



**Australian Government**

Professional Standards Board for  
Patent and Trade Marks Attorneys

23 September 2016

## **Knowledge requirements for Trans-Tasman Patent Attorneys**

The *Intellectual Property Laws (Amendment) Act 2015* (Cth) (the Amending Act) received Royal Assent on 25 February 2015. The New Zealand Parliament is currently considering the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Bill (the NZ Bill) which includes patent attorney provisions compatible with the Amending Act.

Subject to the passing of the NZ Bill, Schedule 4 to the Amending Act is due to commence before 25 February 2017. The NZ Bill and provisions in Schedule 4 will establish a new regulatory framework which will govern the operation of a single patent attorney regime in Australia and New Zealand. The Amending Act will continue the existing Professional Standards Board for Patent and Trade Marks Attorneys as the Trans-Tasman IP Attorneys Board (the Board), but with an expanded membership to look after New Zealand interests, and a new name to reflect its broader role. For economy of operation, the Board will administer both the trans-Tasman patent attorney regime and the Australian trade marks attorney regime.

IP Australia conducted a public consultation from 4 May-24 June 2016 on the draft Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016. The draft Regulation proposes amendments to the knowledge requirements for a person seeking registration as a patent attorney, whilst preserving the existing knowledge requirements for a person seeking registration as a trade marks attorney.

The Board has the power to issue knowledge requirement guidelines under regulation 20.8(3) of the *Patents Regulations 1991* (Cth). The operation of section 4 of the *Acts Interpretation Act 1901* (Cth) allows the Board to issue guidelines for the knowledge requirements to be satisfied for a person to register as a trans-Tasman patent attorney.

The Board first approved the trans-Tasman knowledge requirement guidelines at its meeting on 23 March 2016. These guidelines and the draft Regulation were discussed at the Board's meeting on 17 June 2016. Consequently, the Board has revised the knowledge requirement guidelines for the trans-Tasman patent attorney regime and issued separate knowledge requirement guidelines for Australia's trade marks attorney regime.

The Board hopes that publishing the revised trans-Tasman knowledge requirement guidelines now will give educational providers time to either update existing courses or develop new courses prior to the expiration of the specific transitional arrangements for the registration of patent attorneys.

The Secretary to the Board, Mr Jeff Carl, is available to discuss any aspect of the trans-Tasman knowledge requirement guidelines. Mr Carl's contact details appear below.

**TOPICS OF STUDY AND THE DESIRED OUTCOMES FOR  
REGISTRATION AS A PATENT ATTORNEY FOLLOWING  
COMMENCEMENT OF THE TRANS-TASMAN PATENT  
ATTORNEY REGIME.**

Note:

A new trans-Tasman regulatory framework for patent attorneys in both Australia and New Zealand is proposed to commence before 25 February 2017. This will include knowledge requirements that need to be satisfied for a person to register as a trans-Tasman patent attorney.

The knowledge requirements that need to be satisfied for a person to register as a trade marks attorney in Australia are unchanged.

The Professional Standards Board for Patent and Trade Marks Attorneys (the Board) first issued Trans-Tasman Knowledge Requirement Guidelines on 31 March 2016. The Board has now revised these Guidelines to take account of the provisions contained in the draft Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016. The main change since the first guidelines were issued is that the draft Regulation will preserve the existing knowledge requirements for a person seeking to register as a trade marks attorney.

Consequently, the Board has issued separate Knowledge Requirement Guidelines for people seeking registration as a trade marks attorney after the new Regime's commencement date (which must be before 25 February 2017).

The Board will soon be publishing further information on the transitional arrangements and their effect on people seeking registration as a patent attorney after the commencement date, but who started their studies before the commencement date.

**OUTCOMES OF A COURSE OF STUDY QUALIFYING A PERSON FOR  
REGISTRATION**

Schedule 5 to the *Patents Regulations 1991* (Cth) provides the knowledge requirements for a person wishing to register as a patent attorney.

Once the trans-Tasman patent attorney regime commences, these knowledge requirements will also apply to applicants based in New Zealand – subject to any applicable transitional arrangements.

