

# Protection of Patent Advisors against Forcible Disclosure

DK: Beskyttelse af patentrådgivere mod tvungen afgivelse af oplysninger

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*Specialet omhandler den stigende tendens blandt mange civil law jurisdiktioner, hvorefter de indfører beskyttende foranstaltninger (fx vidneudelukkelse, lovfæstet tavshedspligt o.l.) til patentagenter, der ikke er advokater, ved at ændre deres nationale lovgivning for at imødekomme common law's discovery-procedure. Specialet fokuserer på tendensen blandt EU-medlemsstater, og hvordan udviklingen forholder sig til reglerne om EU's indre marked. Med fokus på tre udvalgte jurisdiktioner inden for EU, stiller specialet sig for at besvare spørgsmålet, om disse tre EU-lande har tilgodeset reglerne om EU's indre marked ved indførelsen af disse beskyttende foranstaltninger. Derudover undersøger specialet om disse foranstaltninger rent faktisk har den tiltænkte effekt, ved at analysere det amerikanske "patent-agent privilege" samt nyere retspraksis fra de amerikanske føderale domstole om anerkendelse af fremmede jurisdiktioners beskyttelsesforanstaltninger i patentretssager.*

*The thesis treats the increasing tendency amongst many civil law jurisdictions to enact improved protection (eg witness exclusion, statutory secrecy obligations etc.) to non-lawyer patent advisors against forcible disclosure by amending their national legislation to accommodate the American discovery procedure. The thesis focuses on the tendency amongst EU Member States, and how the developments correlate with the provisions of the EU internal market. In examining three approach models taken by different Member States, the thesis applies the internal market law on these measures to assess the compliance of the Member States with EU law. In addition, in light of the recent American federal case law on the subject, the thesis also examines the developments of the American patent-agent privilege and the federal courts' recognition of the foreign protective measures for non-lawyer patent advisors when conducting patent litigation in the US.*

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## **Abstract**

This thesis analyses the development of the protection of non-lawyer patent advisors against forcible disclosure. The thesis has two main focuses. Firstly, the development of the law in the European Union (EU) Member States and their compliance with EU internal market law regarding the free movement of services. Secondly, the thesis analyses the American patent-agent privilege, and the application of this privilege on foreign patent advisors, such as those based in the EU.

As the fact-finding procedures in common law and civil law jurisdictions are vastly different, EU Member States, which are primarily civil law jurisdictions, have amended their procedural legislation to accommodate the differences to common law jurisdictions. In examining three approaches to implementing protective measures taken by the different EU Member States, as well as in the context of the EU internal market law, the thesis determines the compliance of Member States with EU law.

The thesis uncovers that some Member States fail to meet their obligations under EU law. It further argues that the interest in pursuing enforcement procedures to rectify these problematic approach models are simply not significant enough to materialise into concrete action from neither the Commission nor other Member States.

The amendments to the legislation of EU Member States are in part motivated by a wish to protect against the American discovery procedure. Therefore, the thesis examines the American approach to protection of non-lawyer patent advisors – the patent-agent privilege. Finally, recent American case law is analysed to determine how the American courts will grant protection to foreign patent advisors and to what extent. The preliminary analysis suggests that the federal courts will grant the foreign patent advisor protection as in its home jurisdiction.

## 1. Introduction

The history of patents reaches back thousands of years with records suggesting that the first patent was granted in ancient Greece in 600 BC for “some kind of newfangled loaf” of bread.<sup>1</sup> The fundamental principles of today’s patent system were founded with the Venetian act of 1474 on intellectual property rights, putting forth the framework.<sup>2</sup> In 1623 the British Parliament enacted their Statute of Monopolies, creating a framework for patents in the UK.<sup>3</sup> In 1790 the American Congress promulgated their first Patent Act,<sup>4</sup> and slowly the rest of the world followed suit with similar frameworks and slowly built the patent system of today.

The first professional patent advisors appeared during the early 1800s, providing assistance to the inventors in all matters related to patent laws, helping them develop strategies to maximise the value of the inventions and to avoid infringement.<sup>5</sup> The patent advisor has to be able to manage through the jungle of patent law, yet also be able to understand the inventions of the client and the technologies behind it. Illustratively, an American judge described the patent advisor’s role to be “the ‘interpreter’ for a wide segment of science to the Patent Office, to the industry and to the courts”, highlighting the importance of the patent advisor in the whole patent system.<sup>6</sup> Since the 1800s, the inventions have become more technically advanced, and extensive knowledge of these advancements are necessary to correctly prepare a patent application, including handling all the necessary claims of the invention and having knowledge of prior art.

While the professional patent advisors have been around for many years, the concept of protecting patent advisors is somewhat new. The dual role of the patent advisor put it in an awkward gap between technical and legal advisor. The technical aspect is often not considered to be worthy of protection at

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<sup>1</sup> Matt Kwong, 'Six significant moments in patent history' (Thomson Reuters, 2014).

<sup>2</sup> Ibid.

<sup>3</sup> British Statute of Monopolies 1623, c. 3.

<sup>4</sup> American Patent Act of 1790, 1 Stat. 109.

<sup>5</sup> Midori Okazaki, 'Documenting Invention: Patent Attorneys, Their Records, and the Study of Invention', (Smithsonian Institute, 2000) at 8.

<sup>6</sup> Arthur R. Whale, 'A Trenchman’s Guide to Getting Better Patents', *Journal of the Patent and Trademark Office Society*, 71/3 (1989), at 245.

all, while the legal aspect is not wide or legal “enough” to be considered as worthy of protection as for an example the work of lawyers.

Protection against forcible disclosure for lawyers was developed by the common law courts during the 1500s as the legal professional privilege and is now one of the oldest common law evidentiary privileges.<sup>7</sup> While some patent advisors are qualified as lawyers, and thereby covered by the legal professional privilege, most patent advisors are not. They, therefore, receive no protection from the legal professional privilege, although they perform the same tasks for their clients. The non-lawyer patent advisor’s role as legal counsel was not recognised until much later.

The US Supreme Court was the first to acknowledge the work of patent advisors to be legal with its ruling in *Sperry v. Florida* in 1963,<sup>8</sup> and provided that the attorney-client privilege should be extended and also grant protection to non-lawyer patent advisors. However, the privilege was much more limited than the attorney-client privilege granted to lawyers. Back then, the reasoning for a more limited scope of protection was that the patent advisors may only render legal services which are “reasonably necessary and incident” to patent prosecution.<sup>9</sup>

In the following decades, only a few more jurisdictions enacted similar provisions granting equivalent protection to patent advisors. Then, after entering the new century, more jurisdictions soon enacted different measures for protecting their patent advisors. This trend was arguably sparked by the ruling of the American district court of New York in 1999 in the case *Bristol-Myers*.<sup>10</sup> The court ruled that because French law did not provide an evidentiary privilege or some other equivalent protection to patent advisors, the subject French patent advisor was not protected against the extensive discovery procedure at the federal courts, even though a similar skilled and qualified American patent advisor would be protected.

A few years later, France amended its Intellectual Property Code motivated by the *Bristol-Myers* ruling. The amendment was aimed explicitly at cases like the aforementioned, to ensure that French patent advisors would be protected in proceedings at foreign courts, primarily American.<sup>11</sup> Soon, more jurisdictions followed suit, and in 2018 more than 15 European Member States had enacted some sort of protection for patent advisors.<sup>12</sup>

## 1.1. Research Problem

The developments in the protection of non-lawyer patent advisors against forcible disclosure have shown that there is an increasing tendency amongst many jurisdictions all over the world to amend their national legislation to accommodate the American discovery procedure. The thesis focuses on

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<sup>7</sup> Thomas C. Jr. Dawson, John T. III Tucker, and Kevin J. Whyte, 'The Attorney-Client Privilege', *University of Richmond Law Review*, 19/3 (1985), at 560.

<sup>8</sup> *Sperry v. Florida*, 373 U.S. 379 (US Supreme Court, 1963).

<sup>9</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: The United States of America', at 1.

<sup>10</sup> *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 188 F.R.D. 189 (S.D. New York, 1999).

<sup>11</sup> French Senate, 'Ordinary Session 2002-2003, Document No: 176, Title 7 [Réforme du statut de certaines professions judiciaires ou juridiques, des experts judiciaires et des conseils en propriété industrielle, N° 176, SÉNAT, SESSION ORDINAIRE DE 2002-2003, Annexe au procès-verbal de la séance du 12 février 2003]', (2003).

<sup>12</sup> Belgium, Bulgaria, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Latvia, Lithuania, Poland, Spain and Sweden, cf. the WIPO Compilation of laws and practices for the respective countries.

the tendency amongst EU Member States, and how the developments correlate with the provisions of the EU internal market. In examining three approach models taken by different Member States, the thesis applies the internal market law on these measures to assess the compliance of the Member States with EU law. In addition, in light of the recent American federal case law on the subject, the thesis will also examine the developments of the American patent-agent privilege and the federal courts' recognition of the foreign protective measures for non-lawyer patent advisors when conducting patent litigation in the US.

## **1.2. Scope and limitations**

Many professionals perform patent advisory services, but the scope of the thesis is limited to patent advisors, who are not lawyers. Furthermore, "providing services" shall be limited to the situation where an EU-based patent advisor temporarily assists a client in another EU Member State, why the thesis only lightly touches upon the subject of permanent establishment and recognition of professional qualifications.

In the US, while some issues are handled at the state level, most patent laws are enacted on the federal level, why the analysis of the American patent-agent privilege only will treat law and cases at the federal level.

## **1.3. Methodology**

The thesis uses the traditional legal doctrine of describing, systemising and analysing the relevant sources of law.

Patent advisors' protection against forcible disclosure is not harmonised within the EU. Therefore, the analysis of the EU internal market encompasses the free movement provisions of the Treaty of the Functioning of the EU (TFEU), EU secondary legislation, the case law of the European Court of Justice (the Court or ECJ), and the work of legal scholars from within the field.

The American patent-agent privilege is analysed on the federal level with regard to federal legislation, federal jurisprudence, associated works by legal scholars, and submissions from various jurisdictions to the World Intellectual Property Organization (WIPO).

## **1.4. Layout**

The thesis begins with an introduction to the patent advisor and its work, followed by a description of the most common forcible disclosure measures in the traditional common and civil law legal systems. This is done to showcase how the legal systems provide different measures for forcible disclosure and thus require different corresponding protection. Next, will be an introduction to the patent advisory sector and patent litigation, and afterwards, the differences between common and civil law will be put into the context of patent advisory in Section 2.3.

That will create the foundation of the thesis. Following this, the thesis will continue with an introduction to the approach models chosen by three Member States of the EU to accommodate the procedural differences in the legal systems in Section 3.1. Thereafter, it is analysed how these approach models comply with the provisions of the EU internal market in Section 3.2.

