

Keeping it Confidential: Client - Attorney Privilege for Patent Attorneys at European level

Peter R. Thomsen

President European Patent Institute

Magyar Szabadalmi Ügyvivői Kamara

Online Conference, 23.09.2025



Topics

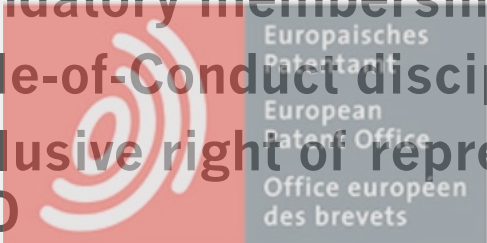
- European Patent Attorney (EPA) vs. national qualification
- Client-Attorney Privilege for EPAs
- Experience with recognition by US Courts in patent litigations
- Practical considerations



European Patent Attorney vs. National Patent Attorney

European Patent Attorney

- Unique really pan-European profession with ONE exam (EQE) for all 39 EPC member countries
- Central register at EPO
- Unitary Profession inhouse/private practice
- Mandatory membership with epi
- Code-of-Conduct disciplinary surveillance
- Exclusive right of representation before EPO
- With additional qualification (EPLC) Right of representation before UPC



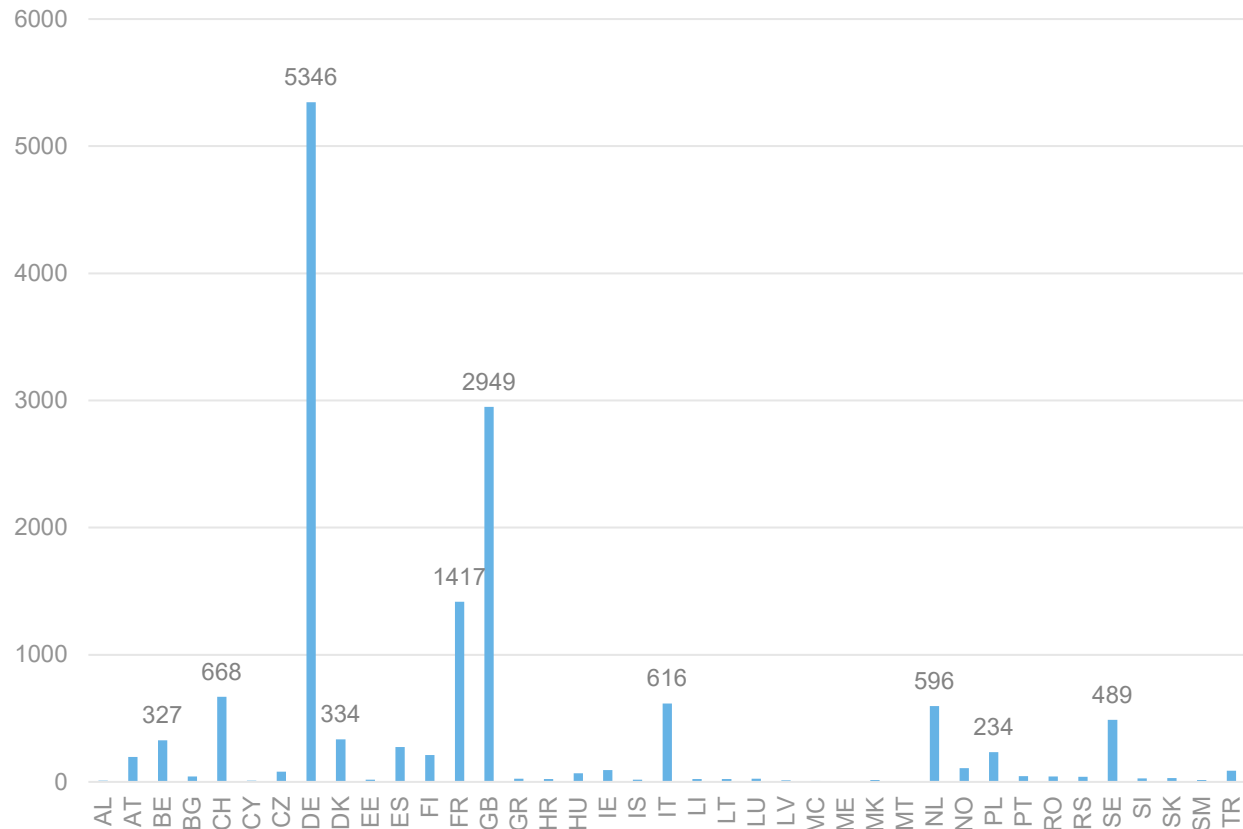
Swiss Patent Attorney

- Introduced only 2011
- Legal protection of professional title
- Examination (oral/written)
- Unitary Profession: inhouse and private practice
- Central register at CH Patent Office
- Surveillance by government agency (EJPD)
- Non-exclusive right of representing before CH Patent Office
- Partial representation right at Federal Patent Court



Number of European Patent Attorneys

Number of European Patent Attorneys 2024



Country	2024
AL	10
AT	196
BE	327
BG	42
CH	668
CY	9
CZ	80
DE	5346
DK	334
EE	17
ES	274
FI	210
FR	1417
GB	2949
MC	7
ME	1
MK	15
MT	6
NL	596
NO	107

GR	26
HR	22
HU	67
IE	92
IS	17
IT	616
LI	23
LT	22
LU	25
LV	13
PL	234
PT	44
RO	42
RS	40
SE	489
SI	28
SK	29
SM	15
TR	89

Why a Client-Attorney Privilege (CAP)?

- Common Law vs. Civil Law legal tradition
- Obtaining evidence in litigations /investigations
- Fundamental human rights to fair trial and privacy of communication
(see Art. 6 and 8 ECHR)
- Discovery proceedings
- Need to protect exchange of information between client and legal advisor
- Foreign recognition of CAP

Features of Client-Attorney Privilege (CAP)

- a communication
- between an attorney and a client
- made in confidence
