Submission from IP Australia to the request for comments on Domestic and International Issues Related to Privileged Communications between Patent Practitioners and their Clients – USPTO Roundtable Notice [Docket No. PTO-C-2014-0066].

We refer to the above notice calling for comments on the issue of privilege in communications between patent practitioners and their clients.

The Australian Government recently addressed this issue through legislative amendments to our client-attorney privilege provisions through the *Intellectual Property Laws Amendments (Raising the Bar) Act 2012.* The *Raising the Bar Act* and the Explanatory Memorandum are available at
http://www.comlaw.gov.au/Details/C2014C00180
http://www.comlaw.gov.au/Details/C2011B00114/Explanatory%20Memorandum/Text

Australia now affords privilege to communications between clients and registered patent attorneys (non-lawyer agents) including individuals authorised to do patents work under a law of another country or region. To attract privilege, the communications must be made for the dominant purpose of the registered patent attorney providing intellectual property advice to a client. Similar amendments were made to trademarks legislation to afford privilege to communications between Australian trademark applicants and their trademark attorney or agent advisors.

Our domestic policy position was developed through an ongoing process of consultation, which included consultation on an issues paper and on an exposure draft of the provisions in the draft bill.

Under our legislation, American innovators can now secure privilege for communications with their patent attorneys (or agents) when seeking patent protection in Australia, regardless of whether the attorney is in Australia, the United States or another foreign jurisdiction. However, the reverse situation where Australian innovators seek patent protection overseas is less certain. For example, Australian clients cannot be confident that communications, even with their local attorneys in Australia, will be protected against disclosure in court proceedings throughout the United States.

What is left to be achieved after the 2012 amendments to our Patent Act is to increase certainty that confidential communications between Australian innovators and their patent attorneys, both Australian and foreign attorneys, are not subject to forcible disclosure overseas.

We hope that in looking at the question of privilege, the United States would adopt an analogous policy approach to afford similar rights to Australian innovators seeking intellectual property protection throughout the United States.

Given the global nature of patent filings, we also encourage the United States to investigate multilateral solutions to address this issue. As with unilateral introduction of privilege into each country's national law, this option has the advantage that convergence among national practices could be achieved.

IP Australia is happy to undertake further discussions with the USTPO on this important topic.