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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND
REGULATIONS NOTIFIED UNDER ARTICLE 63.2
OF THE AGREEMENT**

AUSTRALIA

This document reproduces the text¹ of the Patents and Trade Marks Legislation Amendment Regulations 2008 (No. 1), as notified by Australia on 22 May 2013 under Article 63.2 of the Agreement (see document IP/N/1/AUS/5).

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À
LA PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES AU TITRE
DE L'ARTICLE 63:2 DE L'ACCORD**

AUSTRALIE

Le présent document contient le texte¹ du Règlement de 2008 portant modification de la législation relative aux brevets et aux marques (n° 1), notifié par l'Australie le 22 mai 2013 au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/AUS/5).

**Consejo de los Aspectos de los Derechos de Propiedad
Intelectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA
PROPIEDAD INTELLECTUAL NOTIFICADOS EN VIRTUD
DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

AUSTRALIA

En el presente documento se reproduce el texto¹ del Reglamento de 2008 que modifica la legislación relativa a las patentes y marcas de fábrica o de comercio (N° 1), notificado por Australia el 22 de mayo de 2013 en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/AUS/5).

¹ In English only./En anglais seulement./En inglés solamente.

PP 3-52 - Offset (Pdf file attached)
PP 3 à -52 - Offset (fichier Pdf joint)
PP 3-52 - Offset (fichero Pdf adjunto)



Patents and Trade Marks Legislation Amendment Regulations 2008 (No. 1)¹

Select Legislative Instrument 2008 No. 122

I, PHILIP MICHAEL JEFFERY, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Patents Act 1990* and the *Trade Marks Act 1995*.

Dated 19 June 2008

P. M. JEFFERY
Governor-General

By His Excellency's Command

KIM CARR
Minister for Innovation, Industry, Science and Research

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1 Name of Regulations

These Regulations are the *Patents and Trade Marks Legislation Amendment Regulations 2008 (No. 1)*.

2 Commencement

These Regulations commence on 1 July 2008.

3 Amendment of *Patents Regulations 1991*

Schedule 1 amends the *Patents Regulations 1991*.

4 Amendment of *Trade Marks Regulations 1995*

Schedule 2 amends the *Trade Marks Regulations 1995*.

5 Transitional

- (1) The amendments made by Schedules 1 and 2 apply to:
- (a) an application for registration received on or after 1 July 2008; and

Regulation 5

- (b) a disciplinary proceeding commenced on or after 1 July 2008.
- (2) For paragraph (1) (b), disciplinary proceedings are taken to have commenced on or before 30 June 2008 if, on or before that date, the Board has given written authority to a complainant to bring proceedings against a registered patent attorney.
- (3) If, on or before 30 June 2008:
- (a) a person has been granted an exemption from a requirement in Schedule 5 to the *Patents Regulations 1991*; or
 - (b) the Board has decided that it is satisfied that a person has an academic qualification; or
 - (c) the Board has accredited a course of study;
- the exemption, decision or accreditation applies to that person or course, as if it had been exempted, decided or accredited under the relevant provision of the *Patents Regulations 1991*, as amended by these Regulations.
- (4) If, in the period starting on 1 July 2008 and ending at the end of 30 June 2009:
- (a) a person would have satisfied the employment requirements set out in regulation 20.3 of the *Patents Regulations 1991* immediately before the commencement of Schedule 1; and
 - (b) the person applies for registration as a patent attorney;
- the person is taken to meet the employment requirements.

Schedule 1 Amendments of *Patents Regulations 1991*

(regulations 3 and 5)

[1] Subregulation 1.3 (1), definition of *former attorneys Regulations*

substitute

former attorneys Regulations means the following Regulations:

- (a) the Patent Attorneys Regulations as in force immediately before the commencing day under the 1952 Act;
- (b) the *Patents Regulations 1991* as in force immediately before 1 July 2008.

[2] Chapter 20

substitute

Chapter 20 Patent attorneys

Part 1 Introduction

20.1 Interpretation

- (1) In this Chapter:

AQF means the Australian Qualifications Framework.

Board means the Professional Standards Board for Patent and Trade Marks Attorneys.

candidate means a person who proposes or proposed to sit, or has sat, for an examination.

Chairperson means Chairperson of the Board.

Disciplinary Tribunal means the Patent and Trade Marks Attorneys Disciplinary Tribunal established by regulation 20.61.

professional misconduct has the meaning given by regulation 20.32.

Register or **Register of Patent Attorneys** means the register kept under section 198 of the Act.

statement of skill has the meaning given by regulation 20.11.

unqualified, in relation to a particular time, means:

- (a) not holding one or more of the academic qualifications or knowledge requirements required for registration at that time by these Regulations; or
- (b) not holding a qualification required for registration at that time by the former attorneys Regulations.

unsatisfactory professional conduct has the meaning given by regulation 20.32.

- (2) For regulation 20.6, the **higher education sector** comprises:
 - (a) universities; and
 - (b) higher education institutions other than universities; and
 - (c) higher education providers.

Part 2 **Obtaining registration for first time**

20.2 **Form of application**

An application for registration as a patent attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by evidence and material mentioned in regulation 20.3; and
- (c) be accompanied by the fee mentioned in item 104 of Schedule 7.

20.3 Evidence that applicant meets registration requirements

- (1) An application for registration as a patent attorney must be accompanied by the following:
 - (a) evidence that the applicant is ordinarily resident in Australia;
 - (b) evidence that the Board is satisfied that the applicant has, or is entitled to the award of, an academic qualification of a kind mentioned in regulation 20.6;
 - (c) evidence that the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney;
 - (d) one or more statements of skill, for the purposes of regulation 20.11;
 - (e) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.12 (1); and
 - (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.12 (2);
 - (f) a statutory declaration, by another person, that the applicant is of good fame, integrity and character.
- (2) A statutory declaration under paragraph (1) (f) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character.

20.4 Certificate of registration

If the Designated Manager registers a person as a patent attorney, the Designated Manager must give the person a certificate of registration.

20.5 Evidence of academic qualifications

- (1) The Board must be satisfied that a person has a qualification mentioned in regulation 20.6 if:
 - (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the person has the qualification; and
 - (ii) the original or a certified copy of an academic record that shows the units that make up the qualification.
- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the qualification, notify the person, in writing, of its decision.

Note A decision that a person does not have a qualification is reviewable under regulation 22.26.

20.6 Academic qualifications

- (1) The Designated Manager must not approve an applicant for registration as a patent attorney unless the applicant has, or is entitled to:
 - (a) an AQF qualification from the higher education sector that the Board is satisfied is an appropriate qualification for a patent attorney; or
 - (b) a qualification awarded by an overseas institution that the Board is satisfied is equivalent to an AQF qualification from the higher education sector.
- (2) The Board must not be satisfied that a person has an AQF qualification unless the qualification, or a course taken for the purpose of the qualification:
 - (a) is in a field of science or technology that contains potentially patentable subject matter; and
 - (b) involves a depth of study that the Board considers is sufficient to provide an appropriate foundation for practice as a patent attorney.