- for the purpose of seeking, obtaining, or providing legal advice
- Attorney Work Products

Are protected against being produced as evidence

Client-Attorney Privilege for EPAs: R. 153 EPC

- EPC2000 revision introduced 2007 new CAP provision

Rule 153

Attorney-client evidentiary privilege¹⁸⁹

(1)¹⁹⁰ 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 and falling under Article 2 of the Regulation on discipline for professional representatives, are permanently privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client.

(2) Such privilege from disclosure shall apply, in particular, to any communication or document relating to:

- (a) the assessment of the patentability of an invention;
- (b) the preparation or prosecution of a European patent application;
- (c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application.

Recognition of CAP by US District Courts



- **DC MA: Philips North America LLC vs. Fitbit LLC**, 583 F. Supp. 3d 251 (D. Mass. 2022)
 - Whether emails of Philips inhouse NL und EP Patent Attorney protected by CAP?
 - Philips could not prove, that activities belong to statutory core expertise of NL/EP Patent Attorney
 - National NL CAP law does not include express right to deny access in civil proceedings
 - UPC-privilege could change view?

patent attorney acting in that capacity.” (Gerritzen Decl. 5.7). Even if the legislature intended to create an evidentiary privilege for Patent Attorneys that is similar to the privilege for lawyers and patent agents around the globe, there is no indication that it wished to expand the scope of a Patent Attorney’s legal authority or to create a privilege that is co-extensive with the attorney-client privilege for attorneys-at-law. As Fitbit argues, while amendments to the DPA

have acknowledged that Dutch patent agents may more generally assist with acts and proceedings before the Netherlands Patent Office and limited proceedings before the District Court of the Hague, the scope of a patent agent’s licensure remains limited to those specific activities and, in particular, does not extend to the general context of litigation,

*268

which requires admission to the Netherlands bar as an advocaat.

