

TOPICS OF STUDY AND THE DESIRED OUTCOMES FOR REGISTRATION AS AN AUSTRALIAN TRADE MARKS 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 new knowledge requirements for the registration of trans-Tasman patent attorneys.

The knowledge requirements for the registration of trade marks attorneys 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).

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. These knowledge requirements are modified by Regulation 20.11 of the *Trade Marks Regulations 1995* (Cth) for a person who wishes to register as a trade marks attorney.

Once the trans-Tasman patent attorney regime commences, the knowledge requirements for trade marks attorneys which applied before the commencement date are effectively preserved and continue unchanged after the commencement date.

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.

Group A1 Legal process

An understanding of the Australian legal system and how the appeal/review structures operate. Topics include:

- Parliament**
- The courts**
- Precedent**
- Statutory interpretation**.

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
- Geographical Indications
- 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 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. 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))
 - Domain names
 - Geographical Indications
 - Systems for the protection of national flags, emblems and culturally significant names
- Criteria which affect registrability:
 - Distinctiveness**
 - Deception and confusion**
 - 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 and other countries. Topics include:

- Classification systems
- Searching
- Types of applications/registrations
- The practices and procedures of IP Australia:
 - Filing**
 - Examination**
 - Hearings**
 - Opposition**
 - Evidence**
 - Extension of time**
- 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.

NOTES

People seeking joint registration as a trans-Tasman patent attorney and an Australian trade marks attorney after the commencement date should note that:

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.