



Australian Government



New Zealand Government
Te Kāwanatanga o Aotearoa

Trans-Tasman IP Attorneys Board Chair's Report 2022-23



Chair's Report 2022-23

Introduction

The Trans-Tasman IP Attorneys Board (the Board) is a statutory body established under section 227A of the *Patents Act 1990* (Cth). The Board was given effect by the *Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys* (the Trans-Tasman Patent Attorney Arrangement).

This report covers the activities of the Board and the Designated Manager for the period 1 July 2022 – 30 June 2023.

Functions and responsibilities

The Board administers the regulatory and disciplinary systems for patent attorneys in Australia and New Zealand, and for trade marks attorneys in Australia. The Board's primary roles are:

- to determine whether an applicant for registration as a patent attorney has the required academic qualifications in a field of science or technology;
- to determine whether an applicant for registration as an attorney has the required knowledge of intellectual property law and practice;
- to accredit courses of study providing the knowledge required for registration as an attorney;
- to establish standards of practice for registered attorneys;
- to investigate complaints against registered attorneys; and
- to determine when the conduct of a registered attorney should be the subject of disciplinary proceedings before the Trans-Tasman IP Attorneys Disciplinary Tribunal.

2022–23 Board highlights

The Board met on 3 occasions (26 July 2022, 6 December 2022 and 29 March 2023). It assessed 174 applications, and approved 159 applications, concerning the academic qualifications and the knowledge requirements for attorneys. Common reasons why applications are not approved are:

- Academic qualifications not containing the required depth of study
- Knowledge requirement applications not containing study outcomes equivalent to those provided by the accredited courses
- Insufficient material provided by the applicant, including incomplete application forms

Detailed statistics are in Table 3.

During 2022-23 the Board investigated ten complaints against registered attorneys, an increase of 67% over the preceding year. The Board determined one complaint met the threshold for referral to the Trans-Tasman IP Attorneys Disciplinary Tribunal. These proceedings were dismissed by the Tribunal when the attorney in question was removed from the Register at their request in accordance with Patent Regulation 20.26. This is not the first time this attorney has engaged in the practice of removing their name from the Register to defer disciplinary action. The Board does not have power to pursue attorneys once they have removed themselves from the Register. I note the recent report on the Review of the Trans-Tasman Patent Attorney Arrangement includes a recommendation intended to address this gap in the regulations¹.

¹ *Report on the Review of the Arrangement Between the Governments of Australia and New Zealand Relating to the Trans-Tasman Regulation of Patent Attorneys* May 2023 at recommendations 7 and 8.

One matter referred to the Tribunal in 2021–22 remains open. This matter was heard by a Tribunal panel in September 2022 and a decision had yet to be issued as at 30 June 2023.

Enhancement of the Guidelines to the Code of Conduct

The Board has established the *Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018* (the Code of Conduct), which sets standards of practice for assessing the professional conduct of attorneys. The Board has produced *Guidelines* to the Code of Conduct, which explain and elaborate its provisions. In June 2023, substantial enhancements to the Guidelines were published, and an educative webinar on the enhancements was provided to attorneys and other stakeholders.

Review of the Trans-Tasman Patent Attorney Arrangement

The report on the Review of the Trans-Tasman Patent Attorney Arrangement was published on 31 May 2023. The report concluded that, at a high level, the arrangement is working well. The report provided 12 recommendations for improvement of the administration of the regime, six of which were directed to the Board.

As at 30 June 2023, the Board had not had the opportunity to formally meet and consider the Review recommendations. The table below provides my initial view as Chair on how the Board will respond over the next 12 months. The Board will provide a comprehensive update on progress against the recommendations in next year’s Annual Report.

Recommendation	Response from Chair of the Board
No. 1. The Board, with IP Australia (IPA) and the Ministry of Business, Innovation and Education of New Zealand (MBIE), should continue to monitor the availability of suitable courses to qualify as patent attorneys	The Board will continue monitoring the availability of suitable courses.
No. 2. The Board should review the accredited courses to qualify as a patent attorney to ensure they reflect current law and practice.	The Board will consider the process for undertaking a review of accredited courses at its August 2023 meeting.
No. 5. The Board should continue its work to provide more: <ul style="list-style-type: none"> a. guidance and general information to attorneys, especially about conflicts of interest, complaints, and discipline matters. b. educational resources to the profession, such as seminars and presentations on subject matter of interest. This would include the Board continuing its work to pilot continuing professional education courses on professional conduct, ethics, and other topics of interest. 	The Board’s Communications and Outreach sub-committee will consider how we continue to provide guidance, information, and educational resources to the attorney professions. A pilot webinar was delivered by the Board in June 2023 in collaboration with IPTA and NZIPA, which attracted over 900 registrations.
No. 6. The Board should continue to regularly review the Code of Conduct as required by the Arrangement. Such a review should include consideration of the protection available to complainants and whether the Code of Conduct should provide a clause that bars attorneys from launching defamation proceedings or other legal action in certain circumstances.	The Board will consider an appropriate timeframe for the next review of the Code of Conduct at its August 2023 meeting.
No. 9. The Board, with IPA and MBIE, should continue to provide information to the profession, potential clients, and the public about the regime and the ability for patent attorneys to operate across both jurisdictions. This content should continue to be easily and readily available, with consistent information across jurisdictions and platforms	The Board’s Communications and Outreach sub-committee will consider how we can continue to provide information to stakeholders about the trans-Tasman regime.