After that analysis, the European approach models will be put into an American perspective in Section 4. For that purpose, the American patent-agent privilege is initially examined, followed by an analysis of how the federal courts will handle the issue of recognition of the foreign protective measures and the implications thereof.

Finally, the main points and arguments will be gathered and summarised in the conclusion in Section 5.

## **2. Patent advisors and forcible disclosure**

### **2.1. The patent advisor and his role**

A patent advisor can broadly be defined as a professional representative who advises on matters regarding patents. Often, the patent advisor provides a wide range of services, such as assisting in preparing applications for patents, determining the validity of patents and prosecuting patents.

They possess a central role in the patent system, ensuring that patents are correctly filed and disclosed to provide the most favourable conditions for businesses to commercialise their innovations to their fullest potential. There is often a need for both legal and technical knowledge to interpret the technology into the legal context of a patent.

Another vital part of the work of the patent advisor is developing and executing patent strategies, and by this, advise on what to achieve with the patent, what innovations should be patented and where, and how to act concerning competitors' patents and infringement cases.

Professionals offering these services are often referred to as "patent agents", "patent advisors" or "patent attorneys" in many countries. This thesis will primarily use the broad term "patent advisor" to not limit the scope of the term, except when dealing specifically with a jurisdiction that uses a specific terminology. However, it is essential that the patent advisor is not a lawyer and therefore, do not enjoy the same right of privilege and duty of confidentiality.

### **2.2. Forcible Disclosure**

A key element of litigation is fact-finding to determine on what grounds, to decide the judgement. As part of this, forcible disclosure is a term for the measure of forcing a person or an entity to disclose something they know or that are in their possession. In order to decide which measures should be available, each jurisdiction has to find a balance between forcible disclosure and privacy, which essentially are to find a balance between competing public and private interests.

On the one hand, the client has an interest in keeping his knowledge and communications with his advisor secret. Meanwhile, the public also has an interest in the client being honest and frank with the advisor, so the advisor can determine the proper procedure moving forward, which is to the benefit of the administration of justice and the broader society. On the other hand, to disclose all available information is of interest to the public to reach the correct and right judgement.

How different jurisdictions strike this balance and what measures can be taken for forcible disclosure – and the protections against these measures – vary from jurisdiction to jurisdiction. However, a full examination of these measures goes beyond the scope of this introduction.

This introduction will distinguish between measures found in jurisdictions belonging to the legal family of common law and the legal family of civil law, albeit this distinction has been discredited by many scholars as being meaningless, and not showing enough appreciation to the distinctiveness of the many jurisdictions within each family.<sup>13</sup> Nonetheless, as the jurisdictions associated with the two legal families are similar within the family regarding forcible disclosure, and as the two families are distinctly different to each other, this distinction is deemed to be appropriate for this purpose.

### **2.2.1. The Common Law Family**

In the jurisdictions associated with the common law family, the fact-finding process most often begins with the ‘discovery’ or ‘disclosure’ procedure.<sup>14</sup> It requires both parties to create a list of documents that sets out, describes and identifies documents relating to any matters in question between the parties. The lists may include witness lists, lists of documents to be used to prove one’s case, and certain other preliminary documents.

While the scope of the procedure varies between the jurisdictions, the purpose is to disclose all documents and witnesses, which may be crucial to the final goal of fact-finding. This entails that the parties not only have to disclose all that is supporting their case but any matter that is relevant to any party’s claim or defence.

The only exception to discovery proceedings is privileged information. Privileged information is confidential information that a party may refuse to supply to the other party. Most well-known is the attorney-client privilege, which is based on the abovementioned balance between privacy and publicity during litigation and is created to ensure open and honest communications between client and legal counsel. As patent advisors to some degree perform the same functions and have the same responsibilities as legal counsel, a new patent-agent privilege has developed.<sup>15</sup>

### **2.2.2. The Civil Law Family**

The same procedures of disclosure are not found in the civil law systems. The parties to civil law litigation are more independent and generally are much more responsible themselves to put forth evidence supporting their case. While many jurisdictions have measures for forcible disclosure, eg the opportunity for a party to request the court to require the other party to produce a document, such measures play a much smaller role than in common law systems.

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<sup>13</sup> See eg H. Patrick Glenn, 'Comparative Legal Families and Comparative Legal Traditions', in Mathias Reimann and Reinhard Zimmermann (eds.), *The Oxford Handbook of Comparative Law* (Oxford University Press, 2006).

<sup>14</sup> The term for this process differs from jurisdiction to jurisdiction. The US and Canada use the term ‘discovery’ while England and Wales use the term ‘disclosure’. The terms will be used interchangeably.

<sup>15</sup> It was first introduced by the American courts in *Sperry V. Florida* as an extension of the attorney-client privilege, but has recently been developed into a standalone privilege, see section 4.1. The UK acknowledged the privilege by enactment of the Civil Evidence Act 1968 and most recently did Canada acknowledge the privilege by the enactment of amendments to the Canadian Patent Act in 2016.

As the parties are not exposed to the same risk of disclosing their information in civil law litigation as in litigation with discovery procedures, the same protection is not necessary either. Most jurisdictions instead have the notion of a secrecy obligation imposed on certain professionals. It derives from either statute or professional standards, and breach of the obligation is often subject to civil and sometimes even criminal penalties.

The judicial system recognises the secrecy obligation. It will exempt the obliged professional from giving witness statements in court, and the professional may refuse to produce documents, which include information subject to the secrecy obligation.

### **2.3. The impact of globalisation – rethinking European civil procedure**

Global trade has increased substantially during the last decades. This is to the benefit of many, creating great wealth in especially the US and Europe. However, the increased global trade and the more connected world of today does not come without issues.

The modern patent system is developed upon the notion of disclosure and openness, to encourage innovators to keep improving products and technologies for the betterment of all humankind. While this is an admirable approach, it introduces a risk for competitors creating a minor variation of the same idea or technology, claiming it to be inventive and novel. Furthermore, the mere number of patents today makes the system an immense jungle to navigate, with more than 600.000 patent applications filed in the US alone in 2017.<sup>16</sup> The vast number of patents increases the risk of an inventor simply not knowing about another patent, of which his technology potentially infringes.

As companies now have easier access to other markets than their home market, the chance for conflicting products and patents increase – and this leads to litigation. The US has made a significant effort to publish litigation data, and these show that there has been an increase in patent litigation cases for the federal district courts by more than 250 % since the turn of the millennium, peaking at more than 6,000 cases filed in 2013.<sup>17</sup>

To promote the patent system and to protect patent holders, the US has taken a “pro-patent” approach and has empowered the courts to grant exceptionally high damages for patent infringement. By the introduction of the notion of ‘enhanced damages’, the courts may grant up to tri-fold the suffered damages to the infringed patent-holder, if the infringer is guilty of ‘willful infringement’.<sup>18</sup> To determine the adequate damages, the court considers all the circumstances of the case, but the intention and willingness of the defendant to infringe are of great importance. When assessing if a party is guilty of ‘willful infringement’, the court shall first consider if the defendant engaged in acts that infringed the claimed patented patent and if the defendant knew those acts violated the patent. If that is found to be true, and the defendant still acted as if they were ignorant of the law or had reckless regard for the patent, they are considered to have been wilful infringing the patent.<sup>19</sup> The damages awarded by American courts are notable, and the damages awarded in successful litigations have

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<sup>16</sup> World Intellectual Property Organization, 'WIPO statistics database', (2020).

<sup>17</sup> World Intellectual Property Organization, 'Special theme: An overview of patent litigation systems across jurisdictions', *World Intellectual Property Indicators 2018* (2018), 12-22 and the United States Patent and Trademark Office, 'Patent Litigation Docket Reports Data'.

<sup>18</sup> 35 US Code § 284.

<sup>19</sup> *Halo Electronics, Inc. v. Pulse Electronics*, 579 U.S. \_\_\_\_ (US Supreme Court, 2016).



been trending upwards during the last 20 years, with a median of \$ 9.2 million in 2013-2017, and with multiple cases exceeding \$ 1 bn.<sup>20</sup>

The notion of willful infringement – and especially the following risk of enhanced damages – is what made many jurisdictions create protection for their companies and patent advisors against lawsuits from the US. To prove whether a company knew of the claimed infringed patent, the discovery procedure is an incredibly powerful tool to gain an insight into the opposing party's knowledge. A company will often get an opinion from a patent advisor before publishing a new product or technology, and this opinion is often a great indication of what the company knew at the time. In case the opinion indicates that other similar patents might be problematic, this is something the company should be aware of and react to. If the company does not, it might indicate that they had knowledge of the other patent and still launched its product or technology.

While the American companies and patent-holders are protected to a certain extent by the patent-agent privilege,<sup>21</sup> this was (and still is for many) not the case for non-American companies, as their national legislation does not have a privilege or measures substantially equal to it. This dissimilarity between the American companies and their non-American competitors created what would be perceived as an unfair advantage, which became apparent with the ruling of *Bristol-Myers*<sup>22</sup> in 1999.

An American company had filed a lawsuit against a French company accusing the French company of having infringed their patent rights. During discovery, the French company claimed that communications with their French patent advisors should be privileged and thus not subject to the discovery procedure, as they would not be subject to forcible disclosure in France because of the French patent advisor's secrecy obligation. However, the court initially noted that there is a fundamental difference between a secrecy obligation and an evidentiary privilege and then continued to dismiss the French company's arguments of privilege, as it established that no evidentiary privilege-equivalent existed under French law.

Interestingly, the court noted that there are fundamental differences in the legal procedures of the US and France, which in practice leads to very little need for a privilege-like measure in French civil procedure. It noted that although a secrecy obligation might suffice to grant adequate protection in France, it is not an evidentiary privilege comparable to the American privilege.

A similar situation occurred for Swiss patent advisors and Swiss law. In *In re Rivastigmine*,<sup>23</sup> the court was faced with the question of whether the Swiss secrecy obligation and the ancillary evidentiary rules were comparable to the American privilege for patent advisors. The court used much of the same reasoning as in *Bristol-Myers* and eventually established that the Swiss measures were not comparable to the American privilege.

In this case, the court explicitly discussed the differences between the two legal systems and how these should be treated. The Swiss company argued “*that because of more limited Swiss discovery procedures, a Swiss court (allegedly) would not order disclosure of the documents at issue*” and, thus,

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<sup>20</sup> Pwc, '2018 Patent Litigation Study', (PWC Forensics, 2018).

<sup>21</sup> The scope of the patent-agent privilege is limited and will be examined later in chapter 4.1.

<sup>22</sup> See footnote 10.

