



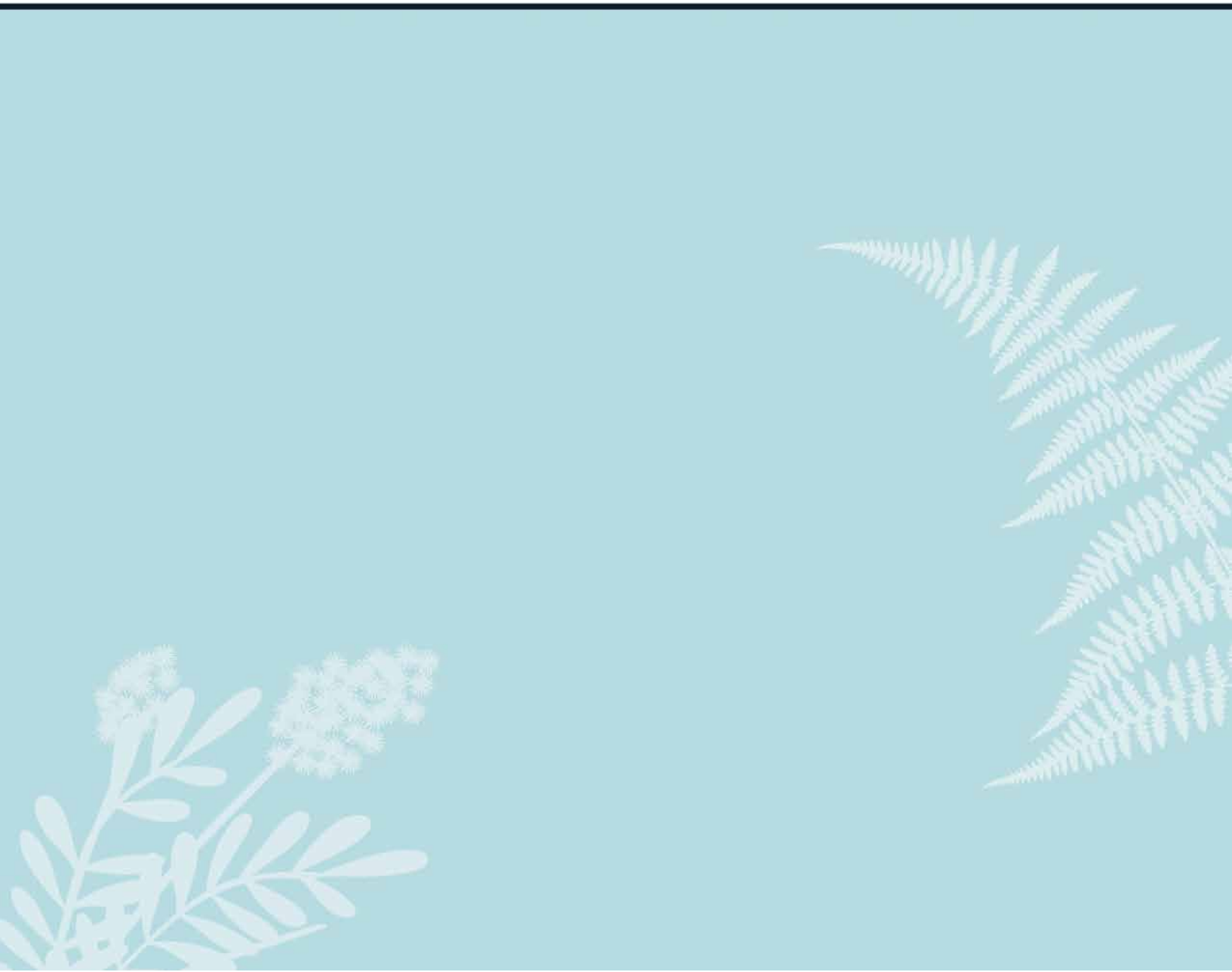
Australian Government



New Zealand Government

Te Kāwanatanga o Aotearoa

Trans-Tasman IP Attorneys Board Chair's Report 2020-21



Chair's Report 2020-21

Introduction

The Trans-Tasman IP Attorneys Board (the Board) is a statutory body established under section 227A of the *Patents Act 1990* (Cth). The Board was given effect by the *Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys* (the Arrangement).

