EXPLANATORY STATEMENT

Select Legislative Instrument 2008 No. 122

Issued by the Authority of the Minister for Innovation, Industry, Science and Research

Patents Act 1990
Trade Marks Act 1995

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

Section 228 of the Patents Act 1990 (the Patents Act) and section 231 of the Trade Marks Act 1995 (the Trade Marks Act) provide, in part, that the Governor-General may make Regulations for the purposes of those Acts, prescribing matters required or permitted by these Acts to be prescribed.

Paragraph 228(2)(r) of the Patents Act and paragraph 231(2)(ha) of the Trade Marks Act respectively provide that the Governor-General may make Regulations for the control of the professional conduct of registered patent and trade marks attorneys and the practice of the professions.

In addition, subsection 198 (4) of the Patents Act and subsection 228A (4) of the Trade Marks Act provide that the Designated Manager must register as a patent attorney or as a trade marks attorney respectively, a person who inter alia holds such qualifications as are specified in, or ascertained in accordance with, the regulations under each of those Acts.

The Regulations amend the Patents Regulations 1991 and the Trade Marks Regulations 1995 to update the scheme for registering patent attorneys and trade marks attorneys, and for disciplining registered attorneys. The framework for that scheme is set out in Chapter 20 of the Patents Regulations 1991 and in Part 20 of the Trade Marks Regulations 1995. To avoid the duplication of several provisions relating to registration and discipline, the majority of the amendments made by the Regulations are to provisions in Chapter 20 of the Patents Regulations 1991. Part 20 of the Trade Marks Regulations 1995, as amended, applies, with appropriate modification, a number of provisions in Chapter 20 of the Patents Regulations 1991 to applicants for registration as trade marks attorneys, and to registered trade marks attorneys.

The changes to the scheme for registering and disciplining patent and trade marks attorneys arose from two reviews on the regulatory and discipline regimes conducted by the Professional Standards Board for Patent and Trade Marks Attorneys (“Board”). The Australian Government responded to these reviews in 2005 and after extensive consultation, IP Australia published two position papers on how the Government intended to respond to the reviews.

The Regulations amend the Patent Regulations 1991 and Trade Marks Regulations 1995 to:
• provide that a person seeking registration as a patent attorney or as a trade marks attorney must have sufficient knowledge of intellectual property law and practice (‘the knowledge requirement’);

• ensure that the Board is empowered to accredit courses of study provided by institutions, which would assist applicants to achieve the knowledge requirement;

• require that an applicant for registration as a patent attorney, or as a trade marks attorney, has (or is entitled to) an academic qualification from the higher education sector, which is accredited under the Australian Qualifications Framework (AQF) or is an equivalent foreign qualification;

• ensure that any academic qualification sufficient for registration as a patent attorney is in a field of science or technology that contains potentially patentable subject-matter;

• require each applicant for registration as a patent attorney to have undertaken at least two years employment relevant to practice as a registered attorney, and to evidence the practical skills acquired in that employment;

• require each registered patent attorney, and registered trade marks attorney, to undertake continuing professional education in every year—failing which the Designated Manager may de-register the attorney for up to 6 months;

• simplify the disciplinary procedure applying to registered patent attorneys and registered trade marks attorneys; and

• amend the key definitions of misconduct to bring them into line with definitions applying to legal practitioners.

Details of the Regulations is at Attachment A.

In accordance with section 17 of the Legislative Instruments Act 2003, IP Australia has undertaken consultation with the Board, peak intellectual property organisations and individual patent and trade marks attorneys. The Regulations have been made in response to recommendations of a review of the registration system for patent and trade marks attorneys undertaken by the Board.

The Regulations commence on 1 July 2008.
ATTACHMENT A

Details of the *Patents and Trade Marks Legislation Amendment Regulations 2008 (No. 1)*

Regulation 1 identifies the Regulations as the *Patents and Trade Marks Legislation Amendment Regulations 2008 (No. 1)*.

Regulation 2 specifies that the Regulations commence on 1 July 2008.

Regulation 3 specifies that Schedule 1 amends the *Patents Regulations 1991*.

Regulation 4 specifies that Schedule 2 amends the *Trade Marks Regulations 1995*.

Regulation 5 outlines the transitional provisions to facilitate a smooth transition to the new arrangements.

**Schedule 1 – Amendments to the Patents Regulations 1991**

**Item 1** amends the definition of “former attorneys Regulations” to include reference to the *Patents Regulations 1991*, as in force immediately before 1 July 2008.

**Item 2** substitutes a new Chapter 20 for the previously existing Chapter 20 of the *Patents Regulations 1991* to update the existing scheme for registering patent attorneys and for disciplining registered attorneys.

Part 1 sets out the definitions of several expressions appearing in Chapter 20.

