Contents

This presentation shows the recognitions of Attorney-client privilege (ACP) by U.S. federal courts, based on the Japanese new code and the Japanese old code*.

1. Japanese new code

2. Japanese old code

1. Recognition based on the new code.

1. **Japanese new code**

2. Japanese old code

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In 1998, Japanese civil procedure code was amended to introduce articles 197 and 220 that provide the **statutory privileges** to the Japanese patent attorneys, with retrospective effects.

The ACP of Japanese patent attorney was recognized in VLT case based on the new code, and followed by a number of decisions* including Eisai Ltd. v. Dr. Reddy’s Lab. (S.D.N.Y. 2005).

2. Recognition based on the old code.

1. Japanese new code

2. Japanese old code


2-1. Recognition based on the old code.

Nintendo relied on the old Article 281 of the Japanese Code of Civil Procedure for arguing the existence of the patent agent-client privilege (ACP) to shield the documents held by the patent agent's client.

However, there were "gaps" between “the ACP to shield the documents held by the patent agent's client" and “the right of the patent agent to refuse to testify” stipulated in the old Article 281.
2-2. Recognition based on the old code.

Article 281 of the Japanese Code of Civil Procedure
A witness may **refuse to testify**: (1) ... ; or (2) In cases where the witness is questioned as to the knowledge of facts which, he, being or having been, a doctor, dentist, pharmacist, mid-wife, **attorney**, **patent agent**, advocate, notary or an occupant of a post connected with religion or worship, has obtained in the exercise of professional duties and which facts should remain secret; or

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2-3. Recognition based on the old code.

- Nintendo had failed to offer any Japanese decisions that had filled Article 281’s "gaps".
- Nintendo's Japanese counsel, in their opinion letter to Magistrate Judge Lee, conceded that no court decisions in Japan, "directly address the application of Article 281, to a fact pattern similar to the present one."
- After all Nintendo could not prove the ACP of Japanese patent attorney.
2-4. Recognition based on the old code.  

- Analysis of the Japanese old code
  
  “Attorney-Client Privilege in the U.S. and Its Applicability to Japanese Attorneys at law and Patent Attorneys” by Akihiko Hara¹, Yasunobu Sato¹
  

  The authors studied the adequacy of findings of Japanese law based on the Japanese old code in Alpex case and Santrade case. In Santrade case, the similar analysis on Japanese old code was made in the court.

¹: Attorney at law, admitted practice in Japan and the U.S.
²: Santrade, Ltd. v. General Electric Co., 150 F.R.D. 539 (E.D.N.C)

2-5. Recognition based on the old code.  

- As the Nintendo’s Japanese counsel conceded, there was no court decision in Japan, "directly address the application of Article 281, to a fact pattern similar to the present one."

- However, the application by analogy of article 281 (Right to refuse to testify) to article 312 (Obligation to produce documents) was mentioned in a number of cases as “obiter dicta”, for doctors stipulated in Article 281 (2) and civil officers stipulated in Article 281 (1).
2-6. Recognition based on the old code.  

- The authors found that these decisions for doctors and civil officers could have worked to fill “the gaps” in Alpex case even before the amendment of Japanese code.

Article 281 of the Japanese Code of Civil Procedure
A witness may refuse to testify:
(1) civil officers...; or
(2) In cases where the witness is questioned as to the knowledge of facts which, he, being or having been, a doctor, dentist, pharmacist, mid-wife, attorney, patent agent, advocate, notary or an occupant of a post connected with religion or worship, has obtained in the exercise of professional duties and which facts should remain secret; or

2-7. Recognition based on the old code.  

- The author also pointed out that Japanese attorney at law could be in the same position as Japanese patent attorney regarding the ACP, so long as the privilege is recognized based on the article 312 (Obligation to produce documents).

- It is common belief that documents reflecting communications with Japanese attorneys at law and Japanese patent attorneys in Japan are not subject to production under Article 312, according to this article.

- The authors assumed that no direct case involving the attorneys had been found because nobody had even thought of challenging the privilege.
3. Recognition based on the old code.

1. Japanese new code

2. Japanese old code


3-1. Recognition based on the old code.

- In this case, the privileges of Korean Lawyers were recognized. The court studied Korean law, considering the Japanese old code analyzed in Alpex case and the Japanese new code analyzed in VLT case.

- The court pointed out “if no privilege is provided for by the statutes of the foreign forum, no privilege can be implied (Alpex, 1992)” and “Korean civil code Article 286 is nearly identical to Japanese civil code Article 281”.
3-2. Recognition based on the old code.

Korean Article 286 (Right to Refuse to Testify)
(1) A witness may refuse to testify in the following cases:
   Where a lawyer, patent attorney, notary public, ... or a person who was in such profession is questioned on secret matters which came to his knowledge in the course of performing his professional duties; and

Japanese Article 281
A witness may refuse to testify:
(1) ... ; or
(2) In cases where the witness is questioned as to the knowledge of facts which, he, being or having been, a doctor, dentist, pharmacist, mid-wife, attorney, patent agent, ... ; or

3-3. Recognition based on the old code.

- However, Astra had demonstrated that the documents would not be subject to production in a Korean civil lawsuit described by Article 316 of the Korean Code of Civil Procedure.

- Korean Article 316 (Obligation to Produce Documents)
The holder of a document shall not refuse to produce it in the following cases:
1) When the party himself possesses the document which he has cited in the lawsuit;
2) When the applicant is entitled to request the holder of the document to deliver it or to make it available for inspection; and
3) When the document has been prepared for the benefit of the applicant, or prepared with regard to a legal relation between the applicant and the holder thereof.
3-3. Recognition based on the old code.

The court also considered followings.

1. The same statutory limitations of the discovery existed under *Japanese law as considered by the court in Alpex* prior to January 1, 1998, and documents held by parties in litigation were not generally subject to mandatory production under Article 312 of the Japanese old code.

2. In 1998, the Japanese Code was amended to allow for liberal discovery similar to the practices in the United States. Even under those new discovery rules, documents reflecting communications with patent attorneys and patent agents in Japan are not subject to production.

3-4. Recognition based on the old code.

- However, Andrx pointed out that this court should not apply the Korean law of discovery, since law regarding document disclosure is *procedural*. 
- Courts should use choice-of-law rules to determine whether to *apply another forum’s substantive law* but *always use their own procedural rules*.
- The court agreed with Andrx that discovery of the Korean documents is governed by the US Federal Rules of Civil Procedure.
3-5. Recognition based on the old code.

- However, the court disagree that the absence of Korean attorney-client privilege and work product provisions requires this court to order the wholesale production of all of the Korean documents in their entirety because it would violate principles of comity and would offend the public policy of this forum.

- Therefore, the court applied US privilege law* to the Korean documents, even though the communications do not "touch base" with the United States, and the ACP was recognized.


4. Conclusion

<table>
<thead>
<tr>
<th>Argument for ACP</th>
<th>Yes (e.g. JP, UK, and other JP-new-code nations)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Statutory privilege</td>
<td>No</td>
</tr>
<tr>
<td>Foreign Case law</td>
<td>Yes (e.g. JP-old-code nations)</td>
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<tr>
<td>Limited discover</td>
<td>Yes (e.g. JP-old-code nations)</td>
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<td>?</td>
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Astra case (U.S. Law*)

Golden trade case (Foreign Law)*2

Thank you for your attention!