



**Australian Government**



**Te Kāwanatanga o Aotearoa**  
New Zealand Government

# Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Trans-Tasman Regulation of Patent Attorneys

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IP Australia  
New Zealand Ministry of Business, Innovation and Employment

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# Executive Summary

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The *Arrangement between the Governments of Australia and New Zealand relating to the Trans-Tasman Regulation of Patent Attorneys* (the **Arrangement**) requires that a review of the effectiveness of the registration regime be undertaken within five years of its implementation in February 2017. This is a joint government report on that review.

The issues considered are framed upon the six objectives of the Arrangement, which are to:

1. strengthen the relationship between Australia and New Zealand;
2. provide a joint registration regime for patent attorneys to register and practise in Australia or New Zealand and between Australia and New Zealand;
3. allow economies of scale to be achieved in institutional arrangements for regulating patent attorney services;
4. minimise the regulatory and business compliance costs for patent attorneys to practise in Australia or New Zealand and between Australia and New Zealand;
5. increase business confidence in the quality and standard of service provided by patent attorneys, especially when patent attorneys provide services on a trans-Tasman basis; and
6. facilitate competition in the market for patent attorney services.

IP Australia (**IPA**) and New Zealand's Ministry of Business, Innovation and Employment (**MBIE**) collected information on issues through a public consultation on the regime. The consultation ran from 17 November 2021 to 2 February 2022 and received seven submissions.<sup>1</sup>

In addition to the consultation process, IPA and MBIE have considered research, stakeholder feedback, and issues raised through direct contact with the Secretariat. IPA specifically commissioned work by Dr Vivienne Thom as part of its input into the review.

At a high level, the regime is working well, and the review concluded that:

- there are no substantive issues with the regime's performance, but some minor issues were identified around the administration of the regime;
- the Arrangement does not require any amendments; and
- several improvements could be made to address the minor administrative issues identified.

The issues identified are discussed at length in this report. IPA and MBIE have summarised the improvements to address these in twelve recommendations.

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<sup>1</sup> The submitters are listed in **Annex 1**.

# List of Recommendations

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1. The Trans-Tasman IP Attorneys Board (the **Board**), with IPA and MBIE, should continue to monitor the availability of suitable courses to qualify as patent attorneys.
2. The Board should review the accredited courses to qualify as a patent attorney to ensure they reflect current law and practice.
3. IPA and MBIE should consult further with the profession about the location conditions specified for the employment requirements under regulation 20.10 of Australia's *Patents Regulations 1991*. Ministerial consideration of possible amendments may be required.
4. IPA and MBIE should consider candidates with appropriate educational knowledge as part of the Board appointments process. If the Board does not have the relevant educational knowledge, they should consider obtaining independent expert advice about course accreditation and contemporary educational methodology.
5. The Board should continue its work to provide more:
  - a. guidance and general information to attorneys, especially about conflicts of interest, complaints, and discipline matters.
  - b. educational resources to the profession, such as seminars and presentations on subject matter of interest. This would include the Board continuing its work to pilot continuing professional education courses on professional conduct, ethics and other topics of interest.
6. The Board should continue to regularly review the Code of Conduct as required by the Arrangement. Such a review should include consideration of the protection available to complainants and whether the Code of Conduct should provide a clause that bars attorneys from launching defamation proceedings or other legal action in certain circumstances.
7. IPA and MBIE should consider methods to modernise and simplify the disciplinary process. Ministerial consideration of possible amendments to Australia's *Patent Regulations 1991* may be required. Consideration should include:
  - a. Whether to empower:
    - i. The Board to investigate alleged misconduct of a previously registered attorney
    - ii. The Board to commence or continue disciplinary proceedings against a previously registered attorney
    - iii. The Trans-Tasman IP Attorneys Disciplinary Tribunal to impose certain penalties, such as suspension or conditions for reregistration, where it finds an attorney guilty of professional misconduct or unsatisfactory professional conduct.
  - b. The inequity of disciplinary actions allowable against an individual attorney versus an incorporated attorney.
  - c. The use of suitably experienced administrative staff to triage cases and decide on simple matters.

8. IPA and MBIE should review the reregistration and restoration criteria and consider providing more rigorous requirements of good fame, integrity, and character to those seeking reregistration or restoration. Ministerial consideration of possible amendments to Australia's *Patent Regulations 1991* may be required.
9. The Board, with IPA and MBIE, should continue to provide information to the profession, potential clients, and the public about the regime and the ability for patent attorneys to operate across both jurisdictions. This content should continue to be easily and readily available, with consistent information across jurisdictions and platforms.
10. IPA and MBIE should investigate the prevalence of non-registered persons providing patent attorney services in Australia and New Zealand, including foreign attorneys, and any negative impacts upon the end users of the Australian and New Zealand patent systems.
11. The Board's annual report should include an update on the progress of any recommendations assigned to the Board. IPA and MBIE should report on the progress of other recommendations as appropriate.
12. IPA and MBIE should continue to monitor the regime and commence a further review in 5 years' time from the publication of this report to ensure the Arrangement is still working effectively.

# Analysis

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## 1. Introduction

- 1.1 Part 12 of the Arrangement between the Governments of Australia and New Zealand requires that a review of the effectiveness of the joint registration regime be carried out no later than five years after its implementation in February 2017.
- 1.2 As part of this review, IPA and MBIE ran a public consultation from 17 November 2021 to 2 February 2022, which received seven submissions.<sup>2</sup> IPA and MBIE also considered research, stakeholder feedback, and issues raised directly with the Secretariat. IPA also commissioned work by Dr Vivienne Thom as part of its input into the review.
- 1.3 This report sets out the findings and conclusions of the review, including IPA and MBIE's observations and recommended actions in relation to the issues raised. The issues considered are framed upon the six objectives of the Arrangement, which are to:
  1. strengthen the relationship between Australia and New Zealand;
  2. provide a joint registration regime for patent attorneys to register and practise in Australia or New Zealand and between Australia and New Zealand;
  3. allow economies of scale to be achieved in institutional arrangements for regulating patent attorney services;
  4. minimise the regulatory and business compliance costs for patent attorneys to practise in Australia or New Zealand and between Australia and New Zealand;
  5. increase business confidence in the quality and standard of service provided by patent attorneys, especially when patent attorneys provide services on a trans-Tasman basis; and
  6. facilitate competition in the market for patent attorney services.
- 1.4 The consultation also included a section on the Australian trade marks attorney registration regime, but this does not form part of this joint review. IPA's independent responses to the issues raised regarding this regime are set out in Annex 3.