- (3) The Board must not be satisfied that a qualification from a foreign institution is equivalent to an AQF qualification unless the qualification, or a course taken for the purpose of the qualification:
 - (a) is in a field of science or technology that contains potentially patentable subject matter; and
 - (b) involves a depth of study that the Board considers is sufficient to provide an appropriate foundation for practice as a patent attorney.

20.7 Evidence of knowledge requirements

- (1) The Board must be satisfied that a person has a knowledge requirement mentioned in regulation 20.8 if:
 - (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the applicant has the relevant knowledge; and
 - (ii) the original or a certified copy of any academic record that shows the study that contributes to the knowledge.
- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the knowledge requirement, notify the person, in writing, of its decision.

Note A decision that a person does not have a knowledge requirement is reviewable under regulation 22.26.

20.8 Knowledge requirements

- (1) The Designated Manager must not approve an applicant for registration as a patent attorney unless the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney.

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- (2) Subject to subregulations (3), (4) and (5), the Board must, in satisfying itself whether or not an applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney, take into account whether the applicant has the knowledge requirements that meet the minimum requirements set out in Schedule 5.
 - (3) The Board may publish guidelines setting out criteria for deciding whether or not areas of study are likely:
 - (a) to meet the minimum requirements set out in Schedule 5;
 - (b) to provide a person with the appropriate level of understanding to practice as a patent attorney.
 - (4) The Board may be satisfied that an applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney, despite the fact that the applicant does not meet every requirement set out in Schedule 5.
 - (5) The Board is not able to be satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney if the knowledge requirements on which the applicant relies were obtained more than 10 years prior to the application.
 - (6) If an applicant has been granted an exemption under regulation 20.9, the applicant is taken to meet the requirement in Schedule 5 for which the exemption is granted.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (b) requires that a person hold such qualifications as are specified in, or ascertained in accordance with, the Regulations.

20.9 Exemption from a requirement in Schedule 5

- (1) The Board may exempt an applicant from having to satisfy all or some of the requirements mentioned in Schedule 5.
- (2) The Board must not give an exemption to an applicant unless:
 - (a) the applicant makes an application in the form approved by the Board; and

- (b) the applicant gives the Board enough information for the Board to be satisfied under paragraph (c); and
- (c) the Board is satisfied that:
 - (i) the applicant has passed a course of study at a satisfactory level; and
 - (ii) the course of study has outcomes that are the same as, or similar to, those of a knowledge requirement for which the exemption is sought.
- (3) The Board may give an exemption under subregulation (1) if it is satisfied that the applicant has successfully completed a relevant course of study within the 7 years preceding the application or within a longer period specified in writing by the Board.
- (4) An exemption under subregulation (1) is valid for 5 years from the date that the exemption was granted or for a longer period specified in writing by the Board.

20.10 Employment requirements

- (1) The applicant:
 - (a) must have been employed in a position, or positions, that provided the applicant experience in the following skills:
 - (i) searching patent records;
 - (ii) preparing, filing and prosecuting patent applications in Australia;
 - (iii) preparing, filing and prosecuting patent applications in other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia;
 - (iv) drafting patent specifications;
 - (v) providing advice on the interpretation, validity and infringement of patents; and
 - (b) must have been employed in a position, or positions, of that kind for at least:
 - (i) 2 continuous years; or
 - (ii) a total of 2 years within 5 continuous years.

Examples of major trading partners for subparagraph (a) (iii)

- European Community
- Japan
- New Zealand
- People's Republic of China
- United States of America.

- (2) The requirements set out in subregulation (1) must be evidenced by means of one or more statements of skill, as defined in regulation 20.11.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (c) requires that a person be employed as prescribed for not less than the prescribed period.

20.11 Statements of skill

- (1) For paragraph 20.3 (1) (d) and subregulation 20.10 (2), a *statement of skill* is a statement by a registered patent attorney who has been registered for at least 5 years that, in the opinion of the registered patent attorney, the applicant has the experience mentioned in one or more of subparagraphs 20.10 (1) (a) (i) to (v).
- (2) Without limiting subregulation (1), a statement of skill must:
- (a) contain details of the basis of the opinion that the applicant has the required experience; and
 - (b) include details of the evidence on which the opinion is based;
- described by reference to:
- (c) the skills mentioned in paragraph 20.10 (1) (a); and
 - (d) the employment requirements mentioned in paragraph 20.10 (1) (b).
- (3) If an applicant is unable to obtain a statement of skill from a registered patent attorney who has been registered for at least 5 years, the Board may, at the request of the applicant, prepare a statement of skill in relation to the applicant.

20.12 Prescribed offences

- (1) An offence against the Act, the *Designs Act 2003* or the *Trade Marks Act 1995* is a prescribed offence for paragraph 198 (4) (e) of the Act.
- (2) An offence of dishonesty for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence for paragraph 198 (4) (f) of the Act.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (e) requires that a person not have been convicted of a prescribed offence during the previous 5 years. Paragraph 198 (4) (f) requires that a person not be under sentence of imprisonment for a prescribed offence.

Part 3 Accreditation of courses of study

20.13 Accreditation of courses of study

- (1) The Board may accredit a course of study that is provided by an institution if the Board is satisfied that the learning outcomes of the course would result in a person who passes the course acquiring some or all of the knowledge of intellectual property law and practice that the Board considers necessary for a person to practice as a registered patent attorney.
- (2) In deciding whether or not to accredit the course, the Board must consider whether the learning outcomes of the course meet some or all of the requirements set out in Schedule 5.
- (3) In considering whether the learning outcomes of the course meets some or all of the requirements set out in Schedule 5, the Board must consider any information provided by the institution.
- (4) If the institution gives the Board sufficient information for the Board to decide whether the learning outcomes of the course meet a requirement mentioned in Schedule 5, the Board must, within 4 months after receiving the information, decide whether to accredit the course.

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- (5) Subject to subregulation (7), if the Board accredits a course, accreditation is for 5 years.
 - (6) If an institution intends to change an accredited course, it must advise the Board in writing.
 - (7) The Board may revoke an accreditation if:
 - (a) changes are made to the course; and
 - (b) the Board decides that the course no longer achieves the learning outcomes stated for the knowledge requirements to which it relates.

20.14 Provisional accreditation

- (1) The Board may provisionally accredit a course if:
 - (a) the institution has sought accreditation for the course; and
 - (b) the information provided by the institution shows that the course includes a requirement mentioned in Schedule 5; and
 - (c) either:
 - (i) the Board does not expect to complete its consideration of the course under regulation 20.13 before the start of the academic semester; or
 - (ii) the Board has not completed its consideration of the course under regulation 20.13 when the academic semester starts.
- (2) The Board may provisionally accredit a changed course if:
 - (a) a consequence of the change to the course is that the learning outcomes of the course may meet fewer of the requirements set out in Schedule 5; and
 - (b) the Board considers that the changed course still achieves the learning outcomes stated for the knowledge requirements mentioned in Schedule 5.
- (3) Provisional accreditation:
 - (a) starts when the course is provisionally accredited; and
 - (b) ends at the earlier of:
 - (i) when the course has concluded; and

- (ii) when a decision in relation to the course is made under regulation 20.13.

