

**WEBINAR SERIES
LIFECYCLE OF A SMART IDEA**

HOW PRIVILEGE CAN BE USED TO PROTECT YOUR INNOVATIONS AND PRODUCTS

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Gowling WLG's Global IP Group



LEGAL ADVICE PRIVILEGE PROTECTS

- Confidential communication
- Between lawyer and client
- Dominant purpose for the giving or receiving legal advice
- Need a lawyer and a client
- Privilege belongs to the client

LITIGATION PRIVILEGE PROTECTS

- Legal advice
- Confidential communications between client/lawyer and third party
- Dominant purpose will be litigation in progress or in reasonable contemplation
- Broader than just legal advice privilege

NO DISCOVERY IN FRANCE BUT

- Privilege applies
 1. To all communications between a client and his/her lawyer
 2. To all communications between lawyers
 3. Regardless of the form or medium of the document
 4. In all proceedings
- Privilege applies only to qualified lawyers
 - Qualified lawyer = member of the Bar
 - In-house counsel do not benefit from the privilege
 - Patent attorneys who fall within the category of professional advising on industrial property benefit from the privilege

DISCOVERY / DISCLOSURE IN CHINA?

- Some rules close to the concept of discovery
- Limited "privilege" between lawyer and client

CLIENT ↔ AGENT COMMUNICATIONS ARE PRIVILEGED IN CANADA IF

- they are confidential

and

- they relate to advice regarding the protection of an invention

CANADA RECOGNIZES FOREIGN AGENT PRIVILEGE IF:

- The foreign agent's communications are privileged in their home country

and

- The foreign agent's communications meet the Canadian agent privilege requirements

CANADA RECOGNIZES FOREIGN LAWYERS

- Canadian courts readily uphold claims of privilege involving foreign lawyers
- However, the communications at issue must *actually involve a lawyer*

LEGAL VS. BUSINESS ADVICE

- In Canada in-house lawyers and agents are treated the same as outside lawyers and agents
- However, in-house lawyers and agents need to be mindful of legal vs. business advice

CHINA

- In-house are considered common employees
- Foreign lawyer practicing under foreign laws in China enjoys limited privilege

ENSURING PRIVILEGE IN FRANCE

- Involve a lawyer (external counsel member of the Bar)
- Other option: NDA – must contain strong sanction in case of violation to actually protect

CHINA

- What happens in China might not just stop in China
- Proper email subject and restricted email recipients
- Get an international team involved to protect the privilege

TIPS FOR PROTECTING PRIVILEGED COMMUNICATIONS

- Mark communications as “PRIVILEGED”
- Communicate by phone or in person
- Avoid business advice-only communications
- Is it appropriate to add someone new to an email chain?
- Mark your email at the beginning: Do Not Forward
- Write with good news; call with bad news

TIPS FOR PROTECTING PRIVILEGED COMMUNICATIONS

- Training for employees
- Seek guidance for appropriate steps in advance
- Protect communications by signing an NDA
- Deliver confidential opinion in person or only involve persons enjoying privilege in sensitive communications

TAKE AWAYS

- Write with good news, call with bad news, and deliver confidential advice in person – not to a broad class of people
- Watch out for email chains that run out of control – set rules and give training about how to avoid that
- In-house lawyers do not enjoy the same status in civil Law countries, but even in Common law jurisdictions their internal advice is more vulnerable, so use outside counsel to establish a stronger privilege regime
- Watch out for the dominant purpose of communications – do not mix matter which you want to be privileged with general business advice
- China is special – what happens in China might not stop in China, and foreign lawyers enjoy very little protection there

THANK YOU FOR ATTENDING

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