

COMMONWEALTH OF AUSTRALIA

Patents Act 1990

Patents Regulations 1991, Chapter 20

TRANS-TASMAN IP ATTORNEYS BOARD and MASSANG

Reasons for Decision on penalty

Introduction

1. On 13 July 2023, the Trans-Tasman IP Attorneys Disciplinary Tribunal delivered its Reasons for Decision on liability in this matter.¹ Nine charges of unsatisfactory professional conduct were brought by the Trans-Tasman IP Attorneys Board in relation to Mr Jaime Massang's engagement by The FIRM International Cruise Line Pty Ltd between February and May 2020, pursuant to which he prepared two provisional patent applications (referred to in the Decision as the First Specification and the Second Specification). Four of the charges were dismissed and five were upheld.
2. Mr Massang was found guilty of unsatisfactory professional conduct, as follows:
 - (a) One charge of failing to adequately and properly disclose to The FIRM information that was materially relevant to the work undertaken;
 - (b) Two charges of failing to act to the requisite standard of competence and due skill and care of a registered patent attorney carrying out the work he was engaged to undertake;
 - (c) Two charges of failing to maintain requisite standards of professional practice as a registered patent attorney.
3. The Tribunal directed that the parties file written submissions on penalties and to notify the Secretariat of the Tribunal if they wished to make oral submissions. The Tribunal received written submissions but no requests to make oral submissions.

¹*Trans-Tasman IP Attorneys Board v Massang*, TTIPA Disciplinary Tribunal, 13 July 2023.

Patent Regulation 20.45 and applicable principles

4. Regulation 20.45 of the *Patent Regulations* 1991 Cth provides the penalties for unsatisfactory professional conduct, as follows:

20.45 Penalties—unsatisfactory professional conduct

- (1) Subject to subregulation (2), if a Panel of the Disciplinary Tribunal finds a registered patent attorney guilty of unsatisfactory professional conduct, it may:
 - (a) suspend the attorney’s registration as a patent attorney for a period of not more than 12 months; or
 - (b) administer a public reprimand to the attorney.
 - (2) The Panel may, in addition to suspending a registered patent attorney’s registration under subregulation (1), also impose conditions on the attorney’s return to the register after the period of suspension has elapsed.
 - (3) Without limiting subregulation (2), the conditions that the Panel may impose include either or both of the following:
 - (a) that the attorney undertake additional continuing professional education, as specified by the Panel;
 - (b) that the attorney work for a period of time, not exceeding 2 years, under the supervision of a person who has been a registered patent attorney for a period of not less than 5 years.
5. The Board submitted a summary of the general principles and relevant factors in relation to the imposition of penalties for unsatisfactory professional conduct. Mr Massang accepted the Board’s summary as “properly and fairly referenced” whilst noting that the factors listed were not exhaustive. The Tribunal agrees. It is therefore appropriate to quote the summary here:

“The general principles which must be applied when considering penalties are similar to those considered by tribunals and courts with respect to legal practitioners.² The relevant principles have been summarised as follows:³

- (a) the power to discipline a practitioner is protective in character and does not involve punishment, but should be exercised in a manner ‘*likely to achieve the maintenance of a high standard of conduct within the profession which will continue its good reputation, and so protect, not only the future of the profession, but also protect its clients from harm*’.

² *Professional Standards Board for Patent & Trade Marks Attorneys v Patent & Trade Marks Attorneys Disciplinary Tribunal* [2002] AATA 728 (**Professional Standards Board**) [61].

³ *Professional Standards Board* [62]-[66]; *Re Blenkinship* (unreported, Patents and Trade Marks Attorneys Disciplinary Tribunal, 23 February 2012) (**Blenkinship**) [127].

