

Ms Lisa Bailey
IP Australia
PO Box 200
Woden ACT 2606

Dear Ms Bailey,

Submission to IP Australia Regarding the Exposure Draft of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016

Please find below the Law Institute of Victoria's (the LIV) submission on the Exposure Draft of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016. This submission has been prepared in conjunction with the LIV Intellectual Property and Information Technology Committee of the Commercial Law Section.

The below comments are numbered according to the proposals in the Explanatory Statement and provisions in the Exposure Draft.

Amendments to Patent Regulations 1991 (Patent Regulations)

Items 4-7 and Items 163-167; paragraph 3.2C(2)(a) and sub-regulation 22.10: Address for service

Having regard to the widely reported and experienced difficulties with the delivery of physical mail, and also acknowledging the general approach of businesses to increasingly rely on electronic mail, the LIV suggests that the opportunity be taken to add to paragraph 3.2C(2)(a) and sub-regulation 22.10 a provision allowing delivery of relevant documents by email address.

Item 16; paragraph 20.6(1)(a): Patent Attorney Qualifications

The LIV agrees with the position put forward in the submission provided by the University of Technology Sydney that Level 5 AQF is not a sufficient qualification for professional practice as a patent attorney and that a level 7 or higher AQF (or corresponding NZQF qualification) should be a pre-requisite for registering as a patent attorney.

The Level 5 AQF is a diploma level qualification that provides skills commensurate to a paralegal position. However, patent attorneys are required to be highly skilled professionals who must possess in-depth knowledge and robust skills (including legal skills) beyond that of a paralegal. Given the requirements and scope of the practice of a patent attorney, the LIV submits that a higher qualification level of at least AQF 7 would better service and protect consumers who wish to engage the services of a patent

attorney, by ensuring their training is of a sufficiently high standard to meet the requirements of the patent attorney's role.

Item 74; paragraph 20.48: Matters that may be considered in determining penalties

Where a patent attorney is also a legal practitioner in Australia or New Zealand, they will be subject to jurisdiction specific conduct rules for legal practitioners. Where the legal practitioner is non-compliant with these conduct rules in their jurisdiction, they may be subject to disciplinary action by the regulator in that jurisdiction (for example, the Victorian Legal Services Board in Victoria). Accordingly, the LIV submits that proposed paragraph 20.48 of the Patent Regulations should be amended to include a sub-paragraph 20.48(1)(c) which would state '(c) if the patent attorney is also an admitted legal practitioner, any other relevant disciplinary proceedings relating to the same conduct'.

By proposing the above amendment, the LIV is concerned to ensure that all relevant disciplinary proceedings relating to the same conduct (including in an individual's capacity as a legal practitioner) are taken into account by a Panel of the Disciplinary Tribunal when considering the scope of any penalties in a disciplinary matter brought before it.

Item 113; paragraph 20.63: Trans-Tasman Attorneys Disciplinary Tribunal eligibility

The LIV notes that a person is not eligible to be appointed as President of the Trans-Tasman IP Attorneys Disciplinary Tribunal (the Tribunal) unless the person is currently enrolled as a legal practitioner in Australia or New Zealand, and has been enrolled for at least seven years.

However, legal practitioners are not able to become 'other' Tribunal members unless they also satisfy other criteria within 20.63(2) (essentially that they are currently or have previously been a patent or trade marks attorney). Given the high standard of professional and ethical conduct required of legal practitioners, and generally their expertise in dispute resolution, they are eminently qualified and appropriate to be a Tribunal Members. This is reflected in the fact that the President is required to be a legal practitioner who had been admitted for at least 7 years. Accordingly, the LIV recommends that a sub-paragraph 20.63(2)(e) be added to this section which states 'a qualified legal practitioner in Australia or New Zealand'.

Amendments to Trade Marks Regulations 1995 (Trade Mark Regulations)

Item 12 and Item 65, sub-regulations 17A.74(2) and 21.74A – Address for service

The LIV's comments above in respect of the proposed amendments to the address for service provisions at paragraph 3.2C(2)(a) and reg 22.10 of the Patent Regulations are also applicable to these proposed amendments.

Items 15-16, sub-regulations 20.6(a) and 20.6(b) – Academic qualifications

The LIV's comments above regarding Paragraph 20.6(1)(a) of the Patent Regulations in relation to patent attorneys are also applicable in respect of the proposed amendments to the required qualification level of registered trade mark attorneys, particularly as there is no required period of supervised workplace training for trade mark attorneys (unlike legal professionals and patent attorneys).

Amendments to the Designs Regulations 2004 (Designs Regulations) and Plant Breeder's Rights Regulations 1994 (Plant Breeder's Rights Regulations)

The LIV again refers to its comments regarding paragraph 3.2C(2)(a) and reg 22.10 of the Patent Regulations and notes that these comments are also applicable to the proposed amendments under the Designs Regulations and the Plant Breeder's Rights Regulations.

If you have any questions regarding the above submission, please contact Ms Mollie Tregillis, Senior Lawyer for the Commercial Law Section at the LIV on (03) 9607 9318 or mtregillis@liv.asn.au.

Sincerely yours,

A handwritten signature in black ink that reads "Steven Sapountsis". The signature is written in a cursive, slightly slanted style.

Steven Sapountsis
President
Law Institute of Victoria