## 2. The Relationship Between Australia and New Zealand

- 2.1 The Arrangement seeks to strengthen the relationship between Australia and New Zealand to continue the mutually beneficial economic and trade ties that currently exist.

### Issues Raised

- 2.2 Most submitters expressed the view that they were unable, or not well placed, to comment on the impact the regime has had on the broader relationship between the countries. However, two submitters commented on the relationship between attorneys from each country.
- 2.3 Although an Australian submitter considered that there was no major impact on relationships with their New Zealand counterparts, a New Zealand submitter considered the collegial relationship between attorneys of the two countries had been negatively impacted.

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<sup>2</sup> The submitters are listed in **Annex 1**.

## **Observations**

2.4 Whilst attorneys can now offer their services across jurisdictions, creating a larger pool of competitors, there is no evidence that this has impacted the relationship between the countries themselves.

## **Recommendation**

2.5 Nil.

## 3. Impact on Availability of Patent Attorneys

3.1 The Arrangement creates a joint registration regime for patent attorneys to register and practise in Australia or New Zealand and between Australia and New Zealand. Prior to the Arrangement, patent attorneys had to independently register in each country to practise.

## **Issues Raised**

3.2 Most submitters considered that there has either been no notable impact on the availability of patent attorney services or that it was too soon to assess the impact of the regime. It was also noted that availability was affected by factors unrelated to the regime itself, including training requirements and the small number of positions in firms.

3.3 Notwithstanding, some submitters commented on the regime's impact on market choice. One stated that mergers may have reduced the number of experienced attorneys, but an increase in small firms may be seen to provide new options to consumers. Another considered the regime has led to 'mega-groups', with staff 'splintering off' only giving the appearance of more choice.

3.4 There was also a concern that attorney registration data did not reveal underlying demographic trends and ageing of the profession, which may impact future availability.

## **Observations**

3.5 There is no evidence showing availability of patent attorney services has changed due to the regime. There is also no information available to monitor the age demographic of the patent attorney profession.

3.6 Competition is monitored by specialist bodies, namely the Australian Competition and Consumer Commission (**ACCC**) in Australia and the Commerce Commission (**CC**) in New Zealand.

3.7 In 2019, the ACCC completed a market analysis of a proposed merger between the second and third largest providers of IP services in Australia, and determined this would not substantially lessen competition in the relevant market as there were a number of alternative large and medium suppliers. Similarly, in 2020 the CC granted clearance for one of the largest providers of specialised IP services in New Zealand to acquire another New Zealand IP service provider.

## **Recommendation**

3.8 Nil.

## 4. Economies of Scale in Institutional Arrangements

- 4.1 Administration of the Board is undertaken by a small secretariat team comprised of IPA employees. This institutional arrangement allows for economies of scale, avoiding the duplication of effort found in separate regulatory systems.

### Issues Raised

- 4.2 No suggestions were made to improve the economies of scale under the joint regime.

### Recommendation

- 4.3 Nil.

## 5. Regulatory and Business Compliance Costs

- 5.1 The joint regime reduces the compliance costs for attorneys to practise across both countries by only requiring a single registration.

### Issues Raised

#### *Registration and Renewal Fees*

- 5.2 Australian submitters generally supported the current business and compliance costs for patent attorneys, with one stating that there have been modest savings in money and another commending the single-fee practice.
- 5.3 On the other hand, New Zealand submitters stated that compliance costs for local patent attorneys have not reduced. Although registration fee payments are simplified, as they are only paid to a single entity, the fees themselves are slightly higher compared to the old regime.

#### *Continuing Professional Education Fees*

- 5.4 A submitter proposed that continuing professional education (**CPE**) courses on professional conduct and ethics should be available at no or low cost because of their universal nature and importance.

#### *Qualification and Course Costs*

- 5.5 New Zealand submitters were generally concerned about the increase in qualification costs when compared to the previous New Zealand regime. An Australian submitter stated that, aside from reducing registration fees, other costs cannot be avoided or minimised without harming the quality of patent attorney services.

### Observations

#### *Registration and Renewal Fees*

- 5.6 In line with the arrangement establishing the regime, fees are reviewed by the Director General of IPA every four years in accordance with the Australian Government Cost Recovery Policy. The current registration fees are set to recover the costs of administering the regime and will be reviewed in accordance with the above arrangements in 2024.



### *Continuing Professional Education Fees*

- 5.7 Steps are already being taken by the Board to pilot CPE courses on professional conduct and ethics. Whilst the costs of these are yet to be determined, the regime is administered on a cost recovery basis so any sessions would attract a fee.

### *Qualification and Course Costs*

- 5.8 Qualifications and training requirements are discussed in depth later in this paper (Part 6.A). Although the cost of education has increased in New Zealand, this reflects the fact that it no longer depends on volunteers from the profession setting and marking examination papers on a pro bono basis.
- 5.9 The current system, which is run through universities, is seen as more robust and equitable. The previous New Zealand regime favoured larger firms as they had more resources to support trainees. The university system puts trainees outside larger firms on a more equal footing.

### **Recommendation**

- 5.10 Nil.

## 6. Business Confidence in the Quality and Standard of Service

- 6.1 The joint regime supports the quality and standard of service provided by patent attorneys by:
- prescribing qualifications and training prior to registration;
  - setting standards of conduct and ethical practice for the profession;
  - requiring ongoing professional development; and
  - providing a complaints and disciplinary process to address breaches of required standards of conduct and ethical practice.
- 6.2 In 2021 the Code of Conduct and the associated guidelines were reviewed by Professor Andrew Christie on behalf of the Board.

## A. Qualifications and training requirements to register

### **Issues Raised**

#### *Course Quality, Costs and Availability*

- 6.3 Australian submitters tended to be less critical of the current qualifications and training requirements, with one stating that generally a suitable balance was achieved between the quality of services provided by new entrants and the availability and affordability of services. Another noted that educational requirements do not adversely impact those wanting to register and practise and, like other professions that value university education, persons choosing to join it must determine the cost-benefit of this and be aware of trainee demand.
- 6.4 Although some issues were raised, such as difficulties getting into courses, timetable clashes and educators not being adequately compensated despite high course costs, it was acknowledged that the small number of students makes more course options challenging.