This report covers the activities of the Board and Designated Manager for the period 1 July 2020 – 30 June 2021.

Functions and responsibilities

The Board administers the regulatory and disciplinary systems for patent attorneys in Australia and New Zealand, and trade marks attorneys in Australia. The Board's role is to determine:

- the academic qualifications required to become patent and trade marks attorneys;
- the knowledge requirements for a person to register as a patent or trade marks attorney;
- consideration of exemptions from the knowledge requirements of a topic group or groups based on an individual's prior study;
- accreditation of courses for registration as a patent or trade marks attorney that satisfy the respective subject requirements under the *Patent Regulations 1991* (Cth) or the *Trade Marks Regulations 1995* (Cth);
- disciplinary matters, including a complaints and investigation procedure; and
- the professional conduct of patent and trade marks attorneys.

2020–21 Board highlights

As in 2019-2020, the Board's activities were not significantly impacted by COVID-19 during 2020–21. Meetings of the Board and its sub-committees continued to be held by videoconference in response to travel restrictions.

The Board met on four occasions (25 August 2020, 15 October 2020, 13 November 2020 and 12 March 2021) and approved 412 applications spanning patent and trade marks attorney academic qualifications, knowledge requirements and exemptions. This represents an overall increase in the number of approved applications compared to the previous year (271), reflecting interest in the profession, particularly in relation to trade marks attorneys. Detailed statistics can be found at Table 2 of the Appendix.

The Board investigated nine complaints against registered patent and trade marks attorneys during the period (2019–20: eight). Of those complaints, only one was referred to the Disciplinary Tribunal. Disciplinary Tribunal proceedings for this matter ended when the attorney voluntarily withdrew their registration. Whether disciplinary proceedings should be able to be continued against attorneys who are not currently registered is being considered as part of a review of the Arrangement.

Code of Conduct Health Check

While no complaints were deemed to meet the necessary threshold for referral to the Disciplinary Tribunal in 2020-21, the Board did identify some common themes in the complaints received which suggested that there may be scope to improve or clarify the *Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018* (the Code of Conduct) and its associated guidelines. The Board has engaged Professor Andrew Christie, Chair of Intellectual Property at Melbourne Law School, to undertake a health check of the Code of Conduct. Professor Christie is a leading expert in the area and has previously assisted the Board with reviews of the Code of Conduct. Professor Christie has begun meeting with a wide range of stakeholders from Australia and New Zealand, and his report is expected by the end of 2021.

Trans-Tasman IP Attorneys Regulation Regime Review

During the period, the Australian and New Zealand Governments began work on a review of the Trans-Tasman IP Attorneys Regulation Regime. This review is required by the arrangement which established the regime in 2017, and is intended to consider the effectiveness of the regime in achieving its objectives, with a view to identifying any improvements which can be made. The questions of whether the trans-Tasman regulation of patent attorneys should continue or whether there should be a regulated trade marks attorney profession in New Zealand are not within the scope of the review.

Although the review focuses on the trans-Tasman regulation of patent attorneys, the opportunity is also being used by IP Australia to seek feedback on the regulation of Australian trade marks attorneys, as there is a significant overlap between the membership of the patent and trade marks attorney professions and the regulations that apply to them.

The review will include a period of public consultation which has commenced and will utilise a variety of channels to seek the views of stakeholders across Australia and New Zealand. The review is expected to be completed in early 2022.

2020–21 Designated Manager update

The *Patents Act 1990* (Cth) provides for a person, the Designated Manager, to register patent and trade marks attorneys and to maintain the respective Registers of Patent Attorneys and Trade Marks Attorneys. The role of Designated Manager is performed by the Director General of IP Australia, Michael Schwager.

As at 30 June 2021, there were a total of 1571 individual and 86 incorporated registered attorneys (up from 1533 individual and 77 incorporated registered attorneys in 2019-2020). 63 new registrations were recorded during the year offsetting those attorneys removed from the Registers. Further detail is available in tables 3, 4 and 5 of the Appendix.