Part 4 Board examinations

20.15 Board examinations

- (1) The Board may hold examinations for a requirement mentioned in Schedule 5.
- (2) The Board may appoint examiners for the purposes of the examinations, and give them instructions about the setting and marking of papers.
- (3) An examiner is entitled to be paid the fees that the Minister determines in writing.

20.16 Time for holding Board examinations

- (1) The Board must arrange to publish in the *Official Journal*, with adequate notice:
 - (a) the time of each examination it holds and the place where it is to be held; and
 - (b) the deadline for applications for admission to sit for each examination it holds.
- (2) Subregulation (1) does not apply to a supplementary examination under regulation 20.21.

20.17 Examinable subject matter

From time to time, the Board must arrange to publish in the *Official Journal* particulars of:

- (a) the subject matter covered by the courses for which examinations are to be held in relation to the relevant requirements mentioned in Schedule 5; and
- (b) the reading and study material it recommends to candidates.

20.18 Admission to sit for a Board examination

An application by a person to sit for an examination must be in the form approved by the Board.

20.19 Notification of Board examination results

As soon as practicable after an examination conducted by the Board, the Board must give to each candidate who sat for the examination his or her results in the examination.

20.20 Reasons for failure of Board examination

- (1) A candidate who fails an examination conducted by the Board may apply to the Board in the form approved by the Board within 1 month after being told of the failure for a report of the reasons for the failure.
- (2) For subregulation (1), a report may be given by:
 - (a) the Board; or
 - (b) if the Board approves — the examiner appointed under subregulation 20.15 (2).

20.21 Supplementary Board examination

- (1) An application by a person to sit for a supplementary examination must be in the form approved by the Board.
- (2) The Board may let a candidate sit for a supplementary examination if:
 - (a) the candidate:
 - (i) failed an examination; and
 - (ii) applies to the Board to sit for the supplementary examination within 1 month of being told of the failure; or
 - (b) the candidate:
 - (i) did not sit for the examination because of illness or another reason that the Board reasonably considers sufficient; and
 - (ii) applies to the Board to sit for the supplementary examination within 1 month of the examination.

- (3) For an application under paragraph (2) (a), the Board may take account of an examiner's comments on the candidate's performance.
- (4) A supplementary application under paragraph (2) (b) must be accompanied by evidence of the reason for failing to sit the examination that was obtained at the time of the illness or of the occurrence of the other event giving rise to the reason.

Part 5 Maintaining registration

20.22 Requirements for remaining on Register

- (1) To remain on the Register, a registered patent attorney must, for every year of registration:
 - (a) pay the annual registration fee set out in item 105 or 106 of Schedule 7; and
 - (b) provide evidence that he or she has undertaken continuing professional education, as required by regulation 20.24.
- (2) Paragraph (1) (b) applies to a registered patent attorney who seeks to remain on the Register for the 12 months commencing on 1 July 2009 and for each subsequent period of 12 months.

20.23 Payment of annual registration fee

- (1) The annual registration fee is payable by a registered patent attorney to whom regulation 20.26 does not apply on 1 July in a year.
- (2) The Designated Manager must, not later than 1 June in each year, give to each registered patent attorney to whom regulation 20.26 does not apply, notice of the fee that is payable.

20.24 Continuing professional education — number of hours

- (1) Subject to subregulation (3), a registered patent attorney must, in the 12 months immediately before the date on which the attorney applies for renewed registration, have completed 10 hours of activities that the Designated Manager is satisfied are appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.
- (2) The Board may publish guidelines setting out criteria for deciding whether or not activities are likely to be appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.
- (3) A person who is both a registered patent attorney and a registered trade marks attorney must, in the 12 months immediately before the date on which the attorney applies for renewed registration, have completed 15 hours of activities that the Designated Manager is satisfied are appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.
- (4) In this regulation:
renewed registration means an application by a registered patent attorney to renew his or her registration, other than the first application to renew his or her registration.

20.25 Method of demonstrating that continuing professional education has been undertaken

- (1) In making an application for a renewed registration, a registered patent attorney must:
 - (a) give the Designated Manager a written statement made by the attorney that states that the attorney has met the requirements of this Part; and
 - (b) have kept written records in relation to each continuing professional education activity on which the attorney relies.

- (2) For paragraph (1) (b), the records must:
 - (a) enable an assessment of the activity to confirm that the activity meets the requirements of this Part; and
 - (b) be produced to the Designated Manager on request; and
 - (c) be kept until 3 years after the end of the registration period during which the activity was completed.

Part 6 Removal from Register

20.26 Voluntary removal of name from Register

The Designated Manager must, on the written request of a registered patent attorney, remove the attorney's name from the Register of Patent Attorneys.

20.27 Failure to pay annual registration fee

If a registered patent attorney does not pay the annual registration fee by 31 July in the year in which the fee is payable, the Designated Manager must:

- (a) remove the name of the attorney from the Register of Patent Attorneys; and
- (b) notify the attorney of that removal.

20.28 Failure to comply with continuing professional education requirements

- (1) If a registered patent attorney fails to comply with the requirements applicable to the attorney under subregulation 20.25 (1) or (2), the Designated Manager may remove the attorney's name from the Register for a period not exceeding 6 months.
- (2) If a registered patent attorney, without reasonable excuse:
 - (a) provides a written statement under paragraph 20.25 (1) (a) that is false in a material particular; or
 - (b) fails to produce written records of his or her continuing professional education activities in accordance with a request under paragraph 20.25 (2) (b);

the Designated Manager must remove the attorney's name from the Register.

- (3) If the Designated Manager removes the name of a registered patent attorney from the Register under subregulation (2), the name of the attorney must not be returned to the Register in accordance with regulation 20.29 for a period of 6 months from the day on which the attorney's name was removed from the Register.

Part 7 Returning to Register

20.29 Restoring attorney's name to Register

- (1) Subject to subregulation (2), if:
- (a) a patent attorney's name was removed from the Register under regulation 20.26; and
 - (b) the attorney requests the Designated Manager, in writing, to restore the attorney's name to the Register; and
 - (c) the attorney pays:
 - (i) the annual registration fee payable for the year in which the reinstatement is made; and
 - (ii) the fee mentioned in item 107 of Schedule 7;
- the Designated Manager must restore the attorney's name to the Register.
- (2) A request under paragraph (1) (b) must be made no more than 3 years after the removal of the attorney's name from the Register.
- (3) The Designated Manager may, in restoring the name of a registered patent attorney to the Register, impose a condition that, before 1 July of the following registration year, the registered patent attorney must undertake such continuing professional education activities as the Designated Manager considers reasonable in the circumstances.
- (4) If:
- (a) the Designated Manager imposes a condition; and

- (b) the registered patent attorney fails to comply with the condition;

the Designated Manager may remove the name of the attorney from the Register.