- 6.5 On the other hand, New Zealand submitters raised concerns about course quality, increased qualification costs and the limited qualification options delivered in New Zealand. Despite it being too soon to assess the full impact of the regime, a submitter expected a decrease in trainees because of costs and considered that such costs have a greater impact on local firms and businesses as they are generally smaller.
- 6.6 Multiple submitters expressed opposition to a reduction of the time required to qualify, with one emphasising that it takes years to develop the knowledge and skills needed to practise. Another opposed the reduction in qualification or training requirements more generally as it would lower standards for newly registered patent attorneys in the profession.
- 6.7 Suggestions from submitters to improve the regime included:
- subsidies for firms to train patent attorneys;
  - a bilateral system with foundation-level courses being offered through universities and advanced practical papers offered through a professional body;
  - approaching additional universities to offer courses; and
  - a deferred education expense scheme, with fees paid after registration.
- 6.8 Dr Thom suggested that IPA and MBIE monitor the availability of accredited courses to assess the risk of topics being unavailable and determine whether intervention is required. It was also suggested that the Board review the 2016 curriculum to ensure it reflects current law and practice and contains sufficient details in all topics to facilitate candidates seeking exemptions.
- 6.9 Beyond this, she proposed that the Board consider obtaining independent expert advice about course accreditation and contemporary educational methodology if no members have relevant experience.

#### *Experience Requirements*

- 6.10 Suggestions about experience requirements varied, including patent examiner experience being considered as part of mandatory work experience and limitations being placed on inexperienced attorneys practising alone or in small firms.
- 6.11 Geographic requirements imposed on the employment experience required under Regulation 20.10 was also raised as being inappropriate in this time of flexible working and virtual collaboration. It was noted that, as Australian and New Zealand firms are increasingly operating internationally, attorneys will leave these countries to set up new offices and, during this time, mentor and train new trainees outside the geographical boundaries.
- 6.12 Separate to geographic requirements, applicants must demonstrate extensive experience with filing and prosecuting applications in Australia and New Zealand. It was suggested that the requirements of the statements of skill are higher in practice than the regulations, focusing on quantity rather than quality, and that more guidance would be beneficial on the requirement to have appropriate competency in the field relevant to a patent.
- 6.13 Dr Thom proposed that IPA and MBIE should review this requirement to establish whether a period of employment outside of Australia or New Zealand, but under the supervision of an Australian or New Zealand patent attorney, could fulfil this requirement.

## Observations

### *Course Quality, Costs and Availability*

6.14 The costs charged for courses are not unusual or excessive for a skilled profession with high earning potential. No practical alternatives have been suggested to reduce these costs and it is beyond the remit of the regime to influence university fees. Although not all courses are provided in each country, this could lead to higher costs because of the limited number of students. A balance needs to be struck so changes do not have unintended consequences.

6.15 Regarding submitters' suggestions, we note that:

- There is no evidence of a patent attorney shortage, so it is unclear why their qualifications should be subsidised by the governments over other occupational groups and professions.
- A bilateral system would not be a practical solution to ensure availability and quality, while reducing course costs. This implies courses would be run by another institution or body at a reduced cost compared to the university-run courses. University fees are market driven and, as there are currently multiple suppliers providing accredited courses, it is expected that these would be competitive. If a hybrid system was in place and the number of university courses decreased this would likely make providing courses less financially viable. This would, in turn, risk increased costs or courses being dropped from universities altogether.
- An increase in the number of universities providing courses is not necessarily beneficial as, if the pool of applicants does not increase, this could make them more expensive or unviable.
- There is no evidence to support a deferred education expense scheme. Many firms already pay for trainees' education as part of their employment, and it is for each individual government to determine to what extent they wish to loan money for postgraduate tuition.

6.16 The Board, with IPA and MBIE, already monitor the availability of accredited courses. Concerns have been raised in discussions with Victoria University of Wellington about inconsistent levels of prescribed content among the different topic areas of the curriculum. Lower levels of prescription can make it difficult for universities to design a course that satisfies the Board's accreditation requirements. The current curriculum was developed prior to the Arrangement and is due for review.

### *Experience Requirements*

6.17 The purpose of work experience is to ensure patent attorneys have the skills to provide quality services to clients without the need for further supervision. The Designated Manager and the Board do not consider work as a patent examiner is appropriate work experience alone given that patent examiners have different knowledge, experience, and skills to attorneys. There is also insufficient evidence to suggest recently registered sole practitioners are causing poor client outcomes. Customers can decide who to hire and can consider experience when making this decision.

- 6.18 The purpose of geographical requirements is to ensure trans-Tasman patent attorneys have a strong understanding of, and practical experience in, Australian and New Zealand patent law. However, there is no requirement that a registered attorney must remain in Australia or New Zealand to maintain registration and a significant number of registered trans-Tasman patent attorneys are located overseas. As remote working increases and firms expand their offices across the Asia-Pacific region, it may be possible to gain an appropriate level of knowledge and experience without working physically in Australia or New Zealand.
- 6.19 To qualify, candidates need to obtain a statement of skill from an experienced registered trans-Tasman patent attorney, which implicitly requires supervision by such a person. Although they can apply to the Board for a statement if they cannot obtain one, the Board will not provide this if there has been no supervision by a registered attorney. At present, the regulations only state that a statement of skill needs to be provided and what it needs to address. This statement is accepted if those minimum requirements are fulfilled.

### **Recommendations**

- 6.20 The Board, with IPA and MBIE, should continue to monitor the availability of suitable courses to qualify as patent attorneys.
- 6.21 The Board should review the accredited courses to qualify as a patent attorney to ensure they reflect current law and practice.
- 6.22 IPA and MBIE should consult further with the profession about the location conditions specified for the employment requirements under regulation 20.10 of Australia's *Patents Regulations 1991*. Ministerial consideration of possible amendments may be required.
- 6.23 IPA and MBIE should consider candidates with appropriate educational knowledge as part of the Board appointments process. If the Board does not have the relevant educational knowledge, they should consider obtaining independent expert advice about course accreditation and contemporary educational methodology.

## **B. Confidence in the profession's standard of service**

### **Issues Raised**

#### *CPE Requirements*

- 6.24 Submitters generally supported current CPE requirements, referring to them as flexible, fair, balanced, appropriate, and achievable. That said, improvements were suggested including:
- up to one hour per year for mental health management; and
  - flexibility to 'catch up' if an area was lacking in a given year.
- 6.25 Dr Thom suggested that the Board look to facilitate and promote a greater range of CPE on topics not already covered in courses, or by existing providers, and consider facilitating and endorsing training on professional conduct.

### *Board Involvement in Compliance*

6.26 Most submitters agreed on the desirability of a modern approach to compliance which is based on supporting practitioners to meet their obligations. Suggestions for how the Board and Secretariat might undertake a more coordinated and proactive approach included:

- publishing anonymised summaries of complaints to the Board, including the outcome and any recommendations to assist attorneys on how to avoid such complaints;
- delivering seminars, webinars, or similar activities to attorneys on the topic of compliance with the Code of Conduct;
- streamlining the disputes process, including the provision of a simplified response system for attorneys to mitigate the impact of vexatious complaints, introduction of a fee for vexatious complaints, and mediation for primarily financial disputes.

