

***Intellectual Property (Standards of Practice) Instrument 2013 (No. 1)***

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This instrument commences on 15 April 2013.

For paragraph 228(2)(r)(ia) of the *Patents Act 1990* and paragraph 231(2)(ha)(ia) of the *Trade Marks Act 1995*, the Professional Standards Board establishes the Code of Conduct for Patent and Trade Marks Attorneys (published by the Board and commencing on 1 July 2008) as a standard of practice.

PROFESSIONAL STANDARDS BOARD FOR PATENT AND TRADE MARKS  
ATTORNEYS

22 March 2013



**Australian Government**

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Professional Standards Board for  
Patent and Trade Marks Attorneys

**CODE OF CONDUCT**

FOR

**PATENT AND TRADE MARKS  
ATTORNEYS**

1 July 2008

# **CODE OF CONDUCT**

## **FOR**

### **PATENT AND TRADE MARKS ATTORNEYS**

**1 JULY 2008**

#### **1. BACKGROUND**

- 1.1. The Code of Conduct published by the Professional Standards Board for Patent and Trade Marks Attorneys (the Board) applies to all registered patent and trade marks attorneys (attorneys) including those employed in companies undertaking the business of the company.
- 1.2. The former Code of Conduct was developed by the Board on the basis of widespread stakeholder consultation and with the cooperation of the profession and the Australian Competition and Consumer Commission (ACCC). It was established at the instigation of the Government in its response to the Review of the Regulatory Regime for Patent Attorneys undertaken in 1996.
- 1.3. The Board has revised the former Code of Conduct to reflect changes to the discipline regime for registered attorneys brought about by amendments to the *Patents Regulations 1991* and the *Trade Marks Regulations 1995*.
- 1.4. In this Code a reference to the professions is a reference to the patent and trade marks attorney professions.
- 1.5. This Code commences on 1 July 2008.

#### **2. OBJECTIVES OF THE CODE**

- 2.1 To provide a framework for fair and equitable dealing between attorneys and their clients; attorneys and their fellow practitioners; and attorneys and IP Australia – the office of Patents, Trade Marks, Designs and Plant Breeders Rights.
- 2.2 To provide a standard of acceptable conduct that can be used in the settling of disputes.
- 2.3 To assist clients of attorneys and others dealing with the professions to understand the obligations of attorneys to their clients, IP Australia and each other. The Code also provides how information can be provided to the Board to enable the Board to investigate the conduct of the attorney.

### **3. THE CODE OF CONDUCT**

#### **3.1 Preamble**

- i. The Code contains specific comment about some behaviour by way of illustration to assist attorneys and their clients to understand the breadth of the Code and the types of conduct covered. The specific instances are not exhaustive and in no way limit the impact of the principles of the Code on the individual attorney's method of practice.
- ii. This Code does not diminish an attorney's responsibility to act according to law. In addition, it does not in any way diminish a client's rights.

#### **3.2 Code**

3.2.1 Only registered patent attorneys, as defined under the *Patents Act 1990*, may undertake all aspects of practice as patent attorneys and may describe themselves as patent attorneys. Only registered trade marks attorneys, as defined under the *Trade Marks Act 1995*, may describe themselves as trade marks attorneys or as trade mark agents.

- i. The *Patents Act 1990* allows legal practitioners, *who are not patent attorneys*, to carry on the business, act or practice as a patent attorney but they must not describe themselves as patent attorneys. They are not allowed to prepare specifications, except under specified conditions, such as acting under the instructions of a registered patent attorney, or acting at the direction of a court. The Act also allows the client of a registered patent attorney the right to claim privilege in relation to communications with the patent attorney in appropriate circumstances.
- ii. The *Trade Marks Act 1995* allows any person to practise before IP Australia in trade mark matters, but only registered trade marks attorneys have the right to describe themselves as trade marks attorneys or trade marks agents. The Act also allows the client of a registered trade marks attorney the right to claim privilege in relation to communications with the trade marks attorney in appropriate circumstances.
- iii. An attorney must not undertake work for which he/she is not qualified, for example, an attorney must not purport to be able to represent a client before a court if they are not entitled to do so.

3.2.2 An attorney supervising unqualified staff is responsible for the work of the unqualified staff.

- i. If a client is dealing with a staff member who is not an attorney, the client must be informed that the staff member is not registered. The staff member must work under the active supervision of an attorney.

- 3.2.3 In the interests of clients, the qualifications of an attorney to practise will be clearly indicated, and appropriate expertise, including technical expertise, will be brought to bear on work entrusted by clients.
- 3.2.4 Where an attorney engages another practitioner, either in Australia or in another country to act on behalf of a client, the attorney must make inquiries to satisfy himself or herself that the other practitioner is appropriately qualified to carry out the work required.
- 3.2.5 An attorney must at all times maintain standards of professional practice which are at once courteous, ethical and well-informed.
- i. An attorney must act according to, and uphold the norms of the professions.
  - ii. An attorney must not act in a way that is fraudulent or deceitful and must at all times ensure that his/her conduct is appropriate to the professions.
  - iii. The success of the professions relies heavily on trust, honesty, and a high standard of behaviour as described in the following paragraphs.
  - iv. An attorney must make available to a client, information regarding the implications of having the attorney act on the behalf of the client in a matter, in terms of procedures, cost and timing. This will ensure that the client is made aware of the likely costs of the actions that are necessary or recommended by the attorney.
  - v. At the request of a client, an attorney must provide a detailed estimate of the cost of acting for the client in a particular matter.
  - vi. Where an attorney withdraws his or her services or ceases to act for a client, the attorney must inform the client of any actions necessary to maintain the intellectual property rights of that client.
- 3.2.6 An attorney must handle the funds of a client in accordance with proper accounting practices. An attorney must not use monies paid by a client other than for the purposes for which the monies are paid.
- 3.2.7 An attorney must at all times act within the law and be subject to that obligation in the best interests of the client.
- i. An attorney must act promptly on a client's instructions or promptly inform a client of his or her inability to do so.
  - ii. An attorney must not use his/her position to take advantage of either on his/her own account or on behalf of another person -
    - information given to the attorney by a client, or
    - circumstances resulting from the professional relationship with a client.