20.30 Restoring attorney's name to Register following payment of unpaid fee

The Designated Manager must restore a patent attorney's name to the Register if:

- (a) the attorney's name was removed from the Register under regulation 20.27; and
- (b) on or before 1 September of the year in which the attorney's name was removed from the Register, or within such further period as the Designated Manager reasonably allows, the attorney:
 - (i) pays the fee mentioned in regulation 20.27 and item 107 of Schedule 7;
 - (ii) makes an application in the form approved by the Designated Manager.

20.31 Returning to Register in other circumstances

- (1) A person who has been a registered patent attorney, and to whom regulation 20.29 or 20.30 does not apply, may apply to the Designated Manager to have his or her name restored to the Register.
- (2) An application under subsection (1) must be in a form approved by the Designated Manager.
- (3) An application under subsection (1) must be accompanied by the following:
 - (a) evidence that the Board is satisfied with the currency of the person's knowledge of intellectual property law and practice;
 - (b) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.12 (1); and

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- (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.12 (2);
 - (c) a statutory declaration, by another person, that the person is of good fame, integrity and character;
 - (d) a fee that is the sum of the fee mentioned in item 105 or 106 of Schedule 7, whichever is applicable, and the fee mentioned in item 107 of Schedule 7.
- (4) A statutory declaration under paragraph (3) (c) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character

Part 8 Discipline

Division 1 General

20.32 Definitions

In this Part:

Code of Conduct means the document titled ‘Code of Conduct for Patent and Trade Marks Attorneys’ published by the Professional Standards Board for Patent and Trade Marks Attorneys, as existing on 1 July 2008.

conduct includes an act and an omission.

former attorney means a person whose registration as a patent attorney has been suspended or cancelled under this Part.

professional misconduct means:

- (a) unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or
- (b) any other conduct, whether occurring in connection with practice as an attorney or otherwise, that shows that the attorney is not of good fame, integrity and character; or
- (c) any contravention of a law that is declared by these Regulations to be professional misconduct.

unsatisfactory professional conduct includes conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney.

20.33 Role of Board in disciplinary proceedings

- (1) The Board has the sole responsibility for commencing and conducting disciplinary proceedings against a registered patent attorney.
- (2) The role of the Board in commencing disciplinary proceedings includes investigating, either as a result of information received or of its own motion, whether:
 - (a) a registered patent attorney has been engaged in:
 - (i) professional misconduct; or
 - (ii) unsatisfactory professional conduct; or
 - (b) at the time of his or her registration, a registered patent attorney did not hold either or both of the following:
 - (i) the academic qualifications mentioned in regulation 20.6;
 - (ii) the knowledge requirements mentioned in regulation 20.8; or
 - (c) a registered patent attorney obtained his or her registration by fraud.
- (3) The Board may commence proceedings before the Disciplinary Tribunal against a registered patent attorney if the Board is satisfied that there is a reasonable likelihood of the attorney being found guilty of unsatisfactory professional conduct.
- (4) The Board must commence proceedings against a registered patent attorney before the Disciplinary Tribunal if the Board is satisfied that there is a reasonable likelihood of the attorney being found guilty of an offence under subregulation (2), other than of unsatisfactory professional conduct.

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- (5) In deciding whether or not to commence disciplinary proceedings against a registered patent attorney, the Board may take into account patterns of behaviour of the attorney when deciding whether or not it is satisfied that there is a reasonable likelihood of the attorney being found guilty of an offence under subregulation (2).
- (6) In deciding whether or not a registered patent attorney has been engaged in:
- (a) professional misconduct; or
 - (b) unsatisfactory professional conduct;
- the Board must consider whether or not the attorney has complied with the Code of Conduct.

20.34 Board may require attorney to cooperate with investigation

- (1) In investigating whether or not to commence proceedings against a registered patent attorney, the Board may request the attorney who is the subject of the investigation to provide information.
- (2) The failure, without reasonable excuse, of a registered patent attorney to provide information requested by the Board under subregulation (1) is unsatisfactory professional conduct.

20.35 Commencing disciplinary proceedings

- (1) The Board must commence disciplinary proceedings by way of a notice given to the Disciplinary Tribunal.
- (2) A notice must be in writing and must set out the charges that are made against the registered patent attorney.
- (3) The Board must, as soon as practicable after giving a notice to the Disciplinary Tribunal, give a copy of the notice to the registered patent attorney who is the subject of the notice.

Division 2 Proceedings in Disciplinary Tribunal

20.36 Procedure of Disciplinary Tribunal

- (1) Subject to this Part, the Disciplinary Tribunal may determine its procedure.
- (2) Proceedings before the Disciplinary Tribunal are to be conducted quickly and informally, while allowing for proper consideration of the matter before that Tribunal.
- (3) The Disciplinary Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.
- (4) The Disciplinary Tribunal may take evidence on oath or on affirmation and, for that purpose, may administer an oath or affirmation.

20.37 Notification of hearing of disciplinary proceedings

- (1) The Disciplinary Tribunal must, as soon as practicable after receiving a notice under regulation 20.35 in relation to a registered patent attorney, fix a time and place for the hearing of the charges set out in the notice.
- (2) The Disciplinary Tribunal must, as soon as practicable after fixing a time and date for the hearing of charges against a registered patent attorney, notify the attorney and the Board of that time and place.
- (3) The time of hearing must not be less than 21 days after the day on which the registered patent attorney is notified of the time and place for the hearing.

20.38 Hearings to be public except in special circumstances

- (1) Subject to subregulation (2), a hearing before the Disciplinary Tribunal must be in public.

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- (2) If the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so, in the public interest or because of the confidential nature of any evidence or matter, the Tribunal may:
- (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
 - (b) give directions restricting or prohibiting the publication or disclosure of:
 - (i) evidence given before the Tribunal, whether in public or in private; or
 - (ii) matters contained in documents lodged with the Tribunal or received in evidence by it.
- (3) A person must comply with a direction given to him or her under this regulation.

Penalty: 5 penalty units.

20.39 Representation before Disciplinary Tribunal

- (1) At the hearing of proceedings before the Disciplinary Tribunal, a party to the proceedings may appear in person or be represented by a legal practitioner.
- (2) The Disciplinary Tribunal may allow a person to be represented by a person who is not a legal practitioner.
- (3) A party to proceedings before the Disciplinary Tribunal, or his or her representative, may request that Tribunal to summon witnesses.

20.40 Summoning of witnesses

- (1) For the purpose of the hearing of a charge against a registered patent attorney before the Disciplinary Tribunal, the Tribunal may, by instrument in writing signed by the person constituting the Tribunal:
 - (a) summon any person, other than the attorney, to appear before the Tribunal to give evidence about the charge and to produce any documents or articles mentioned in the summons; or

- (b) summon the attorney to appear before the Tribunal:
 - (i) to produce any documents or articles mentioned in the summons; and
 - (ii) to give evidence to identify the documents or articles.

- (2) A registered patent attorney summoned under this regulation must appear in person.

