



Australian Government



New Zealand Government  
Te Kāwanatanga o Aotearoa

Trans-Tasman IP Attorneys Board

# Trans-Tasman IP Attorneys Board Post-Meeting Communiqué 5 & 6 December 2022

The Trans-Tasman IP Attorneys Board met on 5 & 6 December 2022 in Melbourne. This was my first Board meeting as Chair, a position I will hold for three years. The Board warmly welcomed new members Michelle Goldsmith and Dr Jason Coonan, who bring valuable experience and expertise.

In a refreshing change to the meetings held during COVID-19, a Meet & Greet event was hosted with a small but enthusiastic crowd. They heard from Karin Innes and me, as we answered questions submitted by the profession. A selection of these questions and answers are reproduced below. More will be presented through the Board's LinkedIn posts this year.

In addition to the standard business of considering attorney candidate applications and professional conduct matters, the Board considered applications for course accreditation from the Victoria University of Wellington and for course reaccreditation from UTS, discussed upcoming strategic activities, and heard from IP Australia's Dr Nathan Madsen about the *Aristocrat* High Court decision.

## Professional conduct

The Board is aware that stakeholders would like to receive more detailed information about the numbers and types of professional conduct matters that come before it. Over the course of the 2022 calendar year the Board considered 16 matters, some of which originated in 2021. The majority of these matters were submitted by clients; however, a small number were brought to the Board's attention by IP Australia staff or members of the profession.



Aspects of the *Code of Conduct* raised in the complaints range from **competency** and **diligence** to **communication** and **conflict of interest**.

Some of the matters currently before the Board are:

A trade mark matter, where an inexperienced client appears to have taken the results of a brief, complimentary search, which was provided during the first contact, as clearance for launching a product line under a trade mark prior to obtaining registration of the trade mark. The attorney provided engagement materials that explained the trade mark registration process, identified the benefits of registration, and stated that correspondence from the IP rights



office would be communicated promptly and accompanied by advice on options for overcoming any issues. The client considers that an adverse response to its trade mark application was not forwarded in a timely manner, and that options for overcoming the objections were not provided. The Board has requested more information from both parties.

A patent matter, where a trainee patent attorney attended to much of the drafting and prosecution of the matter under the supervision of a registered attorney. There may not have been a clear, common understanding between the client and the attorney as to the nature or the scope of the invention. Two provisional patent applications were filed, one of which the client considers was not upon instructions. The Board has requested copies of communications, records, file notes and other material that establish exactly what instructions to act were given by the client.

A potential conflict of interest matter, which was referred by IP Australia staff. At one point in the history of a complicated patent case, the same attorney was listed as the representative for both the applicant for the patent and the applicant for a s36 declaration. Questions about the attorney's entitlement to act were raised by IP Australia, to which the attorney responded. The Board has sought further information from the attorney about the attorney's knowledge of the legal status of the patent applicant and the standing of the s36 applicant.



## Course accreditation

The following postgraduate courses offered by the Victoria University of Wellington have been accredited for 5 years, commencing 6 December 2022:

- Legal Systems & Sources of Law LAWS 552 (Topic Group A1)
- New Zealand & Australian IP Law LAWS 551 (Topic Group A2)
- Trade Mark Law and Unfair Competition LAWS 536 (Topic Group C)
- Patent Law LAWS 537 (Topic Group E)
- New Zealand and Australian Copyright and Designs Law LAWS 530 (Topic Group I)

The following postgraduate courses offered by the University of Technology, Sydney have been reaccredited for a further 5 years and are now accredited until 23 March 2028 :

- 77905 Preparing for Intellectual Property Practice (Topic Groups A & B)
- 77889 Trade Marks Law (Topic Group C)
- 77890 Trade Marks Practice (Topic Group D)
- 77898 Patent Law (Topic Group E)
- 77891 Patent Systems (Topic Group F)
- 77894 Drafting of Patent Specifications (Topic Group G)
- 77895 Interpretation and Validity of Patent Specifications (Topic Group H)
- 77893 Designs Law and Practice (Topic Group I)

## Communication and outreach activities

The Board's LinkedIn profile is growing in popularity, and is offering more information and links to relevant material than ever before. If you're not connected with or following us, now is the time to reach out. It was through our LinkedIn profile that we received most questions from the profession that went into our recent Q & A session.



The Board's Meet & Greet Q & A session at the Langham hotel in Melbourne offered the first chance since 2019 for a face-to-face meeting between the Board and members of the profession. We are pleased to be able to hold networking events again, and are looking forward to several more in 2023.

Most questions were from attorneys wanting to assist their trainees to achieve registration and concerned the process for approval of academic qualifications and exemptions. We also received a few questions about the *Code of Conduct*.

The Q & A presented in the Meet & Greet event were:

### **Can you explain the process for approval of academic qualifications and exemptions from knowledge requirements so that I can assist my trainee with their applications for registration as an attorney?**

The process for approval is governed by the provisions of the Australian *Patent Regulations 1991* (the Regulations).

Pursuant to regulation 20.6 of the Regulations, the Designated Manager *must not* approve an applicant for registration as a patent attorney unless the applicant has:

- An Australian or New Zealand qualification of level 5 or higher, OR
- An overseas qualification that the Board is satisfied is equivalent AND

This level 5 or higher qualification needs to be:

- In a field of science or technology that contains potentially patentable subject matter AND
- Involves a depth of study deemed sufficient by the Board to provide an appropriate foundation for practice as a patent attorney

### **What fields of study contain potentially patentable material?**

Several fields of science and technology clearly contain potentially patentable subject matter.

