

Written Comments on Agent-Client Privilege - Japan Patent Attorneys Association

1. Authority and Service of Japanese Patent Attorneys

Japanese patent attorneys (*benrishi*) and US patent attorneys hold substantially equivalent roles and authorities.

The scope of service for Japanese patent attorneys is defined in Articles 4, 5, 6, 6^{bis} of the Japanese Patent Attorney Law. Japanese patent attorneys are permitted to conduct patent prosecution services in order to obtain various intellectual property rights from the Japan Patent Office, as well as from foreign countries. They are also empowered to send warning letters and handle licensing services and ADR services. Japanese patent attorneys are also able to solely represent their clients before the court in actions to rescind appeal decisions, serve as assistants in infringement litigation, and even represent their clients in infringement litigations under the condition that they work together with attorneys-at-law. Although this power to act as an attorney in infringement litigation was formally granted by the revision of the law in 2002, in practice, Japanese patent attorneys have been involved as assistants to attorneys-at-laws in intellectual property infringement litigation for many years, even before the revision.

Under the Japanese law, attorneys-at-law are permitted to work as patent attorneys through being registered as patent attorneys; however, there are very few attorneys-at-law who specialize in intellectual property due to the expertise required for intellectual property matters. Therefore, it is Japanese patent attorneys who are the ones that serve as the US “patent attorney,” including in cases of disputes. Taking into consideration such reality of the situation regarding the duties of Japanese patent attorneys, the client-attorney privilege of Japanese patent attorneys should also be accepted from the same viewpoint as that of US patent attorneys for litigation cases in the US.

2. Client-Attorney Privilege of Japanese Patent Attorneys in the U.S.

(1) “Privilege” in Japan

Japan is a civil law country which does not use the “discovery” system of document disclosure. Hence, the “privilege” referred to in common law countries such as the U.S. is not found in Japanese law. However, Japanese law does contain a “duty of confidentiality” as a legal concept corresponding to

such “privilege.” This “duty of confidentiality” is defined in Article 30 of the Japanese Patent Attorney Law and Articles 197 and 220(iv) of the Code of Civil Procedure which were newly introduced by the revision of 1998.

Article 197 (right of refusal to testify) stipulates that “a patent attorney may refuse to testify at the court with regard to any fact which he/she has learnt in the course of his/her duty and which should be kept a secret” and Article 220 stipulates that “one may refuse to submit to the court a document stating matters which are to be kept secret.”

(2) Cases and Precedents in the U.S. regarding Japanese Patent Attorneys' Privilege

Client-attorney privilege regarding Japanese patent attorneys has become gradually accepted since the revision of the Code of Civil Procedure in 1998, since a legal provision which substantially corresponds to the privilege in the U.S. also exists in Japan (Article 220 of the Code of Civil Procedure), in terms of “international comity.”

Examples of cases and precedents in the U.S. in which privilege has been accepted for Japanese patent attorneys include the VLT case (2000), the Knoll Pharms. case (2004), the Murata case (2005) and the Eisai case (2005).

(3) Current Issues and Requests from the JPAA

The “right to refuse to submit a document” in Article 220 of the Code of Civil Procedure and the “right to refuse to testify” in Article 197 of the Code of Civil Procedure are legally different from the privilege in the U.S. due to the differences between the respective legal systems of each country. In the above cases, such differences have been overlooked and the privilege in the U.S. has been accepted, but it is uncertain as to whether privilege will always be judged in a similar manner in the courts. Therefore, it is considered that the situation regarding the privilege of Japanese patent attorneys in the U.S. remains unstable.

Accordingly, we strongly request the USPTO to prepare a uniform federal standard for the privilege of foreign patent attorneys in the U.S. from an “international comity” point of view, so that such standard may become a substantial criterion for judgments in the courts.

Furthermore, in terms of the so-called “touch base” doctrine, judgments have been made in the courts to the effect that client-attorney privilege does not apply

to legal advice or comments on U.S. laws or practice made by Japanese patent attorneys. However, taking into consideration the fact that clients generally seek advice from Japanese patent attorneys in cases of infringement litigation in the U.S., regarding whether or not infringement has actually occurred, client-attorney privilege should also be accepted for advice, comments and decisions regarding U.S. laws or practice made by Japanese patent attorneys.

3. International Aspects

To date, the privilege of Japanese patent attorneys has not yet been accepted in any common law country other than the U.S. (e.g. India, Singapore, South Africa, etc.). Indeed, there has even been one case where the privilege of an English patent attorney was not accepted in Australia, despite it also being a common law country.

Although it is essentially a domestic legal issue regarding how one considers and stipulates such “privilege,” when taking into consideration the actual situation involved in obtaining intellectual property rights in a plurality of countries, the situation wherein the privilege of a foreign patent attorney is accepted in one country but not accepted in other countries shows blatant disrespect for the protection of intellectual property rights in each country and is therefore entirely inappropriate in terms of ensuring the protection of intellectual property rights holders. Accordingly, privilege is both a domestic issue and an international issue and includes the cross-border aspect of “whether the privilege of a foreign patent attorney can be accepted in other countries.”

The AIPPI has been focusing on this issue and international discussions on such topic have been conducted at the WIPO/SCP (Standing Committee on the Law of Patents) since 2010 for the purpose of preparing an international agreement. We, as a participating nation, have to exert our utmost efforts to make sure these discussions succeed, in order to bring about the realization of a successful international agreement.

With regard to this issue, the JPAA also has a vested interest in view of the protection of clients’ interests and always sends a representative to the SCP to actively participate in discussions regarding this matter. We thus request the USPTO to make a sincere effort to achieve a successful international agreement at the SCP.