The Board considers that the overall objective of the education regime supporting registration should be to provide a student with an appropriate level of:

- knowledge and practical application to enable them to provide advice on which category or categories of protection might be applicable to a particular activity
- appreciation of the advantages of particular forms of protection as they relate to a client's activity
- understanding of how to obtain and maintain appropriate protection on behalf of the client
- understanding of the required standard of professional conduct.

## TOPICS OF STUDY

The topics of study have been grouped together with an outcome statement for the particular grouping. However, there is no requirement that groupings be reflected in any particular course structure, provided the outcomes are achieved.

To assist in understanding the requirements for teaching the following legend applies to the topics:

\*\* very important requiring in-depth study.

All topics are to be studied across both New Zealand and Australian law and practice, including identifying and discussing differences in law and practice between Australia and New Zealand.

The Board anticipates that, in the light of the additional subject matter which is required to be introduced into the currently accredited courses, it may be necessary to facilitate additional teaching time (e.g. by introducing a tutorial program).

### **Group A1 Legal process**

An understanding of the Australian and New Zealand legal systems and how the appeal/review structures operate in both countries. Topics include:

- Parliament\*\*
- The courts\*\*
- Precedent\*\*
- Statutory interpretation\*\*
- The Treaty of Waitangi and Maori perspectives relating to the New Zealand legal system.

### **Group A2 Overview of intellectual property**

An understanding of the way that intellectual property rights may be protected. Topics include:

- Patents
- Trade Marks
- Designs
- Copyright
- Circuit Layouts
- Plant Breeder's Rights/Plant Variety Rights
- Geographical Indications/Appellations of Origin
- Confidential Information/Trade Secrets
- Trade Practices and Anti-Competitive Practices
- International Intellectual Property Treaties.

### **Group B Professional Conduct**

An understanding of the rights, privileges and responsibilities of trade marks and patent attorneys. Topics include:

- Conflicts of interest\*\*
- Privilege
- Confidentiality
- Professional liability and negligence
- Code of Conduct\*\*

- Maintenance of rights/monitoring systems\*\*
- Fiduciary obligations to clients.

### **Group C Trade Mark Law**

An understanding of the principles of trade marks and the trade marks system in Australia and New Zealand. Topics include:

- Passing off and unfair competition
- Advice on registrability\*\*
- Comparison of business names and trade marks
- Marks excluded from registration
- Other regimes which provide protection for trade indicia:
  - Legislation protecting major sporting and cultural events and related insignia (e.g. the *Olympic Insignia Protection Act 1987* (Cth), the *Major Events Management Act 2007* (NZ))
  - Domain names
  - Geographical Indications/Appellations of Origin
  - Systems for the protection of national flags, emblems and culturally significant names
- Criteria which affect registrability:
  - Distinctiveness\*\*
  - Deception and confusion\*\*
  - Offensive/scandalous matter
- Ownership:
  - "Authorship" of the trade marks.\*\*
- Use:
  - Intention to use\*\*
  - Honest concurrent use\*\*
  - Prior continuous use\*\*
- Protection:
  - Infringement\*\*
  - Well-known marks.\*\*

### **Group D Trade Mark Practice**

An ability to advise and to handle the interests of a client regarding the prosecution and maintenance of trade marks applications. This includes advice on the desirability of seeking trade marks protection and alternative protection regimes in Australia, New Zealand, and other countries. Topics include:

- Classification systems
- Searching
- Types of applications/registrations
- The practices and procedures of IP Australia and IPONZ:
  - Filing\*\*
  - Examination\*\*
  - Hearings\*\*
  - Opposition\*\*
  - Evidence\*\*
  - Extension of time\*\*
  - The role of the Maori Advisory Committee (NZ)
- Removal for non use\*\*

- Rectification\*\*
- Registration of security interests
- Border controls
- Exploitation:
  - Assignment\*\*
  - Licensing\*\*
  - Parallel imports\*\*
  - Managing a trade marks portfolio\*\*
- Misuse and criminal provisions
- International:
  - Treaties and Conventions
    - The Madrid Protocol
  - Regional systems – e.g. the European Union trade mark (EUTM) [formerly the Community Trade Mark (CTM)]
  - Basic understanding of the principal differences between different systems including consideration of requirements to use, first-to-file versus first-to-use, post-acceptance versus pre-acceptance / registration opposition and renewal requirements
  - Other classification systems
  - Unacceptable trade marks - restrictions on registrability
  - Practice differences such as legalised and notarised documents, powers of attorneys.