Recognition of CAP by US District Courts II

- *Knauf Insulation, LLC v. Johns Manville Corp.*, No. 1:15-cv-00111-TWP-MJD (S.D. Ind. Oct. 1, 2019)
- **Whether communication of UK Patent Attorney is privileged**
- **District Court: yes, as long as activities belong to statutory or professionally prescribed duties of the patent attorney**

The Court holds that the patent-agent privilege applies to Knauf's communications with Farmer that were made within the scope of Farmer's authority as a patent attorney in the U.K. JM has "specifically reserve[d] the right to bring an additional motion to compel relating to the Farmer documents on more specific grounds, for example challenging specific documents and/or specific deficiencies in Knauf's privilege logs," [Dkt. 499 at 6 n.1], and the Court agrees that it would not have served judicial economy for the parties to brief any such arguments before the Court resolved the general privilege issue. Accordingly, if the parties are unable to resolve any such issues, JM may seek leave to file a motion to compel raising them.

Recognition of CAP by US ITC and DC

- *Align Technology Inc. Vs. 3Shape A/S and others* Civil Action No. 17-1646-LPS (D. Del. Feb. 3, 2020) and previous related ITC actions
- Whether presentation given by 3Shape's in-house EPA in Denmark to VP of Product Strategy were privileged
- Denmark has no national qualification
- District Court, ITC: no, because 3Shape could not prove that EPA was on the Art. 134 EPC list at the time the documents were created and that the activity were not related to EPO

Fourth and lastly, after applying the reasoning above and the guidance provided by *In re Queen's*, the Court concludes that were the Federal Circuit confronted with this issue, it would determine that a patent-agent privilege could serve to shield certain communications between registered foreign patent agents and their clients from disclosure, if the party seeking protection could either show that: (1) the communications at issue were made to or by patent agents acting within the scope of the "authorized practice of law" set out by the law of the foreign country (or by the regulations of an governmental entity similar to the USPTO); or (2) the law of the foreign country at issue otherwise recognizes a patent-agent privilege that is broader than or otherwise in conflict with that recognized by United States courts, and the foreign communications at issue fall within the scope of that privilege. *In re Queen's*, 820 F.3d at 1302; (Tr. at 50, 52); cf. *Knauf Insulation*, 2019 WL 4832205, at *5-6 (concluding that *In re Queen's* counseled that "as long as the patent agent in question is subject to regulation in his or her own country analogous to being registered with the [USPTO] in this country, [then] applying U.S. privilege law to foreign patent agents means applying the patent-agent privilege to communications relating to services that the patent agent is permitted to provide in the patent agent's own country" and that if the foreign "patent agent made "communications [with the client] within the scope of [the patent agent's] authority as a patent attorney in the U.K." such communications could be protected) (emphasis added).¹²

Recognition of CAP by US ITC and DC

- *Align Technology Inc. Vs. 3Shape A/S and others* Civil Action No. 17-1646-LPS (D. Del. Feb. 3, 2020) and previous related ITC actions

¹⁵ Mr. Ninn-Grønne states in his declaration that he is permitted by the EPO to practice before that body, (D.I. 193, ex. 8 at ¶ 5), though he is not authorized to practice law in any court in Denmark, (D.I. 198, ex. O at 16, 54; Tr. at 60). The EPO has requirements that those who practice before it must meet, (D.I. 193, ex. 9-A); if EPAs meet those qualifications, then it could be said that they have EPO “authorization” to practice before that body. (Tr. at 30) **but none of the disputed documents involve or relate to practice before the EPO.** And so the Court does not see how any form of legal “authorization” from the EPO as to Mr. Ninn-Grønne’s work could be relevant to a finding that the disputed documents are subject to the patent-agent privilege.