2022–23 Designated Manager update

The *Patents Act 1990* (Cth) provides for a person, the Designated Manager, to register patent attorneys and trade marks attorneys, and to maintain the respective Registers of Patent Attorneys and Trade Marks Attorneys. The role of Designated Manager is performed by the General Manager, Governance Group, IP Australia, Jennifer Hutchinson.

As at 30 June 2023, there were a total of 1580 individual registered attorneys and 94 incorporated registered attorneys (an increase of 3.5 % and 9.3%, respectively compared to last year). 80 new registrations were recorded while 73 attorneys were removed from the Registers. Common reasons for an attorney to request removal are:

- Retirement
- Maternity/Paternity Leave
- Relocation overseas and no intention to practice in the trans-Tasman jurisdiction

Further detail is available in tables 4, 5 and 6.

Registered attorneys	Individuals		Incorporated	
	2022-2023	2021-2022	2022-2023	2021-2022
Single-registered patent attorneys	381	376	34	31
Single-registered trade marks attorneys	511	485	7	7
Dual-registered patent & trade marks attorneys	688	665	53	48
Total registered attorneys	1580	1526	94	86

Membership

The legislation establishing the Board provides for a minimum of seven and no more than 10 members. Members, other than ex officio members, are appointed by the Australian Minister for Industry and Science in consultation with the New Zealand Minister for Commerce and Consumer Affairs. The Board is required to include:

- the Chair – alternatively held by an Australian-based appointee and a New Zealand-based appointee.
- the Director General of IP Australia, ex-officio.
- the New Zealand Commissioner of Patents, ex-officio.
- at least two New Zealand resident patent attorneys (nominated by the New Zealand Minister of Commerce and Consumer Affairs); and
- at least two other members.

Australian Government guidelines also recommend geographic and gender diversity, with women and men each holding a minimum of 40 per cent of positions at an individual board level. The Board's membership addresses this recommendation.

The terms of the New Zealand-based Chair, one New Zealand-based appointed member, and two Australian-based appointed members expired during the reporting period. These vacancies are now full, and I will hold the position of Chair until 14 November 2025.

TABLE 1: OFFICE HOLDERS DURING THE REPORTING PERIOD

Name	Position	Location	Gender	Background
Ms. Elizabeth Hopkins	<i>Outgoing Chair</i>	<i>New Zealand</i>	<i>F</i>	<i>Independent consultant and non-executive director</i>
Mr Ian Finch	<i>Outgoing Member</i>	<i>New Zealand</i>	<i>M</i>	<i>Patent attorney</i>
Mr Anthony Alder	<i>Outgoing Member</i>	<i>New South Wales, Australia</i>	<i>M</i>	<i>Patent and trade marks attorney</i>
Mr Carl Harrap	<i>Outgoing Member</i>	<i>New South Wales, Australia</i>	<i>M</i>	<i>Patent attorney</i>
Ms. Jennifer Hutchinson	Deputy ex officio Member	Australian Capital Territory, Australia	M	General Manager of Governance Group, IP Australia, representing Director General, IP Australia
Mr Ross van der Schyff	Ex officio Member	New Zealand	M	New Zealand Commissioner of Patents
Ms. Kate Duckworth	Appointed Member	New Zealand	F	Patent and trade marks attorney
Dr Karin Innes	Appointed Member	Victoria, Australia	F	Patent and trade marks attorney
Ms. Viet-Chau Tran	Appointed Member	New South Wales, Australia	F	Special Counsel
Prof Andrew Christie	New Chair	Victoria, Australia	M	Legal practitioner, trade marks attorney, professor of intellectual property law
Dr Jason Coonan	New Member	Victoria, Australia	M	Scientist, patent attorney, innovation specialist
Ms. Michelle Goldsmith	New Member	Victoria, Australia	F	Scientist, commercialisation specialist

Meetings

Three formal Board meetings were held during the reporting period. The Board has Sub-Committees (comprising a subset of Board members) to which the Board delegates responsibility for considering operational matters and making recommendations to the Board. Sub-Committee meetings occur virtually, in advance of formal meetings.

