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## **BUSINESSEUROPE COMMENTS ON THE DRAFT AGREEMENT ON CROSS-BORDER ASPECTS OF CLIENT-PATENT ATTORNEY PRIVILEGE**

BUSINESSEUROPE is the leading advocate for growth and competitiveness at European level, standing up for companies across the continent and actively campaigning on the issues that most influence their performance. We speak for all-sized enterprises in 35 European countries whose national business federations are our direct members.

BUSINESSEUROPE has taken note of the public consultation on the Draft Agreement on Cross-Border Aspects of Client-Patent Attorney Privilege, launched by the Swiss Federal Institute of Intellectual Property in the framework of the B+ Group project on this issue. BUSINESSEUROPE is happy to contribute to this debate with a few targeted comments explained below.

### **GENERAL COMMENTS**

BUSINESSEUROPE welcomes the initiative of the Federal Institute of Intellectual Property to launch a consultation on the Draft Agreement on Cross-Border Aspects of Client-Patent Attorney Privilege (CAP). We also appreciate the work done by the B+ Core Group on the CAP over the past years. This is an important issue affecting the day-by-day communications between patent advisors and their clients, as these exchanges are constantly confronted with highly confidential information. It is therefore key to ensure that the confidentiality of the information exchanged between patent attorneys – either working in private practice or employed in-house – and their clients and colleagues is duly respected in all instances, including cross-borders transactions.

- **Further harmonisation**

Different countries have different legislations regarding the CAP. Some ensure a broad confidentiality to the information exchanged between the patent attorney and their clients, while other countries do not foresee any privilege and the confidentiality is not protected.

BUSINESSEUROPE believes that it is important to ensure that the confidentiality of the information exchanged by both in-house and private practice patent advisors is respected regardless of the specific treatment ensured by the country of origin of the patent attorney concerned.



BUSINESSEUROPE has always been supportive of further harmonisation in intellectual property matters. Businesses would benefit from harmonisation of certain cross-border aspects of CAP insofar as, among other things, it could increase legal certainty and ensure the same protection of the confidential information exchanged between patent attorneys and their clients everywhere in the participating countries, and hopefully globally. Because of these expected benefits, BUSINESSEUROPE supports the future harmonisation of the national rules governing cross-border aspects of CAP taking account the specific comments below.

- **The Preamble**

The Preamble of the Draft Agreement refers to the importance of Intellectual Property (IP) rights and highlights the protection of the “communications to and from IP advisors” and “in relation to IP rights”.

The Preamble is very broad in scope as it seems to refer to the professional advice given by “any” IP advisor in relation to “any” IP right. This broad scope is however not reflected in the text of the Draft Agreement. The latter is in fact limited to the communications between “the patent advisor” and his/her clients, and in relation to patent-related advice. BUSINESSEUROPE considers that the Preamble should be consistent with the text of the Draft Agreement.

In addition, our members believe that the Preamble should also highlight the advantages of CAP for third parties who do not own IP rights themselves. This could encourage less developed countries to join a future international agreement on CAP. To this end, we therefore propose to add the following wording to the Preamble:

*“Noting that the adverse consequences of the loss of the confidentiality of the professional advice also affect third parties who are confronted with intellectual property rights of others and who might need to seek confidential advice about the validity of such intellectual property rights and/or about the likelihood of infringement of such rights. The protection of the confidentiality of the advice given by a patent advisor is also in the interest of third parties who are not owners of intellectual property rights. This is expected to prevent unnecessary litigation and contribute to ensure the respect of valid intellectual property rights.”*

- **Definition of “patent advisor”**

Draft Article 1 lett. a) defines the “patent advisor” as “an advisor who is authorised to act before a competent administrative or judicial authority in a jurisdiction of a signatory State or to which a signatory State participates, and officially certified to provide professional advice concerning patents. The criteria of qualification and the categories of certification are defined by national and international law”.

BUSINESSEUROPE considers that Draft Article 1 lett. a) should clearly require that the “patent advisor” has to be listed on the European or national register as a patent attorney or patent agent.



In addition, our members believe that the definition under Draft Article 1 lett. a) seems to only cover patent attorneys in private practice. Our members are of the view that this provision should mention that in-house patent attorneys are included in the scope of the Draft Agreement. The CAP should in fact cover the exchanges of confidential information between in-house patent attorneys and their “clients”, e.g., the colleagues in the company for which they work and external advisors. These exchanges also involve information which is confidential by nature such as strategic plans of the company concerning the implementation of new inventions, comparative analysis of technologies of third parties, status research and innovation of projects. Draft Article 1 lett. a) should be amended accordingly.

In the brief explanations made to Article 1 lett. a) of the Draft Agreement, it is stated that *“the professional must be subject either [to] privilege or be bound by professional secrecy in his [or her] professional activities in his or her country”*. This requirement does not seem to be mentioned in the provisions of the Draft Agreement. Our members believe that this condition should not be imposed to patent advisors to broaden the scope of CAP in the Draft Agreement. Accordingly, this sentence should be removed from the explanations made to Article 1 lett. a).

- **Definition of “professional advice”**

Draft Article 1 lett. d) defines the “professional advice” as *“advice given on patent law within the patent advisor’s area of expertise, as defined by the national or international law that stipulates the professional qualifications whether it is transmitted to another person or not”*.

BUSINESSEUROPE considers that this provision should be amended to better clarify that the privileged advice covers all aspects of the life of a patent, including entitlement, inventorship, ownership, patent validity and patent scope issues, patent litigation, transactions (including licences), confidential information, and trade secrets.

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