

Privilege for patent and trademark agents now in force in Canada

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By virtue of amendments to the Canadian *Patent Act* and *Trademarks Act* introduced in Bill C-59 (*An Act to implement certain provisions of the budget tabled in Parliament on April 21, 2015 and other measures*), which received royal assent on June 23, 2015, statutory privilege between Canadian patent and trademark agents and their clients comes into force as of June 24, 2016.

Specifically, Bill C-59 has added section 16.1 to the *Patent Act* and section 51.13 to the *Trademarks Act*, which provide that a communication is privileged in the same way as a communication that is subject to solicitor-client privilege, and that no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding, provided that the communication meets certain conditions. These conditions require the communication to be:

(a) between a person who is a registered patent agent/trademark agent and that person'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, or a trademark, official mark or geographical indication protectable under the *Trademarks Act*, respectively.

The statutory privilege is subject to those exceptions that apply to solicitor-client privilege, and privilege can be expressly or implicitly waived by the client.

Further, the statutory privilege extends to communications with patent/trademark agents working in other countries that provide privilege, provided that the communications meet the above-noted criteria.

Privilege will apply retroactively to communications made prior to the date the legislation comes into force, provided that such communications have remained confidential; however, privilege will not apply in respect of an action or proceeding commenced before this date.

This new statutory privilege represents a significant improvement to Canada's intellectual property regime, as it provides clients who use patent and trademark agents with more secure protection of their confidential communications, bringing Canada in line with other jurisdictions where such privilege is already enjoyed.