



Australian Government

IP Australia

IP Australia Response to Dr Vivienne Thom AM

*Independent report on the effectiveness of the
Trans-Tasman regulation of patent attorneys and
related matters*



Acknowledgement of Country

IP Australia acknowledges the rich contributions to innovation that Aboriginal and Torres Strait Islander peoples have made through 60,000 plus years of continuing lore and history.

We pay our respects to the Traditional Custodians of our land and its waters. We extend this to all Aboriginal and/or Torres Strait Islander people reading this response.



Introduction

The [*Arrangement between the Government of Australia and the Government of New Zealand relating to Trans-Tasman regulation of Patent Attorneys*](#) (the Arrangement) is a bilateral agreement entered into in March 2013 establishing a regime relating to the registration, governance and discipline of patent attorneys.

The Arrangement requires that a review of its effectiveness with a view to deciding on and implementing any necessary improvements is carried out no later than five years after it has taken effect (the Review). In November 2021 IP Australia (IPA) and the Ministry of Business, Innovation and Employment New Zealand (MBIE) jointly published a consultation paper seeking submissions for that review.

The joint report of the Review is available here: [*Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys*](#). The Review concluded that the regime is working well and there are no substantive issues with its performance. Some minor issues were identified around the administration of the regime. The report makes twelve recommendations for improvements and potential reform to the regime.

IP Australia commissioned an independent report by Dr Vivienne Thom AM on the effectiveness of the Arrangement and recommendations for improvement for its use in the Review. Dr Thom's *Independent report on the effectiveness of the Trans-Tasman regulation of patent attorneys and related matters*, March 2022 was based on stakeholder research and feedback.

Several of Dr Thom's recommendations align with research, stakeholder feedback and investigations conducted by IPA and/or MBIE during the Review. This document details IP Australia's response to the recommendations put forward by Dr Thom in her independent report that were not addressed by the Review.

Recommendations and Responses

Recommendations		Responses
1.	IPA and MBIE should ensure that any nominations to responsible Ministers for Board appointments should include a diverse range of individuals with skills and experience that are relevant to the role and functions of the Board and complement the skills and experience of existing Board members	Refer to section 6A and the recommendation at 6.23 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
2.	The Board should publish comprehensive information about how conflicts of interest are identified and managed.	Refer to section 8D and the recommendation at 8.24 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
3.	The Board should finalise and implement its communication strategy. The Board should evaluate the success of the strategy by seeking feedback from registered attorneys 12 months after implementation.	This is a matter for the Board and has been referred for consideration.
4.	IPA and MBIE should review the requirement in section 203 of the Patent Act 1990 to have a registered patent attorney in regular attendance at an office and in continuous charge of the patents work done at that office or place.	This recommendation has been placed on the IP Australia “New Policy Issues Register” for further consultation and consideration.
5.	IPA and MBIE should clarify with IPONZ how an Australian attorney can remove their address for service from an application in New Zealand without cancelling the application.	IPA will raise this matter with IPONZ for clarification.
6.	IPA and MBIE should continue to monitor the availability of accredited courses to assess the level of risk of particular topics not being available and determine whether any intervention is required.	Refer to section 6A and the recommendation at 6.20 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
7.	The Board should consider obtaining independent expert advice about course accreditation and contemporary educational methodology if it does not have a member with experience in course development and teaching in the tertiary education sector.	Refer to section 6A and the recommendation 6.21 and 6.23 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.

8.	IPA and MBIE should consider whether the requirement for a technical qualification to register as a patent attorney should be broadened to include 'potentially patentable subject matter in Australia, New Zealand <u>or overseas</u> '.	This issue was not raised in the review by any other stakeholders. No further action is proposed at this time.
9.	The Board should review the 2016 curriculum of studies to ensure it reflects current law and practice and contains sufficient details in all topics to facilitate candidates seeking exemptions.	Refer to section 6A and the recommendation at 6.21 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
10.	IPA and MBIE should review the requirement in regulation 20.10 of the Patent Regulations 1991 to establish whether a period of employment outside of Australia or New Zealand, but under the supervision of an Australian or New Zealand patent attorney, should be included.	Refer to section 6A and the recommendation at 6.22 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
11.	The Board should develop a targeted campaign for SMEs to promote confidence and awareness in the registered patent and registered trade marks attorney professions and trans-Tasman arrangements. The campaign should explain how the regulation of the profession ensures a high level of professional standards.	Refer to section 7 and the recommendation at 7.10 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
12.	The Board should clarify the appropriateness of the use of the term 'Trans-Tasman IP Attorney' and advise the profession accordingly.	This is a matter for the Board and has been referred for consideration.
13.	The Board should explore ways to facilitate and promote a greater range of continuing professional education on topics that are not covered in the courses of study and not delivered by existing providers.	Refer to section 8D and the recommendation at 8.24 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
14.	The Board should consider facilitating and endorsing training on professional conduct matters including the Code of Conduct and professional ethics	Refer to section 8D and the recommendation at 8.24 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.

15.	IPA and MBIE should review the disciplinary and complaint-handling regime increasing the focus on the resolution of complaints. This review should be based on the following principles:	Refer to section 6D and the recommendation at 6.49 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
	a. Complaints should be triaged initially according to the alleged conduct with a focus on early resolution.	Refer to section 6E and the recommendation at 6.59 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
	b. Investigations should be actively case managed and investigated to ensure prompt resolution.	Refer to section 6D and the recommendations at both 6.49 and 6.59 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
	c. Decisions should be made at the most appropriate level.	Refer to section 6E and the recommendation at 6.59 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
	d. A range of appropriate remedies and sanctions should be available.	Refer to section 6D and the recommendation at 6.49 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
16.	IPA and MBIE should review whether existing powers available to the Board to obtain information are sufficient. At the same time, the question of retaining professional privilege over material disclosed to the Board should also be considered.	Refer to section 6E and the recommendation at 6.59 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
17.	IPA and MBIE should review the ability of the Board to initiate disciplinary proceedings against an incorporated attorney and propose legislative amendment if appropriate.	Refer to section 8E and the recommendation at 8.18 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.

18.	IPA and MBIE should propose legislative amendments to allow the Board and Tribunal discretion whether to commence or continue with disciplinary proceedings in the event that an attorney voluntarily withdraws their registration.	Refer to section 6D and the recommendation at 6.49 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys.
19.	IPA and MBIE should consider whether the Board should have any role or powers to set up arrangements to ensure that the practice of a registered attorney who is temporarily incapacitated should be taken over for a period to ensure that the IP rights of clients continue to be safeguarded.	This is a matter for the Board and has been referred for consideration.
20.	IPA should clarify the extent to which individuals who are not legal practitioners can do trade marks work in light of the reserve of legal practitioners at a state or territory level and inform applicants and registered attorneys of the outcome of this review. Depending on the outcome of this exercise, IPA should also clarify the current provisions relating to the scope of work that can be done by trade marks attorneys.	This issue has been added to the IP Australia Policy Register for further consideration.
21.	IPA should investigate the experiences of trade mark applicants who have used unqualified and unregistered practitioners to determine if further regulation of the profession is required. This could be achieved, for example, by way of a quantitative and qualitative survey of trade marks clients after opposition proceedings to ascertain the extent to which the advice of unqualified and unregistered practitioners was considered by clients to have adversely affected their interests.	Refer to section 8A and the recommendation at 8.7 of the Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Regulation of Patent Attorneys. This issue has also been added to the IP Australia Policy Register for further consideration.