<sup>23</sup> *In re Rivastigmine* 239 F.R.D. 351 (S.D.N.Y., 2006).

the situation is equal to a de-facto privilege. The court admitted that “*special problems [may] arise when evaluating the attorney-client privilege of foreign jurisdictions whose discovery systems are not comparable to [the American system]*”. Nevertheless, it dismissed the argument, as the court refused to imply a privilege where no such privilege exists.

In 2009 Switzerland enacted legislation providing for professional secrecy obligations and made amendments to the code of civil procedure enabling patent advisors to refuse the production of evidence that is subject to professional secrecy.<sup>24</sup> After the enactment of the new legislation, the federal courts again had the chance to evaluate the Swiss measure in *In re Zoledronic acid*.<sup>25</sup> This time, the court changed the precedent and found that the Swiss measures were comparable to the American privilege. Thus, the privilege did apply to the Swiss patent advisor.

### **3. Patent Advisory Services in the EU Internal Market**

One of the major aspects of the EU is the internal market. The internal market is built upon the foundation of the free movement of goods, services, persons and capital; commonly referred to as the four freedoms. These four freedoms enable free movement across borders, resulting in greater competition and larger markets within the Union. However, the internal market also creates obligations for the EU Member States to comply with and to consider when introducing new legal measures.

#### **3.1. Approach Models**

Amongst the EU Member States, consensus established that protection of domestic businesses and their intellectual property against competitors, and especially transatlantic competitors, should be enacted. As a mean to this, they began to create privilege-like systems to grant patent advisors protection against forcible disclosure. The Member States have chosen different approaches for this, and this next section will examine three approach models taken by different states.

##### **3.1.1. Sweden**

Sweden enacted a new law on the authorisation of patent representatives in 2010.<sup>26</sup> The law introduced a scheme for authorising patent advisors (*patentombud*) in Sweden and simultaneously provided amendments to the law on civil procedure,<sup>27</sup> establishing protection for authorised patent advisors.

The protection granted to authorised patent advisors by the new authorisation scheme includes both exception from the duty to testify before the courts and an exception to produce documents for the court in matters relating to patents.

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<sup>24</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: Switzerland', at 2.

<sup>25</sup> *In re Zoledronic acid*, 2:12-cv-03967 (D.N.J., ).

<sup>26</sup> Law on the authorisation of patent representatives [*Lag om auktorisation av patentombud*] (2010:1052).

<sup>27</sup> Law on civil procedure [*Rättegångsbalk*] (1942:740).

These amendments aim to grant Swedish patent advisors equal protection to that of the American privilege. In the explanatory memorandum for the law proposal, it is stated that it is of great importance to give this improved protection to the Swedish patent advisors. They would otherwise suffer from a competitive disadvantage compared to their competitors with base in other jurisdictions that do provide for better protection of confidentiality.<sup>28</sup> An explicit reference is made to the American legal system and the discovery procedure as one of those significant difficulties that the measures shall protect against.<sup>29</sup>

The Swedish system does, however, not provide any provisions on temporary mobility or the exercise of the free movement of services in the internal market. The Swedish system does not grant exclusive rights to exercise the profession; it merely grants the authorised patent advisor a “certificate” that the advisor is skilled and qualified in addition to the abovementioned protection against disclosure.

### 3.1.2. Denmark

Denmark has chosen a more limited approach to a patent advisor authorisation-system. In 2018, Denmark enacted a law expanding the scope of the exclusion of providing witness statements in court to also include patent advisors registered at the list of European Patent Attorneys (EPA) maintained by European Patent Office.<sup>30</sup> The new law provides that an EPA can no longer be demanded to testify before Danish courts concerning all matters having come to their knowledge during the exercise of their functions as EPA.

The new law has a broader scope than just witness statements in court. The rule is linked with the rules concerning the production of documents for the court. Thus, the patent advisor cannot be demanded to produce documents to the court if the documents contain information regarding matters that would be protected by the witness exclusion rules.

In Denmark, the title of “patent advisor” is not protected, thus in principle allowing everybody to make use of it. However, the Danish Ministry of Justice considered it necessary to have some sort of requirement for qualification to be granted the protection. The Danish Ministry of Justice deemed that to implement a new, full authorisation system – like Sweden decided to do – would be too resource-demanding.<sup>31</sup> Based on the argument that a large amount of the Danish patent advisors at the time of the proposal was certified EPAs, it was proposed to make such qualifications the requirement for protection. This ensures that the patent advisors have certified qualifications and is very cost-efficient for the Danish administration.

In the explanatory memorandum to the law proposal, the Ministry of Justice stated that the reason to implement this amendment is rooted in a concern that Danish companies are in a competitive disadvantage compared to foreign companies, whose patents are better protected than the Danish. This

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<sup>28</sup> The Swedish government’s proposal: Authorisation and secrecy obligation for patent representatives [*Regeringens proposition: Auktorisation och tystnadsplikt för patentombud*] (2009/10:202), at 16f.

<sup>29</sup> Ibid, 18f.

<sup>30</sup> Law on the amendment of the Administration of Justice Act, Law no. 710 of 08/06/2018 (2018) [*Lov om ændring af retsplejeloven, lov nr. 710 af 08/06/2018*].

<sup>31</sup> The Danish Department of Justice, 'Proposal to amend the Administration of Justice Act [*Lovforslag til ændring af retsplejeloven, som fremsat*]', *FT 2017-18 tillæg A L 157*, (2018), at 5f.

concern is especially regarding companies that wish to operate on the American market.<sup>32</sup> However, it was noted that it is uncertain if the American federal courts will acknowledge the Danish witness exception and to what extent during litigation.<sup>33</sup> As later proceedings have shown, it proved hard to get a finite answer on the question.<sup>34</sup>

### 3.1.3. Germany

In Germany, the profession of advising on patents is a regulated profession, the title of patent attorney (*patentanwalt*) is protected and may only be used by authorised patent attorneys, and only authorised patent attorneys may provide patent services. The profession is subject to comprehensive regulation, first and foremost the Patent Attorney Code,<sup>35</sup> which also includes all regulation as to how to obtain authorisation as a patent attorney.

Under German law, the right to refuse testimony before the courts are dependent on whether the person is under a legal obligation to maintain confidentiality.<sup>36</sup> To accommodate and to grant protection for the patent attorneys, section 39a (2) of the Patent Attorney Code provide for a secrecy obligation for the patent attorney. The scope of the secrecy includes everything the patent attorney learns during the exercise of its function, and, thus, offer comprehensive protection. While the Patent Attorney Code was first enacted in 1966, not until 1994 was the law amended to include the secrecy obligation. Breach of this obligation is subject to both civil and criminal penalties.

In addition to the Patent Attorney Code, Germany has also enacted a law regulating European Patent Attorneys exercising their functions in Germany.<sup>37</sup> The law both lay the foundation for the recognition of foreign patent advisors from other EU Member States wishing to be permanently authorised to practice in Germany and foreign patent advisors wishing to provide services in Germany temporarily.

That the profession is regulated sets certain limits for the possibility for foreign patent advisors to provide services in Germany. No matter whether the profession is regulated in the home state of the patent advisor or not, it must notify the German Chamber of Patent Attorneys of its wish to provide services before engaging in such activities. Upon receipt of the notification, the Chamber will enter the patent advisor into a public register, and the patent advisor will hereafter be able to legally provide services for a year from that point.

A patent advisor providing services temporarily is also subject to the same secrecy obligation as German authorised patent attorneys. This means that once the foreign patent advisor is legally able

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<sup>32</sup> Ibid., at 3f.

<sup>33</sup> Ibid., at 6f.

<sup>34</sup> As will be further elaborated in chapter 4.2.

<sup>35</sup> German Patent Attorney Code of September 7, 1966 (Federal Law Gazette I p. 557), last amended by Article 16 of the Law of December 12, 2019 (Federal Law Gazette I p. 2602) [*Patentanwaltswahlordnung vom 7. September 1966 (BGBl. I S. 557), die zuletzt durch Artikel 16 des Gesetzes vom 12. Dezember 2019 (BGBl. I S. 2602) geändert worden ist*].

<sup>36</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: Germany', at 2.

<sup>37</sup> German Law on the activity of European Patent Attorneys in Germany, 2017 (Federal Law Gazette I p. 1121) [*Gesetz über die Tätigkeit europäischer Patentanwälte in Deutschland vom 12. Mai 2017 (BGBl. I S. 1121, 1137), das durch Artikel 7 des Gesetzes vom 30. Oktober 2017 (BGBl. I S. 3618) geändert worden ist*].

to provide services in Germany, it will be obliged to secrecy as the local patent attorneys, and also be protected in the same manner.

### 3.2. Patent advisory as a service

Before analysing the three approach models in the context of the EU internal market, the framework of the analysis has to be established. During the early days of the EU, it was argued that the provisions regarding the free movement of services should be considered the residual legal category of the four freedoms. This seems to follow the intentions of the drafters of the TFEU as article 57 of the Treaty defines “services” to be what is not governed by the provisions relating to the other three freedoms. However, the wording must be interpreted as a product of its time, where services were not given the same attention and recognition as industrial production.<sup>38</sup> The European Court of Justice has later explicitly dismissed the idea that the provisions should be residual to the other freedoms in its judgement of *Fidium Finanz*.<sup>39</sup>

The freedoms related to goods and services have developed distinctly similarly and have been subject to almost parallel regulatory approaches.<sup>40</sup> However, as the nature of the two is inherently different in fundamental ways, the law still differs. In the early case law of the Court, the distinction has simply been made as to whether the nature of the activity is tangible or intangible.<sup>41</sup> The Court has since moved to a more pragmatic approach, where it seeks to identify the core activity to establish whether the tangible or intangible aspect of the activity is merely ancillary to the other, while also looking at the economic rationale behind the activity.<sup>42</sup>

As set out in article 57 of the TFEU, it is a requirement that the services are “normally provided for remuneration”. This requirement has been subject to much discussion and extensive case law, especially as to how ‘normally’ should be interpreted; however, the concept has been interpreted very wide and flexible by the Court.<sup>43</sup> It includes both the situation where the service receiver pays directly to the provider as remuneration, but also include eg publicity associated with the delivery of services to be remuneration.<sup>44</sup> The very wide interpretation by the Courts means that only situations with virtually no economic activity are excluded from the provisions.<sup>45</sup>

Considering the above, it can be concluded that the delivery of patent advisory services constitutes a service and are subject to the TFEU. The core service is the advice and services granted by the patent advisor to the client. Any tangible product that the advisory produces, eg a document that includes an

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<sup>38</sup> Vassilis Hatzopoulos, *Regulating Services in the European Union* (Oxford University Press, 2012) at 3f.

<sup>39</sup> C-452/04 “*Fidium Finanz*” (2006), para 32.