### **Group E Patent Law**

An understanding of the principles of patents and the patent systems in Australia and New Zealand. Topics include:

- Patent-eligible subject matter:
  - Including the approach to establishing patent-eligible subject matter\*\*
  - Exclusions to patent eligibility (e.g. nucleic acid molecules, methods of treatment and diagnosis, plant varieties, invention contrary to public order and morality, etc.)\*\*
- Prior art base\*\*
- Patent specifications:
  - Requirements for description\*\*
  - Requirements for claims\*\*
  - Relationship between description and claims including need for support for the claims in the disclosure\*\*
- Infringement\*\*
- Inventorship\*\*
- Ownership
- Breach of confidence.

### **Group F Patent System**

An ability to advise and to handle the interests of a client regarding the prosecution and maintenance of patent applications. This includes advice on the desirability of seeking patent protection and alternative protection regimes in Australia, New Zealand and other countries.

Topics include:

- Types of applications:
  - Provisionals
  - Completes
  - Divisionals
  - Patents of addition
  - Convention
- Priority dates\*\*
- IP Australia's and IPONZ's practices and procedures:
  - Amendment\*\*
  - Opposition\*\*
  - Re-examination
  - Maintenance
  - Extension of term
  - Extension of time and restoration
  - The role of the Maori Advisory Committee (NZ)
- Revocation\*\*
- Treaties, conventions and international agreements—for example:
  - Patent Cooperation Treaty
  - Budapest Treaty
  - Paris Convention
  - Global Patent Prosecution Highway
- Searching
- Assignment
- Registration of security interests
- Licensing
- Compulsory licences
- Crown use
- Restrictions on exploitation
  - Patents Act
  - Trade Practices.
- Circuit layout legislation and practice
- Plant protection legislation and practice
- Patentability in other countries (including kinds of patent available, novelty and inventive step provisions, who may apply for a patent, the general form of the specification and any required format of the claims)\*\*
- Patent procedures in other countries (major trading partners: US, EPC, CA, JP, CN, KR and other in the region) (including a general outline of examination procedures, pre- or post-grant opposition procedures that may be available, including re-examination, and publication of documents relating to the application)\*\*
- Innovation patents (Australia only) and other short-term patents such as utility models.\*\*

### **Group G      Drafting of patent specifications**

An ability to elicit relevant information about an invention and from that, given the prior art, draft a specification to accompany a provisional application, a standard complete application, an international application and an innovation patent application.\*\*

## **Group H Interpretation and validity of patent specifications**

An ability to express an understanding of a patent specification and what it covers with a view to advising on infringement, validity over given prior art, section 40 of the *Patents Act 1990* (Cth)/section 39 of the Patents Act 2013 (NZ) and other grounds of revocation and amendment.\*\*

## **Group I Designs law and practice**

An ability to advise and to handle the interests of a client regarding the prosecution and maintenance of design applications. This includes advice on the desirability of seeking design protection and alternative protection regimes in Australia, New Zealand and other countries. Topics include:

- Subject matter:
  - Registrability\*\*
  - Newness and distinctiveness/originality\*\*
- IP Australia's and IPONZ's practices and procedures:
  - Filing\*\*
  - Examination\*\*
  - Maintenance\*\*
  - Third Party objection (Australia only)\*\*
- Infringement\*\*
- Expungement
- Ownership
- Registration of security interests
- Copyright
- International aspects of design practice including Design Patents.

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## **NOTES**

People seeking joint registration as a Trans-Tasman patent attorney and an Australian trade marks attorney after the commencement date should note that, (subject to specific transitional arrangements referred to in the Note above):

1. A course of study that meets the knowledge requirements for Topic Groups A1, C and D for registration as a trade marks attorney **will not support** an application for exemption for the same Topic Group for registration as a trans-Tasman patent attorney because the trade marks attorney course does not have sufficient New Zealand content.
2. A course of study that meets the knowledge requirements for Topic Groups A1, A2, B, C and D for registration as a trans-Tasman patent attorney **will support** an application for exemption for the same Topic Group for registration as a trade marks attorney because the respective courses have the same or similar Australian content.