6.27 Dr Thom considered there was a need for businesses to be better informed about the profession and trans-Tasman arrangements. It was suggested the Board could develop a targeted campaign for SMEs to promote confidence in, and awareness of, registered attorney professions and the trans-Tasman arrangements.

### **Observations**

#### *CPE Requirements*

6.28 The Designated Manager determines what CPE activities are suitable. Relevant skills, such as practice management, can already be counted towards CPE hours. The regulations also allow conditional approvals for attorneys who provide a valid reason for falling short on their hours in a registration period, provided the shortfall is addressed the following year.

6.29 The Board is currently working on CPE improvements, including the facilitation of CPE courses. We acknowledge that there are time and cost commitments involved in the Board taking on these additional roles and functions, which must be weighed against its other responsibilities and reflected in the recovery of costs in line with the requirements of the regime.

### *Board Involvement in Compliance*

6.30 The profession's desire for more information and guidance from the Board regarding complaints, professional conduct matters, and the Code of Conduct has been communicated during previous consultations, such as the 2021 health check of the Code of Conduct.

6.31 The Board has already begun work on the delivery of educational activities, such as webinars, on the topic of the Code of Conduct, as well as professional conduct and ethics more generally. Operational issues raised by submitters, along with the practicality of fees for vexatious complaints and mediation, are discussed under Part 6.E below.

6.32 The Board is not responsible for the promotion of patent attorney services, this ought to come from attorneys themselves. We do not consider there is sufficient evidence that a targeted campaign is necessary in the short term. That said, the Board may choose to promote the regulatory system and its benefits as part of its role in the future.

### **Recommendation**

6.33 The Board should continue its work to provide educational resources to the profession, including piloting CPE courses on professional conduct, ethics and other topics of interest.

## C. Code of Conduct and the disciplinary regime

### Issues Raised

#### *Effectiveness of the Code of Conduct*

6.34 Most submitters who commented on the Code of Conduct agreed it is an effective mechanism for regulating conduct and providing confidence in the standards of the profession. Some suggestions a submitter made for enhancements as part of the 2021 health check of the Code of Conduct were repeated, including providing:

- more prescription regarding the requirement, under sections 19 (Loyalty) and 21 (Independence), that an attorney gains 'informed consent' from clients;
- more prescription around when an attorney that works part-time as an in-house attorney and part time in private practice may have conflicting interests with clients;
- a mechanism by which a complainant's or information provider's identity could be kept confidential to the extent that natural justice permits; and
- more guidance on the requirement that an attorney have appropriate competency for the work they undertake, in the context of familiarity with a particular field of science or engineering relevant to a patent.

#### *Alternatives to the Code of Conduct*

6.35 No submissions suggested suitable alternatives to a Code of Conduct. It was submitted that the combination of a Code of Conduct, supported by guidelines, is an authoritative yet flexible instrument. It was also suggested that regulations be a last resort and the aims of the Code of Conduct be supported through training and guidance across the skills required to practise.

### Observations

#### *Effectiveness of the Code of Conduct*

6.36 The content of the Code of Conduct and its efficacy, including the above issues, were considered in the health check of the Code of Conduct commissioned by the Board in 2021.

6.37 The report found that the Code of Conduct has no major deficiencies. However, it did make recommendations to enhance the guidelines and other actions to further the objectives of the Code of Conduct, the majority of which the Board resolved to implement in April 2022.

#### *Alternatives to the Code of Conduct*

6.38 The notion that there is no need to consider alternatives to a Code of Conduct is supported by findings in the 2021 health check. The issue of providing support and guidance as a proactive means to prevent professional conduct issues is discussed under Part 6.B above.

### Recommendation

6.39 The Board should continue to regularly review the Code of Conduct as required by the Arrangement.

## D. Voluntary removal from the register and the disciplinary regime

### Issues raised

6.40 The Board can only investigate complaints about the conduct of registered attorneys. Under current circumstances, if an attorney is aware they will be subject to a complaint they could avoid investigation by removing their registration or allowing it to lapse.

6.41 All submissions discussing the application of the disciplinary regime following voluntary removal from the register agreed that:

- there should be some mechanism to ensure attorneys cannot use voluntary removal or discontinuing registration to avoid disciplinary proceedings; and/or
- they should face some bar to reregistration in such circumstances. Submitters generally felt the matter should be addressed before an attorney could resume work, with one suggesting this should include work in any capacity for a patent attorney firm.

6.42 Submitters noted that most of the penalties applicable would not be relevant where an attorney is not currently registered, but that possible options could include:

- requiring that matters be satisfactorily resolved, or a suspension period served, before reregistration could occur.
- imposing a temporary bar on reregistration (i.e., where registration would have been revoked).
- requiring the attorney to undertake additional CPE before reregistration.
- requiring the attorney to work under supervision for a period of time following reregistration.
- administering a public reprimand.

6.43 It was also suggested that possible penalties should be balanced and flexible, noting that where a voluntary removal is in good faith, this should be considered (e.g. an attorney acknowledging that they are not fit to continue practising).

### Observations

6.44 If an attorney is aware they will be subject to a complaint, they could avoid investigation by removing their registration or allowing it to lapse. However, it may still be in the public interest for allegations to be investigated and for a finding to be made. This would ensure that, if the accused returned to practise, the issues are addressed and the public is protected.

6.45 Where Trans-Tasman IP Attorneys Disciplinary Tribunal (**Tribunal**) proceedings have commenced there is a benefit to completing the process and having a finding as to the attorney's guilt, whether or not they are registered. However, this may involve the Tribunal having flexibility to decide whether proceedings should continue, having regard to the seriousness of the allegations and the stage of the proceedings.

6.46 Parties to proceedings before the Tribunal typically obtain legal representation and proceedings can involve considerable expense to the parties even before the hearing. Therefore, allowing proceedings to discontinue may result in wasted resources, no satisfactory outcome for a complainant and no means to ensure the public is protected from future misconduct. On the

other hand, where proceedings are at an early stage, the cost of continuing may not always justify the benefits where the accused is no longer practising as an attorney.

6.47 Where an attorney removes themselves from the register at any point following the submission of a complaint, it may be appropriate that they are not allowed to reregister without addressing the complaint to the satisfaction of the Board. If proceedings do continue after deregistration, a bar or suspension from reregistration may be an appropriate penalty.