<sup>40</sup> Margot Horspool, Matthew Humphreys, and Michael Wells-Greco, *European Union Law* (9 edn.: Oxford University Press, 2016) at 310.

<sup>41</sup> See eg case C-155/73 “*Sacchi*” (1974), where the Court did not hesitate to differ tv-signals as services because of its nature, while trade material, sound recordings, films and apparatus were considered goods.

<sup>42</sup> Hatzopoulos, *Regulating Services in the European Union* at 24 that use the example of a leasing contract, which is considered a service irrespective of the economic value of the underlying asset, cf. case C-36/02 “*Omega Spielhallen- und Automatenaufstellungs-GmbH v Oberbürgermeisterin der Bundesstadt Bonn*” (2004).

<sup>43</sup> Hatzopoulos, *Regulating Services in the European Union* at 22f.

<sup>44</sup> See eg the joined cases C-51/96 and C-191/97 “*Deliège*” (2000).

<sup>45</sup> See eg case C-159/90 “*Society for the Protection of Unborn Children Ireland v Grogan and Others*” (1991) where a student union provided information about possibilities for legal abortions in a neighbouring country. The Court concluded that these services did not include any economic activity.

infringement opinion or a filled out application form for a patent, must be considered purely ancillary to the services provided by the patent advisor. Moreover, as the concept of the remuneration is interpreted as vast as it is, it should bring no doubt that the free movement of services protects the services. The Court has had a few chances to decide on this matter and came to the same conclusion.<sup>46</sup>

Because of the very nature of services, it has proven very difficult to regulate the service as such. Instead, the focus of the regulators shifted to the one providing the services, and as such the free movement of services is indeed linked with the free movement of persons and the freedom of establishment as well.

### 3.3. Distinction between establishment and providing services

The right to establish in another Member State is protected by article 49 of the TFEU. From case law of the Court, it can be deduced that the main criterion distinguishing permanent establishment and temporarily providing services is duration.<sup>47</sup> However, not only the duration is essential, but also the regularity, periodicity and continuity of the services provided have to be taken into consideration.<sup>48</sup>

The distinction is essential, as the protection varies between the two. Because of the more permanent and continued nature of an establishment, the Member States are allowed more freedom to regulate and restrict entry into industries or professions in their jurisdiction.

Also, a whole framework around mutual recognition of regulated professions is put in place to enable professionals to easier migrate from one Member State to another, namely the Directive on the recognition of professional qualifications.<sup>49</sup> One of the professions regulated by this directive is the “patent agent”.<sup>50</sup> The framework is set up to allow professionals to easier get access to the same profession in another Member State.<sup>51</sup> It, however, allows the Member States to have a more rigid test of each individual’s qualifications, before having to allow the professional to practice and provide services on a continued basis.

For a functioning internal market on services, the Member States can hardly be allowed to make the same requirements for test and qualifications, when the service provider seeks to merely temporarily provide services or perhaps just to provide a single service. It would simply be inefficient and would, in practice, discourage many service providers from providing services across borders.

That issue is essential for this thesis. The goal of the national legislation is to ensure proper protection of domestic patent advisors and thereby, domestic companies. To achieve this goal, protection is often granted to patent advisors authorised by the national authority of the Member State.<sup>52</sup> Furthermore, authorisation is often a requirement to practice the profession at all.<sup>53</sup> When a foreign patent advisor

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<sup>46</sup> See eg case C-76/90 “Säger v Dennemeyer” (1991).

<sup>47</sup> See eg case C-55/94 “Reinhard Gebhard v Consiglio dell’Ordine degli Avvocati e Procuratori di Milano” (1995).

<sup>48</sup> Ibid., para. 27.

<sup>49</sup> Directive 2005/36/EC on the recognition of professional qualifications.

<sup>50</sup> The profession “patent agent” appears in the Regulated Professions Database maintained by the European Commission and are as of 21 May 2020 regulated in 18 different EU Member States. [https://ec.europa.eu/growth/tools-data-bases/regprof/index.cfm?action=profession&id\\_profession=2160](https://ec.europa.eu/growth/tools-data-bases/regprof/index.cfm?action=profession&id_profession=2160).

<sup>51</sup> Directive 2005/36/EC, preamble 3.

<sup>52</sup> As is seen in the current Swedish regulation. See section 3.1.1.

<sup>53</sup> An example of this is Germany, as described earlier in section 3.1.3.

seeks to establish or to work for a patent advisory firm, he will go through the process of having his qualifications recognised, which will eventually be granted followed by authorisation and protection.

However, as the temporary service provider cannot be forced to go through the process to become authorised, it will therefore not be protected against forcible disclosure by these means. The question can then be raised: is this differential treatment of permanent and temporary service providers in compliance with the notion of the free movement in the internal market? That is what this chapter seeks to answer.

### **3.4. The idea of creating a single market – the Service Directive**

The directive on services in the internal market,<sup>54</sup> commonly referred to as the Service Directive, was enacted in December 2006 and had to be implemented by the Member States by the end of 2009. This directive seeks to ease both establishing and temporarily providing services in another Member State. Thus, it aims to ease both the right to establishment and the right to provide services within the Union by removing internal barriers and thereby promoting internal economic activity.<sup>55</sup>

The Service Directive defines services with reference to (now) article 57 of the TFEU, which are understood as such that services in relation to the directive shall have the same definition as services in the TFEU.<sup>56</sup> It is evident from the preambles that a wide range of services are to be included by the directive.<sup>57</sup> However, many services are also explicitly excluded from the directive in article 2(2). As patent advisory – as legal or technical advisory in general – are not explicitly excluded, it is *prima facie* covered by the directive.

Nonetheless, article 17(6) of chapter IV regarding the free movement of services further excludes services of regulated professions.<sup>58</sup> As previously mentioned, a majority of EU Member States have regulated the patent advisory profession; thus, these services are to be excluded from the coverage of the directive. Therefore, this directive will not apply in many of the Member States regarding patent advisory.

Besides, if a Member State has not yet regulated the patent advisory profession, the scope of protection for the service providers granted by the Service Directive have little to no impact on this issue. Article 16(2) limits a range of requirements that the Member State can impose on foreign service providers. Yet, none of the Member States examined has implemented measures that will be affected by these limitations, or that affects matters concerning the protection against forcible disclosure.

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<sup>54</sup> Directive 2006/123/EC on services in the internal market.

<sup>55</sup> Directive 2006/123/EC, preamble 1.

<sup>56</sup> Directive 2006/123/EC, article 4(1).

<sup>57</sup> Directive 2006/123/EC, preamble 33.

<sup>58</sup> See also preamble 31.

Moreover, article 16(1) provides an explicit prohibition against discrimination, yet with room for justifications – very similar to article 56 of the TFEU.<sup>59</sup> It has, however, been argued that the permissible justifications under article 16(1) of the Service Directive are narrower than article 56 of the TFEU. The Court has not yet made a finite decision on the matter.<sup>60</sup>

Due to the above, while the Service Directive to some extent does apply, the protection granted by the Service Directive deviate so little from the more general protection of the TFEU that this thesis will focus on the articles of the TFEU. Reference to the Service Directive will only be made when it is deemed to provide for a fundamental difference to the analysis and result.

### 3.5. Discrimination, restrictions and market barriers

The provisions on the free movement of services include a prohibition against discriminatory measures. A discriminatory measure restricts cross-border trade more than it restricts domestic trade and thereby creates a comparative disadvantage for foreign services and their providers.<sup>61</sup>

It follows from article 57(3) of the TFEU that the Member States must allow foreign service providers to temporarily provide services in their jurisdiction on the same conditions as its nationals. It is therefore clear that a host Member State may not enact discriminatory measures against a service provider from another Member State, seeking to physically move to the host Member State to provide services there.<sup>62</sup>

Not only differential treatment in situations where a service provider travel to another Member State to provide services are prohibited. Also, the situation where neither the service provider nor the receiver travels, but merely the service itself travels, are granted protection by the free movement of services.<sup>63</sup>

The Treaty goes even further, and article 56 provides that any restrictions on the freedom to provide services shall be abolished, regardless of whether the obstacle makes a distinction between national providers and those of another Member State or not.

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<sup>59</sup> It has been pointed out that the justifications provided in the Service Directive are legally obsolete, as they are all already existing in either the TFEU or the Court's case law. See eg Hatzopoulos, *Regulating Services in the European Union* at 171.

<sup>60</sup> The only judgement on article 16 about the scope of justifications are case C-179/14 "Commission v Hungary" (2016), where the Court decided not to answer the question, but instead decided the case on lack of proportionality, see para. 116.

<sup>61</sup> Tinne Heremans, *Professional Services in the EU Internal Market (Modern Studies in European Law: Hart Publishing, 2012)* at 156.

<sup>62</sup> See eg also case *Gouda*, C-288/89 "Stichting Collectieve Antennevoorziening Gouda v Commissariaat voor de Media" (1991), para. 10.

<sup>63</sup> Cf. article 56 of the TFEU. See eg case C-384/93 "Alpine Investments v Minister van Financiën" (1995), where just the service as such travelled to another Member State.



While the Treaty prohibits both discriminatory measures and restrictions, the Court has a preference to deem most infringing measures as restrictions, regardless of how obvious the case is discriminatory.<sup>64</sup> This approach may be explained with the judgement in *Säger*, where the Court saw discrimination as one kind of infringement of article 56.<sup>65</sup> But prohibitions are not limited to this – other restrictions impeding the service provider were also caught.<sup>66</sup>

The line put forth in *Säger* has since evolved into settled case law, and the scope of possible restrictions is now extended to “all measures which prohibit, impede or render less attractive the exercise of the freedom to provide services.”<sup>67</sup> This extensive scope of possible restrictions forced the Court to try to define some limits for the prohibitions. While the Court repeatably refused to acknowledge a *de minimis*-rule,<sup>68</sup> it has acknowledged that some restrictions are too uncertain and indirect to be capable of hindering the free movement.<sup>69</sup>

The wide definition of restrictions caused the Court to introduce what has commonly been referred to as the market access test with its judgement in *Alpine Investments*,<sup>70</sup> to determine if a national measure constitutes a restriction. The Court would do a test to determine if the measure in question was able to directly affect access to the market in services in the Member State.<sup>71</sup> The market access test seeks to determine whether movement or access to a specific market is restricted, without any need for it to be more restricted for foreigners than for nationals.<sup>72</sup>

The market test has proven to be very wide as well, as more or less all regulatory measures can potentially ‘hinder’ the market access to some degree.<sup>73</sup> At the same time, the evidentiary burden to establish a hindrance is subject to a low threshold.<sup>74</sup> Considering the broad positive definition of restrictions, a negative definition may be more useful – what the Court has determined not to be measures that hindered market access. This seems to be the case when the rules in question are measures that the service provider easily can adjust its business after, and therefore the measures do not affect the access to the market.<sup>75</sup> This has been argued not to be an acceptance of a *de minimis*-rule, but rather as a requirement that the measures have to make it harder for foreign service providers to operate on the market, and that they have to adjust their business model substantially.<sup>76</sup>

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<sup>64</sup> Karsten Engsig Sørensen and Jens Hartig Danielsen, *EU-Retten [EU Law]* (7 edn.: Jurist- og Økonomforbundets Forlag, 2019) at 615 and Josephine Steiner and Lorna Woods, *EU Law* (10 edn.: Oxford University Press, 2009) at 505.

