

GUIDANCE NOTE April 2017
From the Designated Manager

Statement of Experience – Trade Marks Regulation 22.15(3)

To New Zealand applicants seeking registration as an Australian trade mark attorney under transitional arrangements:

The trans-Tasman patent attorney regime commenced on 24 February 2017. Regulation 22.15 of the *Trade Marks Regulations 1995* is a transitional provision allowing for a patent attorney registered in New Zealand immediately before the commencement date, to apply for registration as a trade marks attorney in Australia within 12 months of commencement.

One aspect of the application requirements is a statement of experience. While each application will be considered on a case by case basis, this note aims to provide guidance to assist applicants in preparing their statement.

Regulation 22.15(3) sets out what an applicant applying for registration must provide in their statement of experience:

- (3) For paragraph (2)(b), the statement of experience must:
 - (a) set out details of the applicant's experience in the following activities in the 5 years preceding the application:
 - (i) searching trade marks records;
 - (ii) preparing, filing and prosecuting trade marks applications in relation to Australia and New Zealand;
 - (iii) preparing, filing and prosecuting trade marks applications in relation to other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia and New Zealand;
 - (iv) providing advice on the validity and infringement of trade marks; and
 - (b) contain a declaration, signed by the applicant, that the details of the applicant's experience set out in the statement of experience are true and correct; and
 - (c) be accompanied by evidence of such experience.

The statement must satisfy the Designated Manager that the applicant's level of competency in trade marks law and practice is sufficient to warrant the applicant becoming a registered Australian trade marks attorney. Each part of regulation 22.15(3) must be addressed, however information can be provided at a high level and it is not necessary to list specifics of cases. If there are some aspects of your application that need further clarification or additional information you will be contacted via email requesting this.

Factors to consider when preparing the statement include:

- the applicant's current and previous positions in regard to trade mark matters within a practice and years of experience in those positions.
- the range, breadth and complexity of trade mark cases prosecuted by the applicant, including searching, in Australia and New Zealand.
- the range of trade marks prosecuted in other jurisdictions. This could include working with international associates, and noting this does not need to cover every jurisdiction.
- outlining relevant experience in validity and infringement of trade marks including any high profile matters.

- Addressing the factors above will generally meet the requirement of 22.15 (3) (c).
- outlining any other relevant experience or position held - this could cover professional memberships and publications.



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13 April 2017