

EPC 2000 - Privilege

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Revised Convention on the Grant of European Patents
(European Patent Convention-EPC 2000)

ENTRY INTO FORCE: 13 December 2007

Little impact on daily patent practice but ...

Introduction of Attorney-Client Evidentiary Privilege

Article 134a-(1) *"The Administrative Council shall be competent to adopt and amend provisions governing:...*

(d) *...the obligation of **confidentiality** on the professional representative and the **privilege** from disclosure in proceedings before the European Patent Office in respect of **communications** between a **professional representative** and his client or any other person"*

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Rule 153 (1)

(1) *Where advice is sought from a **professional representative** in his capacity as such, all **communications** between the professional representative and his client or any other person, relating to that purpose and falling under Article 2 of the Regulation on discipline for Professional Representatives, are **permanently privileged** from disclosure in proceedings **before the European Patent office**, unless such privilege is expressly waived by client*

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

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

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EXPECTATIONS

Attorney-client evidentiary privilege under EPC 2000 **be recognized by:**
(1) National Law of individual European contracting states party to EPC2000;
(2) US courts, in case of litigation, particularly during **Discovery** process, involving a US patent which has a corresponding European patent

For the latter, reference to:

Bristol-Myers Squibb Company v. Rhône Poulenc Rorer, 188 F.R.D. 189 (SDNY 1999)

Lead counsel in ground-breaking decision following a 2-day evidentiary hearing finding there was no French privilege applicable to French in-house patent agents or French in-house attorneys.

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Suggested "rules" for written communications to client to be considered "privileged" under EPC2000

- (i) Refer to request made by Client
- (ii) Confidentiality-inform client on obligations and label Communication
- (iii) Mention Legal advice
- (iv) Single case dealt with *per* Communication
- (v) Refer to European patent (application) or EPC 2000
- (vi) Specify that act is performed as or on behalf of "European patent Attorney" or "Professional Representative"