24 September 2014.

- 119 AIPPI-A brief to AIPPI-CH on the Australian process of amending the Acts – email 3 April 2014 and email of Stephan Freischem (Secretary General, AIPPI) of same date.
 - 120 Summary extracted from Alex Pfister's draft Explanatory Memorandum for Group B+ Plenary Session – 23/24 September 2014.
 - 121 AIPPI-A email of 27 August 2014 to Jessica Allen.
 - 122 AIPPI-A email of 2 October 2014 to Steve Garland.
 - 123 Notice of the proposed USPTO Roundtable on the Protection – January 2015.
 - 124 AIPPI-A emails to Steve Garland of 9 and 11 February 2015.
 - 125 AIPPI-A email to Jessica Allen of 11 February 2015.
 - 126 AIPPI-A email to Richard Hamer of 13 February 2015.
 - 127 IPC Submission (LCA) to USPTO dated 27 February 2015.
 - 128 Q199 email of 17 February 2015 to Thierry Calame & others (CH Group).
 - 129 Q199 email of 19 February 2015 to James Tumbridge & others (UK Group).
 - 130 Q199 email of 6 May 2015 to Jochen Buehling (DE Group).
 - 131 Q199 email of 6 July 2015 to Andri Hess (CH Group).
 - 132 Q199 email of 6 July 2015 to Jochen Buehling (DE Group).
 - 133 Q199 email of 24 July 2015 to Shoichi Okuyama (JP Group).
 - 134 AIPPI-A email of 12 August 2015 to Jessica Allen, and her response of 24 August 2015.
 - 135 AIPPI email of 18 August 2015 to Alex Pfister.
 - 136 Q199 email to Steve Garland of 5 October 2015.
 - 137 The Core Group of GB+ Questionnaire – 2015.
 - 138 AIPPI-A Memorandum to Peter Franke – 23 December 2015.
 - 139 AIPPI-A Brief to IPA of 11 March 2016.
 - 140 AIPPI-A comments to FICPI-A and IPTA on the Titan Enterprises case – 24 October 2016.
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Annex 2

Acronyms / Abbreviations Used

AGs	Attorney General's Department
AIPLA	American Intellectual Property Law Association
AIPPI	International Association for the Protection of Intellectual Property
AIPPI-A	Australian Group of AIPPI
APAA	Asian Patent Attorneys Association
APAA-A	Australian Group of APAA
CAP	Client Attorney Privilege
CEIPI	Centre for International Intellectual Property Studies
DAG	Development Agenda Group
EXCO	Executive Committee of AIPPI
FICPI	International Federation of Intellectual Property Attorneys
FICPI-A	Australian Group of FICPI
FICPI CET	Educational Function of FICPI
GB+	Group B+ nations in WIPO
ICC	International Chamber of Commerce
IP	Intellectual Property
IPA	IP Australia
IPC	Intellectual Property Committee of the Law Council of Australia
IPIC	Intellectual Property Institute of Canada
IPRs	Intellectual Property Rights
IPTA	Institute of Patent & Trade Marks Attorneys of Australia
JPO	Japanese Patent Office
LCA	Law Council of Australia
MLA	Multilateral Agreement
NGs	National or Regional Groups of AIPPI
NGOs	Non-Governmental Organisations
PTFRs	Privilege Task Force Representatives

SCP	Standing Committee on the Law of Patents
ToR	Terms of Reference
USPTO	United States Patent and Trademark Office
WGs	Working Guidelines
WIPO	World Intellectual Property Organization

Two Letter Abbreviations for Nations

AR	Argentina
AU	Australia
BE	Belgium
BG	Bulgaria
BR	Brazil
CA	Canada
CL	Chile
DK	Denmark
FR	France
DE	Germany
HK	Hong Kong
IN	India
ID	Indonesia
JP	Japan

KR	Republic of Korea (South)
MY	Malaysia
NL	Netherlands
PK	Pakistan
PH	Philippines
SG	Singapore
ZA	South Africa
ES	Spain
SE	Sweden
CH	Switzerland
TH	Thailand
UK	United Kingdom
US	United States of America

Annex 3

Main Events of AIPPI's Privilege Project (and its Prelude)

2003

Contents

AIPPI EXCO Meeting in Lucerne – Q163 Resolution on Client Attorney Privilege

2004

April Francis Gurry's meeting with Michael Dowling in Melbourne – the beginning of the Privilege Project with WIPO to consider studying the problem in the SCP.

June Decision of Heerey J (*Eli Lilly v Pfizer Ireland Pharmaceuticals (No 2)* [2004] FCA 850) – that the protection of non-lawyer patent attorney advice in Australia was (then) limited to attorneys registered to practise in Australia.

2005

July Luis Duran and Michael Dowling – Submission to WIPO on the inadequacies of the protection and the proposal of a minimum standards agreement to solve the problem.

2007

June IP NGOs in AU obtained the opinion of Neil Young QC on amending the Australian Patent and Trade Marks Acts to improve the protection in AU

August Submissions of Australian IP NGOs to the Australian government to amend the Australian Patent and Trade Marks Acts and to support the motion to WIPO to study the problem. Supported by the opinion of Neil Young QC as to how the amendments should be worded and by statements by five major Australian companies which were users of the IP systems in AU.