<sup>65</sup> C-76/90 *Säger*, para. 12.

<sup>66</sup> Jukka Snell, *Goods and Services in EC Law: A Study of the Relationship Between the Freedoms* (Oxford University Press, 2002) at 61.

<sup>67</sup> See eg the recent case C-64/18 “*Maksimovic*” (2019), para. 30.

<sup>68</sup> Snell, *Goods and Services in EC Law: A Study of the Relationship Between the Freedoms* at 123f.

<sup>69</sup> See eg case C-483/12 “*Pelckmans Turnhout*” (2014), para. 25.

<sup>70</sup> Case C-384/93 *Alpine Investment*.

<sup>71</sup> *Ibid.*, para. 38.

<sup>72</sup> Gareth Davies, *Nationality Discrimination in the European Internal Market* (Kluwer Law International, 2003) at 93.

<sup>73</sup> Heremans, *Professional Services in the EU Internal Market* at 158.

<sup>74</sup> Stephanie Reynolds, 'Explaining the constitutional drivers behind a perceived judicial preference for free movement over fundamental rights', *Common Market Law Review*, 53 (2016), 643-78 at 666.

<sup>75</sup> See eg case C-602/10 “*SC Volksbank România*” (2012) and case C-565/08 “*Commission v Italy*” (2011).

<sup>76</sup> Sørensen and Danielsen, *EU-Retten [EU Law]* at 621.

It has been argued that it appears as if the Court try to avoid using the term 'market access', and instead rely on the broader definition of a restriction.<sup>77</sup> This has some support in recent case law, which merely refer to the broader definition of what constitutes a restriction.<sup>78</sup> This does not seem to indicate that the Court intends to abandon the market access test overall, but rather that the Court does not wish to limit the scope of the freedom.

### 3.6. Secrecy as a restriction

After defining restrictions and how the Court assesses these, the next thing to consider is whether secrecy is such a substantial matter that lack thereof or differential treatment in that respect may constitute a restriction.

For this, the tasks performed by the patent advisors for their clients must be recalled. The patent advisors assist the companies with technical, strategic and legal counselling on patent-related issues, eg the possibility to bring products based on innovations on the market, or how the company should navigate concerning the competitors' patent rights.

A substantial part of the counselling consists of continuous assessments of the company's work with the development of new products. It can be decisive for the company's decision to either continue their investments, adjust a development in a specific direction or to stop the current work on a product.

As a natural part of their operations, the patent advisor obtains knowledge of the company's intellectual property and deepest trade secrets. It is fundamental for the companies that these secrets remain secret to the outside world and especially to their competitors. Indeed, the patent system is designed to grant exclusive rights to inventors in return for disclosure of the invention. Nevertheless, the company has a great interest in keeping much of the work leading up the patentable product and the underlying internal discussions and reasoning hidden from their competitors.

While an obligation to keep confidentiality often occurs in the contractual relationship between the patent advisor and the client, this has often proven insufficient to protect the intellectual property and the trade secrets from disclosure, especially when subject to the common law discovery proceedings. To not have the communications between the patent advisor and the client protected may render the client vulnerable to having its secrets disclosed forcibly, to significant harm to the client.

The importance of the protection against forcible disclosure for the patent advisor seems to have received a general consensus. The International Association for the Protection of Intellectual Property (AIPPI) has created a standing committee regarding the importance of protection for the patent advisors, the committee on client attorney privilege.<sup>79</sup> Similarly, the Standing Committee on the Law of Patents (SCP) of the World Intellectual Property Organization has had 'confidentiality of communications between clients and their patent advisors' as a regularly returning item on their meeting

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<sup>77</sup> Heremans, *Professional Services in the EU Internal Market* at 158.

<sup>78</sup> See eg C-64/18 Maksimovic, para. 30.

<sup>79</sup> Aippi, 'The Committee on Client Attorney Privilege', <<https://aiippi.org/about-aiippi/committees/>>, accessed 21 May 2020.

agenda since 2005, where discussions are held about issues and possible international frameworks for the protection of the intellectual property.<sup>80</sup>

Concluding on the above, it must be considered crucial for the companies to have communications with their patent advisors protected against forcible disclosure. It must be expected that a company, given the choice, would choose a patent advisor with whom the communications are protected over a patent advisor with whom the communications are not. Protected patent advisors, therefore, have a competitive advantage on the open market.

Of the examined EU Member States above, it is clear that many have already taken steps towards the protection of the patent advisory and, thus, protection of the companies of the Member State. However, it was demonstrated how some of the Member States had introduced systems that to a greater or lesser extent are constructed to accommodate the foreign patent advisors providing services in the Member State. In some cases, this results in de facto differential treatment of domestic and foreign patent advisors concerning the protection of the counselling.

Case law shows that the Court does very little to search for indirect discrimination, but instead prefers to treat these issues as hindrances and thus restrictions.<sup>81</sup> Due to this and that this thesis aims to provide a general analysis of the issue and not in-depth analyses of each jurisdiction, moving forward this thesis will assume that the problematic national measures will be treated as restrictions, with the associated test and analysis.

### **3.7. Justifications**

Once the Court has established that a Member State's measure constitutes a prima facie restriction, it will continue to consider whether the measure can be justified. The Court has created a two-prong test. First, it examines what interest the measure seeks to pursue, followed by an assessment of whether the restrictive measure is justified.<sup>82</sup>

#### **3.7.1. The interest pursued**

The Court will initially consider whether the interests pursued by the measures are legitimate. It has allowed a wide range of different interests to be justifications for restrictive measures. These interests originate initially from the TFEU, which explicitly allow the Member States to enact the otherwise restrictive measure if they are done in the interest of public policy, public security, public health and the exercise of official authority.<sup>83</sup>

As patent advisors are considered crucial to a well-functioning patent system, as they provide legal assistance to clients, and as they even represent clients at government bodies and courts in some jurisdictions, one might consider justifying the restriction on the ground of official authority, as has

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<sup>80</sup> See eg draft agenda for the 32<sup>nd</sup> session of the SCP,

[https://www.wipo.int/edocs/mdocs/scp/en/scp\\_32/scp\\_32\\_1\\_prov.pdf](https://www.wipo.int/edocs/mdocs/scp/en/scp_32/scp_32_1_prov.pdf)

<sup>81</sup> Catherine Barnard, *The Substantive Law of the EU: The Four Freedoms* (6th edn.: Oxford University Press, 2019) at 301f.

<sup>82</sup> Hatzopoulos, *Regulating Services in the European Union* at 146.

<sup>83</sup> The former three grounds are provided for in article 52, while the latter is from article 51. All of these interests are also applicable to services, cf. article 62.

been tried for lawyers. This must, however, be rejected, as ‘exercise of official authority’ are interpreted very strictly and narrowly by the Court.<sup>84</sup> The Court has rejected restrictions on the profession of lawyers to be justified by these ground.<sup>85</sup> As lawyers perform a closer related activity to the official authority, it is reasonable to assume that the same will be the case for the activities of patent advisors.

In addition to the interests referred to in the TFEU, the Court has expanded the grounds for justification by its case law, provided that the justifications served a reasonable and legitimate purpose. This is considered a consequence of the extensive scope of measures that constitute restrictions. While most measures imposed by the national legislators can be considered to constitute a restriction to the free movement, it is necessary to allow Member States to take measures that pursue legitimate objectives.<sup>86</sup> These legitimate objectives have collectively been referred to as ‘overriding reasons of public interest’, or “ORPI” for short.

The list of ORPIs has been expanded progressively since the very early days of the EU, and now consists of a long list of different grounds for justifications. Some of these has been enumerated in article 4(8) of the Service Directive. This list is by no means exhaustive, as the reference to the Court’s case law suggests, and the list seems to merely exemplify some of the interests that the Member States legitimately can pursue.

Of specific interest to the topic of this thesis is the Court’s recognition of public interest value of professional regulation. The Court recognised already in the early case law that there is a need to allow some restrictive measures, as the nature of some services would justify the restrictions because of the importance and value of the services to the public interest. In *Van Binsbergen*, the Court stated:

“[T]aking into account the particular nature of the services to be provided, specific requirements imposed on the person providing the service cannot be considered incompatible with the treaty where they have as their purpose the application of professional rules justified by the general good - in particular rules relating to organization, qualifications, professional ethics, supervision and liability – [...]”<sup>87</sup>

It is therefore not unthinkable that the Member States will propose that their protection of patent advisors against forcible disclosure add value in the public interests and serve to protect consumers of the advisory services. The case law regarding other professions suggests that the Court probably will accept this as a legitimate interest pursued as the ground for justification. However, it will still depend on the test of proportionality whether the restrictive measures can be allowed.

### 3.7.2. Proportionality

As noted earlier, the Court has acknowledged a wide range of justifications to restrictive measures, and this is considered a consequence to the similarly broad concept of what constitutes a restriction. However, while the Court set forth a low threshold for what interests legitimately can be pursued, the

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<sup>84</sup> Case C-2/74 “*Reyners v Belgian State*” (1974), para. 45.

<sup>85</sup> See *ibid.*, para. 52-55.

<sup>86</sup> Vassilis Hatzopoulos, ‘Case C-250/95, *Futura Participations SA & Singer v. Administration des Contributions (Luxembourg)*, Judgment of 15 May 1997, [1997] ECR I-2471’, *Common Market Law Review*, 35/2 (1998), 493-518 at 500f.

<sup>87</sup> Case C-33/74 “*Van Binsbergen v Bedrijfsvereniging voor de Metaalnijverheid*” (1974), para. 12.

Court has not continued the same expansive path during the test of proportionality but has performed effective control during this final test. This is where the Court truly assesses and determines whether a restrictive measure is justified.

For the test of proportionality, the Court will most often use a two-step test.<sup>88</sup> First, it will examine if the measure is suitable to achieve the pursued interest. Secondly, it will assess whether the measure is necessary to achieve the goal.<sup>89</sup>

Suitability means that the measure in question must be suitable or appropriate to achieve the interest that the Member State seeks to pursue with the measure. It is a test of causality, and whether there is a connection between the measure and the goal.