20.41 Offences by persons appearing before Disciplinary Tribunal

- (1) A person summoned to appear before the Disciplinary Tribunal must comply with the summons by:
 - (a) appearing as required by the summons; and
 - (b) producing documents or articles as required by the summons; and
 - (c) appearing and reporting to the Tribunal, as required.

Penalty: 10 penalty units.

- (2) It is a defence to a prosecution for an offence against subregulation (1) if:
 - (a) the defendant is prevented or hindered from complying with the summons by:
 - (i) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (ii) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons; or
 - (b) in relation to paragraph (1) (c) — the defendant is excused by the Tribunal.

Note A defendant bears an evidential burden in relation to the matters mentioned in subparagraph (2) (a) (i) (see section 13.3 of the *Criminal Code*).

- (3) A person commits an offence if:
 - (a) the person:
 - (i) is not a registered patent attorney to whom subregulation (5) applies; and

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- (ii) appears as a witness before the Disciplinary Tribunal; and
 - (iii) has been paid expenses and allowances; and
 - (b) the expenses and allowances have been determined by the Tribunal in accordance with Part 2 of Schedule 8; and
 - (c) the person refuses:
 - (i) to be sworn or make an affirmation; or
 - (ii) to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: 10 penalty units.

- (4) Strict liability applies to the physical element of an offence against subregulation (3) that is constituted by:
 - (a) the circumstance mentioned in subparagraph (3) (a) (i); and
 - (b) the circumstance mentioned in paragraph (3) (b).

Note For **strict liability**, see section 6.1 of the *Criminal Code*.
- (5) A person commits an offence if the person:
 - (a) is a registered patent attorney against whom proceedings have been instituted; and
 - (b) is summoned to appear at a hearing before the Disciplinary Tribunal in respect of those proceedings; and
 - (c) refuses:
 - (i) to be sworn or to make an affirmation; or
 - (ii) to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: 10 penalty units.

- (6) It is a defence for a person referred to in subregulation (3) or (5) to refuse to answer a question or to produce a document or article, if the answer to the question, or the document or article, may tend to prove that he or she has committed an offence against a law of the Commonwealth or of a State or Territory.

20.42 Protection of person constituting Disciplinary Tribunal, witnesses etc

- (1) A person:
 - (a) constituting or acting as the Disciplinary Tribunal; or
 - (b) appointed under subregulation 20.64 (2);has, in the exercise of the powers and the performance of the functions of that Tribunal under this Part, the same protection and immunity as a Justice of the High Court.
- (2) A member of the Board has, in exercising a power under this Part, the same protection and immunity as a Justice of the High Court.
- (3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.
- (4) Subject to this Part, a person summoned to attend or appearing before the Disciplinary Tribunal as a witness:
 - (a) has the same protection; and
 - (b) is, in addition to the penalties provided by this Part, subject to the same liabilities;as a witness in proceedings in the High Court.

20.43 Decision of Disciplinary Tribunal

- (1) If the Disciplinary Tribunal has heard a charge of professional misconduct against a registered patent attorney, it may find the attorney guilty of professional misconduct.
- (2) If the Disciplinary Tribunal has heard a charge of unsatisfactory professional conduct against a registered patent attorney, it may find the attorney guilty of unsatisfactory professional conduct.
- (3) If the Disciplinary Tribunal has heard a charge that a registered patent attorney was unqualified at the time of his or her registration, that Tribunal may find the attorney guilty of being unqualified at the time of registration.

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- (4) If the Disciplinary Tribunal has heard a charge that a registered patent attorney obtained his or her registration by fraud, that Tribunal may find the attorney guilty of obtaining his or her registration by fraud.

20.44 Penalties — professional misconduct

- (1) Subject to subregulation (2), if the Disciplinary Tribunal finds a registered patent attorney guilty of professional misconduct, it may:
- (a) cancel the attorney's registration as a patent attorney; or
 - (b) suspend the attorney's registration as a patent attorney for a period of between 6 and 12 months.
- (2) The Disciplinary Tribunal may, in addition to cancelling or suspending a registered patent attorney's registration under subregulation (1), impose conditions on the attorney's return to the register after the cancellation has been lifted or the period of suspension has elapsed.
- (3) Without limiting subregulation (2), the conditions that the Disciplinary Tribunal may impose include either or both of the following:
- (a) that the attorney undertake additional continuing professional education, as specified by the Tribunal;
 - (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 not less than 5 years.
- (4) If a registered patent attorney is also a registered trade marks attorney, the Disciplinary Tribunal may also cancel or suspend the attorney's registration as a trade marks attorney.

20.45 Penalties — unsatisfactory professional conduct

- (1) Subject to subregulation (2), if 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 Disciplinary Tribunal 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 Disciplinary Tribunal may impose include either or both of the following:
 - (a) that the attorney undertake additional continuing professional education, as specified by the Tribunal;
 - (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.

20.46 Finding that attorney was unqualified at time of registration

If the Disciplinary Tribunal has heard a charge against a registered patent attorney that the attorney was unqualified at the time of his or her registration and finds the charge proved, that Tribunal may:

- (a) if the attorney has, since that time, obtained that qualification or the qualification is no longer required for registration — reprimand the attorney; or
- (b) in any other case — cancel his or her registration.

20.47 Finding that registration obtained by fraud

If the Disciplinary Tribunal finds that a registered patent attorney obtained his or her registration by fraud, that Tribunal must cancel the registration of the attorney.

20.48 Matters that may be considered in determining penalties

In deciding what to do about a registered patent attorney under regulation 20.44 or 20.45, the Disciplinary Tribunal may take into account the findings about the conduct of the attorney in any other proceedings:

- (a) brought before that Tribunal; or
- (b) brought before the Patent Attorneys Disciplinary Tribunal under the former attorneys regulations.

20.49 Findings of Disciplinary Tribunal

- (1) If the Disciplinary Tribunal reprimands a registered patent attorney, or suspends or cancels the attorney's registration, the Tribunal must give a written notice of the finding of the Tribunal against the attorney that sets out particulars of the reprimand, suspension or cancellation to:
 - (a) the attorney; and
 - (b) the Board; and
 - (c) the Designated Manager.
- (2) If the registration of a registered patent attorney is suspended, the Designated Manager must note the suspension and its duration in the Register of Patent Attorneys.
- (3) If the registration of a registered patent attorney is cancelled, the Designated Manager must remove the name of the attorney from the Register of Patent Attorneys.
- (4) If the Disciplinary Tribunal does not find a charge proved, that Tribunal must notify the registered patent attorney and the Board accordingly.

20.50 Notification and publication of decisions of Disciplinary Tribunal

The Disciplinary Tribunal must, within 14 days after making a decision under regulation 20.44, 20.45, 20.46 or 20.47:

- (a) prepare a written statement that:
 - (i) sets out the decision of the Tribunal; and

- (ii) sets out the reasons for the decision; and
 - (iii) sets out the findings on any material questions of fact; and
 - (iv) refers to evidence or other material on which the findings of fact are based; and
- (b) give:
- (i) the registered patent attorney who is the subject of the notice; and
 - (ii) the Board;
a copy of the statement referred to in paragraph (a); and
- (c) publish, in the *Official Journal*, a written statement that sets out the decision of the Tribunal; and
- (d) arrange for the publication of a copy of the statement referred to in paragraph (a).

