

Use of Counsel's opinions - copyright and confidentiality



The Law Society

DISCLAIMER

This publication has been created solely to assist solicitors in furthering their understanding of the key issues and to offer guidance on how best to store counsel's opinions. It is not intended to replace the need to consider any legal implications relating to the use of counsel's opinions. All persons who use this publication do so entirely at their own risk. The Law Society accepts no responsibility whatsoever for loss or damage arising from use of this publication by any person. The Law Society does not warrant that the information contained herein is complete or accurate.

Frequently Asked Questions

Solicitors enjoy a close, collaborative relationship with barristers in delivering legal services to their mutual clients. Part of this professional service includes requests from solicitors for opinions. Many of these opinions support the transactional work of solicitors and their clients, others may be connected to litigation which is contemplated or underway. Opinions are an essential tool in providing the best legal advice to solicitors' and counsel's mutual lay clients.

These frequently asked questions aim to assist solicitors in furthering their understanding of the key issues and offer practice information on how best to use and store counsel's opinions.

Solicitors should consider the following key points:-

- Copyright in the opinions/advice
- Confidentiality
- The implied undertaking relating to disclosure of documents in litigation
- Liability for negligence to a person other than the original client

Q1: What is copyright?

A: Copyright is an intellectual property right.

Copyright protects original literary, dramatic, musical and artistic works, amongst others. Literary works include written documents such as counsel's opinions. Drawings and graphs are protected as artistic works.

Copyright protects the expression of any idea or fact, not the idea or fact itself.

Copyright lasts for the life of the author plus 70 years. The first owner of a copyright work is its author, unless the author is an employee when the first owner will be the employer.

Generally, copyright in works created by a partner will be an asset of the partnership.

To be capable of copyright protection there are no registration requirements in the UK. The symbol that you often see, (©), acts as no more than a reminder that there is copyright in the work. There are also underlying rights called "moral rights" which allow the author an opportunity to object to derogatory treatment of his/her work and to prevent its false attribution to another person.

Copyright applies to 'original' works, meaning that they must not have been copied from elsewhere. It does not only protect works which are 'creatively' original. The threshold is low.

Infringement

Even if things are easy to copy, for example if they appear on the internet, they are still protected by copyright. This applies to counsel's opinions.

Copyright is infringed by, for example, copying the whole or a substantial part of the work, which includes storing it on a computer, without consent. Scanning and downloading from the internet are acts of copying. The test is qualitative i.e. there may be an infringement even if only a small part of the advice is copied, if that is the critical part. It can also be an infringement to copy a work, even if the exact words are not repeated.

Subject to limited exemptions¹, it is an infringement of copyright to copy a copyright work unless you are the owner, or have permission from the owner. However, it is not an infringement to express the ideas and thoughts behind the opinion using substantially different language. It is not an infringement to read the original opinion, nor to use it as a memory aid. Where permission to copy is needed, sometimes permission will be implied. At other times you may need to ask for express permission (see Q4 below).

¹ Copyright Designs and Patents Act 1988 (the "CDPA") as amended.

Q2: My client has paid for the opinion. Does this mean he or she owns the copyright?

A: No. Your client (and counsel's lay-client) does not own the copyright in the opinion.

The barrister who wrote it owns the copyright. If it was written by more than one counsel then they will be joint authors.

An opinion may also be given in a conference or consultation with counsel. A solicitor would often take a full note during this time. The copyright in that note does not belong to counsel but rather belongs to the firm, unless the note is close to a verbatim report of what counsel said.

The client has the right to use the opinion for the purpose for which the opinion was sought. Use for the purposes of judicial proceedings² is also allowed.

Solicitors should not copy or publish an opinion in which counsel owns copyright, or substantial parts of it, unless they have obtained permission to do so from the barrister first. To establish what constitutes "publishing", consider sections 18 and 20 of the Copyright Designs and Patents Act 1988 (CDPA) as amended.

As to confidentiality issues see Q4, as to storage issues see Q5 below.

Q3: What rights do clients have in opinions if they don't own the copyright?

A: The client will be entitled to use the opinion themselves, and to take copies as necessary for the purposes for which it was obtained, but no more. This right takes the form of a licence from the copyright owner, i.e. the barrister or your firm, to the client. Even if not in writing, that licence will be implied.

The scope of the client's licence will rarely prevent you storing the opinion in your know-how system. This will, however, depend on the circumstances of the case. If in doubt, the client should be specifically informed.

² As defined in the CDPA.

Q4: Will I breach my client's confidentiality if I store an opinion on the know-how system?

A: No. It is, however, important to understand what your general duty of confidentiality to the client is and then to ensure you follow your internal procedures to secure that confidentiality.

The duty of confidentiality is fundamental to the solicitor/client relationship.

“A solicitor is under a duty to keep confidential to his or her firm the affairs of clients and to ensure that staff do the same”.