- iii. A client should be given an opportunity to view drafts of specifications where time allows.
  - iv. Subject to the client satisfying any lien imposed in accordance with the relevant legislation, all documents, samples and other material that is the property of the client must be made available or forwarded to the client on request.
- 3.2.8 An attorney must take all reasonable steps to avoid situations in which a conflict between the interests of a client and the interests of the attorney or those of another client may occur.
- i. Where a conflict or a potential conflict arises, an attorney must take immediate steps to resolve the conflict. Where the rights of a person might be put at risk by failing to act urgently in a conflict or potential conflict, the attorney must take the necessary action to maintain the rights of a person and then immediately resolve the conflict.
- 3.2.9 An attorney must not engage in behaviours or practices which are misleading or deceptive, or that are likely to mislead or deceive. This includes dealings with IP Australia and in, particular, dealings with the Commissioner of Patents, Registrar of Trade Marks, Registrar of Designs and Registrar of Plant Breeders Rights.
- i. To mislead someone may include:
    - lying to them;
    - leading them to a wrong conclusion;
    - creating a false impression;
    - leaving out (or hiding) important information; and
    - making false or inaccurate claims.
  - ii. Advertising is permitted but it should be honest and accurate and it should avoid the pitfalls described above. If it is of a comparative nature it must be factually supportable and any comparisons must not be misleading.

## **4. WHAT IS EXPECTED OF CLIENTS**

- 4.1 The following is intended to assist a client in understanding what makes for a successful relationship with an attorney.
- 4.2 Clients should:
- assist the attorney to provide appropriate advice or take appropriate action by disclosing all relevant information they hold in respect of the rights sought;
  - provide attorneys with clear and timely instructions based on the advice given;
  - provide timely responses to requests from the attorney;
  - settle accounts provided by attorneys promptly, including charges for overseas actions commissioned by the attorney in accordance with client instructions;

- provide advance payments when requested; and
- observe the same standards of honesty and courtesy in the relationship as are required of the attorneys themselves.

## **5. COMPLAINTS AGAINST AN ATTORNEY**

### **5.1 Grounds for complaint**

- i. A complaint or information on the behaviour of an attorney may be provided to the Board on the grounds that an attorney:
  - has breached this Code;
  - has engaged in professional misconduct or unsatisfactory professional conduct;
  - was unqualified at the time of registration; or
  - has obtained registration by fraud.

### **5.2 Definitions**

- i. **Professional misconduct means:**
  - unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or
  - 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
  - any contravention of a law that is declared by the *Patents Regulations 1991* or the *Trade Marks Regulations 1995* to be professional misconduct.
- ii **Unsatisfactory professional conduct** includes conduct, in connection with practice as a registered patent or trade marks 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.

### **5.3 Complaints and Discipline**

- i. The Board has the sole responsibility for commencing and conducting disciplinary proceedings against a registered attorney.
- ii. Any person or body may complain or provide information to the Board concerning the conduct of a registered attorney.
- iii. The Board's role in the commencing of disciplinary proceedings includes investigating either as a result of information received or of its own motion whether an attorney has engaged in professional misconduct or unsatisfactory professional conduct.
- iv. Clients must discuss a grievance with an attorney to attempt settlement before referring the conduct of the attorney to the Board.

### **5.4 Complaints Can Be Made To:**

- i. A complaint about the conduct of an attorney under this Code of Conduct must be made to:

The Secretary  
Professional Standards Board for Patent and Trade Marks  
Attorneys  
PO Box 200  
WODEN ACT 2606  
Phone: (02) 6283 2345.

## **6. ADMINISTRATION OF THIS CODE**

### **6.1 Administration body**

- i. The Code is a publicly available document and it is administered by the Professional Standards Board for Patent and Trade Marks Attorneys established under the *Patents Act 1990* and the *Patents Regulations 1991*.
- ii. The Board will supervise:
  - the publicising of the Code, ensuring widespread awareness of its provisions;
  - the availability of the Code to clients and potential clients;
  - the implementation of measures for ensuring attorney awareness of the Code;
  - the conduct of periodic reviews of the effectiveness of the Code and its procedures with a view to possible change; and
  - the preparation of annual and other reports in relation to the Code.
- iii. Copies of this Code of Conduct are available on the PSB Website and can be obtained from:

Professional Standards Board Secretariat  
PO Box 200  
WODEN ACT 2606  
Phone: (02) 6283 2345.  
Email: [mail.psb@ipaustalia.gov.au](mailto:mail.psb@ipaustalia.gov.au)  
Website: [www.psb.gov.au](http://www.psb.gov.au)