20.51 Completion of outstanding business

- (1) If the registration of a former attorney has been cancelled under paragraph 20.44 (1) (a), the Disciplinary Tribunal may appoint a registered patent attorney to carry on the practice of the former attorney until all outstanding matters are disposed of.
- (2) If the registration of the former attorney has been suspended under paragraph 20.44 (1) (b) or 20.45 (1) (a), the Disciplinary Tribunal may appoint a registered patent attorney to carry on the practice of the former attorney for the period of the suspension or for a specified period, not longer than the period of suspension.
- (3) The Disciplinary Tribunal must not appoint a registered patent attorney under subregulation (1) or (2) unless the registered patent attorney consents to the appointment.
- (4) This regulation does not allow a registered patent attorney to act as a registered patent attorney on behalf of a person without the consent of the person.

20.52 Former attorney may be required to provide assistance

- (1) A registered patent attorney appointed to carry on the practice of a former attorney may give a written notice requiring the former attorney to make available to the attorney so appointed:
 - (a) any information about the practice that he or she may reasonably require; or
 - (b) any books, accounts or other documents concerning the practice that he or she may reasonably require; or
 - (c) any moneys held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that have been paid by a client in respect of services not yet performed for the client.

- (2) A former attorney who has been given a notice under subregulation (1) must not refuse to comply with a requirement in the notice.

Penalty: 5 penalty units.

- (3) It is a defence to a prosecution for an offence against subregulation (2) if the former attorney is prevented or hindered from complying with a requirement in the notice by:
 - (a) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (b) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons.

Note A defendant bears an evidential burden in relation to the question of whether he or she has a reasonable excuse (see section 13.3 of the *Criminal Code*).

Part 9 Rights of registered patent attorneys

20.53 Lien

A registered patent attorney has the same right of lien over documents and property of a client as a solicitor.

Part 10 Administration

Division 1 Professional Standards Board for Patent and Trade Marks Attorneys

20.54 Constitution of Board (Act s 227A)

The Board is constituted by:

- (a) the Chairperson, appointed by the Minister; and
- (b) either:
 - (i) the person holding, or carrying out the duties of, the office of the Director-General of the Division of the Department known as IP Australia; or
 - (ii) the nominee of that person; and
- (c) at least 2 other suitably qualified members, appointed by the Minister.

20.55 Term of office of Board members

The Minister may appoint a member of the Board for a term of up to 3 years.

20.56 Resignation and removal of members from Board

- (1) A member of the Board may resign by giving the Minister his or her resignation in writing.
- (2) The Minister may remove the Chairperson of the Board if the Chairperson:
 - (a) has been absent from 3 consecutive meetings of the Board without leave given by the Board under regulation 20.60; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for at least 12 months; or
 - (c) cannot perform his or her duties as Chairperson of the Board; or
 - (d) has behaved in an offensive or disorderly way, or in a way that is likely to adversely affect the Board's reputation; or

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- (e) has carried out his or her duties as Chairperson of the Board inefficiently; or
 - (f) becomes bankrupt; or
 - (g) applies to take the benefit of a law for the relief of bankrupt or insolvent debtors; or
 - (h) has entered into a debt agreement under Part IX of the *Bankruptcy Act 1966*; or
 - (i) compounds with his or her creditors or assigns his or her salary and allowances for their benefit.
- (3) The Minister may remove a member of the Board if the member:
- (a) has been absent from 3 consecutive meetings of the Board without leave given by the Chairperson; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for at least 12 months; or
 - (c) cannot perform his or her duties as a member of the Board; or
 - (d) has behaved in an offensive or disorderly way, or in a way that is likely to adversely affect the Board's reputation; or
 - (e) has carried out his or her duties as a member of the Board inefficiently; or
 - (f) becomes bankrupt; or
 - (g) applies to take the benefit of a law for the relief of bankrupt or insolvent debtors; or
 - (h) has entered into a debt agreement under Part IX of the *Bankruptcy Act 1966*; or
 - (i) compounds with his or her creditors or assigns his or her salary and allowances for their benefit.

20.57 Meetings of Board

- (1) The Board must hold as many meetings as are necessary for the performance of its functions.
- (2) The Chairperson may, at any time, by notice in writing to the members, call a meeting of the Board at the time and place specified in the notice.

20.58 Member presiding at meetings of Board

- (1) The Chairperson must preside at all meetings of the Board at which he or she is present.
- (2) In the absence of the Chairperson from a meeting, the members present must appoint one of the members present at the meeting to preside.
- (3) The Chairperson or a member who presides at a meeting has a deliberative vote and, in the event of an equality of votes, also has a casting vote.

20.59 Quorum for Board meetings

At a meeting of the Board, a quorum is formed by the majority of the members of the Board.

20.60 Absence of Chairperson from meeting — leave from Board

If the Chairperson is absent from a meeting of the Board, the members present must decide whether to give leave to the Chairperson.

Division 2 Patent and Trade Marks Attorneys Disciplinary Tribunal

20.61 Establishment of Disciplinary Tribunal

The Patent and Trade Marks Attorneys Disciplinary Tribunal is established.

20.62 Disciplinary Tribunal — substantive appointments

- (1) The Minister may, in writing, appoint a person to constitute the Disciplinary Tribunal.
- (2) A copy of the instrument of appointment must be published in the *Official Journal*.

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- (3) A person so appointed holds the office for the period specified in the instrument.
 - (4) A person so appointed may resign in writing given to the Minister.
 - (5) The Minister may remove a person so appointed from office for inefficiency, misbehaviour or incapacity.
 - (6) If a person so appointed:
 - (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
 - (c) fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.64;the Minister must remove the person from office.

20.63 Disciplinary Tribunal — acting appointments

- (1) Subject to subregulation (2), the Minister may, in writing, appoint a person to act as the Disciplinary Tribunal:
 - (a) during a vacancy in the office, whether or not an appointment has been previously made to the office; or
 - (b) during any period, or during all periods, when the holder of the office is, or is expected to be, absent from duty or from Australia or is, for any reason, unable to perform the functions of the office.
- (2) A person appointed to act during a vacancy must not continue to act for more than 12 months.
- (3) A copy of the instrument of appointment must be published in the *Official Journal*.
- (4) The Minister:
 - (a) may terminate the appointment at any time; and

- (b) must terminate the appointment if the person appointed fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.64.
- (5) Anything done by or in relation to a person purporting to act under the appointment is not invalid only because:
 - (a) the need for the appointment had not arisen; or
 - (b) there was a defect or irregularity in connection with the appointment; or
 - (c) the appointment had ceased to have effect; or
 - (d) the need to act had not arisen or had ceased.

