Scope of patent agent privilege provided by new section 16.1 considered by Court

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Background

In 2016, amendments were made to the *Patent Act* to provide privilege in respect of certain communications with patent agents[1]. Section 16.1 lists the necessary conditions for a communication to be privileged in the same way that a communication that is subject to solicitor-client privilege is, such that disclosure or testimony on the communication is not required. However, only recently was the Federal Court called upon to address the scope of this privilege. The issue was brought to the Court, and in particular to the Case Management Judge, by way of a motion in a proceeding pursuant to the *PM(NOC) Regulations*.[2]

Decision

The Court confirmed that patent agent privilege only applies if each of three conditions set out in section 16.1 of the *Patent Act* are met. The communication must be:

1. Between the patent agent and their client;
2. Intended to be confidential; and
3. Made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention.

The Court held that the legislation does not enable the Court to consider or apply any other analogous factors. In addition, patent agents and lawyers are not placed on equal footing with respect to the privilege that attaches to their client communications.

The Court's analysis focused on the third condition. Citing the definition of "protection", the Court held that if all communications between patent agents and clients were intended to be protected, Parliament would have used broader language.

The Court held that "communications "relating to the protection of an invention" as that phrase is used in section 16.1 does not extend to an analysis as to whether a product infringes third party patent rights." (para 18) A non-infringement opinion does not contribute to the patent bargain, nor does it advance the protection of an invention. The

Court refrained from commenting on whether patent agent privilege applies to an infringement opinion relating to the client's own patent.

The Court specifically held that if a patent agent opined that an innovation may be patentable in one country but not another, patent agent privilege would apply. Furthermore, if such a communication was relayed within the company (*e.g.* from the initial contact to the research group), it would remain privileged. Patent agent privilege would continue to attach if the communication was incorporated into another internal document. "The protective bubble of privilege would surround the communication, even if it was moved from one document to another or from one employee to another within the company." (para 21)

Patent agent privilege, like solicitor-client privilege belongs to the client. With solicitor-client privilege, the client is the company, not the individual with whom the patent agent communicated. Thus, solicitor-client privilege is not lost because communications are shared with superiors within an organization. The Court held it is difficult to accept that Parliament intended something different for patent agent privilege.

The Court held that when a document includes both privileged and non-privileged information, only those communications that meet the required terms for patent agent privilege could be redacted. (para 23) Furthermore, not all communications with a patent agent will be privileged. For example, communications relating to "patent strategies" are insufficient to meet the test for patent agent privilege. Those strategies must be related to protecting an invention. (para 23)

Key takeaway

This interpretation of s. 16.1 is in keeping with the context and content of the provision itself. Patent agents do have broad privilege attaching to their communications that relate to "protecting the invention". However, as in the period prior to the promulgation of s. 16.1, a patent agent should be careful to write non-infringement and validity opinions with a lawyer so that solicitor-client privilege applies.

[1] *Patent Act*, RSC 1985, c P-4, as am, s 16.1.

[2] *Janssen Inc v Sandoz Canada Inc*, 2021 FC 1265.

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