(See 16.01 Guide to the Professional Conduct of Solicitors 1999, 8th Edition)

Strict standards are required to ensure that all documents stored electronically are secure. Most firms have a confidentiality policy which is stand alone or set out in a staff handbook.

Storing an opinion in compliance with these standards will ensure that confidentiality is maintained. If an opinion is particularly sensitive, such as containing information relating to a proposed takeover or relating to a public figure, then it may be necessary to exercise additional security and withhold such opinions from a know-how system. Where the firm recognises the potential for conflict in a particular matter and has erected information barriers to avoid this, then it may not be appropriate to store opinions if that would risk breaching the information barrier.

Assuming you store opinions in a know-how system which is only accessible by staff of the firm and subject to the caveat of sensitive information, conflicts and information barriers, you will lessen the risk of any leak of the opinion leading to a breach of client confidentiality.

Q5: I have obtained an opinion on behalf of a client and now wish to store it in our know-how system. Can I?

A: As a solicitor, you will often obtain counsel's opinion on behalf of your client, and not for your firm. The usual implied licence to copy the opinion is limited to copying to provide the original client with advice, though this can be widened by consent.

Barristers give an opinion specifically geared towards a particular set of facts. Barristers are concerned that if the opinion is stored and re-used, advice contained in the opinion may be wrongly interpreted to a different set of facts or may be out-of-date.

Storing the original opinion as a hard copy, and reading it, does not infringe copyright. Nor does reproducing the thoughts and views of counsel, provided substantially different words are used. However, taking a copy for storage, whether electronically or otherwise, without counsel's express or implied consent, could infringe copyright.

Solicitors who attend a conference and make their own note of the conference normally then possess the copyright in the note, which naturally may be re-used for the benefit of their clients (subject to Q2 and Q4 above).

Q6: How can I ensure I have counsel's consent?

A: The following words may be included in the instructions to counsel.

"We intend to store this opinion in our internal know-how system. We will acknowledge you as the author and will ensure that the system is secure, that confidentiality is maintained and that we comply with any data protection regulations and the implied undertaking on disclosure. Please let us know prior to accepting these instructions if you do not consent to this."

Q7: I intend to store the opinion in the know-how system. What steps should I take?

A: Copies of both the opinion and solicitors' own notes *should* be capable of appearing on internal know-how systems if the following procedures are complied with:

- (1) Inform the client before you instruct counsel that you intend to store a copy of the opinion in your know-how system. The intention to store could be referred to in the firm's terms of engagement. The client will not need to be informed in every case if it knows from previous experience that your firm stores opinions for know-how purposes.
- (2) If the know-how system is for the firm's use only and is secure, it is acceptable for names and other identifying features to remain (unless the client has indicated that they consent to storage only on condition that the document is 'cleaned'). It follows that counsel will be able to provide the opinion in a format to be stored electronically without having concerns about confidentiality issues.

- (3) On instructing counsel, it is good practice to advise counsel of plans to store the opinion (see Q6 above) on the know-how system.
 - (4) Data protection compliance procedures should be adhered to where an opinion identifies a data subject.³
 - (5) Before advising counsel of plans to store the opinion (see Q4 and Q5 and paragraph (2) above) and before publishing internally, you should consider whether the opinion contains sensitive information and whether an information barrier is in place. If either of those applies, it is likely to be undesirable to store the opinion in any know-how system. (See Q4 on confidentiality).
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Q8: What are the rules relating to use of disclosed documents in the context of litigation?

A: The Civil Procedure Rules relate specifically to documents disclosed by any party to litigation.⁴

The Rule states that a party to whom a document has been disclosed may only use it for the purposes of the proceedings in which it is disclosed.

There are three exceptions:

- (a) where the document has been read to or by the court, or referred to, at a hearing in public;
- (b) the court gives permission; or
- (c) the party who disclosed the document and the person it belongs to, agree.

Note that even if (a) applies, the court can make an order restricting or prohibiting use of the documents. In arbitrations, there are implied undertakings not to use documents except for the arbitration. The position relating to criminal proceedings is unclear. However CPR Rule 31.22.1 has useful guidance on this issue.

³ For more detailed guidance go to www.dataprotection.gov.uk.

⁴ See CPR Rule 31.22 (See also 31.22.1).



Q9: My client is involved in litigation. Do the rules on use of disclosed documents mean I cannot store opinions?

A: As set out above in Q8, the Civil Procedure Rules mean that generally a document may not be used for any purpose other than those of the proceedings in which it is disclosed.

Any document protected by the Rules and attached to counsel's opinion should not be stored on a know-how system unless consent has been obtained or the undertaking has lapsed.

Any reference to such a document in counsel's opinion should be carefully considered before the document is stored, and, if appropriate, deleted.

Q10: If I re-use the opinion, will counsel be liable in negligence if it is wrong?

A: No. Counsel does not owe a duty of care to a third party.

This is not a reason to prevent the storing of opinions.

Solicitors' attention is also drawn to the guidance that the Bar Council offers its members on this subject, at: www.barcouncil.org.uk