September The *Akzo Nobel Chemicals & Ackros Chemicals v Commission (Competition)* [2007] EUECJ T.253/03 (17 September 2007) Decision in the ECJ that employee lawyer advice is not privileged in civil law.

September AIPPI EXCO meeting in SG – Q199 (Privilege Task Force) constituted, Michael Dowling appointed Chairman.

October On the motion of AIPPI and ICC, WIPO agrees to study the protection and the problem. The process to be commenced by an international Conference on Privilege at WIPO in Geneva, in 2008.

2008

May WIPO/AIPPI Conference on Privilege at WIPO in Geneva.

June AIPPI meeting – SCP 12. AIPPI written submissions in favour of studying the protection. SCP considers CAP as a potential issue for study. Thereafter, AIPPI makes written and oral submissions at the WIPO meetings SCP 13, 14, 15, 16, 17 and 20 in Geneva.

2009

March WIPO meeting SCP 13. Study of the problem of the protection.

April Intervention by Professor John Cross in the project – his paper and speech at INTA meeting in the US.

August WIPO meeting SCP 14. Efforts by AIPPI to obtain mandate for the SCP to study remedies.

September IPSANZ Conference, Auckland, NZ – AIPPI-A – gathering impetus for amendments to be made to the Patent and Trade Marks Acts in AU.

2010

January AIPPI-A and APAA-A submissions to IPA on problems with the amendments proposed to the Australian Acts.

May AIPPI Asian Groups Meeting – Pusan, South Korea – gathering support from Asian National Groups of AIPPI for WIPO to be mandated to study remedies for the problem.

October AIPPI Congress – Paris. Resolution passed by AIPPI to supply Q199 research to WIPO, in support of the SCP being mandated to study remedies.

SCP 15. WIPO mandate obtained for the SCP to study remedies.

2011

May SCP 16 – AIPPI persuading developing countries on remedies.

Presentation by Michael Dowling to AIPPI-UK in London.

August AIPPI Submissions to WIPO on cross-border aspects of the problem.

December SCP 17 – AIPPI Submissions strongly supported by developed countries.

2012

March Further submissions by Australian IP NGOs to IPA on amending the Acts.

April Colloquium concept agreed between IP NGOs (AIPPI and FICPI) – the build-up to the Colloquium to be held in June 2013, begins.

May SCP 18 (not attended by AIPPI Q199).

2013

February SCP 19 (not attended by AIPPI Q199).

- April** Amendment to the Australian Patent and Trade Marks Acts come into force: the protection as to clients of IP professionals in AU, improved and the protection is extended cross-border.
- June** AIPLA, FICPI, AIPPI – Colloquium, Paris. The introduction of AIPPI's Plan B.
- 2014 / 2018** SCP 20/29 – Continuation of the study of the problem culminating in a major WIPO Report – Confidentiality of Communication between clients and their Patent Advisors. [W
\(https://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html\)](https://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html)
- GB+. Continual engagement by AIPPI Q199 with Alex Pfister and the Core Group in relation to their deliberations on a Multilateral Agreement (**MLA**).
- 2014**
- January** The meeting between Steven Garland and Michael Dowling with the Core Group GB+ countries, including Alex Pfister (CH).
- 2017** Amendments to the Canadian law mooted.
- 2018**
- November** USPTO regulations providing the protection for patent agents and overseas patent agents in proceedings before the USPTO; US practice in the courts changes to favour the protection applying to non-lawyer patent and trade marks attorneys and agents overseas to whom professional secrecy and no discovery applies.
- December** Canadian amendments achieved.
- 2019** AIPPI passed a Resolution at its London Congress in September, supporting the GB+ countries working towards agreement on an MLA.
- The Core Group of the GB+ countries reached out to obtain the input of the whole Group on its draft MLA, targeting their responses by end February, 2020.
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Annex 4

Further Acknowledgements

The author gratefully acknowledges permission to copy and allow third parties to copy the respective Attachments to the History of the Privilege Project, granted by the following.

By **WIPO** as to its many documents included in the History – by **Francis Gurry**, Director General of WIPO.

By **Neil Young QC**, as to his Opinion on amending the Patents and Trade Marks Act in Australia – **Attachment 6**.

By **Informa**, publisher of Patent World and Intellectual Property Magazine, as to the author's articles in **Attachments 16, 52 and 112**.

By **Professor John Cross** of the University of Louisville, US – as to his article – 'Evidentiary Privileges in International Intellectual Property Practice' – first published at INTA in April 2009. Further, for his contributions to the Colloquium in Paris in June 2013.

By **Steven Garland** of Smart & Biggar/Fetherstonhaugh, Lawyers of Toronto, CA as to Eve Heafy's Report which is **Attachment 83** and for his steadfast cooperation and efforts in running the project with the author.

The author also gratefully acknowledges the kind assistance of the following persons.

To **Sam Ricketson**, many thanks for his comments and directions on drafting, suggestions as to the publication of the work, and being supportive of the author's endeavours in IP law reform, over decades.

The author also gratefully acknowledges the support of his personal secretarial assistant in Allens, **Maxine Bryant**, for patiently producing numerous drafts of, or relating to, this History, and assisting him in its completion.

Finally, to the author's wife, **Rosemary Dowling**, who has had to do without the author's assistance in many ways for almost two years whilst the History was being researched and written, and for contributing to the author's recollections of overseas events in AIPPI referred to in the History, at many of which she attended and supported him.
