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WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

SCP/36/7
ORIGINAL: ENGLISH
DATE: AUGUST 26, 2024

Standing Committee on the Law of Patents

Thirty-Sixth Session
Geneva, October 14 to 18, 2024

COMPILATION OF COURT CASES WITH RESPECT TO CLIENT-PATENT ADVISOR PRIVILEGE

Document prepared by the Secretariat

1. At its thirty-fifth session, held from October 16 to 20, 2023, the Standing Committee on the Law of Patents (SCP) agreed that the Secretariat would update document SCP/25/4 (Compilation of Court Cases with respect to Client-Patent Advisor Privilege), based on the information received from Member States. Pursuant to the above decision, members of the SCP were invited, through Note C.9199 dated December 7, 2023, to submit information to the International Bureau on the subject.

2. The Secretariat received submissions from Australia and the Republic of Korea in which information relating to national court cases is provided.[1] This document therefore contains the information regarding the national court cases of these Member States.

3. Since the WIPO webpage "Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors"[2] already includes information regarding national court cases relating to the client-patent advisor privilege that had been collected from the Member States, the Secretariat will also incorporate the contents of this document to the said webpage.

Australia

4. Client-attorney privilege is essential for ensuring clients to receive high quality IP advice. It is provided for by Section 200 of the Patents Act 1990 (Cth) (and equivalent provisions in Section 229 of the Trade Marks Act 1995 (Cth)). Australia's legislative provisions afford foreign

[1] The information received from the Member States are published on the website of the SCP electronic forum at: https://www.wipo.int/scp/en/meetings/session_36/comments_received.html.

[2] https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html.

innovators privilege in communications with their own patent attorneys and Australian patent attorneys when seeking protection in Australia. Section 200 (and Section 229) were amended by the Intellectual Property Laws Amendment (Raising the Bar) Act 2012 (Cth) to expressly extend privilege to an individual authorized to do patents work or trademarks work under a law of another country or region, to the extent to which the individual is authorized to provide intellectual property advice of the kind provided.

5. The Federal Court of Australia had found that the earlier version of Section 200 confined the privilege provided by the statute "to communications with patent attorneys registered as such in Australia" (*Eli Lilly & Company v Pfizer Ireland Pharmaceuticals (No 2)* [2004] FCA 850).

6. However, since this amendment, the Federal Court found in *Australian Mud Co Pty Ltd v Coretell Pty Ltd* [2014] FCA 200 that Section 200 "protects communications between a patent attorney and his or her client which are made for the dominant purpose of providing intellectual property advice to the client to the same extent as such communications would be protected if they were between a legal practitioner and his or her client."

Republic of Korea

7. While the case relates to a law attorney's privilege in criminal proceedings, the *Supreme Court en banc Decision 2009Do6788*, decided on May 17, 2012, is indirectly relevant to client-patent advisor privilege in criminal proceedings, since according to Article 149 of the Criminal Procedure Act, in principle, a patent attorney, among attorneys-at-law and others exercising certain professions, may refuse to testify with respect to facts of which he/she has obtained knowledge in consequence of a mandate he/she has received in the course of his/her profession.

Background

8. The case relates to a bribery charge where, according to the reasoning of the lower court's judgement and records, the prosecutor submitted a document as evidence, which had been printed out from a digital storage media seized from the defendant. The document was a legal opinion written by an attorney affiliated with the law firm of the case and the defendants did not consent to using that legal opinion as evidence. The attorney, at the trial, invoked Article 149 of the Criminal Procedure Act and refused to testify with respect to the legal opinion.

9. Article 313(1) of the Criminal Procedure Act states that: "A statement prepared by a Defendant or any other person, except the protocols mentioned in the preceding two Articles, or a written statement, if there being the handwriting, a signature or a seal of maker or stater, may be introduced into evidence, if it is proven to be genuine by the maker or stater thereof by his/her testimony or stater at a preparatory hearing or during a public trial: *Provided*, That the document containing the statement of a defendant may be introduced into evidence only when proven genuine by the testimony of the maker or stater thereof at a preparatory hearing or during a public trial and when the statement is made under circumstances which would lend it special credibility, regardless of the statement made by the defendant at a preparatory hearing or during public trial."

10. Article 314 of the Criminal Procedure Act provides an exception to the above principle regarding the admissibility of evidence by stating that: "In case of Articles 312 or 313, if a person who is required to make a statement at a preparatory hearing or a trial is unable to make such statement because he/she is dead, ill, or resides abroad, his/her whereabouts are unknown, or there is any other similar cause, the relevant protocol and other documents shall be admissible as evidence: *Provided*, That it is admissible only when it is proved that the statement or preparation was made in a particularly reliable state."

11. The lower court upheld the decision of the first instance court, which denied the admissibility of the legal opinion of the attorney as evidence. It reasoned that confidential communication for the purpose of legal counsel between a lawyer and his/her client is included in the right to counsel acknowledged by Article 12(4) of the Constitution; thus, although not explicitly provided in current written law, the client has the privilege to refuse to provide confidential communication related to legal counsel. Subsequently, the lower court determined that the legal opinion of this case has no admissibility unless the attorney establishes its authenticity, and even so, it still may not be used as evidence to establish the crime committed by the defendant – regardless of unlawfulness of the seizure process – based on the attorney-client privilege.

Supreme Court decision

12. The Supreme Court found that the reasoning of the lower court's judgement denying the admissibility of the legal opinion of this case on the ground of attorney-client privilege is inappropriate.

13. The Court referred to Article 12(4) of the Constitution which provides that "[a]ny person who is arrested or detained shall have the right to prompt assistance of counsel" and Article 34 of the Criminal Procedure Act that stipulates "[t]he defense counsel or a person who desires to be a defense counsel may have an interview with the criminal defendant or the criminal suspect who is placed under physical restraint, may deliver or receive any documents or things […]". Furthermore, the Court noted that the Criminal Procedure Act, in Articles 112, 219 and 149, protects the attorney-client confidentiality to a certain degree.

14. In light of these provisions and underlining purposes of the Constitution and the Criminal Procedure Act, the judgement of the lower court – which held that a person who has yet to be considered as either a suspect or a defendant due to criminal procedure (such as an investigation or hearing) not having begun, may nonetheless exercise the attorney-client privilege regarding legal advice during his/her everyday life, or that articles seized without the client's consent cannot be used as evidence in a criminal trial (regardless of unlawfulness of the seizure process) – is unacceptable.

15. The Supreme Court, however, came to the conclusion that the lower court's judgement denying the admissibility of the legal opinion and not accepting it as evidence is justifiable for the following reasons.

- The legal opinion of this case constitutes a "statement or document including the statement made by a person other than the defendant" pursuant to Article 313(1) of the Criminal Procedure Act.

- The admissibility of the legal opinion, however, cannot be acknowledged as its authenticity was not proven by the attorney's statement. The attorney's refusal to testify is justifiable in accordance with Article 149 of the Criminal Procedure Act.

- From the legislative history, current Article 314 of the Criminal Procedure Act should be applied strictly to emphasize the principles of direct examination and of court-oriented trial. In that light, a legitimate refusal to testify on the grounds of Articles 148 and 149 of the Criminal Procedure Act does not constitute as "any other similar cause" pursuant to Article 314. Therefore, the admissibility of the legal opinion cannot be acknowledged pursuant to Article 314.

16. The Court thus concluded that although errors had existed in the reasoning of the lower court's judgement, as long as the decision of denying the admissibility of the legal opinion was justifiable, it could not be seen as having affected the conclusion of the judgement.

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