6.48 To assist the analysis of options in this area, Dr Thom's report considered the regulation of similar professions within Australia, namely migration agents and tax practitioners. The regime for migration agents allows investigations to be started or completed when they are no longer registered, so long as the complaint was received within 12 months after their registration ceased. The Australian Government has agreed to a similar provision for tax practitioners.

### **Recommendations**

6.49 IPA and MBIE should consider methods to modernise and simplify the disciplinary process. Ministerial consideration of possible amendments to Australia's *Patent Regulations 1991* may be required. Consideration should include whether to empower:

- i. The Board to investigate alleged misconduct of a previously registered attorney
- ii. The Board to commence or continue disciplinary proceedings against a previously registered attorney
- iii. the Tribunal to impose certain penalties, such as suspension or conditions for reregistration, where it finds an attorney guilty of professional misconduct or unsatisfactory professional conduct.

6.50 IPA and MBIE should review the reregistration and restoration criteria and consider providing more rigorous requirements of good fame, integrity, and character to those seeking reregistration or restoration. Ministerial consideration of possible amendments to Australia's *Patent Regulations 1991* may be required.

## **E. Conduct investigations and processes**

### **Issues raised**

6.51 Several submitters raised potential issues with the current Board processes for investigating professional misconduct claims, including:

#### *Procedural Matters*

- the need for a more detailed and prescriptive investigation process to ensure the regime is transparent and consistently applied, and a proper process is followed;
- attorneys being repeatedly asked for further information without being informed of all details and the basis of the complaint;
- that current Tribunal processes mimic courts and are overly legalistic for an administrative decision-making body;
- the length of time it takes for matters to be investigated and resolved;



### *Complaints and Dispute Resolution*

- the perception that it is too easy for a complaint to be made to the Board and have the Board commence an investigation;
- the need for attorneys to commit significant time and resources to defend against vexatious complaints or complaints used to attempt to avoid payment of fees;
- the lack of a limited period within which a complaint may be brought; and
- the current system does not provide any resolution for clients - the only options are to refer the matter to the Tribunal or discontinue the investigation.

6.52 Potential issues were also raised in the 2021 report on the health check of the Code of Conduct. Although not formally a part of this review, this is a relevant resource that, at paragraph 154, recommended:

*The Board should conduct a review of the processes it adopts when responding to receipt of a complaint about an attorney. Such a review should consider identifying staged objectives for complaint handling – e.g., whether the initial objective should be a settled outcome obtained through the process of mediation or conciliation. Other matters the review should address are the “triaging” of complaints, the degree of detail required from a complainant before commencing substantive investigation, and the formal process of a substantive investigation.*

6.53 Dr Thom supported this and suggested that IPA and MBIE should review the disciplinary and complaint-handling regime and whether existing powers available to the Board to obtain information are sufficient. As part of this, she thought the question of retaining professional privilege over material disclosed to the Board should be considered.

### **Observations**

#### *Procedural Matters*

6.54 It is clear from the number of submissions that there are several concerns around the current disciplinary processes, particularly regarding the lack of clear and transparent procedures and the time it takes to resolve complaints.

#### *Complaints and Dispute Resolution*

6.55 Granting limited powers to the Board or the Tribunal to caution an attorney or require them to perform an action in certain situations could allow for better efficiency and client outcomes.

6.56 The benefits of other dispute resolution options, such as referring matters to mediation, would need to be weighed against their disadvantages, such as increased fees due to any associated costs. The Professional Standards Board under the previous Australian regime attempted to introduce other options, but this was discontinued due to concerns raised by the attorney profession. Whilst individuals and smaller firms liked the idea of alternative dispute resolution, mainly in the form of mediation, attorneys were hesitant to support the idea due to concerns around enforcement of outcomes and the high fees charged by professional mediators.

6.57 The Board has discretion in whether it investigates a complaint and whether to commence proceedings (except where it is likely the attorney would be found guilty of professional misconduct). Although a fee for vexatious complaints was suggested, this could prevent people coming forward. If complaints are triaged appropriately this would prevent clearly vexatious complaints being investigated further.

6.58 The Tribunal also has significant discretion in relation to penalties. This flexibility allows the Board and Tribunal to consider the time since the alleged conduct issues as a relevant factor throughout the process.

### **Recommendation**

6.59 IPA and MBIE should consider methods to modernise and simplify the disciplinary process (recommended under Part 6.D above). In doing so, they should investigate the use of suitably experienced administrative staff to triage cases and decide on simple matters.

## 7. Competition in the Market

7.1 The joint regime allows Australian and New Zealand patent attorneys to distinguish themselves on the standards, quality, and price of their services, rather than solely on their location. Competition can provide a greater choice to businesses seeking patent attorney services in one or both countries.

### **Issues raised**

#### *Facilitating practising across both countries*

7.2 Most submitters supported provision of more information about the regime and the benefits of engaging registered patent attorneys. It was emphasised that businesses with less intellectual property experience, such as small and medium-sized enterprises (**SMEs**), were unlikely to be aware of the regime or easily find relevant information. While intellectual property offices may be the first port of call for information for some businesses, businesses may also look to attorney firms for relevant information.

7.3 When it comes to marketing patent attorney services themselves, it was suggested that it is up to attorneys and their firms to do this and that the services of attorneys in one country should not be promoted over those in another. Another submitter believed no additional information is needed and clients can make appropriate commercial decisions.

#### *Access to more affordable services*

7.4 Submissions noted that the issue of affordability of patent attorney services for SMEs is largely affected by factors outside the control of the trans-Tasman patent attorney regime.

7.5 Australian SMEs who provided input on the regime in discussions with IPA indicated that, although patent attorney fees could be expensive, they did not consider them to be unreasonable, and that the services provided a return on value.

### **Observations**

#### *Facilitating practising across both countries*

7.6 Demonstrating effective competition is challenging due to the small size of the profession, short duration of the regime, and absence of comparable data. External market forces and the operating environment of the last two years due to the COVID-19 pandemic will have also impacted the market for patent attorney services.

- 7.7 One of the objectives of the regime is to facilitate competition in the market for patent attorney services, by allowing patent attorneys to freely provide services across Australia and New Zealand. For this to be achieved, potential users of patent attorney services should be made aware that patent attorneys in both countries can do work in both jurisdictions, so they can make an informed selection. This is not to suggest that such information should advise the public to hire attorneys in general or in one country over another.
- 7.8 Providing easily accessible information, which highlights the ability of trans-Tasman patent attorneys to operate in both jurisdictions, supports the regime's objectives without bias. IPA and MBIE both have information about the regime on their websites.