The criterion of necessity is more complicated. The Court will assess the measure to ensure that it does “*not go beyond what is necessary to attain [the pursued interest]*.”<sup>90</sup> To conduct this assessment, the Court will consider the nature of the activity or service, the consequences of an eventual failure by the service provider, and the alternative means of protection available to state authorities.<sup>91</sup> The Court has often taken the liberty to conduct in-depth analysis of the measures and their necessity, and it is often at this step that the measures are deemed to be contrary to the free movement of services.

### **3.8. Remarks on the approach models in the context of the internal market**

Concluding on the above, it is deemed likely that the European Court of Justice will perceive the attribution of secrecy to some patent advisors and not others as a competitive advantage that constitutes a *prima facie* restriction or even discrimination. The Court’s test for restrictions and justifications will next be applied to the approach models described previously.

Germany has introduced legislation that allows foreign patent advisors to begin delivering patent advisory services in the jurisdiction quickly, and the legislation simultaneously provided for a secrecy obligation on the patent advisor and, thus, protection from forcible disclosure. In light of the above, this approach can hardly be challenged.

Denmark introduced that all patent advisors registered as European Patent Attorneys at the list maintained by the European Patent Office are to be granted protection from forcible disclosure. It can be argued that Danish patent advisors are more likely to obtain authorisation with the European Patent Office than eg their German colleagues, as this is the only public authorisation available to the Danish patent advisors. Therefore, it can be argued that the Danish patent advisors will more often enjoy protection by the Danish legislation than foreign patent advisors. However, the required authorisation for protection is granted by a common European authorisation system. As all patent advisors have

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<sup>88</sup> The Court has in some cases used a three-step test, where it, in addition to suitability and necessity, examines the principle of consistency and coherence. This approach seems to be abandoned in the recent case law of the Court in favour of the two-step test, cf. Gjermdund Mathisen, 'Consistency and coherence as conditions for justification of member state measures restricting free movement', *Common Market Law Review*, 47 (2010), 1021-48.

<sup>89</sup> As put forth by the Court in *Gebhard* in an attempt to create a formula applicable to all restrictive measures.

<sup>90</sup> Case C-55/94 *Gebhard*, para. 37.

<sup>91</sup> Hatzopoulos, *Regulating Services in the European Union* at 174.

the possibility to and an interest in becoming an authorised EPA, the Danish approach can hardly be challenged either.

Then is the Swedish system. Sweden decided to implement their own authorisation system, where only patent advisors authorised by the Swedish authority are granted a legal obligation to confidentiality and as a consequence also protection against forcible disclosure before the Swedish courts. While everyone, regardless of nationality, may apply to become authorised by the Swedish authority and thus be granted protection, this is a requirement that a majority of Swedish patent advisors fulfil, while only a small fraction of the patent advisors practising in other Members States fulfil this requirement.<sup>92</sup> This will render a Swedish company much more likely to choose a Swedish patent advisor over a foreign. As the regulation has no provisions to mitigate this difference and to allow foreign patent advisors protection, the system is therefore indirectly discriminatory by nature.

Should the Swedish system be challenged, it must be expected that the Swedish government will argue that their system is complying with EU law, as it seeks to protect public interests and to protect consumers of the advisory services, as has been argued in many similar cases of regulation of professions. The Court will likely accept this justification.

In the end, the issue will be settled on the matter of proportionality. According to the two-step test of proportionality, it must be acknowledged that the Swedish authorisation system is indeed able to achieve the goal pursued. Nevertheless, it must be expected that the Court will not accept that the system does not accommodate foreign patent advisors and therefore, discriminate them. The goal can be pursued and achieved while also accommodating the foreign patent advisors with relatively mild measures, eg what has been done in Germany. That Sweden has no such legislation and thus exercise indirect discrimination cannot be proportionate. It must be expected to be contrary to EU law and the free movement of services.

This result proposes the question: why has the Swedish system and other systems like it not been challenged yet?

The answer may lie in the fact that the only parties who can initiate enforcement procedures for breach of Union law are the European Commission and other Member States pursuant to article 258-259 TFEU. Patent litigation also does happen internally in the EU. But because of the civil law systems and that they have no equivalent to the discovery procedure, the patent advisor's professional secrecy obligation will most often suffice to satisfy the courts to exempt it from forcible disclosure. The secrecy obligation often derives from the patent advisor's home jurisdiction, and this will most often be recognised by the courts of the other EU Member States.

Furthermore, the patent advisory sector is not very mobile. Most often, a patent advisor will focus on one jurisdiction, be authorised and practise in that jurisdiction. Some guidance on the mobility of patent advisors can be found in the Regulated Professions Database maintained by the European

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<sup>92</sup> As of 21 May 2020, less than 10 out of 369 authorised patent advisors are seated outside of Sweden, cf. the overview by the Swedish Patent Authority "Patentombudsnämnden", at <https://patentombud.bolagsverket.se/patentombud-sok-web/>.

Commission.<sup>93</sup> According to this database, merely 341 declarations of patent advisors seeking to provide services in another Member State, which has the patent advisory profession regulated, have been given since 2009 – less than once a week in all of the EU.<sup>94</sup>

Presumably, due to these facts, other Member States have not yet felt that the patent advisory systems like the Swedish constitute a sufficient “threat” to the EU internal market that it would commence enforcement procedures.

Neither the Commission has yet commenced any enforcement procedures. This may be due to a variety of reasons. First of all, the Commission has to be aware of the issue. Usually, issues receive the Commission’s attention when a directive has to be implemented – yet these measures not based on a directive but instead on the Member States’ initiatives. Another way to receive attention is by a prejudicial question to the ECJ, but no such questions have yet been presented to the Court. Secondly, the Commission exercises full discretion as to when to take enforcement action. Due to the above reasons, even if the Commission is aware that there might be some problematic issues, there are perhaps more pressing matters that need the Commission’s attention and are more critical for the proper function of the EU internal market.

To summarise, the inner market constitutes a great framework to secure the free exchange of goods, services, people and more. The rules regulating this area are comprehensive. When applied to the approach models taken by Member States for protecting patent advisors against forcible disclosure, it is feasible that some approach models will be considered in conflict with the free movement of services in the internal market. However, the interest in commencing enforcement action against and rectifying these problematic approach models and systems is simply not strong enough to materialise into concrete action by the Commission or other Member States.

#### **4. Application of the American patent-agent privilege**

A few selected approach models chosen by EU Member States to grant protection against forcible disclosure have been described, and the measures taken have been considered in the context of the EU internal market. As seen, providing for protection to domestic patent advisors can prove to be a barrier to market access and thus a restriction, if not proper consideration to the features of the internal market and the freedoms are taken into account when building the systems in the Member States.

As the motivation to establish these systems for the protection of patent advisors can be traced back to be to provide protection for the American courts, an examination of the effect before these courts proves to be of interest.

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<sup>93</sup> While maintained by the Commission, the database relies on input from all of the Member States, why the data should be treated carefully and should perhaps be considered to be inadequate. It does, however, provide some guidance on the subject.

<sup>94</sup> As of 21 May 2020, cf. the “Patent agent” in the Regulated Professions Database by the European Commission.

#### 4.1. A patent-agent privilege in the United States

The US Supreme Court first recognised that some aspects of the work of patent advisors are legal in nature with the ruling in *Sperry v Florida* in 1963.<sup>95</sup> It thereby extended the attorney-client privilege to non-lawyer patent advisors. Then, the Supreme Court stated that registered patent advisors only were allowed to perform legal tasks insofar as they are “*reasonably necessary and incident to the preparation and prosecution of patent applications*”. These rather vague terms set the outer limits for what could be considered legal work for the patent advisor and limited the scope of the privilege.

What should be considered necessary and incident to the patent application has been a question ever since and subject to much litigation. More uncertainty arose as the many federal district courts failed to reach consensus on whether to refuse or to acknowledge to extend the attorney-client privilege to patent advisors registered with the United States Patent and Trademark Office (USPTO).<sup>96</sup> Because of the high cost associated with litigation in the US, the question of privilege was rarely appealed to higher courts, and thus, precedence was rarely created.

However, this changed in 2016 with the decision in *Queen’s University*.<sup>97</sup> The federal court of appeals (Federal Circuit) acknowledged a privilege for patent advisors and explicitly created a new standalone “patent-agent privilege”. At the same time, it determined that the privilege should only apply to those activities that are authorised by the US Congress for patent advisors to perform before the USPTO. The activities authorised by Congress are described as:

“Practice before the [USPTO] in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the [USPTO], drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the [USPTO] that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the [USPTO] regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Board of Patent Appeals and Interferences, or other proceeding[...].”<sup>98</sup>

Simultaneously, the court noted that the aforementioned provisions entail that activities that are not reasonably necessary and incident to the prosecution of patents before the USPTO falls outside the scope of the newly established privilege. The court exemplified by stating:

“For instance, communications with a patent agent who is offering an opinion on the validity of another party’s patent in contemplation of litigation or for the sale or purchase of a patent, or on infringement, are not ‘reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the [USPTO].’”<sup>99</sup>

According to the decision, the USPTO itself promulgated amendments to the patent litigation laws and explicitly codified the privilege.<sup>100</sup> The scope of the codified privilege is much like the one

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<sup>95</sup> See footnote 8.

<sup>96</sup> Megan M. La Belle, 'Privilege for Patent Agents', *Boston University Journal of Science and Technology Law*, 23/2 (2017), 350-78 at 357ff.

<sup>97</sup> *In re Queen's University at Kingston*, 820 F.3d 1287 (US Court of Appeals, Federal Circuit, 2016).

<sup>98</sup> The Code of Federal Regulation, Chapter 37 § 11.5(b)(1).

<sup>99</sup> *Queen's University*.

<sup>100</sup> The Code of Federal Regulation, Chapter 37 § 42.57.



granted in *Queen's University*. However, as the decision was a 2-1 panel result, the USPTO feared that the decision might be revisited later, and because it only addresses domestic US patent advisors and not foreign patent advisors, the USPTO decided there would be benefits of clarity to codify the privilege.<sup>101</sup> The provisions grant foreign patent advisors the same American privilege, including all limitations and exceptions.

As the privilege covers only some activities, the federal courts are generally careful to distinguish between communications which are related to that of the US Congress authorised practice, which should be privileged, and those communications which fall outside of that scope, when applying the patent-agent privilege.

While a standalone patent-agent privilege had now been established on the federal level, the individual states were yet to acknowledge the privilege. This happened for the first time in 2018 when the Texas Supreme Court reversed the decisions by the lower courts and acknowledged the privilege in its decision in *In re Silver*.<sup>102</sup> In doing so, Texas became the first state to acknowledge the patent-agent privilege. Following this, more states are expected to follow suit when they get the opportunity to decide on the matter.