- To maximize chances that US-Courts recognize CAP of Patent Attorney’s communications, EPC privilege appears to need being complemented by national CAP rules
- Broad right to refuse testimony and produce documents for patent attorneys in national law may be useful (e.g. Sec. 160 CH civil procedural code)

CAP not only of relevance in the US, but all Common-law countries

- In Canada, the Federal Court denied CAP for Patent Agents for questions of patent infringement
- Other possible relevant jurisdictions:
 - AU, GB, IN, ZA, IE, but also UPC
 - Wherein (limited) discovery plays a role

Patent Agent Privilege – Federal Court Decision

📅 January 10, 2022

There is a recent decision of the Prothonotary of the Federal Court regarding patent agent privilege that all licensees should be aware of.

In *JANSSEN INC. AND MITSUBISHI TANABE PHARMA CORPORATION V. SANDOZ CANADA INC.*, 2021 FC 1265, the Court stated:

[13] Solicitor-client privilege has broad application. A solicitor-client communication is presumptively privileged if (1) it is a communication between a solicitor and a client; (2) it entails the seeking or giving of legal advice, whether litigious or not; and (3) it is intended to be confidential by the parties (*Solosky v The Queen*, 1979 CanLII 9 (SCC), 105 DLR (3d) 745, [1980] 1 SCR 821 at pp 833-834, 837).

[14] In considering the text of section 16.1, patent agent privilege can only apply if each of three specific conditions are met. The legislation does not enable the Court to consider or apply other analogous factors, nor does it expressly place patent agents and lawyers on equal footing in respect of the privilege that attaches to their client communications. Section 16.1(1)(c) is limited to seeking or giving advice “with respect to any matter relating to the protection of an invention”

Source: <https://cpata-cabamc.ca/en/patent-agent-privilege-federal-court-decision/Decision - CPATA>

Art. 160 Swiss Civil Procedural Code

Art. 160 Duty to cooperate

¹ Parties and third parties have a duty to cooperate in the taking of evidence. In particular, they have the duty:

- a. to make a truthful deposition as a party or a witness;
- b. ⁵⁵to produce the physical records, with the exception of documents forming correspondence between a party or a third party and a lawyer who is entitled to act as a professional representative, or with a patent attorney as defined in Article 2 of the Patent Attorney Act of 20 March 2009⁵⁶;
- c. to allow an examination of their person or property by an expert.

² The court has free discretion to decide on the duty of minors to cooperate.⁵⁷ It shall take account of the child's welfare.

³ Third parties that are under a duty to cooperate are entitled to reasonable compensation.



- **DC New Jersey in *In Re Zoledronic Acid*** (District Court New Jersey; 2:12-cv-03967): Magistrate Judge recognized CAP for Swiss Patent Attorney, because of the inclusion of Patent Attorneys in Art. 160 Civil Procedural Code after 2013;
- Precedence effect of that decision unclear: Special Master decision, main proceedings then settled out of Court

Art. 15 Hungarian Patent Attorney Law

Section 15

(1) Any facts, information or data coming to the knowledge of a person exercising patent attorney activities in the course of these activities shall be considered patent attorney secrets.

(2) The person exercising patent attorney activities shall be obliged to keep patent attorney secrets, unless this Act provides otherwise. This obligation of secrecy shall extend to documents and other data carriers of the patent attorney that contain patent attorney secrets.

(3) The person exercising patent attorney activities shall refuse to give witness evidence or supply data on patent attorney secrets in any official or judicial proceedings, except if the owner of the patent attorney secret released him from the obligation of secrecy.

(4) The obligation of secrecy of the person exercising patent attorney activities shall not depend on the continuation of the legal relationship established for the purpose of pursuing patent attorney activities, and it shall continue to exist without any limitation in time even after the termination of the patent attorney activities or of the patent attorney legal relationship.

Section 15/D

(1) In the course of an official audit, inspection or onsite search conducted at his or her premises, the person subject to patent attorney secrecy may not disclose documents and data containing patent attorney secrets and he or she may not be obliged to give oral testimony or to supply data relating to patent attorney secrets, but he or she may not obstruct the proceedings of the authority.