Patent attorneys need to understand the inventions their clients are seeking to protect. Therefore, attorney candidates need to have studied within a field of science or technology concerning subject matter that has the potential to be patented.

Not all fields of science and technology will automatically be accepted. In some cases, it will come down to the major stream of study within a candidate's qualification.

Examples of sciences and technologies that are generally considered to include patentable subject matter are: Applied Physics, Biochemistry, Biotechnology, Chemical Engineering, Chemistry, Computer Engineering, Electronics, Mechanical Engineering, Mechatronics.

Examples of sciences and technologies that may not be considered to include patentable subject matter are: Software Engineering, Theoretical Physics, Veterinary Sciences. In these cases, the Board may request further information from a candidate to determine whether those studies addressed potentially patentable subject matter. If you have any doubts or concerns about whether a course might contain potentially patentable subject matter, please reach out to the Secretary in the first instance for guidance.

## Can you explain what is meant by breadth and depth of study?

Breadth and depth can be demonstrated by the mapping of a course of study. A guide and [example](#) mapping is provided on our website to assist applicants.

Clients expect a level of expertise from the patent attorney who is handling their application and advising them on their intellectual property. An attorney candidate can demonstrate a breadth of study sufficient to gain this expertise if they have completed several subjects in their relevant field in the early years of the degree.

Depth of study is typically shown by completion of a major in a Bachelor degree, where at least 6 subjects can be mapped over the course of three years to show increasing complexity and reliance upon prerequisite study.

Breadth and depth of study may be difficult to establish in cases where:

- combined degrees are studied, or
- patentable subject matter makes up only a narrow part of the overall degree, or
- there is postgraduate study which doesn't clearly link to subjects in the relevant field in the undergraduate degree.

## What are some examples of qualifications that are acceptable and those that are not?

Below are examples of qualifications routinely approved.

There are several standard Bachelor degrees that are routinely considered acceptable when the major subjects clearly cover potentially patentable material. These include:

- **Bachelor of Engineering** in fields such as Biomedical Engineering, Aerospace Engineering, Mechanical Engineering, and Computer Systems.
- **Bachelor of Science** in fields such as Biomedicine, Pharmacology, Chemistry, Biology, and Biotechnology.

## What can the Secretariat help with in between Board meetings?

The Secretariat is the first contact point for anyone who has queries about qualifications and exemptions.

- The Secretariat receives questions about qualifications and exemptions regularly and is always happy to provide information and assistance in making an application.
- Many applications for qualifications and exemptions can only be considered by the Board on a case-by-case basis. This is particularly so with candidates who have overseas qualifications.
- You can contact the Secretariat on [mail.ttipab@ipaaustralia.gov.au](mailto:mail.ttipab@ipaaustralia.gov.au) in the first instance for questions about Qualifications and Exemptions.

## Is there an opportunity for future review of the qualifications and exemption processes?

The opportunity for input into the qualifications and exemption process is ongoing.

A major review of the Trans-Tasman attorney regime was conducted by IP Australia and the New Zealand Ministry of Business, Innovation and Employment across 2021 and 2022. This review included public consultation on the regime and IP Australia advise the outcomes of this review are expected to be released this year.

If you have suggestions for improvements to the Board's administration of qualifications and exemptions, you can send these to the Secretary on [secretary.ttipab@ipaaustralia.gov.au](mailto:secretary.ttipab@ipaaustralia.gov.au)

## What does adequate provision of advice mean in terms of the Code of Conduct?

The *Code of Conduct* (the Code) explains the standards of competence, diligence and behaviour expected of an attorney.

Under regulation 20.33 of the Regulations, the standards of competence, diligence and behaviour expected of a registered attorney, as set out in the Code, are a mandatory consideration for the Board in assessing whether an attorney has been engaged in unsatisfactory professional conduct or professional misconduct. The Code provides, among other things, that:

- an attorney must act in accordance with the law, in the best interests of the attorney's clients, in the public interest, and in the interests of the profession as a whole;
- an attorney must maintain standards of professional practice that are courteous, ethical and well-informed;
- an attorney must have appropriate competency for the work undertaken, and must carry out that work with due skill and care, and in a timely manner; and
- an attorney must disclose to a client all information of which the attorney is aware that is materially relevant to work being undertaken for the client.

It is not the role of the attorney to simply file applications as quickly as possible without regard to the prospects of those applications becoming registered, valid, enforceable IP rights. Adequate provision of advice includes warning your client of material risks associated with the work you have been engaged to undertake, and documenting the fact you have done so. Even if the advice provided is brief, a competent attorney will ensure their client has been warned of material risks.

- A competent attorney will ensure their records reflect adequate provision of advice. Failure to adequately document advice given to clients may constitute unsatisfactory professional conduct.
- The question of whether conduct falls short of the standard of competence, diligence and behaviour that clients are entitled to expect of their attorney is an objective one. Many complaints that come before the Board are not referred to the Disciplinary Tribunal, as the threshold for referral has simply not been met.
- You can contact the Secretary on [secretary.tipab@ipaaustralia.gov.au](mailto:secretary.tipab@ipaaustralia.gov.au) for queries related to conduct or ethics matters.

Further communications from the Board can be found on the TTIPA website. Our latest publication is the annual report which can be accessed [here](#). As mentioned above, keep an eye on our LinkedIn profile.

Andrew Christie

Chair