#### *Access to more affordable services*

- 7.9 Although the affordability of patent attorney services may be a barrier for some smaller businesses, the factors contributing to this issue and the potential means of addressing them are largely unrelated to the regime and are beyond the scope of this review.

#### **Recommendation**

- 7.10 The Board, with IPA and MBIE, should continue to provide information to the profession, potential clients, and the public about the regime and the ability for patent attorneys to operate across both jurisdictions. This content should continue to be easily and readily available, with consistent information across jurisdictions and platforms.

## 8. Other Issues

- 8.1 The final question posed in the review was a call for submitters to provide any other issues regarding the operation of the joint registration scheme or the regulation of services provided by patent attorneys. If an issue was raised, suggestions for how to address it were encouraged.
- 8.2 Most submitters raised one or more issues in response to this question or, in answering the questions above, raised issues more appropriately addressed separately. Several noteworthy issues raised within the scope of this review are set out below. These issues are highlighted as they were raised by multiple submitters or were closely linked to key areas of the regime.

### A. Services provided by overseas practitioners

#### **Issue raised**

- 8.3 One member organisation raised concerns about non-registered persons providing patent attorney services from overseas, noting that their members had been approached by overseas entities offering to do patent work. Dr Thom's report also noted that practitioners had heard anecdotal reports of some patent work being subcontracted outside Australia or New Zealand.
- 8.4 Concerns were raised about the quality of the work being performed by overseas operators, whether confidentiality requirements were being observed, the lack of regulation of overseas operators, and the disadvantage posed to registered practitioners competing with unregistered operators without the same compliance costs.

## **Observations**

- 8.5 The issue of services being sub-contracted to entities outside Australia and New Zealand was considered as part of the 2021 health check of the Code of Conduct. The Board accepted the recommendation to include clarification that the obligation of disclosure requires an attorney to inform the client of the person by whom work has been undertaken where that person is not the attorney or a member of their firm. A registered attorney is also responsible for the work any non-attorneys do on their behalf.
- 8.6 The regime only regulates patent attorney services provided in Australia and New Zealand. There is limited scope to address the risk arising from businesses, especially foreign businesses, using the services of unregulated persons located in other countries. IPA and MBIE, as the administrators of the Australian *Patents Act 1990* and New Zealand *Patent Act 2013* respectively, can only take action when such persons provide patent attorney services in Australia and New Zealand.

## **Recommendation**

- 8.7 IPA and MBIE should investigate the prevalence of non-registered persons providing patent attorney services in Australia and New Zealand, including foreign attorneys, and any negative impacts upon the end users of the Australian and New Zealand patent systems.

## **B. Action taken against complainants**

### **Issue raised**

- 8.8 Concerns have been raised directly with IPA, and submitted as part of this review, about the lack of protection for complainants. It was suggested that the Code of Conduct should bar attorneys from taking legal action (specifically defamation proceedings) against someone who has made a complaint against them, except where that complaint was vexatious or malicious. Alternatively, adding a new regulation offering specific protection if the complaint was found to have merit was proposed.

### **Observations**

- 8.9 Threatening legal action or other intimidatory tactics to dissuade complaints which are well-founded could affect the Board's ability to regulate professional conduct and identify professional misconduct or unethical behaviour. However, it is not clear if this is a significant issue in practice, and it was not raised as part of the 2021 health check of the Code of Conduct.

### **Recommendation**

- 8.10 The Board should continue to regularly review the Code of Conduct as required by the Arrangement (recommended under Part 6.C above). In doing so, the Board should consider the protection available to complainants and whether the Code of Conduct should provide a clause that bars attorneys from launching defamation proceedings or other legal action in certain circumstances.

## C. Treatment of individual and incorporated attorneys

### Issue raised

8.11 One submission related to regulation 20.10, which provides that the Board can apply to the Tribunal to cancel or suspend an incorporated patent attorney's registration after an employee patent attorney has been found guilty of professional misconduct. That is, unlike individuals, incorporated attorneys can only be subject to disciplinary proceedings where:

- an attorney employee or officer of the incorporated attorney has been identified and found guilty of having breached the Code of Conduct or otherwise contravened the regulations.
- that individual has been found guilty of the more serious offence of professional misconduct, rather than merely unsatisfactory professional conduct; and
- that attorney's registration has been suspended or cancelled.

8.12 Inconsistency was also noted between the limited ability for the Board to bring proceedings against an incorporated attorney and the provisions of the Code of Conduct that apply explicitly to incorporated attorneys (e.g. sections 12(3)(a) and 16(1)(d)). Needing to complete proceedings relating to an individual before action can be brought against the incorporated attorney can be inefficient, particularly in situations where attorneys are jointly responsible or if there are concerns about governance arrangements and no individual is directly responsible.

8.13 Dr Thom suggested IPA and MBIE review the ability of the Board to initiate disciplinary proceedings against an incorporated attorney and propose legislative amendment if appropriate.

### Observations

8.14 There are sound reasons for some differences to exist between the disciplinary provisions for incorporated attorneys and individual attorneys. In particular, the suspension or cancellation of an incorporated attorney's registration may have far more serious ramifications, impacting several employee attorneys as well as their clients.

8.15 That said, there are potential gaps in the professional conduct regime. The only sanctions for an incorporated attorney are suspension or cancellation of registration, and the Tribunal is not formally empowered to administer a public reprimand. Systemic issues within a firm which do not reach the threshold of professional misconduct at an individual level would also be difficult to effectively pursue.

8.16 In addition to the provisions of the Code of Conduct that apply specifically to incorporated attorneys, broad references to 'registered patent attorneys' in the Code of Conduct encompass incorporated patent attorneys (see section 269(1) of the New Zealand *Patents Act 2013* and section 198(10) of the Australian *Patents Act 1990*). However, there is no means of enforcing it without undertaking time-consuming proceedings against its employees or officers.

8.17 To ensure the Board and Disciplinary Tribunal can fulfil their function of protecting the public, it is important that they be able to, where appropriate, act against an incorporated attorney directly to ensure that a result can be achieved in a timely manner.

## **Recommendation**

8.18 IPA and MBIE should consider methods to modernise and simplify the disciplinary process (recommended under Part 6.D above). In doing so, they should investigate the inequity of disciplinary actions allowable against an individual attorney versus an incorporated attorney.

## D. Operation of the Board

### **Issue raised**

8.19 Submitters made several suggestions to improve the way the Board operates, including:

- updating guidelines regularly to ensure they reflect best practice;
- greater transparency and communication about the application of the Code of Conduct in relation to complaints and disciplinary proceedings;
- faster decisions through more frequent meetings; and
- more presentations to communicate key issues.