- **Professional Secrecy**
- **Regulated profession with register**
- **Disciplinary system**
- **Right to refuse witness and provide documents in litigation**

USA: recognition of CAP for Patent Agents

(see *CAFC, In re Queen's* 820 F.3d at 1302 and *Align Technology v. 3Shape A/S*, 2020)

- a patent-agent privilege could serve to shield certain communications between registered foreign patent agents and their clients from disclosure, if the party seeking protection could show either that:
 - (1) the communications at issue were made to or by patent agents acting within the scope of the 'authorized practice of law' set out by the law of the foreign country (or by the regulations of a[] governmental entity similar to the USPTO); or
 - (2) the law of the foreign country at issue otherwise recognizes a patent-agent privilege that is broader than or otherwise in conflict with that recognized by United States courts, and the foreign communications at issue fall within the scope of that privilege.

Some practical advice to maximize chances of CAP (I)

- Documents and communications needs to be prepared under supervision or by CAP entitled person
- Sufficient supervision on auxiliary staff and trainees
 - Documentation important for evidence
- Advice should be restricted to issues that are covered by statutory or professional rules
- No mixing up between (patent) legal advice and business advice
- Current «primary purpose test» had recently been challenged at US Supreme Court, but was finally not decided: (s. In re Grand Jury, 598 U.S. ____ (2023) of 23.01.2023)

Some practical advice to maximize chances of CAP (II)

- **Labelling documents as «Confidential & Privileged»**
 - **But please only relevant documents and not inflationary use**
- **no Privilege for antitrust and competition law?**
 - **See CJEU C-550/07-P AkzoNobel: NO privilege for inhouse lawyers**
- **Simple cc'ing of person who may claim privilege is not sufficient; the person needs to be able to contribute something substantial from her expertise**
- **Consider separating of different legal aspects to different documents/opinions**
- **Education and awareness raising particularly with those inhouse functions that often are confronted with patent-legal issues, e.g. project management, product development, BD&L**

Some practical advice to maximize chances of CAP (III)

- **Privilege is deemed waived if secrecy is lost**

- **Limit access to document to small circle on need-to-know basis (documentation for evidence)**

- **Consider also access to documents being made available to potential future counter parties in litigations (e.g. within due-diligence, litigation financing)**

- **«common interest» Doctrine, z.B. in *Katz v. AT&T Corp*, 191 F.R.D. 433 (E.D. Pa. 2000), *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 115 F.R.D. 308 (N.D. Cal. 1987) oder *Midwest Athletics and Sports Alliance LLC v. Ricoh USA, Inc.*, Civ. No. 2:19-cv-514 (E.D. PA. Sept. 16, 2020)**

- **DO NOT FULLY RELY ON CAP!!!!**

Privilege at UPC

27 January 2025

Rule 288 – Litigation privilege

Where a client, or a lawyer or patent attorney as specified in Rule 287.1, .2, .6 and .7 instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings, including proceedings before the European Patent Office, such communications shall be privileged from disclosure in the same way and to the same extent as provided for in Rule 287.

Rule 287 – Attorney-client privilege

1. Where a client seeks advice from a lawyer or a patent attorney he has instructed in a professional capacity, whether in connection with proceedings before the Court or otherwise, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is privileged from disclosure, whilst it remains confidential, in any proceedings before the Court or in arbitration or mediation proceedings before the Centre.

2. This privilege applies also to communications between a client and a lawyer or patent attorney employed by the client and instructed to act in a professional capacity, whether in connection with proceedings before the Court or otherwise.

3. This privilege extends to the work product of the lawyer or patent attorney (including communications between lawyers and/or patent attorneys employed in the same firm or entity or between lawyers and/or patent attorneys employed by the same client) and to any record of a privileged communication.

4. This privilege prevents the lawyer or patent attorney and his client from being questioned or examined about the contents or nature of their communications.

5. This privilege may be expressly waived by the client.

(b) the expression “patent attorney” shall include a person who is recognised as eligible to give advice under the law of the state where he practises in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice.