20.64 Disclosure of interest

- (1) If a person constituting, or acting as, the Disciplinary Tribunal has or acquires an interest that could conflict with the proper performance of his or her functions in relation to proceedings he or she is to hear, the person:
 - (a) must tell the parties to the proceedings about the interest; and
 - (b) must not perform those functions without the consent of the parties.
- (2) If such a person is unable to perform his or her functions because of a conflict of interest, the Minister may in writing appoint another person to be the Disciplinary Tribunal for the purpose of conducting or completing those proceedings.
- (3) A copy of the instrument of appointment must be published in the *Official Journal*.
- (4) A person so appointed may exercise all the powers and must perform all of the functions of the Disciplinary Tribunal in relation to those proceedings.

**20.65 Qualifications for appointment to, or acting as,
Disciplinary Tribunal**

A person is not qualified to be appointed under subregulation 20.62 (1) or 20.63 (1) or 20.64 (2) unless he or she is enrolled, and has for not less than 7 years been enrolled, as a legal practitioner.

[3] Paragraph 22.11 (4) (b)

substitute

- (b) filing, during the term of a standard patent as required by subsection 71 (2) of the Act, an application under subsection 70 (1) of the Act for an extension of the term of the patent;
- (c) an action or step prescribed in Chapter 20.

[4] Paragraphs 22.26 (2) (b) and (c)

substitute

- (b) the Board under the following provisions:
 - (i) regulation 20.5 ('evidence of academic qualifications');
 - (ii) regulation 20.7 ('evidence of knowledge requirements'); or
- (c) the Designated Manager under the following provisions:
 - (i) regulation 20.28 ('failure to comply with continuing professional education requirements');
 - (ii) regulation 20.29 ('restoring attorney's name to Register');
 - (iii) regulation 20.30 ('restoring attorney's name to Register following payment of unpaid fee');
 - (iv) regulation 20.31 ('returning to Register in other circumstances'); or
- (d) the Disciplinary Tribunal under the following provisions:
 - (i) regulation 20.43 ('decision of Disciplinary Tribunal');

- (ii) regulation 20.44 ('penalties — professional misconduct');
- (iii) regulation 20.45 ('penalties — unsatisfactory professional conduct');
- (iv) regulation 20.46 ('finding that attorney was unqualified at time of registration');
- (v) regulation 20.47 ('finding that registration obtained by fraud').

[5] Regulations 23.19 to 23.24

omit

[6] Regulations 23.27 to 23.31

omit

[7] Schedule 5

substitute

Schedule 5 Knowledge requirements

(regulation 20.8)

Part 1 Overall requirement

1. A course of study must provide for a student to have an appropriate level of:
 - (a) knowledge and practical application so that the student can give advice about applicable categories of protection for particular activities; and
 - (b) appreciation of the advantages of each form of protection for a client; and
 - (c) understanding of how to get and maintain appropriate protection for a client; and
 - (d) understanding of the required standard of professional conduct.

Part 2 Legal process and overview of intellectual property

2. A course of study must provide for a student to have an appropriate level of understanding of the Australian legal system and how intellectual property rights may be protected, including by reference to:
- (a) the Australian legal system; and
 - (b) intellectual property rights.

Part 3 Professional conduct

3. A course of study must provide for a student to have an appropriate level of understanding of the rights, privileges and responsibilities of a patent attorney or trade marks attorney.

Part 4 Intellectual property law

4. A course of study must provide for a student to have an appropriate level of understanding of the principles of trade marks, patents, designs and copyright.

Part 5 Intellectual property systems

5. A course of study must provide for a student to have an appropriate level of understanding of the system of protecting and exploiting trade marks, patents and designs, both in Australia and other countries. This includes:
- (a) the ability to draft patent specifications; and
 - (b) an understanding of patent specifications; and
 - (c) the ability to advise on the interpretation, validity and infringement of patent specifications.

[8] Schedule 7, Part 1, item 107

substitute

- 107 Applying under regulation 20.29, 20.30 or 160
20.31

Schedule 2 **Amendments of *Trade Marks Regulations 1995***

(regulations 4 and 5)

[1] **Part 20**
substitute

Part 20 Registered trade marks attorneys

Division 1 General

20.1 Interpretation

(1) In this Part:

AQF means the Australian Qualifications Framework.

Board means the Professional Standards Board for Patent and Trade Marks Attorneys.

Register or *Register of Trade Marks Attorneys* means the register kept under section 228A of the Act.

(2) For regulation 20.6, the *higher education sector* comprises:

- (a) universities; and
- (b) higher education institutions other than universities; and
- (c) higher education providers.

Division 2 Obtaining registration for first time

20.2 Form of application

An application for registration as a trade marks attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and

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- (b) be accompanied by evidence and material mentioned in regulation 20.3; and
 - (c) be accompanied by the fee mentioned in item 28 of Schedule 9.

20.3 Evidence that applicant meets registration requirements

- (1) An application for registration as a trade marks attorney must be accompanied by the following:
 - (a) evidence that the Board is satisfied that the applicant has, or is entitled to the award of, an academic qualification of a kind mentioned in regulation 20.6;
 - (b) evidence that the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a trade marks attorney;
 - (c) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.10 (1); and
 - (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.10 (2);
 - (d) a statutory declaration, by another person, that the applicant is of good fame, integrity and character.
- (2) A statutory declaration under paragraph (1) (d) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character.

20.4 Certificate of registration

If the Designated Manager registers a person as a trade marks attorney, the Designated Manager must give the person a certificate of registration.

20.5 Evidence of academic qualifications

- (1) The Board must be satisfied that a person has a qualification mentioned in regulation 20.6 if:
 - (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the person has the qualification; and
 - (ii) the original or a certified copy of an academic record that shows the units that make up the qualification.
- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the qualification, notify the person, in writing, of its decision.

Note A decision that a person does not have a qualification is reviewable under regulation 21.35.

20.6 Academic qualifications

The Designated Manager must not approve an applicant for registration as a trade marks attorney unless the applicant has or is entitled to:

- (a) an AQF qualification from the higher education sector; or
- (b) a qualification awarded by an overseas institution that the Board is satisfied is equivalent to an AQF qualification from the higher education sector.

20.7 Evidence of knowledge requirements

- (1) The Board must be satisfied that a person has a knowledge requirement mentioned in regulation 20.8 if:
 - (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the applicant has the relevant knowledge; and
 - (ii) the original or a certified copy of any academic record that shows the study that contributes to the knowledge.

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- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the knowledge requirement, notify the person, in writing, of its decision.

Note A decision that a person does not have a knowledge requirement is reviewable under regulation 21.35.

20.8 Knowledge requirements

- (1) The Designated Manager must not approve an applicant for registration as a trade marks attorney unless the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a trade marks attorney.
- (2) Subject to subregulations (3), (4) and (5), the Board must, in satisfying itself whether or not an applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a trade marks attorney, take into account whether the applicant has qualifications that meet the minimum requirements set out in Schedule 5 to the *Patents Regulations 1991*.