Sub-Committee details are:

Sub-Committee	Membership	Purpose
Accreditation	Michelle Goldsmith (Convenor) Veg Tran Lynell Tuffery-Huria <i>Anthony Alder</i>	Considers and makes recommendations on the accreditation of appropriate courses of study pursuant to regulations 20.13 and 20.14 of the Patents Regulations, and Regulation 20.12 of the Trade Marks Regulations. Recommends the curriculum of study that should be examined to satisfy the topic groups provided in the regulations.
Exemptions	Karin Innes (Convenor) Jason Coonan Lynell Tuffery-Huria <i>Ian Finch</i> <i>Anthony Alder</i> <i>Carl Harrap</i>	Considers and makes recommendations on applications for exemption under regulation 20.9 of the Patents Regulations and the Trade Marks Regulations.
Qualifications	Jason Coonan (Convenor) Kate Duckworth Karin Innes <i>Carl Harrap</i> <i>Anthony Alder</i>	Considers and makes recommendations on applications for approval of academic qualifications under regulation 20.6 of the Patents Regulations and the Trade Marks Regulations.
Discipline	Veg Tran (Convenor) Kate Duckworth Michelle Goldsmith <i>Ian Finch</i> <i>Carl Harrap</i>	Considers and makes recommendations on complaints and discipline matters under regulation 20.33 of the Patents Regulations and 20.15 of the Trade Marks Regulations.
Communications and Outreach	Kate Duckworth (Convenor) Karin Innes Lynell Tuffery-Huria Michelle Goldsmith	Considers and makes recommendations on the Board's communications and outreach activities.

Board and Designated Manager Statistics 1 July 2022—30 June 2023

TABLE 3: APPLICATIONS CONSIDERED AND APPROVED BY THE BOARD

	2022-23		2021-22	
	Considered	Approved	Considered	Approved
Approval of academic qualifications				
Patent attorneys	47	40	41	37
Trade marks attorneys	37	37	48	48
Approval of knowledge requirements				
Patent attorneys	28	23	33	33
Trade marks attorneys	28	28	41	41
Exemptions from knowledge requirements based on prior study				
Patent and trade marks attorneys	26	23	35	30
Accreditation of courses				
Patent and trade marks attorneys	8	8	0	0
Total Applications	174	159	198	189

TABLE 4: NEW ATTORNEY REGISTRATIONS (DESIGNATED MANAGER)

New Attorney Registrations	2022-23	2021-22
Patent attorneys		
Australian-resident patent attorneys	18	14
NZ-resident patent attorneys	8	6
Australian-resident dual-registered patent and trade marks attorneys	10	6
NZ-resident dual registered patent and trade marks attorneys	4	0
Trade marks attorneys		
Australian-resident trade marks attorneys	34	26
NZ-resident trade marks attorneys	5	6
Overseas-resident trade marks attorneys	2	1
Total individual attorneys	81	59
Incorporated attorneys		
Australian-resident incorporated patent attorneys	1	4
NZ-resident incorporated patent attorneys	2	1
Australian-resident incorporated trade marks attorneys	0	4
NZ-resident incorporated trade marks attorneys	0	0
Australian dual-registered incorporated patent and trade marks attorneys	5	2
NZ dual-registered incorporated patent and trade marks attorneys	0	0
Total incorporated attorneys	8	11

TABLE 5: ATTORNEY RENEWALS (DESIGNATED MANAGER)

Renewals	2022-23	2021-22
Patent attorneys	388	376
Trade marks attorneys	488	485
Dual-registered patent & trade marks attorneys	663	665
Incorporated patent attorneys	32	31
Incorporated trade marks attorneys	7	7
Dual-registered incorporated attorneys	53	48
Total	1631	1612

Table 5 presents registrations, not individuals. This is because previously dual-registered attorneys may choose to maintain registration as only one type of attorney.

TABLE 6: REMOVALS FROM AND RESTORATIONS TO THE REGISTERS (DESIGNATED MANAGER)

Removed from the Registers	2022-23		2021-22	
	Individual	Incorporated	Individual	Incorporated
Patent attorneys	17	1	26	4
Trade marks attorneys	53	1	55	6
Total registrations removed	70	2	81	10
Restored to the Registers	Individual	Incorporated	Individual	Incorporated
Patent attorneys	1	0	2	0
Trade marks attorneys	5	0	5	0
Total registrations restored	6	0	7	0

TABLE 7: CONTINUING PROFESSIONAL EDUCATION DEFERRALS (DESIGNATED MANAGER)

Continuing professional education deferrals	2023-2024	2022-2023	2021-2020
Patent attorneys	3	2	2
Trade marks attorneys	9	5	6
Dual-registered patent & trade marks attorneys	3	6	4
Total	15	13	12

Attorneys must pay an annual fee and maintain continuing professional education (CPE) as part of their registration. Attorneys unable to meet the CPE requirements due to personal circumstances beyond their control can request an extension of time to complete the shortfall in hours. Attorneys must complete the deferred hours within the next 12 months otherwise they may be removed from the Register(s) for non-compliance. Attorneys are notified by 1 June of each year that registration renewals are due. Attorneys are removed from the Register/s if they have not renewed by 31 July of any given year.