



**THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS
FICPI AUSTRALIA**

23 May 2011

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IP Australia &
Ministry of Economic Development, New Zealand
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Dear Sir

**Single Trans-Tasman Regulatory Framework for Patent
Attorneys – Discussion Paper April 2011**

This submission is made by **FICPI Australia**, the Australian Association of the International Federation of Intellectual Property Attorneys (**FICPI**) and is in response to the above Discussion Paper prepared jointly by IP Australia and the Ministry of Economic Development, New Zealand (**MED**), dated April 2011.

FICPI is the only international Non Government Organisation whose membership consists exclusively of intellectual property attorneys in private practice. Founded more than 100 years ago, in 1906, **FICPI** now has almost 5,000 members in 86 countries, including the US and Japan, Australia and New Zealand, a strong European membership and newly established national sections in India and PR China.

FICPI aims to enhance international cooperation within the profession of IP attorneys in private practice and to promote the training and continuing education of its members and others interested in IP protection.

Consistent with **FICPI's** aims, **FICPI Australia** highly values the development and maintaining of high professional standards that can be applied to the patent attorney profession in Australia and New Zealand by way of a regulatory body such as is now proposed under the discussion paper.

FICPI Australia is strongly supportive of ensuring that there is no dilution of the effect of past efforts undertaken in both countries to elevate standards to those that have now been achieved. In so doing, **FICPI Australia** supports an approach being taken when there is a variance in the standard between the two countries, of adopting the better standard and, if necessary, improving it, to ensure that it applies to both countries, rather than to diminish the standard achieved in one country by compromising to a lower standard to accommodate the other country.

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In adopting this position, **FICPI Australia** does not disagree with applying any suitable ameliorating condition, such as a transitional period or grandfathering arrangement for those in the country being required to elevate their standard to the new level.

FICPI Australia has had the opportunity to consider the submission made by the Institute of Patent and Trade Mark Attorneys of Australia (IPTA) dated 16 May 2011 in relation to the Discussion Paper.

FICPI Australia generally agrees with the submission made by IPTA and has decided to make a supplemental submission to emphasise certain of the points made in the IPTA submission having regard to its own perspective, and to provide some further commentary which it hopes may benefit both IP Australia and MED in their further deliberations of this important issue.

In order to facilitate consideration of this supplementary submission, **FICPI Australia** has followed the same format used by IPTA.

1. Single Governance Body for Patent Attorneys

Functions of the Governance Body

FICPI Australia endorses each of the points made by IPTA in relation to the above reform proposal. **FICPI Australia** is especially of the view that the education requirements for patent attorneys in both Australia and New Zealand not be left solely to the responsibility of the Governance Body. **FICPI Australia** believes that as a base level requirement the employment requirements, statements of skill and the knowledge requirements as presently set out for Australian patent attorneys in the Australian Patents Regulations 1991, be retained in legislative outline with appropriate changes to accommodate knowledge of practice in both Australia and New Zealand for the benefit of the Governance Body.

FICPI Australia believes that the evolution of these requirements has taken considerable time and effort, and is serving the Australian profession well. Therefore their makeup should not be cast aside with an entirely new set of requirements to be developed which is left to the sole discretion of a new Governance Body that may have a different or diminished perspective as to their importance to the profession in both countries.

Establishment of the Governance Body

FICPI Australia agrees with IPTA's comments.

Composition of the Governance Body

FICPI Australia, similar to IPTA, is not opposed to the proposed composition of the Governance Body. However, in contrast to IPTA, **FICPI Australia** does see benefit in maintaining a strict proportional representation as proposed, primarily for democratic and equitable reasons to reflect the present constitutional basis for decision making in both countries.

Selection of Members

FICPI Australia agrees with IPTA's comments.

2. Consistent Qualification Requirements for Registration as a Patent Attorney

Academic Qualifications for Registration as a Patent Attorney

FICPI Australia agrees with IPTA's comments.

Transitional Arrangements

FICPI Australia agrees with IPTA's comments.

Technical (IP) Qualifications

FICPI Australia agrees with IPTA's comments.

Accreditation of Tertiary Providers

FICPI Australia agrees with IPTA's comments. However, whilst **FICPI** does conduct educational programs related to patent specification drafting and construction in certain developing and developed countries, it would defer to IPTA delivering any courses in Australia and New Zealand, if IPTA considered it appropriate to do so.

Work/Employment Experience – Gaining of Skills

FICPI Australia agrees with IPTA's comments.

Other Qualifications/Attributes

FICPI Australia agrees with IPTA's comments.

Continuing Professional Education

FICPI Australia agrees with IPTA's comments.

3. A Single Register of Patent Attorneys

Registration Process

FICPI Australia agrees with IPTA's comments.

Administration of the Register

FICPI Australia agrees with IPTA's comments.

Information on the Register

FICPI Australia agrees with IPTA's comments.

4. A Single Code of Conduct

Content and Structure of the Code

FICPI Australia agrees with IPTA's comments.

Establishment of the Code

Whilst **FICPI Australia** agrees with IPTA's comments, **FICPI Australia** is also aware of the existence of the Professional Standards Councils in Australia and the work it has been doing to develop requisite standards and codes of conduct for various professional bodies across Australia, including lawyers and accountants.

As **FICPI Australia** sees the Professional Standards Councils work to be closely allied with its own views of elevating and harmonising standards of the patent attorney profession in private practice internationally, it supports the Governance Body also consulting with the Professional Standards Councils in Australia and any similar body in New Zealand to ensure that the Code of Conduct developed for the patent attorney profession in both countries is harmonious with those of similar professions in both countries.

In making this submission, **FICPI Australia** defers to the involvement of IPTA in preference to itself in any consultation process that may arise from these initiatives.

5. A Single Disciplinary Regime

Disciplinary Procedures

FICPI Australia agrees with IPTA's comments, with the qualification that **FICPI Australia** defers to the involvement of IPTA in preference to itself in working with the Governance Body in

settling rules and guidelines under which an investigator may be appointed and conduct investigations.

Determination of Complaints

FICPI Australia agrees with IPTA's comments.

Grounds for Disciplinary Matters

FICPI Australia agrees with IPTA's comments.

Disciplinary Penalties

FICPI Australia agrees with IPTA's comments.

6. An Effective Operating Structure

Collection and Administration of Fees

FICPI Australia agrees with IPTA's comments.

Correspondence and Minute Taking

FICPI Australia agrees with IPTA's comments.

7. Consideration of the Related Question of the Registration of Trade Marks

FICPI Australia agrees with IPTA's comments, especially those querying the proposal to not provide a registration regime for Trade Marks Attorneys in New Zealand in line with the requirement in Australia. Given that the trade mark registration regimes in Australia and New Zealand seem to be in closer alignment than the patent regimes, and the respective trade mark registration systems are at the forefront of legislative and procedural reform for establishing common formality and substantive examination procedures between the Trade Mark offices of the two countries, **FICPI Australia** is at a loss to understand why similar reform cannot be undertaken with respect to developing a single Trans-Tasman Regulatory framework for trade marks attorneys in both countries.

8. Defining Patent Attorney Services

FICPI Australia agrees with IPTA's comments.

Yours faithfully



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FICPI Australia - Secretary