#### **4.2. Application of the privilege to foreign patent advisors – a new era?**

As put forth in chapter 2.3, the American federal courts do extend a privilege to foreign professionals, both lawyers and patent advisors. The state of the law regarding foreign patent advisors is anything but settled.<sup>103</sup> When faced with the issue of recognition of protective measures against forcible disclosure, the district courts have used various approaches. This provides great uncertainty and might even lead to different outcomes in different districts. In some cases, the court has been inclined to use the “touching base”-approach,<sup>104</sup> while other courts “*have decided to forego the ‘touching base’ test*”.<sup>105</sup> However, the majority of case law indicates that the courts will use a “comity plus function”-approach.<sup>106</sup>

With this approach, the court will examine the function of the foreign patent advisor to determine whether it provides independent legal services or merely act as a “conduit” between a US lawyer and a foreign patent office. In addition, the court will examine the foreign law (based on the parties’ submissions) to determine whether the foreign patent advisor’s home jurisdiction grants equal protection to that of the American patent-agent privilege. This approach is what led to the amendments to the civil procedure codes of the various EU Member States as examined earlier, as the jurisdictions sought to provide protection equivalent to the American privilege in their national legislation to protect domestic companies.

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<sup>101</sup> United States Patent and Trademark Office, '37 CFR Part 42: Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board', *Federal Register*, 82/124 (2017), 51570-75 at 51572.

<sup>102</sup> *In re Silver*, 540 S.W.3d 530 (Supreme Court of Texas, 2018).

<sup>103</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: The United States of America', at 8.

<sup>104</sup> See eg *Knauf Insulation, LLC v. Johns Manville Corporation*, Signed 10/01/2019 (S.D.Ind., 2019)

<sup>105</sup> *Baxter International, Inc. v. Becton, Dickinson and Company*, signed 11/22/2019 (N.D.Ill., 2019) at 1.

<sup>106</sup> See eg *ibid.*, *Astra Aktiebolag v. Andrx Pharmaceuticals, Inc.*, 208 F.R.D. 92 (S.D.N.Y., 2002) & *In re Rivastigmine*.

The “comity plus function”-approach also led to some confusion as to how the federal courts will acknowledge privilege for communications between the foreign patent advisor and the foreign company when conducting litigation in the US. Some has argued that the courts should only recognise a privilege for patent advisors authorised to practice before the USPTO, as *Queen’s University* does not mention foreign patent advisors. In contrast, others argued that foreign patent advisors also should be granted privilege as a matter of comity.

It is now settled that the courts will acknowledge that communications with foreign patent advisors can be protected by privilege, even if the foreign patent advisors is not authorised by the USPTO.<sup>107</sup> The question is rather to what extent the privilege will apply.

The two main viewpoints are that the court either should acknowledge foreign patent advisors a narrow privilege equal to that of American authorised patent advisors or an expansive privilege equal to that of the foreign jurisdiction. Following the decision of *Queen’s University*, which established the existence of a patent-agent privilege, and the promulgation of the federal regulation codifying the patent-agent privilege, case law regarding what extent the foreign patent advisors should enjoy privilege has been ambiguous.

In favour of the narrow scope is the US International Trade Commission (“ITC”). It was faced with the issue in *Align v 3Shape: ITC Order no. 24*.<sup>108</sup> The case involved communications between a Danish patent advisor and a Danish company. The ITC deduced from various statements that the communications in question were related to an “*analysis of competitor patents and legal advice to [the Danish company’s] management ‘on them.’*” Referencing to the scope of the patent-agent privilege ascertained in *Queen’s University*, the ITC denied granting privilege to the communications, as those “*are precisely the types of communications that the Federal Circuit identified in Queen’s as being outside the patent agent privilege*”. As the ITC deemed the communications to be outside the scope set in *Queen’s University*, it did not at all consider whether there would be a broader privilege under Danish law – or if there exists a privilege at all – and merely deemed the foreign law irrelevant.

In another case between the same parties, *Align v 3Shape: ITC Order no. 12*,<sup>109</sup> the Danish company again tried to put forth the argument that the communications should be privileged, as the communication enjoy protection under Danish law. However, the ITC again denied this with reference to *Align v 3Shape: ITC Order no. 24* and to the scope of the American patent-agent privilege.<sup>110</sup> The Danish company appealed none of the ITC decisions for procedural and cost reasons. It would be subject to

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<sup>107</sup> This has been showcased in *Bristol Myers, In re Rivastigmine* and a vast number of other case law.

<sup>108</sup> *IN THE MATTER OF CERTAIN INTRAORAL SCANNERS AND RELATED HARDWARE AND SOFTWARE - ORDER NO. 24: ORDER GRANTING COMPLAINANT ALIGN TECHNOLOGY, INC.’S MOTION TO COMPEL PRODUCTION OF UNREDACTED COPY OF DOCUMENT*, USITC Inv. No. 337-TA-1090 (US International Trade Commission, 2018).

<sup>109</sup> *IN THE MATTER OF CERTAIN INTRAORAL SCANNERS AND RELATED HARDWARE AND SOFTWARE - ORDER NO. 12: DENYING RESPONDENTS 3SHAPE A/S, 3SHAPE TRIOS A/S, AND 3SHAPE INC.’S MOTION FOR A PROTECTIVE ORDER REGARDING PRIVILEGED DISCOVERY*, USITC Inv. No. 337-TA-1144 (US International Trade Commission, 2019).

<sup>110</sup> It should be noted that the decision makes it clear that the defendant performed sub-optimal and lacking conducting of legal proceedings for the ITC. To what extent “proper” conducting of the proceedings could influence the result is unknown.

sanctions if it kept withholding the documents, and it perceived the chances of winning the appeal to be very low in case the documents were put forth.<sup>111</sup>

It seems clear that the ITC – at least until a federal court determines otherwise – will not acknowledge expanding the scope of the patent-agent privilege for foreign patent advisors further than what is the case for domestic US patent advisors, as ascertained by *Queen's University*.

However, the little case law that has come from the federal district courts since *Queen's University* seems to suggest a different viewpoint. The district courts did not yet provide a clear and unambiguous answer to the question but did suggest some guidance in the following three cases.

The first is *Knauf Insulation*.<sup>112</sup> A European company had had communications with a patent advisor authorised in the UK. It claimed that communications with the patent advisor enjoy privilege as those same communications would be privileged according to UK law. The court first rejected the idea that privilege for patent advisors was limited to patent advisors authorised by the USPTO, and stated that foreign patent advisors might be granted privilege.

Afterwards, the court was faced with the issue of the scope of the privilege. One party argued that at least some of the communications would not be privileged according to the scope of the patent-agent privilege as ascertained in *Queen's University*, why those communications should not be privileged. In other words, if a US-authorized patent advisor provided the same communications, it would not be privileged – why the communications made by a UK-authorized patent advisor should not be privileged either.

However, the court did not agree. The court cited the Federal Circuit's reasoning for the decision in *Queen's University*:

“A client has a reasonable expectation that all communications relating to obtaining legal advice on patentability and legal services in preparing a patent application will be kept privileged. Whether those communications are directed to an attorney or his or her legally equivalent patent agent should be of no moment.”

Following this reasoning, the court found that communications with the UK-authorized patent advisor should enjoy privilege as it would in the UK. As the court noted: “[t]o hold otherwise would be contrary to the goal of protecting the client's reasonable expectation of privilege in its communications with its legal advisor.” Eventually, all communications with the UK patent advisor were deemed privileged, although this constitutes a significant expansion the scope of the privilege compared to the one ascertained by *Queen's University*.

Merely a month later, another district court delivered its decision in *Baxter Int.*<sup>113</sup> This case was between two American corporations, but the communications in question were made between a Swedish patent advisor and a Swedish subsidiary of the defendant American company.

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<sup>111</sup> Thomas Kirkbak, 'Presentation: Legal privilege for European Patent Agents converted to practice in US [*Legal privilege for European Patent Agents omsat til praksis i US*]', (2018).

<sup>112</sup> See footnote 104.

<sup>113</sup> See footnote 105.

The communications in question were either undated or pre-dated the amendments to the Swedish legislation.<sup>114</sup> The principal question for the court was therefore whether the Swedish amendments have retroactive effect, and consequently not whether the Swedish law does provide for a privilege-equivalent *per se*.

The specific focus on the retroactive effect of the Swedish law insinuates that this was fundamental for the decision – if yes, privilege will apply and if no, the privilege will not. This seems to be based on the assumption that the Swedish law does indeed grant protection that equals the American privilege. Thus, communications with the Swedish authorised patent advisors shall be privileged. This view is supported by the court’s reference to *Lincoln Electronic Company*,<sup>115</sup> in which the Swedish law indeed was found to grant privilege to the communications between a Swedish authorised patent advisor and a Swedish company.

While this decision does not explicitly cover the question of the scope of the privilege granted to foreign patent advisors, it does suggest that the courts will go to great lengths to acknowledge the right to privilege for foreign patent advisors as granted by their home jurisdiction based on the doctrine of comity.

Lastly is the recent decision of *Align*.<sup>116,117</sup> Marking the most recent development in the patent-agent privilege, this case is (yet) another dispute between the American company Align and the Danish company 3Shape. It concerns communications between the Danish company and a Danish patent advisor authorised as a European Patent Attorney. While the ITC set a narrow scope for the privilege during the ITC-proceedings, this district court took a whole other approach.

The court proposed a modified *Queen’s University*-test to be applied on the foreign patent advisors, as the court was persuaded that the Federal Circuit would apply that same specific test when faced with the same issue. The test was put forth as follows:

“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 ‘authorised 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 recognises a patent-agent privilege that is broader than or otherwise in conflict with that recognised by United States courts, and the foreign communications at issue fall within the scope of that privilege.”

After establishing the foundation for the test, the court started to examine both steps to determine if it would be applicable in the present case. For the first prong, the court will have to assess the authorisation system of a foreign jurisdiction. This will be based on the evidence about the foreign law provided by the parties. However, as the party who claims privilege has to prove it exists, it eventually

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<sup>114</sup> The legislation as described earlier in section 3.1.1.

<sup>115</sup> *Lincoln Electric Company v. Esab Group, Inc.*, signed 11/17/2016 (E.D. Tex., 2016).

<sup>116</sup> *ALIGN TECHNOLOGY, INC. v 3SHAPE A/S, 3Shape Trios A/S, and 3Shape, Inc.*, Signed 04/15/2020 (D. Del., 2020).

<sup>117</sup> The decision is a review of a preceding order under the “clearly erroneous or contrary to law” standard. I have been unable to retrieve the initial decision itself, referred to as ‘C.A. No. 16-1646 D.I. 337’.

led to the Danish company having to prove what Danish patent advisors are authorised to perform.<sup>118</sup> The court determined that the company failed to prove this. As was shown previously in chapter 3.1.2 about the Danish approach model, Denmark does not rely on any authorisation to perform the duties of patent advisor, why it is a matter of course that the Danish Company was unable to prove so.

