European Communities Trade Mark Association

Brussels, 19 August 2013

ECTA Study on the International recognition of the client-attorney privilege[1]

At this moment, there is a lot of uncertainty on the subject 'client/attorney privilege (CAP) and confidentiality' also before OHIM. Although "client/attorney privilege" clauses do exist on national level in many EU Member States and is rewarded to some extent (1), it is not clear whether and to what extent the national CAP rule would apply in a situation which goes beyond national trade mark and design law and/or crosses borders. The latter will often be the case, especially where Community trade mark and design rights are involved. This means uncertainty for users of the system, including the clients of the attorneys, with all paraphernalia this implies.

Nowadays services offered cross borders very often. In such situations, the difference between Common Law and Civil Law legal traditions makes the problem even more acute. Would the national CAP be accepted, granted and apply in a specific situation, and, if so, under what conditions? For example, a letter from a French attorney to a German attorney is not protected by CAP. Clearly, the rules of International Private Law on conflict of laws are insufficient here.

A next question that follows from the above is whether the client/attorney privilege (CAP), which applies to national trade marks and designs in most EU Member States, also applies to Community trade mark and design matters. And how about the situation for clients in Member States where no such CAP rule is anchored by national law? They face even more uncertainty as to the status of the information given by them under confidentiality to their attorney. This is an undesirable situation which should be solved to safeguard an unhindered and equal level of services offered by all IP practitioners active within the EU.

For this reason, the international recognition of client/patent attorney privilege has recently been a topic of the Standing Committee on Patents (SCP) of WIPO. It was not possible to reach conformity on this issue yet on WIPO level[2]. Notwithstanding this situation, there is no reason to take this outcome to equally apply to the field of trade marks and designs. After all

[1] This information is based on the responses given by all members to two questionnaires of the Professional Affairs Committee of ECTA; a list of committee members may be consulted on ECTA's official website (www.ecta.org). The first questionnaire was managed by Mr. Kaj-Louis Henriksen (DK), former President of ECTA. Messrs Helmut Sonn (AT), Ari-PekkaLaunne (FI) and Sozos Christos Theodoulou (CY) and Mrs. Maron Galama (NL) have also actively contributed with their inputs.

[2] For the current status of the WIPO SCP deliberations, see the document SCP/18/6 of May 21-25, 2012, on WIPO's website (www.wipo.int).

in the field of trade marks and designs there already exists an European wide Regulation that applies in all EU Member States.

Taking this difference into consideration and due to the fact that harmonization on the issue of CAP and confidentiality is of great importance for a good functioning of the Community trademark and design system as a whole, clear rules should be declared applicable to the client/attorney privilege. This topic should be addressed now, while the EU trade mark system is under revision.

It is of importance that in the Community Trade Mark Regulation and/or its adjoined rules[3], clear provisions stipulate what the client/attorney privilege comprehends: to what extent the client/attorney privilege will apply, when and how.

To this effect, ECTA suggests to implement the following Rule:

- **Attorney–client privilege:**

(1) Where advice is sought from a professional representative in his capacity as such, all communications between the professional representative and his client or any other person relating to that purpose are permanently privileged from disclosure unless such privilege is expressly waived by the client. The same privilege applies to cases involving an in-house practitioner, active in the field of intellectual property, in place of a professional representative.

(2) Such privilege from disclosure shall apply, in particular, to all communications or documents[4] between a trademark/design professional representative and his/her client, unless if at least one of the exceptions of para. 3 below applies:

a) the assessment of registrability;

b) the preparation or prosecution of the application or of any other proceedings before the Office;

c) any opinion relating to the validity, scope of protection or infringement of a registered right or an application for such a right.

[3] Taking that clear provisions are suggested in the Community Trademark Regulation and/or its adjoined rules, the word "Office" here below refers to the "Office for Harmonization in the Internal Market (OHIM)"

[4] This proposal does not aim to make a distinction between CTM or RCD rights on the one hand and national trademark or design rights on the other. What counts are the *communications or documents* between a trademark/design professional representative and his/her client, the subject of which is mentioned under a) to c). In the situations indicated there will always be a link with at least one Community trademark or design right, e.g. the application or registration of the counterparty. In cases before OHIM national trademark and/or design rights may just as well be part of these communications or documents. Therefore the confidentiality does not apply to national trademark (or design) rights or Community trademark (or design) rights *as such*, but the confidentiality applies to the communication between the client and the trademark/design professional.

(3) From the privilege from disclosure under (2) b are explicitly excluded communications filed with the Office:

a) in connection with the application and prosecution before the Office in as far no information is submitted on use of the trademark applied for;

b) in inter partes proceedings, unless the documents submitted are indicated as 'secret' . In the latter case these documents will only be taken into account by the Office if it contains information that does not influence the outcome of the case between the parties. If the Office is of the opinion it cannot take this 'secret' information into account as it would directly harm the other party in its defence, the submitting party may waive the secrecy on this document.

(4) In case information has been submitted with a communication to the Office in ex parte proceedings and the submitting party would like to rely on this information later on towards a third party the privilege from disclosure should be waived explicitly by the submitting party.

It seems advisable to connect a certain time limit to the possibility to waive the secrecy of documents as mentioned under (3) and (4) within which the submitting party may inform the Office of the renunciation of the secrecy.

When this Rule is adopted, this would in practice indicate that initially all communications between a professional representative and its client are in principle covered by a confidentiality rule, apart from documents submitted to the Office:

- In connection with the application and prosecution before the office in as far no information is submitted on use of the trademark applied for and
- in inter partes proceedings, unless indicated as 'secret'.

Next to that there is a possibility to waive the secrecy in all cases when one would like to rely on the submitted documents towards a third party.

The exceptions are provided for in order to secure that the transparency and accessibility of the filing system in connection with the Community trade mark and design application system remain.

In conclusion, it is hereby suggested and strongly recommended to incorporate a client/attorney privilege rule in the Regulation so that anyone on the EU register of trade mark /design professional representatives would be protected by CAP to avoid inequality between IP practitioners and their clients. This would also cover correspondence between attorneys among themselves, as well as between an attorney and the client, no matter where the client is situated. Also communications with the Office are covered only in as far as these communications are submitted in an *inter partes* case and contain 'secret' information and do not directly harm the other party in its defence.

It is to be noted that we consider the above rules to be minimal, emphasizing that they would not set aside applicable national laws and regulations, including criminal measures, and/or

other international rules, in as far as such rules warrant a higher level of protection and enforcement on CAP issues.