Registered attorneys	Individuals		Incorporated	
	2020-21	2019-20	2020-21	2019-20
Single-registered patent attorneys	364	356	30	24
Single-registered trade marks attorneys	516	498	6	4
Dual-registered patent & trade marks attorneys	691	679	50	49
Total registered attorneys	1571	1533	86	77

Appendix

Membership

The legislation establishing the Board provides for a minimum of seven and no more than 10 members. Non ex officio members are appointed by the Australian Minister for Industry, Energy and Emissions Reduction, in consultation with the New Zealand Minister for Commerce and Consumer Affairs. The Board is required to include:

- the Chair;
- the Director General of IP Australia;
- the New Zealand Commissioner of Patents;
- at least two New Zealand resident patent attorneys (nominated by the New Zealand Minister of Commerce and Consumer Affairs); and
- at least two other members.

Australian Government guidelines also recommend geographic and gender diversity, with women and men each holding a minimum of 40 per cent of positions at an individual board level. The Board's membership addresses this recommendation.

During the reporting period, Ms Kate Duckworth, Dr Karin Innes and Ms Viet-Chau Tran were all reappointed for a second three-year term.

TABLE 1: OFFICE HOLDERS DURING THE REPORTING PERIOD

Name	Position	Location	Gender	Background
Ms Elizabeth Hopkins	Chair	New Zealand	F	Independent consultant and non-executive director
Mr Michael Schwager	Ex officio Member	Australian Capital Territory, Australia	M	Director General of IP Australia
Mr Ross van der Schyff	Ex officio Member	New Zealand	M	New Zealand Commissioner of Patents
Ms Kate Duckworth	Member	New Zealand	F	Patent attorney
Mr Ian Finch	Member	New Zealand	M	Patent attorney
Mr Anthony Alder	Member	New South Wales, Australia	M	Patent and trade marks attorney
Mr Carl Harrap	Member	New South Wales, Australia	M	Patent attorney
Dr Karin Innes	Member	Victoria, Australia	F	Patent and trade marks attorney
Ms Viet-Chau Tran	Member	New South Wales, Australia	F	Special Counsel

Board Meetings

The Board held four formal meetings during the reporting period. The Board is also supported by sub-committees (comprising a subset of Board members) that may convene in advance of formal meetings to consider more complex matters.

Board and Designated Manager Statistics 1 July 2020—30 June 2021

TABLE 2: APPLICATIONS CONSIDERED AND APPROVED BY THE BOARD

	Considered	Approved
Approval of academic qualifications		
Patent attorneys	43	41
Trade marks attorneys	49	49
Approval of knowledge requirements		
Patent attorneys	27	26
Trade marks attorneys	73	71
Exemptions from knowledge requirements based on prior study		
Patent attorneys	18	15
Trade marks attorneys	218	210
Accreditation of courses		
Patent attorneys	0	0
Trade marks attorneys	0	0

TABLE 3: NEW ATTORNEY REGISTRATIONS (DESIGNATED MANAGER)

Patent attorneys	
Australian-resident patent attorneys	10
NZ-resident patent attorneys	6
Australian dual-registered patent and trade marks attorneys	16
NZ dual-registered patent and trade marks attorneys	1
Trade marks attorneys	
Australian-resident trade marks attorneys	32
NZ-resident trade marks attorneys	1
Overseas resident trade marks attorneys	3
Total individual attorneys	69
Incorporated attorneys	
Australian incorporated patent attorneys	2
NZ incorporated patent attorneys	4
Australian incorporated trade marks attorneys	2
NZ incorporated trade marks attorneys	0
Australian dual-registered incorporated patent & trade marks attorneys	6
NZ dual-registered incorporated patent & trade marks attorneys	0
Total incorporated attorneys	14

TABLE 4: ATTORNEY RENEWALS (DESIGNATED MANAGER)

Renewals	
Patent attorneys	353
Trade marks attorneys	480
Dual-registered patent & trade marks attorneys	665
Incorporated patent attorneys	24
Incorporated trade marks attorneys	4
Dual-registered incorporated attorneys	44
Total	1570

TABLE 5: REMOVALS FROM AND RESTORATIONS TO THE REGISTERS (DESIGNATED MANAGER)

Removed from the Registers	Individual	Incorporated
Patent attorneys	20	4
Trade marks attorneys	37	6
Total registrations removed	57	10
Restored to the Registers	Individual	Incorporated
Patent attorneys	11	0
Trade marks attorneys	15	0
Total registrations restored	26	0

Note that Table 5 considers registrations, not individuals. This is because some previously dual-registered attorneys have not maintained their registration as either a patent or trade marks attorney, but have maintained their other registration.