Australia: Limited Privilege for Communications with Registered Trademark Attorneys

By Maritza C. Schaeffer

***Titan Enterprises (QLD) Pty Ltd v. Cross,* Federal Court of Australia(Case No. [2016] FCA 1241, October 19, 2016)**

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Section 229 of the Australian Trademarks Act 1995 ("Section 229") defines the scope of privileged protection for communications with registered trademark attorneys. A recent decision before the Federal Court of Australia highlights the limits of such privilege, where the registered trademark attorneys sought to withhold as "privileged" documents that went beyond advisory services relating to an underlying dispute.

Section 229 provides, *inter alia*, protection for a communication, record or document "made for the dominant purpose of a registered trademarks attorney providing intellectual property advice to a client," and protects such communications to the same extent as if the communications had consisted of a lawyer providing legal advice to a client. "Intellectual property advice" under the statute includes patents, trademarks, designs, plant breeder's rights, and related matters. The burden falls on the person asserting the privilege to prove that it is applicable under the circumstances, and the issue

hinges on the *purpose* for which the communication in question was made. Under Section 229, not only must the communications be made in connection with giving or obtaining legal advice or the provision of legal services, they must also constitute "intellectual property advice." As such, the scope of the privilege afforded to trademark attorneys is more limited than that provided to communications between lawyers and clients.

The underlying dispute involved a website operated by the defendant, Mr. Dale Cross—"Beware the Titan Garages"—which Titan Enterprises (QLD) Pty Ltd ("Titan") alleged infringed its trademark and copyright, and constituted illegal deceptive conducts under governing law. The question before the court here was whether certain documents produced pursuant to a subpoena should be granted privilege, thereby precluding Titan from examining them. The subpoena was directed to "the proper officer of a firm of trademarks attorneys" that had represented Mr. Cross, and sought information relating to a domain-name dispute between the parties before the WIPO Arbitration and Mediation Centre. In response to the subpoena, Davies produced redacted versions of the responsive documents, but Titan objected on the basis that it wanted to view the full contents of the documents.

Mr. Cross' trademark attorneys objected to disclosing unredacted versions of the documents, claiming that they were subject to privilege under Section 229 of the Trademarks Act 1995, as they acted "at least nominally" as counsel for Mr. Cross in the domain-name dispute (it is worth noting that with respect to the current dispute concerning the documents, Mr. Cross failed to appear at the hearing and did not respond to attempts from his trademark attorneys to obtain instructions with respect to the privilege claim).

The Court ultimately granted Titan leave to inspect the unredacted documents after holding that certain legal services by a registered trademark attorney do not fall under the protection of Section 229. Specifically, the drafting of a statutory declaration or submission by a registered trademark attorney for use in an arbitral proceeding is not protected (while *advice* relating to such declarations may be protected as privileged communication). Moreover, the privilege does not extend to the communications or documents generated in the course of a registered trademark attorney providing services in connection with court proceedings, but rather just in the advisory context where the attorney is providing "intellectual property advice" as defined by the statute. This is so because "[a]ttorneys do not have the same rights as lawyers do to initiate proceedings and represent parties in court," as noted by the Parliament when explaining the drafting of the statute.

Primary Contacts

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