

Submission on behalf of:

The Intellectual Property Program Educators and Researchers

Faculty of Law, University of Technology Sydney

To:

IP Australia regarding

Exposure Draft regulations for the trans-Tasman

Patent Attorney Regime

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Exposure Draft regulations for the Trans-Tasman Patent Attorney Regime Submission to IP Australia

Introduction

This submission is made by the above educators and researchers in the Postgraduate Intellectual Property Program of the University of Technology Sydney, Faculty of Law, which has been PSB Accredited for more than 15 years and is the major national online provider of the complete knowledge requirements for registration as a Patent and Trade Marks Attorney in Australia.

We have reviewed the relevant aspects of the Exposure Draft and make the following submissions.

Schedule 1 - Single economic market amendments relating to patents

Item 16 Paragraph 20.6(1)(a): Omit “an AQF qualification from the higher education sector”, substitute “a level 5 or higher AQF, or NZQF, qualification.”

Comment: Level 5 AQF is a Diploma level qualification. According to AQF, 'graduates at this level will have specialised knowledge and skills for skilled/paraprofessional work and/or further learning.' This level of qualification is not sufficient for professional practice as a Patent and Trade Marks Attorney. The Patent and Trade Marks Attorney profession is a highly skilled profession requiring in-depth knowledge and technical, legal and quasi-legal skills. This is in addition to the in-depth knowledge and technical skills drawn from previous study in science or engineering. Patent attorneys in practice are required to exercise legal skills and judgment beyond that of a paralegal. These skills are exercised at the point of

1. Advising on whether an invention is patentable (including advising on the nature of the prior art and common general knowledge in the relevant field)
2. Drafting an appropriate specification and claims;
3. Prosecuting a patent to grant including responding to examination reports, and instructing or appearing in opposition hearings and rectification, revocation or invalidity of a registered patent; and
4. Advice on post grant matters which can involve instructing barristers and solicitors on patent infringement matters and revocation proceedings both in Court and before the Registrar of Patents or Commissioner of Patents.

These matters all require teaching legal and professional skills beyond those taught to paralegals in a Level 5 AQF Diploma level course. They are the skills required of at least AQF Level 7 that is ordinarily required for admission to professional practice.

The UTS course accredited by the Professional Standards Board for Patent and Trade Marks Attorneys (Professional Standards Board) is a Master of Intellectual Property (AQF level 9). The members of the UTS IP Program believe that individuals seeking registration as a Patent and Trade Marks Attorney should obtain a level 7 or higher AQF, or NZQF, qualification. This would ensure that students obtain the appropriate level of understanding and skills development in the required knowledge areas.

Item 17 Paragraph 20.6(1)(b): Omit “an AQF qualification from the higher education sector”, substitute “a level 5 or higher AQF, or NZQF, qualification.”

Comment: See comment above regarding Schedule 1 Item 16.

Item 172 Clause 2 of Part 2 of Schedule 5 Repeal the clause, substitute:

2. A course of study must provide for a student to have an appropriate level of understanding of the Australian and New Zealand legal systems and how intellectual property rights may be protected.

Item 173 Clause 5 of Part 5 of Schedule 5

Omit “system of protecting and exploiting trade marks, patents and designs, both in Australia and”, substitute “systems of protecting and exploiting trade marks, patents and designs, both in Australia and New Zealand, and in.”

Comment: UTS would like confirmation that the proposed new knowledge requirements will be similar to those circulated by the Professional Standards Board on 31 March 2016. UTS would welcome the opportunity to review and comment on the proposed knowledge requirements prior to implementation.

Schedule 2 - Single economic market amendments relating to trade marks

Item 15 Paragraph 20.6(a)

Repeal the paragraph, substitute:

(a) a level 5 or higher AQF qualification; or

Comment: Level 5 AQF is a Diploma level qualification. According to AQF, 'graduates at this level will have specialised knowledge and skills for skilled/paraprofessional work and/or further learning.' This level of qualification is not sufficient for professional practice as a Trade Marks Attorney. The Trade Marks Attorney profession is a highly skilled profession requiring in-depth knowledge and technical legal and quasi-legal skills. Trade Marks attorneys in practice are required to exercise legal skills and judgment beyond that of a paralegal. These skills are exercised at the point of:

1. Advising on the registrability of a sign as a trade mark and whether a sign is available for registration (including advising on prior conflicting registered trade marks and common law rights in unregistered signs arising from use)
2. Advising on classification of the trade mark under application and drafting a specification of goods or services;
3. Prosecuting a trade mark to registration including responding to examination reports or compliance reports, and instructing or appearing in opposition hearings or applications for rectification, revocation or invalidity of a registered mark; and
4. Advice on post registration matters which can involve instructing barristers and solicitors on trade mark infringement matters as well as proceedings for applications for rectification, revocation or invalidity of a registered trade mark, either in Court or before the Registrar of Trade Marks or Commissioner of Trade Marks.

These matters all require teaching legal and professional skills beyond those taught to paralegals in a Level 5 AQF Diploma level course. They are the skills required of at least AQF Level 7 that is ordinarily required for admission to professional practice.

The UTS course accredited by the Professional Standards Board for Trade Marks Attorneys is a Graduate Certificate in Trade Mark Law and Practice (AQF Level 8). The members of the UTS IP Program believe that individuals seeking registration as a Trade Marks Attorney should hold a level 7 or higher AQF, or NZQF, qualification. This would ensure that students obtain the appropriate level of understanding and skills development in the required knowledge areas.

Item 16 Paragraph 20.6(b)

Omit “an AQF qualification from the higher education sector”, substitute “a level 5 or higher AQF qualification”.

Comment: See comment above regarding Schedule 2 Item 15.

Conclusion

The authors emphasise the postgraduate nature of training necessary to be a patent and/or trade marks attorney. The substantive law knowledge requirements alone require a university level of training which is well above AQF 5. We suggest that a practitioner with only an AQF 5 qualification may not be able to understand the subtleties and nuances of their opponents technical legal arguments, or may be intimidated by their opponents more comprehensive legal skills (should the opponent hold an AQF 7 and above qualification) and more easily accept their opponents arguments, thereby not properly protecting their client’s interests. This would be made evident, for example, in the circumstance where a patent or trade marks attorney needs to trace ownership rights through a network of licence agreements exploiting existing patents, trade marks and designs. And while such a patent or trade mark attorney is not practicing commercial intellectual property law, they still require more comprehensive legal skills than a paralegal course (AQF 5) can provide.

Further, most students have already completed as a minimum a Bachelor Level degree (others hold a Master or PhD), and in the case of those seeking registration as a Patent Attorney, that degree needs to be in the sciences, engineering or other technical degree. Such a degree is already at AQF 7 and students entering training in the knowledge requirements from an AQF 7 course may still have difficulties comprehending the legal concepts necessary to achieve registration as a patent or trade marks attorney. Accordingly, we urge a reconsideration of the amendments proposed to Schedule 1 Items 16 and 17 and amendments proposed to Schedule 2 Items 15 and 16.