8.20 Regarding membership, Dr Thom suggested IPA and MBIE ensure Board nominations include a diverse range of individuals with skills and experience relevant to its role and functions, complementing the skills and experience of existing members. She also suggested that the Board finalise and implement its communication strategy, as well as publishing comprehensive information about how conflicts of interest are identified and managed.

### **Observations**

8.21 We note the Board is working towards increased transparency and guidance for patent attorneys. Actions to date include finalisation of their communication strategy, public release of the Board's Annual Report and circulating post-meeting communiques, which include information on complaints and disciplinary proceedings.

8.22 The Board can progress urgent matters out-of-session. Between meetings, both accreditation and disciplinary matters are often discussed by the Board. Modernisation and simplification of disciplinary processes recommended earlier in this report (Part 6.D) would include consideration of appropriate timeframes.

8.23 IPA and MBIE are aware that a diverse range of individuals and skills on the Board is required and will emphasise this to decision makers throughout appointments processes.

### **Recommendation**

8.24 We recommend that the Board continue its work to provide more:

- guidance and general information to attorneys, especially about conflicts of interest, complaints, and discipline matters; and
- educational resources to the profession, such as seminars and presentations on subject matter of interest.

## 9. Next Steps

9.1 To maintain the effectiveness of the registration regime it is important that it is reviewed regularly and that any recommendations are considered and/or addressed.

### **Recommendations**

9.2 The Board's annual report should include an update on the progress of any recommendations assigned to the Board. IPA and MBIE should report on the progress of other recommendations as appropriate.

9.3 IPA and MBIE should continue to monitor the regime and commence a further review in 5 years' time from the publication of this report to ensure the Arrangement is still working effectively.

# Annexures

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## Annex 1: List of Submitters to the Public Consultation

1. The New Zealand Institute of Patent Attorneys
2. Henry Hughes IP
3. The Institute of Patent and Trade Mark Attorneys of Australia
4. International Federation of Intellectual Property Attorneys
5. Dr Marguerite Port
6. Matthew J. Hammon
7. Kristy Tan



## Annex 2: Executive Summary and List of Recommendations from the Independent Report on the Effectiveness of the Trans-Tasman Regulation of Patent Attorneys and Related Matters by Dr Vivienne Thom commissioned on behalf of the Australian Government

### Executive Summary

This is an independent report on the effectiveness of the Trans-Tasman Arrangement for the regulation of patent attorneys for use by IPA in a five-year bilateral review of the arrangement. This report also looks at regulation of the trade marks profession in Australia.

The key findings are:

1. Currently available data and anecdotal information do not confirm the prediction by some stakeholders that there would be a significant decrease in the number of attorneys in New Zealand following the implementation of the Arrangement.
2. The institutional arrangements are generally working well although there could be a greater diversity of skill and experience on the Trans-Tasman IP Attorney Board (the Board), and the Board should ensure that it has clear public guidelines for managing conflicts of interest.
3. The Board should engage more with the profession and actively support compliance with the Code of Conduct.
4. Compliance costs for Australian attorneys have decreased marginally while New Zealand attorneys face higher costs, with particular concerns about the costs of education.
5. There are limited providers of accredited courses. While intervention is not warranted at this stage, the situation should be monitored closely.
6. While the course costs are significant, they are not out of line with other courses that pave the way to a respected and well-paid profession.
7. There does not seem to be a large mismatch between the number of candidates and available positions except in certain areas of technology.
8. While foreign-qualified attorneys face barriers to entry to the profession, this is not an issue that should be solved by further intervention by government.
9. There is a need for businesses to be better informed about the registered patent and registered trade marks attorney professions and Trans-Tasman arrangements, and how the regulation of the profession ensures a high level of professional standards.
10. There are significant concerns about the Board's processes for handling disciplinary matters.
11. The current regime is directed to the discipline of attorneys. It does not provide a mechanism for the resolution of disputes between attorneys and clients. It is not consistent with modern regulatory regimes.
12. The report proposes some broad principles to guide reform of the disciplinary process and suggests how these principles might be implemented. Key changes could be:
  - Triaging and early dispute resolution by public servants for simple matters.
  - The Board to decide on matters that do not meet the current Tribunal threshold but are suspected breaches of the Code of Conduct.
  - Providing the Board with powers to sanction.

13. Given the small number of cases, it would be premature to change the current jurisdiction for the Tribunal for more serious cases at this stage.
14. The Board and Tribunal should have the discretion whether to commence or continue with disciplinary proceedings in the event that an attorney voluntarily withdraws their registration.
15. The limited amount of data available in the short period since implementation indicates that the Trans-Tasman Arrangement may have increased competition in the marketplace although this is probably not the primary cause for the increase in the number of firms; the re-structuring of the profession with the rise of listed entities, mergers and acquisitions is also relevant.
16. There is currently uncertainty about who might provide trade marks services for gain considering the reserve of legal practitioners. This should be resolved.
17. The issue of providing exclusive rights to practice to trade marks attorneys requires further exploration. Data should be collected to ascertain whether the use of unqualified unregistered practitioners significantly affects the interests of trade mark applicants.

The report makes twenty-one recommendations to improve the effectiveness of the regime.

#### List of Recommendations

1. IPA and MBIE should ensure that any nominations to responsible Ministers for Board appointments should include a diverse range of individuals with skills and experience that are relevant to the role and functions of the Board and complement the skills and experience of existing Board members.
2. The Board should publish comprehensive information about how conflicts of interest are identified and managed.
3. The Board should finalise and implement its communication strategy. The Board should evaluate the success of the strategy by seeking feedback from registered attorneys 12 months after implementation.
4. IPA and MBIE should review the requirement in section 203 of the *Patent Act 1990* to have a registered patent attorney in regular attendance at an office and in continuous charge of the patents work done at that office or place.
5. IPA and MBIE should clarify with IPONZ how an Australian attorney can remove their address for service from an application in New Zealand without cancelling the application.
6. IPA and MBIE should continue to monitor the availability of accredited courses to assess the level of risk of particular topics not being available and determine whether any intervention is required.
7. The Board should consider obtaining independent expert advice about course accreditation and contemporary educational methodology if it does not have a member with experience in course development and teaching in the tertiary education sector.
8. IPA and MBIE should consider whether the requirement for a technical qualification to register as a patent attorney should be broadened to include 'potentially patentable subject matter in Australia, New Zealand or overseas'.