The court then continued to the second prong of the test, where the Danish company should prove that Danish law grant “*a patent-agent privilege that is broader than [...] that recognised by United States courts*”. This should be plausible for the Danish company, as the Danish witness exemption rules cover everything the EPA has learned during its activities. However, both the initial order and the subsequent review determined that the Danish company failed to prove it. The company provided the court with declarations from a Danish IP litigator, but the exact content of the declaration has not been published. It seems to suggest that the American courts set a high threshold for certainty to establish that a foreign jurisdiction grants a broader privilege than the American. It is, however, a shame that the decision did not provide a positive outcome from the newly proposed test, to showcase a practical use of the second prong, to bring a bit more certainty to this very uncertain field of law.

It remains a question to what extent the court will recognise a privilege that is “*otherwise in conflict with that recognised by United States courts*”, as stated as the alternative to a “broader” scope of the privilege in the second prong of the test. While the federal courts have shown much effort to accommodate foreign law, it is well-established that it will not do so if it is contrary to the public policy of the forum. The application of this “second part” of the second prong can be argued to be a rather narrow fit in-between what is to be considered “in conflict” with the American privilege while not being so much in conflict that it is “contrary to public policy”.

The first prong of the test seems to have many similarities with the previous decisions from another district court, *Knauf Insulation*, and would most certainly have ended up with the same outcome. In its conclusion, the court found that communications “*that were made within the scope of [the UK authorised patent advisor’s] authority as a patent attorney in the UK*” were deemed privileged – a perfect match for the first prong of the *Align* test.

While it is certainly not incompatible with the *Align* test, *Baxter Int.* is a less obvious match. While evident from the circumstances of the case, the court did not have a chance to positively define what should set the scope for the privilege and thus whether it would apply a similar test or not.

It will indeed be interesting to follow this development in the future, as the courts have merely scraped the surface of this field of law. While it might last years before the issue reaches the Federal Circuit, it will indeed be interesting to see how it handles the issue – and if it adopts the proposed test in *Align* or perhaps follows the ITC and their much more restricted approach.

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<sup>118</sup> That the party who claims privilege bears the burden of proof is well established by case law, see eg *COMMISSARIAT À L'ENERGIE ATOMIQUE v SAMSUNG ELECTRONICS CO., et al.*, 245 F.R.D. 177 (D. Del., 2007).

### 4.3. Implications of the proposed test

*Knauf Insulation* is clear and *Align* at least proposes a test and a way forward, yet the status of the foreign patent-agent privilege is very uncertain. However, what implications do the conclusions above have for American patent advisors?

With the *Align* test, the courts have opened the door slightly for a broader patent-agent privilege for foreign patent advisors than for domestic American patent advisors. Whereas it is no major surprise in light of the doctrine of comity, and surely in line to meet the reasonable expectations of the client, as stated in *Knauf Insulation*, it is interesting what this means for how the American companies compete with foreign companies.

During patent litigation, a frequently used tool to reveal the competitor's bad will or knowledge of infringement is to present legal opinions made by patent advisors or communications with the same. These legal opinions are commonly produced for companies throughout the world by patent advisors, to help the companies determine whether a new invention will infringe a current patented invention or product. Just not in the US, as this leaves a "paper trail" that can be used against the company requesting the legal opinion. As an American lawyer once said: "We have a special expression for a negative legal opinion over here – it is called a phone call!"

As the courts now proposed that it is the foreign law that determines the scope of the privilege for foreign patent advisors – obviously still on the condition that the patent advisor is subject to privilege-equivalent rules in their home jurisdiction – American companies using American patent advisors are now protected by a more narrow and limited privilege than their foreign competitors, which may prove to be a competitive disadvantage.

Meanwhile, it can prove hard for the US to match this competitive advantage. The EU Member States are all predominantly civil law jurisdictions and thus mainly governed by statute, which can "easily" be amended, as has been seen during the last 20 years on this field of protection against forcible disclosure for patent advisors. Also, several other predominantly common law countries have enacted legislation to protect their patent advisors, eg the UK in 1968<sup>119</sup> and more recently, Canada in 2016.<sup>120</sup>

By contrast, the American patent-agent privilege did not emerge from legislation, but rather uniquely from case law, and derive from the attorney-client privilege, which is limited to legal advice. Thus, the patent-agent privilege is built upon the foundation that it is limited to legal advice too. One might consider if this will force the US to rethink their system – will the US stay true to their historical system of solely protecting legal advice, or perhaps consider expanding the privilege to match the protection granted by many other states.

While it was argued in section 3.8 that the interest in commencing enforcement procedures against an EU Member State for a problematic national measure in the context of the EU internal market was not significant enough to materialise into concrete action, to mitigate this competitive disadvantage

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<sup>119</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: The United Kingdom'.

<sup>120</sup> Wipo Standing Committee on the Law of Patents, 'Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors: Canada'.

for American companies against their foreign competitors may prove to be of sufficiently significant interest to the US. However, how this disadvantage may be mitigated is uncertain.

At this point, it is hard to imagine that the driving forces for this change will be the courts. The revolutionary creation of the patent-agent privilege by the decision of *Queen's University* is barely five years old, so to already think of yet another new revolution seems far-fetched. However, as *Queen's University* did create a new standalone patent-agent privilege that is no longer merely an expansion of the attorney-client privilege, the Federal Circuit did open up for this privilege to develop in a new yet unseen direction, and possibly even abandoning its legal privilege roots.

While this may be possible, it is hard to imagine that a district court will expand the scope of the privilege by itself. It might be years or more before such a case reaches the Federal Circuit again – and even longer before it reaches the Supreme Court.

Therefore, it seems more obvious that a sudden expansion will arrive through the legislators. It was seen that the USPTO enacted federal legislation to codify the patent-agent privilege of *Queen's University*. However, this was done *after* the decision, and they solely followed the path already set by the Federal Circuit. The US has no tradition of interfering with the management of privileges, and it is set out in the Federal Rules of Evidence rule 501 that the common law governs the matter of privilege. So, while it seems *more* obvious that sudden expansion of the scope will arrive from the legislators, it is still almost unthinkable at this point.

## 5. Conclusion

The thesis set out to examine the recent developments in the protective measures granted to non-lawyer patent advisors against forcible disclosure, with two main focuses. Firstly, the developments in the European Union Member States put in the context of the internal market and the free movement of services. Secondly, the effect of the recent case law by the American federal courts on the patent-agent privilege, and the recognition of foreign protective measures for non-lawyer patent advisors.

It is apparent that there are fundamental differences in the way litigation are conducted in the jurisdictions belonging to the common law and civil law families. The common law family is subject to a much more extensive fact-finding procedure than the civil law family, which creates different needs for corresponding protective measures in the two families. This difference became progressively more apparent with the increase in global trade. It has compelled many civil law jurisdictions to rethink and amend their civil procedure legislation to mitigate the competitive disadvantage that their domestic companies faced during the increasingly important matter of patent litigation, especially in a US forum.

The lack of harmonisation on the field has caused the EU Member States to use various means to provide protective measures to patent advisors. Three models of different approaches taken by different Member States has been described. As shown, the Member States tend to merely focus on domestic matters and, in that process, fail to sufficiently consider the provisions of the internal market.

The provisions of the internal market consist of an extensive set of legislation and case law. However, this thesis focused on the provisions relating to the free movement of services pursuant to article 56 of the TFEU and the related law. While slightly neglected during the early days of the EU, the laws regarding services now constitute a tremendous and comprehensive collection of primary law, a vast number of case law and secondary law. Through its case law, the ECJ has produced a test to assess if a national measure complies with the provisions of the free movement of services, construed of an assessment of the capability of the measure to be a restriction on the free movement followed by an assessment of the justification of the restrictive measure regarding the interest pursued and the proportionality.

As the test set out by the ECJ was applied to the three approach models, it was found that while the German and Danish system was unproblematic, this was not the case for the Swedish. It is argued that the Swedish system constitutes a *prima facie* restriction on the free movement of services and that the system hardly can be justified.

That conclusion proposed the question – why has the Swedish system not been challenged yet? Due to the immobility of the profession, and as only other Member States or the European Commission may initiate enforcement procedures against a Member State, and that the Commission may choose to pursue more pressing matters, it is found that the interest in challenging the system is simply not significant enough to materialise into concrete action.

It is argued that the motivation to implement the protective measures in the EU Member States is – to a varying extent – to protect domestic companies from patent litigation and the discovery procedure before the American federal courts. The thesis then sought to examine the patent-agent privilege developed by the federal courts and more importantly, how the courts apply the European protective measures and to what extent a privilege will be acknowledged.

The Federal Circuit has not yet had the chance to provide clarity, but the US International Trade Commission and several district courts have been faced with the issue. The question cannot be said to be settled. While the ITC has taken a restrictive approach when applying the privilege to foreign patent advisors, it is suggested that the district courts seem to agree on to what extent to apply the privilege. The sparse decisions since the introduction of the patent-agent privilege with *Queen's University* in 2016 have taken different approaches. However, they have eventually reached the same conclusion: communications with foreign patent advisors shall be granted privilege if a privilege-equivalent protective measure exists in the client's home jurisdiction.

More interestingly, the scope of the privilege shall be equal to that of the client's home jurisdiction if the court finds it proven that either the patent advisor is acting within the 'authorised practice of law' of the home jurisdiction or a privilege-equivalent measure in the home jurisdiction has a broader scope of protection than the American patent-agent privilege.

The result is based on the notion that clients have a reasonable expectation that communications with the patent advisor will remain privileged – no matter in what jurisdiction potential litigation might occur. Due to this, the courts argued that the privilege should apply as it would have been applied by the courts of the client's home jurisdiction.



That idea is well-founded on the doctrine of comity and is of great value to clients' legal certainty and rights. However, it also brings the implication that the foreign patent advisor may be granted broader protection than its American counterpart. The federal courts are generally careful to distinguish between communications which are legal and thus privileged and those which are not when applying the American patent-agent privilege. Nevertheless, in *Knauf Insulation*, after establishing that a UK privilege did exist, the court immediately applied the privilege to all the communications with the UK patent advisor – without any remark as to the nature of the communications.

This may eventually prove to be a competitive disadvantage for the American patent advisors against their foreign counterparts, and it is uncertain if that will have any consequences for the future development of the privilege or the recognition of foreign protective measures. It is argued that the courts are unlikely to adjust the scope of the privilege any time soon, and the legislators have traditionally been very hesitant to interfere with matters of privilege, why any expansion of the scope of the privilege is highly unlikely – to the detriment of the American patent advisor.

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