



Ownership of Files

File ownership has been the subject of recent complaints before the Trans-Tasman IP Attorneys Board (the Board). This Practice Note is published by the Board to help registered attorneys understand their obligations and to facilitate the delivery of the client's property in a reasonable timeframe. This Practice Note may change from time to time.

Responsibilities of registered attorneys to act in a timely manner

The Board expects that registered patent attorneys and registered trade marks attorneys (collectively, 'registered attorneys') should maintain a file in such a manner that the client's property is, or can be, readily identified. This will allow the registered attorney to promptly comply with a request for the delivery of the client's property.

Legislative requirements

The *Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018* (the Code) deals generally with the professional conduct required of registered attorneys. Section 25 of the Code deals with client or former client property, including the return of a client's property when the client asks the registered attorney for its return. However, a registered attorney need not return the client's property if the client has not satisfied a lien imposed in accordance with the *Patents Regulations 1991* (Cth) or the *Trade Marks Regulations 1995* (Cth), or the *Patents Act 2013* (NZ) or otherwise by law.

A registered attorney may claim a lien over client documents if outstanding fees are owing to the registered attorney. If a registered attorney is running several files for a client, then the lien could be applied to all the client's files.

Which parts of these files are client property that need to be released to the client on request

Examples of client property (whether held in paper or electronic form) could include:

- documents¹, samples or other material *created by the client* either prior to, or during, the retainer and given to the registered attorney for the purpose of doing the work subject to the retainer;
- a document the client is entitled to have a copy of during the retainer;
- documents prepared by the registered attorney for the benefit of the client;
- documents prepared by a third party and sent to the registered attorney at the client's expense;

¹ A document is defined in this Practice Note as a piece of written, printed, or electronic matter that provides information or evidence, or that serves as an official record.

- documents brought into existence by a registered attorney who acts only as an agent for a client for this purpose;
- communications between the registered attorney, IP offices and third parties for the benefit of the client.

Registered attorneys should note that paragraph 25(1)(b) of the Code provides for the registered attorney to release ‘documents, samples or material to which the client may have access under an agreement between the registered attorney and the client’. This category of documents, etc. will be determined by the nature of the agreement between the client and the registered attorney, however it should not take away from the client’s right to the client’s property. Registered attorneys may seek to clarify these matters in their standard retainer terms for the avoidance of doubt.

Which parts are not client property

Examples of documents that are not client property could include:

- documents given to a registered attorney for the registered attorney’s own use and benefit;
- documents prepared by the registered attorney at no charge to the client solely for the registered attorney’s own benefit, protection or records;
- notes of attendances by the registered attorney on the client;
- internal records and memos about work done or work to be done.

Can an attorney levy charges, etc. for the extraction, copying and delivery of a client’s file (and if so, when)

A client should not be charged for the purposes of a registered attorney retaining a copy of the client’s property.

In practice, a registered attorney should not levy service charges for delivery of the client’s property unless the registered attorney and client have otherwise agreed. If a charge has been agreed, then it is recommended that the charge reflect the approximate cost to the registered attorney of delivering the client’s property.

In the absence of such an agreement, if a registered attorney were to charge an unreasonable amount for document storage, extraction, copying or delivery of a client’s property it could be argued that such conduct is inconsistent with the registered attorney’s obligation to act in the best interests of the registered attorney’s client.

If you have any concerns please contact the Secretary, Trans-Tasman IP Attorneys Board.

Contact details:

Tel: +61 2 6283 2345

Email: mail.ttipab@ipaaustralia.gov.au