- (b) the penalty involves no retributive element or intention to express outrage, but should be no more than necessary to ‘*maintain professional discipline and high standards of conduct*’.
- (c) the protection of the public is not confined to the protection of the public against further default by the practitioner in question. It extends also to the protection of the public against similar defaults by other practitioners and has, in that sense, the purpose of marking the seriousness of what the practitioner has done.
- (d) suspension or cancellation is a course that should be adopted only if it is necessary for the public protection. The public needs to be protected from delinquents and wrong-doers in the profession. It also needs to be protected from ‘*seriously incompetent professional people who are ignorant of basic rules or indifferent as to rudimentary professional requirements. Such people should be moved from the register... at least until they can demonstrate that their disqualifying imperfections have been removed.*’

Factors that are relevant to the determination of an appropriate penalty include:

- (a) the nature and seriousness of the conduct found to constitute unsatisfactory professional conduct, including whether it relates to an essential feature of the work of a registered attorney;⁴
- (b) whether the patent attorney has acknowledged the conduct and cooperated with the Board’s enquiries;⁵
- (c) whether the conduct resulted in an adverse result for the client, and whether the attorney has taken steps to address the conduct and ameliorate its effects;⁶ and
- (d) whether the attorney has previously engaged in unsatisfactory professional conduct or professional misconduct.⁷

6. The unsatisfactory professional conduct which Mr Massang has been found guilty of traverses the scope of a patent attorney’s practise. Mr Massang knew when he sent the First Specification to the client purportedly ready for filing, that it was incomplete in a manner that gave rise to a risk of it not complying with the enabling disclosure requirement under sub-section 40(1) of the *Patents Act* 1990 Cth and therefore at risk of not establishing an effective priority date, yet he failed to warn of those risks. And despite

⁴ *Blenkinship* [129]. Similarly, in *Re Massang* (unreported, Patent and Trade Marks Attorneys Disciplinary Tribunal, 24 November 2009) (*Massang*) the Disciplinary Tribunal held ‘[e]ach case must be considered first and foremost on its own facts and circumstances, including the overall seriousness of the unsatisfactory conduct and any relevant mitigating factors’ at [16].

⁵ *Macauley* [109]; *Re Schulze and Boehm* (unreported, Patent and Trade Marks Attorneys Disciplinary Tribunal, 23 February 2012) (*Schulze*) [139].

⁶ *Professional Standards Board* [62]-[66]; *Re Macauley* (unreported, Patents and Trade Marks Attorneys Disciplinary Tribunal, 19 February 2016) (*Macauley*) [116].

⁷ *Macauley* [111]; *Schulz* [140]; *Massang* [19]; *Blenkinship* [131].

being generally aware that a computer implemented method lacking a technical solution was at risk of refusal he was apparently not attuned to that risk when drafting the Second Specification. Nor did he grasp the character of the alleged invention as a business method, or mere scheme which, according to the expert witnesses, should have been obvious. He therefore did not advise of the risk that the alleged invention might be found not to meet the manner of manufacture requirement. These cumulative failures resulted in the charges relating to (lack of) competency and due skill and care being made out. Finally, contrary to basic professional practice standards, Mr Massang failed to provide his client with any meaningful documented advice and retained only the most cursory diary notes of any verbal advice.

7. We agree with the Board that these failures related to essential aspects of the work of a registered patent attorney and that they were serious. We have noted its submission that the conduct resulted in an adverse impact on the client which Mr Massang has not compensated.
8. On the other hand, we note that Mr Massang's failures did not involve acts of dishonesty.⁸ Also, whilst Mr Massang has been found guilty of unsatisfactory professional conduct once before, that conduct concerned occurred over 15 years ago and was of a different nature.⁹ We have also noted Mr Massang's representation through his counsel that he has not undertaken any patent work since the Decision was handed down.
9. Taking all of the above into account and in order to maintain professional discipline and the high standards of conduct expected of the patent attorney profession, the Tribunal considers that a suspension of Mr Massang's patent attorney registration is warranted and that during that time, Mr Massang should undertake additional continuing professional education (CPE). Accordingly, the Tribunal directs that
 1. Mr Massang's registration as a patent attorney be suspended for six (6) months from the date of the Decision (i.e from 13 July 2023); and that
 2. Mr Massang's re-registration as a patent attorney be conditional upon him having completed to the satisfaction of the Board, ten (10) hours of CPE in the following areas:

⁸ *cf Professional Standards Board* at [46] and [54]

⁹ *Massang* at [166]

- a) Not less than four hours in relation to fundamental patent principles including the requirement for an invention to relate to patentable subject matter, be novel and involve an inventive step, and including the requirements under s 40 of the *Patents Act Cth 1990*; and
- b) Not less than four (4) hours in relation to practice management including file management and record-keeping.

12 September 2023

Siobhán Ryan KC

Dr Patrick McManamny

Mark Roberts