



THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
FICPI AUSTRALIA

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To: Janine Brown  
Trans-Tasman IP Attorneys Board IP Australia

Dear Ms Brown

### Review of the Code of Conduct – Consultation Paper

FICPI Australia welcomes the opportunity to respond to the Draft for Public Consultation of the Code of Conduct and Guidelines for Trans-Tasman Patent and Trade Marks Attorneys 2018, produced as a result of the Trans-Tasman IP Attorneys Board review of the Code of Conduct and thanks the Board for providing an extension of time to today to file our response.

#### About FICPI Australia

As you may be aware, FICPI Australia is an organisation whose members are all registered Patent Attorneys or Trade Marks Attorneys, or registered Patent and Trade Marks Attorneys who have senior roles in IP firms conducting business in Australia.

We now provide our response to the DRAFT Code of Conduct.

Overall FICPI Australia has no major issue with the DRAFT or the Guidelines as proposed.

The following points are raised to highlight what is considered to require additional clarity in the Code, or further explanation in the Explanatory Memorandum, or the provision of revised or additional Guidelines.

#### Code

##### 4 Definitions

- In the definitions of “ancillary business”, “incorporation group” and “partnership group” the term “ancillary” has been misspelt and should appear as “ancillary”.

##### 16 Communication

- Section 16 should explicitly apply to client attorney services so as to exclude the ambit of ‘ancillary business’ (defined) services being treated in the same manner, when that should not be in the purview of the Code.
- In subsection (1)(d) the term ‘legal personality’ intends to ensure that the new or prospective client is informed that the attorney is ‘registered’ but

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does that also require a 'patent attorney director' to inform the client of that status?

- In subsection (1)(f), the phrase "the member" should be corrected to "a member".
- Further, the requirement of subsection (1)(f) could be interpreted to mean that an individual member of a group MUST identify ALL other individual members of the 'ownership group'. However, the definition of 'ownership group' relates to an incorporation group or a partnership group. We submit that the requirement should be amended to clearly require that the new or prospective client be informed of the member groups rather than the individuals that are members of those groups.

## **19 Loyalty**

- In the Explanatory Notes terms such as 'obligation', 'expressly imposes' and 'prohibits' are used, whereas in the Code the operative term is 'must'. Consistency or careful use of appropriate terms in the Explanatory Notes is considered useful and of assistance to minimise different interpretations than intended.
- Subsection (6) is not clear about the meaning of 'confidential information relevant to the matter', since for example, is the financial status of a client considered relevant to a matter?

## **21 Independence**

- Given that the terms "independent" and "independently" are used for the first time in Section 21, and therefore not at all in Sections 19 and 20, it is suggested that Subsection 21(2) would read more clearly in the positive - for example, along the lines:

"For the purposes of sections 19 and 20, a registered attorney that is a member of an ownership group must operate independently of the other members of the group in the provision of attorney professional services to clients".

Further, it is noted that there is no definition or explanation of the terms "operate independently" and "attorney professional services".

- In Subsection 21(2) the words "in writing", for clarity should be moved to after the phrase "has given reasonably informed consent".

## **23 Ownership**

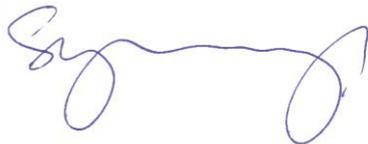
- Subsection (2) should be amended to replace 'identify' by 'identity'.
- The requirement to identify ALL other members of the ownership group could be interpreted to mean that all registered attorneys of the whole group MUST be clearly disclosed on ALL client and public communications. This is clearly impractical and surely not the intention of the section. Clarification is required. This is a similar issue to that raised in relation to subsection 16 (1)(d) and a similar amendment may apply.

## **24 Funds**

- With respect to subsection (4), the requirement of MUST give a client any refund does not allow that a client once informed that a refund of funds is possible may authorise the retention of those funds for future expenses. It is submitted that the subsection should be made "subject to any other agreement with the client.

If further explanation is required of the above or further comment sought on any particular aspect of the proposed new Code or Guidelines, FICPI Australia welcomes any request for such. Please contact our Secretary, Bill McFarlane or myself in relation to this matter.

Yours sincerely

A handwritten signature in blue ink, appearing to be 'Suzanne', written in a cursive style.

President – FICPI Australia

cc: FICPI Australia Councillors