Part 2 provides for obtaining registration as a patent attorney for the first time and includes:

- provisions setting out how an applicant may apply for registration, and the documentary evidence the applicant must provide (regulations 20.2 and 20.3)
- provisions requiring that the applicant has (or is entitled to) an academic qualification from the higher education sector, which is accredited under the Australian Qualifications Framework (AQF) or is an equivalent foreign qualification, and is in the field of science or technology that contains patentable subject matter and involves a depth of study appropriate for practice as a patent attorney. (regulations 20.5 and 20.6)
- provisions requiring that the applicant meet the knowledge requirement —the knowledge of intellectual property law and practice that is required for a person to practice as a patent attorney—and setting out how a person can satisfy the Board that this requirement is met (regulations 20.7 to 20.9)
- provisions requiring each applicant to have undertaken at least 2 years relevant employment in the last 5 years—preparing, filing and prosecuting
patent applications on behalf of clients—and requiring the applicant to provide the Designated Manager with a detailed statement of the applicant’s practical skills prepared by a senior registered patent attorney (regulations 20.10 to 20.11)

Parts 3 and 4 provide for the Professional Standards Board for Patent and Trade Marks Attorneys (‘Board’) to accredit courses of study, or to conduct examinations, for the purposes of applicants meeting the knowledge requirement (regulations 20.13 to 20.21). These provisions are largely unchanged from the previous provisions in regulations 20.2A, 20.2B and 20.6 to 20.12 of the *Patents Regulations 1991*.

Part 5 sets out the requirements for a registered patent attorney to maintain registration, and introduces the requirement for every registered patent attorney to undertake continuing professional education (CPE) each year (regulations 20.26 to 20.25).

Part 6 provides for removal of a registered patent attorney’s name from the Register of Patent Attorneys—at the attorney’s request, or through failure to pay the annual registration fee or to comply with the CPE requirements (regulations 20.22 to 20.28).

Part 7 provides for the restoring of a previously registered patent attorney’s name to the Register of Patent Attorneys, and gives the Designated Manager a new power to require the re-registered attorney to undertake CPE activities as a condition of restoration (regulations 20.29 to 20.31).

Part 8 provides for a simplified disciplinary regime for registered patent attorneys; introduces new definitions of misconduct—‘professional misconduct’ and ‘unsatisfactory professional conduct’—aligned with those applying to legal practitioners; and provides that the Patent and Trade Marks Attorneys Disciplinary Tribunal (‘Disciplinary Tribunal’) can not only suspend or cancel an attorney’s registration (as the Tribunal was able to do previously), but can also require the attorney to undertake additional CPE or submit to supervision by a senior registered patent attorney (regulations 20.32 to 20.52).

Parts 9 and 10 provide respectively for the rights of registered patent attorneys, and for the constitution and administration of the Disciplinary Tribunal and the board. These provisions are unchanged in effect from the previously existing provisions in regulation 20.17 and Part 5 of the *Patents Regulations 1991*.

Item 3 amends subregulation 22.11 (4) to make it clear that the Commissioner of Patents cannot extend the time for undertaking an action or step under Chapter 20 of the *Patents Regulations 1991*, as the Commissioner has no responsibility of matters in Chapter 20.
Item 4 amends subregulation 22.26 (2) to make several decisions of the Board, the Designated Manager and the Disciplinary Tribunal reviewable by the Administrative Appeals Tribunal.

Items 5 and 6 deletes several transitional provisions that are spent.

Item 7 substitutes a new Schedule 5 to the Patents Regulations 1991 setting out the minimum requirements to which the Board must have regard when determining, under new regulation 20.8, whether or not a person has the knowledge of intellectual property law and practice required to practice as a patent attorney.

Item 8 amends fee item 107 in Part 1 of Schedule 7 to the Patents Regulations 1991—previously applying to applications for voluntarily removing a patent attorney’s name from, or restoring it to, the Register of Patent Attorneys—to refer to the new provisions in Part 7 for restoring an attorney’s name to that Register.

Schedule 2 – Amendments to the Trade Marks Regulations 1995

Item 1 substitutes a new Part 20 for the previously existing Part 20 of the Trade Marks Regulations 1995.

The system for registration of trade marks attorneys set out in new Part 20 differs from that for the registration of patent attorneys in several matters. As was previously the case, there is no requirement for any pre-registration employment (see regulation 20.3). It is sufficient that the applicant has a academic qualification from the higher education sector—accredited under the AQF, or an equivalent foreign qualification—it need not be in any field of science or technology (see regulation 20.6). The knowledge requirements set out in new Schedule 5 to the Patents Regulations 1991, are modified necessarily to refer to the system of protecting and exploiting trade marks, both in Australia and other countries.

Otherwise, the new system for registration and discipline of trade mark attorneys is substantially identical with that applying to patent attorneys: by virtue of regulations 20.12 to 20.15, which apply the provisions of new Parts 3 to 8 of Chapter 20 of the Patents Regulations 1991 with necessary modifications.

Item 2 amends subregulation 21.28 (1) to make it clear that the Registrar of Trade Marks cannot extend the time for undertaking an action or step prescribed in Part 20.

Item 3 amends subregulation 21.35 (2) to make several decisions of the Board, the Designated Manager and the Disciplinary Tribunal reviewable by the Administrative Appeals Tribunal.

Item 4 amends fee item 31 in Schedule 9 to the Trade Marks Regulations 1995—previously for applications for voluntarily removing an attorney’s name from, or restoring it to, the Register of Trade Marks Attorneys—to refer to new regulation 20.14, which applies with modifications the new provisions in Part 7 of the Patents Regulations.
1991 for restoration of an attorney’s name to the Register.