

## **Introduction**

The background of this case is in patent law however the case has a wider application for practitioners in intellectual property. It relates to circumstances where practitioners provide evidence in litigation matters for their clients.

The patent holder (Servier), sought by motion to amend its patent pursuant to s 105 of the *Patents Act 1990* (Cth). The only evidence in support was provided by the solicitor conducting the matter. In his evidence he stated that he had acquired the knowledge to make the affidavit from his involvement in the proceedings and some records obtained from the patent records of his client.

It was argued that this reliance on the solicitor's recommendations for the application opened the door to further documents ordinarily within the claim for privileged communications.

## **Issue**

The issue came to a head when Apotex Pty Ltd (Apotex), whom Servier alleged had infringed the patent, served a notice to produce on Servier seeking certain documents recording or referring to the lawyer's views as expressed in his evidence in support of the application as well as the instructions from Servier. The basis for this request was that the supporting evidence referred to the identification by the solicitor of a gap in the patent's claims, that being the subject matter of the application to amend. An example from his evidence was as follows:

*Following the receipt of instructions and between December 2006 and early February 2007, I reviewed the Alpha Crystalline Patent and formed the view that the specifications disclosed matter which could be the basis of additional claims: [4].*

Apotex contended that Servier had by its reliance on this evidence as the basis of it seeking the amendment, waived its privilege over the documents it now sought to claim.

## **Decision**

Servier was required to produce certain documents which provided the background for the amendments sought, which would otherwise have been privileged.

## **Reasons**

Before considering a number of other cases as examples, Bennett J stated the common law principle that a person who was entitled to claim legal professional privilege could waive that privilege. Waiver could be express or

implied and was a matter for objective consideration regardless of the intention of the party who has lost the privilege (*Mann v Carnell* (1999) 201 CLR 1 at [29]).

Of telling relevance was an examination of whether there was an inconsistency between the conduct of the client and maintenance of the confidentiality of the relevant communications (*Mann v Carnell* at [28]).

Its application to the case was that her Honour considered that it was inconsistent for Servier to claim legal professional privilege with respect to the communications between Servier and their solicitor concerning the solicitor's opinion, their instructions, the application for amendment and Servier's reasons for making it, having disclosed the legal advice they were given by presenting that advice as the totality of its reasons for seeking amendment: [19].

Her Honour noted that Section 118 of the *Evidence Act 1995* (Cth) ('the *Evidence Act*') established privilege in relation to the provision of legal advice to a client. Section 122 of the *Evidence Act* set out the circumstances in which this client legal privilege may be lost.

Bennett J observed that the *Evidence Act* applied to the adducing of evidence in proceedings to which the *Evidence Act* was applicable. It did not however apply to pre-trial processes such as discovery or to the production of documents prior to the adducing of evidence (*Mann; Esso Australia Resources Limited v Commissioner of Taxation of the Commonwealth of Australia* (1999) 201 CLR 49).

As the documents sought in the notice to produce were for the purpose of inspection and not for being immediately adduced in evidence, the *Evidence Act* had no application to the production of documents pursuant to the notice to produce: [27]

Her Honour noted that there was some uncertainty as to whether Order 33 rule 11 of the *Federal Court Rules* introduced the *Evidence Act* into pre-trial processes of the Court. Bennett J referred to the full court decision in *Seven Network Ltd v News Ltd* (2005) 144 FCR 379 at [17], where court held that O 33 r 11 of the Federal Court Rules did not so operate, concluding that the rule was limited to cases where the order to produce would result in immediately admissible evidence: '*circumstances in which an order is made for production of a document or thing to the Court ... at a time when the Court ... is authorised to receive evidence. That is, in circumstances in which the order to produce the document or thing is made to facilitate its being immediately adduced in evidence*'.

*Apotex Pty Ltd (ACN 096 916 148) v Les Laboratoires Servier* [2008] FCA 1466  
(Bennett J, 30 September 2008)