9. The Board should review the 2016 curriculum of studies to ensure it reflects current law and practice and contains sufficient details in all topics to facilitate candidates seeking exemptions.
10. IPA and MBIE should review the requirement in regulation 20.10 of the Patent Regulations 1991 to establish whether a period of employment outside of Australia or New Zealand, but under the supervision of an Australian or New Zealand patent attorney, should be included.
11. The Board should develop a targeted campaign for SMEs to promote confidence and awareness in the registered patent and registered trade marks attorney professions and Trans-Tasman arrangements. The campaign should explain how the regulation of the profession ensures a high level of professional standards.
12. The Board should clarify the appropriateness of the use of the term 'Trans-Tasman IP Attorney' and advise the profession accordingly.
13. The Board should explore ways to facilitate and promote a greater range of continuing professional education on topics that are not covered in the courses of study and not delivered by existing providers.
14. The Board should consider facilitating and endorsing training on professional conduct matters including the Code of Conduct and professional ethics.
15. IPA and MBIE should review the disciplinary and complaint-handling regime increasing the focus on the resolution of complaints. This review should be based on the following principles:
  - a. Complaints should be triaged initially according to the alleged conduct with a focus on early resolution.
  - b. Investigations should be actively case managed and investigated to ensure prompt resolution.
  - c. Decisions should be made at the most appropriate level.
  - d. A range of appropriate remedies and sanctions should be available.
16. IPA and MBIE should review whether existing powers available to the Board to obtain information are sufficient. At the same time, the question of retaining professional privilege over material disclosed to the Board should also be considered.
17. IPA and MBIE should review the ability of the Board to initiate disciplinary proceedings against an incorporated attorney and propose legislative amendment if appropriate.
18. IPA and MBIE should propose legislative amendments to allow the Board and Tribunal discretion whether to commence or continue with disciplinary proceedings in the event that an attorney voluntarily withdraws their registration.
19. IPA and MBIE should consider whether the Board should have any role or powers to set up arrangements to ensure that the practice of a registered attorney who is temporarily incapacitated should be taken over for a period of time to ensure that the IP rights of clients continue to be safeguarded.
20. IPA should clarify the extent to which individuals who are not legal practitioners can do trade marks work in light of the reserve of legal practitioners at a state or territory level, and inform applicants and registered attorneys of the outcome of this review. Depending on the outcome of

this exercise, IPA should also clarify the current provisions relating to the scope of work that can be done by trade marks attorneys.

21. IPA should investigate the experiences of trade mark applicants who have used unqualified and unregistered practitioners to determine if further regulation of the profession is required. This could be achieved, for example, by way of a quantitative and qualitative survey of trade marks clients after opposition proceedings to ascertain the extent to which the advice of unqualified and unregistered practitioners was considered by clients to have adversely affected their interests.

## Annex 3: Response to Issues Raised in regard to the Australian Registered Trade Mark Attorneys Regime by IP Australia

### A. Introduction

In Australia, unlike in New Zealand, trade mark attorneys are recognised and regulated as a profession. Trade mark attorneys gained recognition as a separate profession to patent attorneys in 1998, when restrictions on practising as a trade marks agent were largely removed. Whilst the question of whether New Zealand should provide a regulatory regime for trade mark attorneys is outside the scope of this review, submissions on the effectiveness of the regulation of trade mark attorneys in Australia were welcome from any stakeholder.

### B. What are the costs and benefits of the of the Trans-Tasman regime also encompassing regulation of trade mark attorneys in Australia?

#### **Issue raised**

Submitters did not raise any concerns with the way in which the Australian trade marks attorney profession is regulated alongside the Trans-Tasman patent attorney profession. Submitters considered that this arrangement is beneficial as there is no need for a separate regulatory system, and the current regime ensures quality in the Australian trade marks attorney profession.

#### **Observations**

Given the significant proportion of patent attorneys who also register as trade marks attorneys, the joint regulation of the trans-Tasman patent attorney profession and the Australian trade marks attorney profession delivers significant efficiencies and makes it easy for trans-Tasman patent attorneys to register and meet professional requirements as an Australian trade marks attorney.

#### **Recommendation**

Nil.

### C. What improvements could be made to the regulation of trade mark attorneys in Australia?

#### **Issue raised**

Several submissions were received regarding academic qualifications and work experience requirements for qualifying as a trade mark attorney, with all submissions suggesting stricter requirement would lead to better outcomes for the profession and clients.

The existence of a 'grey area' in relation to the services that trade marks attorneys are authorised to provide, considering the various state and territory laws restricting the provision of legal services, was raised in several submissions and referred to in Dr Thom's report. The lack of an explicit authorisation for trade marks attorneys to provide any particular services leaves their status unclear and vulnerable to challenge.

Linked to these concerns about exclusive rights to practise for trade marks attorneys, were concerns about unregistered foreign agents. Foreign agents, who are allegedly more likely to lodge poor quality filings and provide inconsistent or incorrect advice, may utilise a forwarding address or drop box in Australia to meet address requirements. Submitters suggested that IPA should enforce more stringent address for service requirements.

### **Observations**

Trade marks attorneys were introduced as a class of practitioner to drive down costs to clients, by introducing a new qualification that is less difficult and expensive to obtain than qualification as a patent attorney.

The Trans-Tasman IP Attorneys Board (the Board) and IPA both play a regulatory role in relation to the provision of trade marks services. The lack of clarity around what services a trade marks attorney can provide hinders the Board's ability to effectively regulate the profession. As the body responsible for determining the registration requirements of trade marks attorneys, and for disciplining attorneys who act improperly, the Board should be able to advise with certainty what services its attorneys should or should not be providing to clients. Instead, what services are provided by trade marks attorneys is largely dictated by convention, derived from the services that patent attorneys previously provided.

This lack of clarity also affects the 'value proposition' of becoming registered as a trade marks attorney (with the resulting benefits to the public of regulated standards of knowledge, continuing education, and professional and ethical standards of practice), as at present it is unclear what benefits there are to registration, other than the ability to use the title 'trade marks attorney'.

The multiple submissions, in combination with Dr Thom's observations and the value of trade marks to Australian businesses, justify undertaking further research to determine whether increased regulation by means of exclusive rights to practise is an appropriate solution.

### **Recommendations**

IPA, with assistance from the Board, should investigate this issue further. Factors to consider include:

- The definition of *trade marks work* and authorisation to conduct such work; and
- Clarification of the extent to which individuals who are not legal practitioners can do *trade marks work*.

Research into the experiences of trade mark applicants who have used unqualified and unregistered practitioners to determine if further regulation of the profession is required would supplement the evidence base for future proposals in this regard.