



Confidentiality of communications between clients and their patent advisors

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Patent Attorney Privilege in India



Categories of Patent Professionals

- **‘Advocates’** under the Advocates Act, 1961
- **‘Patent Agents’** under the Indian Patents Act, 1970



Scope of Privilege

- **Section 126:**

Professional communications between an ‘Advocate’ and Client in the course of and for the purposes of professional employment protected by privilege.

- **Section 127:**

Privilege extended to clerks, interpreters and servants of Advocates.



Scope of Privilege

- **Section 128:**

Client may disclose such communications and may ask Advocate to disclose such communication or to appear as witness.

- **Section 129:**

Protects clients from being compelled to disclose communications between client and legal professional advisor.



Exceptions to Privilege

- Communication made in furtherance of any illegal purpose.
- Any fact after commencement of engagement with Advocate showing that some crime or fraud has been committed.



In-house Counsel not covered by Privilege

- In-house lawyers (employees) not entitled to be registered as 'Advocates' and accordingly communication with in-house lawyers not protected by privilege.



Patent Agents not covered by Privilege

- Patent Agents not included in Section 126 to 129 and therefore communication with patent agent not entitled to protection by Privilege.



Privilege for Patent Agents - Old Issue

- **69th Law Commission Report, May 1977:**

The functions of a patent agent are analogous to those of professional legal advisers. Further, given the rapid scientific progress in the country and the rising practical importance of patent agents, the law of evidence must provide a separate provision for extending the privilege to communication between client and patent agent.

- **185th Law Commission Report, March 2003:**

The report recommended that the privilege be extended to not only patent agents but also trade mark agents. The report recommended that separate provisions be provided regarding privilege to communications with 'patent agents' and 'trade mark agents'.



Patent Profession in Practice

- Many patent agents in India are also Advocates and therefore communications with such patent agents is protected by privilege.
- Most patent law firms are run by Advocates that employ patent agents. Accordingly, such patent agents are also covered by the umbrella of privilege.
- Only those patent agents that are not Advocates and not employed by Advocates, are excluded from the benefits of privilege.



Privilege Must Extend to Patent Agents

- Stated objective of the Indian National IPR Policy, 2016 to encourage innovation.
- Economic Advisory Committee Report to the Prime Minister, 2022, on why India needs to urgently invest in the Patent Ecosystem and the need to promote innovation.
- Encourage free and frank communication between inventors and patent agents.
- Make a more level playing field for independent patent agents that are not Advocates and not employed by Advocates.



Privilege Must Extend to Patent Agents

- Will have no adverse impact on assessment of patentability or the Indian patent system that is based on documents and information in the public domain and not documents and information that has not been disclosed to the public.
- Will result in more effective and efficient representation. Likely to result in sound legal advice as the advice will be based on complete information given by the client. This will not only promote the interest of the client but also the public in general. This is also likely to improve the quality of patents.



Thank you very much for your attention!

Questions?

