

AIPPI • JAPAN



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International Association for the Protection of Intellectual Property of Japan

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February 25, 2015

The United States Patent and  
Trademark Office

AIPPI Japan's Comments on Domestic and International Issues Related to  
Privileged Communications Between Patent Practitioners and Their Clients

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the “Domestic and International Issues Related to Privileged Communications Between Patent Practitioners and Their Clients”

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

Our comments are as follows.

In the 1980s and the 1990s, Japanese patent attorneys (Benrishi) were denied their privilege over documents prepared by themselves in many patent lawsuits in the United States, because a Japanese patent attorney was not qualified as an attorney at law and a patent attorney's secrecy obligations were not explicitly stipulated by the Japanese law at that time. After a revision of the Japanese Civil Procedure Code in 1999, several U.S. courts recognized that Japanese patent attorneys had become substantially equal to lawyers in secrecy obligations due to this revision. Today, there are established court precedents, according to which a Japanese patent attorney's privilege is recognized in the U.S. courts.

However, secrecy obligations imposed in Japan which is a civil-law country are fundamentally different from privilege granted under common law countries. For this reason, it is desirable that further provisions will be made toward unification of legal interpretations on this issue in the future.

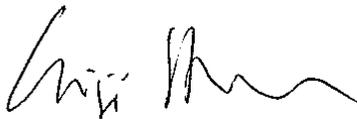
Based on the above, AIPPI JAPAN makes the following recommendations:

1. The U.S. courts should recognize privilege for U.S. patent agents and foreign patent practitioners by establishing a national standard for this purpose.
2. It is desirable that an international framework be formed as a minimum standard for privilege. The framework might be substantially the same as in Appendix 5 of the following document:

[https://www.aippi.org/download/onlinePublications/Attachment1SubmissiontoWIPODecember182013\\_SCP.pdf](https://www.aippi.org/download/onlinePublications/Attachment1SubmissiontoWIPODecember182013_SCP.pdf).

Again, we are grateful to have an opportunity to offer the above comments this time.

very truly yours,



Eiji Katayama  
President  
The Japanese Group of AIPPI