

Privilege for Patent and Trademark Agents now in effect for Canada

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Effective June 24, 2016, amendments to the *Patent Act* and *Trade-marks Act* came into effect providing protection for confidential communications between clients and their patent agents and trademark agents made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention or trademark, respectively (the implementing legislation can be found [here](#)). With the amendments, these communications with agents (whether or not they are also lawyers) are intended to be protected from disclosure in court and administrative proceedings by a statutory privilege akin to solicitor-client privilege or, in civil law, to the professional secrecy of advocates and notaries.

Specifically, the *Patent Act* amendments provide that a statutory privilege may apply to a communication that is: (a) between an individual whose name is entered on the register of patent agents and that individual's client; (b) intended to be confidential; and (c) made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention. Similarly, the *Trade-marks Act* amendments provide that a statutory privilege may apply to a communication that is: (a) between an individual whose name is included on the list of trademark agents and that individual's client; (b) intended to be confidential; and (c) made for the purpose of seeking or giving advice with respect to any matter relating to the protection of a trade-mark, geographical indication or certain other section 9(1) prohibited marks.

These amendments should provide certainty surrounding communications between clients, patent agents and trademark agents and will bring Canada in line with the approach taken to such communications in other common law countries that recognize privilege. Moreover, the amendments allow for communications protected as privileged by recognized patent agents and trademark agents in other jurisdictions to be deemed to be privileged in Canada where: (a) the communications are privileged under the law of the foreign jurisdiction; and (b) the communications, if they had been made by a Canadian agent, would otherwise have satisfied the three requirements for Canadian statutory privilege.

Finally, these amendments have retroactive effect, applying to communications made before June 24, 2016, so long as the communications, in fact, remained confidential as of June 24, 2016. The amendments do not, however, apply to court or administrative proceedings commenced before June 24, 2016.