Note Schedule 5 to the *Patents Regulations 1991* applies to a trade marks attorney as modified by regulation 20.11 of these Regulations.

- (3) The Board may publish guidelines setting out criteria for deciding whether or not areas of study:
- (a) are likely to meet the minimum requirements set out in Schedule 5 to the *Patents Regulations 1991*; and
 - (b) are likely to provide a person with the appropriate level of understanding to practice as a trade marks attorney.
- (4) The Board may be satisfied that an applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a trade marks attorney, despite the fact that the applicant does not meet every requirement set out in Schedule 5 to the *Patents Regulations 1991*.

- (5) The Board is not able to be satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practice as a trade marks attorney if the knowledge requirements on which the applicant relies were obtained more than 10 years prior to the application.
- (6) If an applicant has been granted an exemption under regulation 20.9, the applicant is taken to meet the requirement in Schedule 5 to the *Patents Regulations 1991* for which the exemption is granted.

Note Subsection 228A(4) of the Act provides that the Designated Manager must register as a trade marks attorney a person who satisfies certain conditions. Paragraph 228A(4)(a) requires that a person hold such qualifications as are specified in, or ascertained in accordance with, the Regulations.

20.9 Exemption from a requirement in Schedule 5 to Patents Regulations

- (1) The Board may exempt an applicant from having to satisfy all or some of the requirements mentioned in Schedule 5 to the *Patents Regulations 1991*.
- (2) The Board must not give an exemption to an applicant unless:
 - (a) the applicant makes an application in the form approved by the Board; and
 - (b) the applicant gives the Board enough information for the Board to be satisfied under paragraph (c); and
 - (c) the Board is satisfied that:
 - (i) the applicant has passed a course of study at a satisfactory level; and
 - (ii) the course of study has outcomes that are the same as, or similar to, those of a knowledge requirement for which the exemption is sought.
- (3) The Board may give an exemption under subregulation (1) if it is satisfied that the applicant has successfully completed a relevant course of study within the 5 years preceding the application or within a longer period specified in writing by the Board.

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- (4) An exemption under subregulation (1) is valid for 5 years from the date that the exemption was granted or for a longer period specified in writing by the Board.

20.10 Prescribed offences

- (1) For paragraph 228A (4) (c) of the Act, an offence against the Act, the *Designs Act 2003* or the *Patents Act 1990* is a prescribed offence.
- (2) For paragraph 228A (4) (d) of the Act, an offence of dishonesty for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence.

20.11 Application of Schedule 5 to Patents Regulations

Schedule 5 to the *Patents Regulations 1991* applies to obtaining registration as a trade marks attorney for the first time as if item 5 in Part 5 provided:

- ‘5. A course of study must provide for a student to have an appropriate level of understanding of the system of protecting and exploiting trade marks, both in Australia and other countries.’

Division 3 Accreditation of courses of study

20.12 Accreditation of courses of study

Part 3 of Chapter 20 of the *Patents Regulations 1991* applies to the accreditation of a course of study for the purposes of Schedule 5 to the *Patents Regulations 1991* in its application to the registration of a trade marks attorney under this Part as if references to ‘patent attorney’ were references to ‘trade marks attorney’.

Division 4 Board examinations

20.13 Board examinations

Part 4 of Chapter 20 of the *Patents Regulations 1991* applies to a requirement referred to in Schedule 5 to the *Patents Regulations 1991* in its application to the registration of a trade marks attorney under this Part as if references to ‘patent attorney’ were references to ‘trade marks attorney’.

Division 5 Maintaining registration, removal from Register and returning to Register

20.14 Maintaining registration, removal from Register and returning to Register

Parts 5, 6 and 7 of Chapter 20 of the *Patents Regulations 1991* apply to a trade marks attorney in its application to the registration of a trade marks attorney under this Part as if:

- (a) references to ‘patent attorney’ were references to ‘trade marks attorney’; and
- (b) references to the ‘Register’ were references to the ‘Register of Trade Marks Attorneys’; and
- (c) references to ‘trade marks attorney’ were references to ‘patent attorney’; and
- (d) the reference in paragraph 20.22 (1) (a) of the *Patents Regulations 1991* to ‘item 105 or 106 of Schedule 7’ were a reference to ‘item 29 or 30 of Schedule 9’; and
- (e) the reference in regulations 20.26 and 20.27 of the *Patents Regulations 1991* to the ‘Register of Patent Attorneys’ were a reference to the ‘Register of Trade Marks Attorneys’; and
- (f) the reference in regulations 20.29, 20.30 and 20.31 of the *Patents Regulations 1991* to ‘item 107 of Schedule 7’ were a reference to ‘item 31 of Schedule 9’.

Division 6 Discipline

20.15 Discipline

Part 8 of Chapter 20 of the *Patents Regulations 1991* applies to a registered trade marks attorney as if:

- (a) references to a ‘registered patent attorney’ were references to a ‘registered trade marks attorney’; and
- (b) references to a ‘registered trade marks attorney’ were references to a ‘registered patent attorney’; and
- (c) the reference in regulation 20.49 of the *Patents Regulations 1991* to ‘the Register of Patent Attorneys’ were a reference to ‘the Register of Trade Marks Attorneys’.

Division 7 Rights of registered trade marks attorneys

20.16 Lien

A registered trade marks attorney has the same right of lien over documents and property of a client as a solicitor.

[2] Paragraph 21.28 (1) (s)

substitute

- (s) the filing of a document or the giving of advice to the Registrar under Part 3A;
- (t) an action or step prescribed in Part 20.

[3] Paragraphs 21.35 (2) (a) and (b)

substitute

- (a) the Board under the following provisions:
 - (i) regulation 20.5 (‘evidence of academic qualifications’);
 - (ii) regulation 20.7 (‘evidence of knowledge requirements’); or

- (b) the Designated Manager under the following provisions of the *Patents Regulations 1991* in their application to trade marks attorneys:
 - (i) regulation 20.28 ('failure to comply with continuing professional education requirements');
 - (ii) regulation 20.29 ('restoring attorney's name to Register');
 - (iii) regulation 20.30 ('restoring attorney's name to Register following payment of unpaid fee');
 - (iv) regulation 20.31 ('returning to the Register in other circumstances'); or
- (c) the Disciplinary Tribunal under the following provisions of the *Patents Regulations 1991* in their application to trade marks attorneys:
 - (i) regulation 20.43 ('decision of Disciplinary Tribunal');
 - (ii) regulation 20.44 ('penalties — professional misconduct');
 - (iii) regulation 20.45 ('penalties — unsatisfactory professional conduct');
 - (iv) regulation 20.46 ('finding that attorney was unqualified at time of registration');
 - (v) regulation 20.47 ('finding that registration obtained by fraud').

[4] Schedule 9, item 31

substitute

- 31 Applying to be restored to the Register, as \$160
authorised by regulation 20.14

Note

1. All legislative instruments and compilations are registered on the Federal Register of Legislative Instruments kept under the *Legislative Instruments Act 2003*. See <http://www.frli.gov.au>.