



Curriculum of Studies for meeting the minimum knowledge requirement Under Reg 20.8 – Patent Regulations 1991

BACKGROUND

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

Regulation 20.8(3) allows the Trans-Tasman IP Attorney Board (the Board) to publish guidelines setting out criteria for deciding whether or not areas of study are likely to meet the requirements set out in Schedule 5.

The Board has established a curriculum of studies as a guideline for meeting the minimum knowledge requirements.

CURRICULUM OF STUDIES

The curriculum of studies consists of nine topic groups of study. Each group covers content that provides an appropriate level of understanding of a specific area. The topics have been grouped together with an outcome statement for the particular grouping. Together, the nine topic groups cover all the content required to prepare students to practise as patent attorney. If registration is only sought for practice as a trade marks attorney, then only the first four are required. However, there is no requirement that groupings be reflected in any particular course structure, provided the outcomes are achieved.

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

Topic 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:	
<ul style="list-style-type: none"> • Parliament** • Precedent** • Statutory interpretation** • The courts** 	<ul style="list-style-type: none"> • The Treaty of Waitangi and Maori perspectives relating to the New Zealand legal system.
Topic Group A2 Overview of intellectual property An understanding of the way that intellectual property rights may be protected. Topics include:	
<ul style="list-style-type: none"> • Circuit Layouts • Copyright • Designs • Patents • Trade Marks 	<ul style="list-style-type: none"> • Confidential Information/Trade Secrets • Geographical Indications/Appellations of Origin • International Intellectual Property Treaties. • Plant Breeder’s Rights/Plant Variety Rights • Trade Practices and Anti-Competitive Practices
Topic Group B Professional Conduct An understanding of the rights, privileges and responsibilities of trade marks and patent attorneys. Topics include:	
<ul style="list-style-type: none"> • Code of Conduct** • Conflicts of interest** • Maintenance of rights/monitoring systems** 	<ul style="list-style-type: none"> • Confidentiality • Fiduciary obligations to clients. • Privilege • Professional liability and negligence

** - very important requiring in-depth study
Curriculum of Studies – updated Feb 2024

<p>Topic Group C Trade Marks Law</p> <p>An understanding of the principles of trade marks and the trade marks system in Australia and New Zealand. Topics include:</p>	
<ul style="list-style-type: none"> • Advice on registrability** • Criteria which affect registrability: <ul style="list-style-type: none"> – Distinctiveness** – Deception and confusion** – Offensive/scandalous matter • Ownership: <ul style="list-style-type: none"> – "Authorship" of the trade marks.** • Use: <ul style="list-style-type: none"> – Intention to use** – Honest concurrent use** – Prior continuous use** • Protection: <ul style="list-style-type: none"> – Infringement** – Well-known marks.** 	<ul style="list-style-type: none"> • Comparison of business names and trade marks • Marks excluded from registration • Passing off and unfair competition • Other regimes which provide protection for trade indicia: <ul style="list-style-type: none"> – 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

<p>Topic Group D Trade Marks Practice</p> <p>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:</p>	
<ul style="list-style-type: none"> • Exploitation: <ul style="list-style-type: none"> – Assignment** – Licensing** – Managing a trade marks portfolio** – Parallel imports** • Classification systems • Removal for non use** • Rectification** • Searching • Types of applications/registrations • The practices and procedures of IP Australia and IPONZ: <ul style="list-style-type: none"> – Evidence** – Examination** – Extension of time** – Filing** – Hearings** – Opposition** – The role of the Maori Advisory Committee (NZ) 	<ul style="list-style-type: none"> • Border controls • Misuse and criminal provisions • Registration of security interests • International: <ul style="list-style-type: none"> – 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.

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Topic Group E Patent Law An understanding of the principles of patents and the patent systems in Australia and New Zealand. Topics include:	
<ul style="list-style-type: none"> ● Patent-eligible subject matter: <ul style="list-style-type: none"> – 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.)** ● Patent specifications: <ul style="list-style-type: none"> – Requirements for description** – Requirements for claims** – Relationship between description and claims including need for support for the claims in the disclosure** 	<ul style="list-style-type: none"> ● Prior art base** ● Infringement** ● Inventorship** ● Ownership ● Breach of confidence

Topic 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:	
<ul style="list-style-type: none"> ● Innovation patents (Australia only) and other short-term patents such as utility models.** ● IP Australia’s and IPONZ’s practices and procedures: <ul style="list-style-type: none"> – Amendment** – Opposition** – Re-examination – Extension of term – Extension of time and restoration – Maintenance – The role of the Maori Advisory Committee (NZ) ● 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)** ● 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)** ● Priority dates** ● Revocation** 	<ul style="list-style-type: none"> ● Assignment ● Circuit layout legislation and practice ● Compulsory licences ● Crown use ● Licensing ● Plant protection legislation and practice ● Registration of security interests ● Restrictions on exploitation <ul style="list-style-type: none"> – Patents Act – Trade Practices. ● Searching ● Treaties, conventions and international agreements—for example: <ul style="list-style-type: none"> – Budapest Treaty – Global Patent Prosecution Highway – Paris Convention – Patent Cooperation Treaty ● Types of applications: <ul style="list-style-type: none"> – Completes – Convention – Divisionals – Patents of addition – Provisionals

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Topic 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.**

Topic 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.**

Topic 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:

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| <ul style="list-style-type: none"> • Subject matter: <ul style="list-style-type: none"> – Newness and distinctiveness/originality** – Registrability** • IP Australia’s and IPONZ’s practices and procedures: <ul style="list-style-type: none"> – Examination** – Filing** – Maintenance** – Third Party objection (Australia only)** • Infringement** | <ul style="list-style-type: none"> • Copyright • Expungement • International aspects of design practice including Design Patents. • Ownership • Registration of security interests |
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