7. The expression “patent attorney” shall also include a professional representative before the European Patent Office pursuant to Article 134 (1) EPC.

Position Paper on representation before the UPC by in-house European Patent Attorneys

The present document describes the position of the Institute of Professional Representatives before the European Patent Office (**epi**), which is the professional body of all European Patent Attorneys. Currently, **epi** has about 14,500 members from the 39 Contracting States to the European Patent Convention. European Patent Attorneys work in private practice or as in-house patent attorneys in industry. They represent a wide variety of users of the European Patent system, from individual inventors to multinational corporations. A large number of **epi** members have been registered as UPC representatives.

Right of inhouse European Patent Attorneys to represent before the UPC

This position paper is focussed on the issue of representation by in-house European Patent Attorneys qualified on the basis of Article 48(2) UPCA. Recently issued orders¹ and a pending appeal at the UPC raise the question to what extent European Patent Attorneys who are employed and work as in-house patent attorneys can appear as representatives for their employers before the UPC.

epi is deeply concerned that a decision in this case which could be understood to be broadly applicable beyond the specific facts and situation of this case, may have unintended and detrimental general consequences regarding the principles of representation before the UPC.

Status and Legal basis for representation at the UPC by European Patent Attorneys

Under Article 48(2) UPCA, European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications, such as a European Patent Litigation Certificate may represent parties before the UPC. When the UPCA became operational in 2023, many thousands of European Patent Attorneys have used the possibility of registering themselves onto the list of such UPC Representatives under Article 48(3) UPCA. Since then, many actions before the UPC have been performed by such representatives who are employed as in-house patent attorneys.

¹ Suinno Mobile & AI Technologies Licensing Oy vs. Microsoft Corporation, see, e.g., ORD_41174/2024 concerning Application RoP333 No. App_40799/2024 – 16 September 2024; ORD_43015/2024 concerning Application RoP333 No. App_42138/2024 – 16 September 2024; Order of the CoA concerning an application for a discretionary review UPC_CoA_586/2024, APL_54732/2024 – 9 October 2024 and UPC_CoA_570/2024, APL_53968/2024 – 15 October 2024.

In the future: an international instrument on CAP for patent professionals?

Annex I – Draft Agreement on CAP

[In order to reflect the different opinion of the Core Group Members on some points, we have reproduced the different opinions in the Draft agreement in square brackets and highlighted in yellow.]

AGREEMENT
ON CROSS-BORDER ASPECTS
OF CLIENT-PATENT ATTORNEY PRIVILEGE

(Draft proposal for a multilateral agreement presented by the Core Group of B+ delegations of Australia, Canada, [Japan], [Korea]², Spain and Switzerland).

[THE FOLLOWING STATES ... / THE PARTIES TO THIS AGREEMENT:]

Recognising that intellectual property rights (IPRs) exist globally and are supported by treaties and national laws and that global trade requires and is supported by IPRs,

Acknowledging that 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,

Noting that Persons need to be able to obtain advice in confidence on IPRs from IP advisors nationally and transnationally,

Further noting that 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 unless and until the persons so advised make public such communications, documents or other records,

- Negotiated and drafted at B+ Group since 2013
- Since autumn 2024 IP Australia took over lead from CH Patent Office in WG
- Draft Agreement is ready for a Diplomatic Conference?

Key Elements of a possible international Treaty on CAP for patent professionals

- Definition of “Patent Advisor”
- Opt-out/flexibility for national leg
- Binding or non-binding character of international instrument?

a) *patent advisor* means 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.

Article 6 – Flexibilities for national legislation

States may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in Article 2, including specific requirements which a patent 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.^[6] *States may exclude the application of Article 2 in criminal procedures*.

- c) *advice* means the subjective or analytic views and opinions of the patent advisor. Raw data and mere facts are not privileged in and of themselves unless:
1. they are communicated with the “dominant purpose” of seeking or giving advice; or
 2. 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.
- d) *professional advice* means 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.

Merci

Thank you!