

Patents Amendment Regulations 1998 (No. 10) 1998 No. 345

EXPLANATORY STATEMENT

STATUTORY RULES 1998 NO. 345

Issued by the Authority of the Minister for Industry, Science and Resources

Patents Act 1990

Patents Amendment Regulations 1998 (No. 10)

The Statutory Rules amend the Patents Regulations (the Regulations) to implement changes to the regulatory regime for professional practice in patent matters as a consequence of the changes included in Schedule 2 of the *Intellectual Property Laws Amendment Act 1998*.

The changes in the Act -

- remove restrictions on who can practice before the Trade Marks and Designs Offices to allow any person the right of professional practice before the offices,
- establish a new registered profession of trade marks attorney with a requirement to obtain qualifications before being eligible for registration
- introduce revised qualification requirements for registration to reflect the revised system for both the registration of trade marks attorneys and the registration of patent attorney
- include provisions allowing for the tertiary sector to have responsibility for the testing of knowledge based competence for registration while at the same time allowing the Board to conduct examinations if necessary,
- introduce a course accreditation system to be administered by the Board
- introduce time limits for completing courses of study
- provide necessary transitional arrangements enabling certain classes of practitioners to be registered as trade marks attorneys on the basis of experience where they have not satisfied all the requirements of the education regime.

Details of the amendments made by the Statutory Rules are as follows:

Regulation 1 cites the regulations as the *Patents Amendment Regulations 1998*.

Regulation 2 provides that the Regulations will commence date of 27 January 1999.

Regulation 3 incorporates the provisions in Schedule 1 into the *Patents Regulations 1991*.

Schedule 1

Item [1] removes the definition of a patent attorney from the Regulations as the Act now provides the definition.

Item [2] amends the definition of the Disciplinary Tribunal to reflect its changed role for both patent and trade marks attorneys.

Item [3] amends the definition of the Board to reflect the revised provisions in the Act.

Item [4] introduces a new accreditation regime that enables the Board to approve courses to be conducted by institutions as meeting the education requirements contained in the Regulations.

Regulation 20.2A allows the Board to accredit courses for a period of five years where a course contains appropriate topics and delivers outcomes. Where the board requests further information to confirm accreditation it must settle the issue within 2 months of receiving the information. However the Board may revoke accreditation where changes are made to a course so that it no longer satisfies the requirements. Institutions are also required to advise the Board of changes made to courses so that the Board can re-evaluate the course.

Regulation 20.2B provides that the Board may give provisional accreditation where it receives information that meets the requirement in respect of topics but the evidence is not conclusive in respect of outcome and more evidence is required. However the provisional accreditation must be confirmed within 2 months of receiving the information or the additional information in accordance with the provisions in regulation 20,2A.

Item [5] revises requirements for registration necessitated by the changes made in the Act and the introduction of the accreditation regime.

Regulation 20.3 inserts revised provisions that specify the requirements for registration as being

- * appropriate qualifications specified in the schedule to the regulations,
- * employment for one year as a technical assistant in a patent attorney practice, or
- * employment in a company practicing in patents for the company or a related company within the meaning of the corporations law, or
- * employment as an examiner in the Patent Office. The Regulation also prescribes offences that would preclude a person from becoming registered. The relevant offences are against the Patents, Trade Marks and Designs Acts and a conviction against an offence of dishonesty carrying a penalty of more than 2 years imprisonment.

Regulation 20.3A introduces 5 years time limits for completing each of the two stages of a course of study to qualifying a person for registration as a trade marks attorney or a patent attorney when the Board conducts examinations or the institution providing the course of study does not impose time limits.

Item [6] omits from Regulation 20.4 a requirement that a person provides evidence that they are over 21 years of age.

Item [7] removes from Regulation 20.4(c) the requirement for the Board to issue certificates and replaces it with a requirement that the Board provide written advice to a person that they have satisfied the requirements.

Item [8] inserts a new paragraph 20.4(e) that requires a person seeking registration to provide statutory declarations that they have not been convicted of prescribed offences and that they are of good fame and character.

Item [9] amends the heading in Regulation 20.6 to make it clear that the provisions related to examinations refer to examinations conducted by the Board.

Item [10] amends Regulation 20.6 to remove the compulsion for the Board to hold examinations.

Item [11] amends Regulation 20.7 to provide that when the Board conducts examinations it will be required to publish adequate notice of the examination and the deadlines for applying to the Board to sit them.

Items [12] and [13] change Regulation 20.8 to reflect the new regime where there are exam providers other than the Board.

Item [14] and [15] change existing Regulation 20.9 to reflect the revised education arrangements in Schedule 5 of the Regulations.

Item [16] changes the heading of Regulation 20.10 to make it clear that the provision applies to examinations conducted by the Board only.

Item [17] changes Regulation 20.11 to ensure that the Board can only give reasons for failure for examinations its conducts.

Item [18] inserts a new Regulation 20.12(2) that allows the Board to take account of examiners comments when considering an application for a supplementary exam and specifies the type of information sought when making an application for a supplementary examination.

Items [19], [20] and [21] amend Regulation 20.13(1), 20.13(2)(b) and 20.13(3) so that the exemption provisions are consistent with the proposed education and examination system. The provisions specify documentation required by the Board to allow it to decide whether an exemption should be granted and remove the requirement for the Board to issue certificates of exemption.

Item [22] amends Regulation 20.14(2)(b) to ensure that a broader range of courses can be deemed to meet the requirement for a qualification in a field of study relating to potentially patentable subject matter.

Items [23], [24] and [25] amend Regulation 20.15 to remove the requirement for the Board to issue a certificate of approval of academic qualifications and to specify the documentation required by the Board to consider the application for approval of the qualification as meeting the prescribed requirements.

Item [26] amends Regulation 20.16 to remove the requirement for the Board to issue a certificate where a person has completed the qualification and replaces it with a written advice where a person has completed the education requirements.

Item [27] changes the reference to patent attorneys in the Regulations to reference to a registered patent attorney.

Items [28] and [29] amend Regulation 20.19 to more clearly state the fee payable for restoration of a registration and insert a new provision 20.19A allowing a registered patent attorney to seek temporary removal from the register for a period of up to three years.

Items [30], [31], [32] and [33] make amendments of form to Regulations 20.21 and 20.32 which are consequential on changes made by the Act.

Item [34] amends Regulation 20.34 to remove restriction on the age of appointees to the Board.

Item [35] changes the title of the discipline tribunal in Division 2 to reflect a broader role as the Patent and Trade Marks Attorneys Discipline Tribunal.

Item [36] make Regulations 23.27, 23.28, 23.29, 23.30 and 23.31 that provide for transitional arrangements to ensure that the existing actions and past decision of the Board remain in place. This ensures that persons who have been taking actions under the current regulations are not disadvantaged by the changes. The Regulations also provide that a person who has passed or has been exempted from having to pass certain subjects under the existing regime will be given equivalent credits in the new regime.

Item [37] seeks to amend Schedule 5 of the existing Regulations to replace the current education requirements with a new regime that shows the required topic of study and the required outcomes that should be achieved by that study. These topics of study and outcomes are proposed as the basis of the new accreditation regime and will determine future courses conducted by the Board.

Item [38] amends Schedule 6 of the existing Regulations to broaden the subject matter of the degree, diploma or post-graduate course required in Regulation 20.3 to that of potentially patentable subject matter.

Item [39] amends Schedule 7, Part 1 to show. new fee rates and to delete the fee item for the issue of a certificate under the old Regulation 20.19.

Item [4] makes a number of minor drafting amendments associated with the changes that will ensure consistency in terminology etc. in other areas that have not been subject to change.