

24 June 2016

Lisa Bailey  
IP Australia

Dear Ms Bailey

**NZIPA submissions to IP Australia on the Exposure Draft of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016**

**Introduction**

These submissions have been prepared by the New Zealand Institute of Patent Attorneys Inc. (NZIPA). The NZIPA previously made submissions in response to the Consultation Paper published December 2014 on Regulation Changes Proposed to Implement Trans-Tasman Initiatives.

The NZIPA was incorporated in 1912 and represents most patent attorneys registered under the New Zealand Patents Act 1953 who are resident and practicing in New Zealand. Many of our patent attorneys are also registered in Australia.

The present membership of the Institute as at 23 June 2016 comprises 150 fellows, 60 students, 14 associates, 18 non-resident members, 6 retired members, and 2 honorary members. The honorary members are Justice Gault and Bill Howie.

The following submissions utilise the same numbering system for the headings as used in the Explanatory Statement published by IP Australia.

## **SCHEDULE 1 – AMENDMENTS TO THE PATENTS REGULATIONS**

### **Requirements for registration as a patent attorney**

**Item 15** would remove the requirement in regulation 20.3(1)(a) of the Patents Regulations that an applicant for registration as a patent attorney must provide evidence that he or she is ordinarily resident in Australia. The applicant will now have to provide only an address for service in either Australia or New Zealand.

The NZIPA maintains that a requirement that a registered patent attorney be a citizen of either Australia or New Zealand, or ordinarily resident in Australia or New Zealand, and proof of the same, is an appropriate pre-requisite to registration.

Providing services to the Australian public requires not only academic qualification but also cultural awareness. Removing the residency and citizenship requirement leads to a risk of patent attorneys based outside Australia, with no connection to Australia, giving advice on Australian law to the Australian public.

## **SCHEDULE 2 – AMENDMENTS TO THE TRADE MARKS REGULATIONS**

**Item 18** would remove the entitlement of a registered trade marks attorney who is the subject of disciplinary proceedings to have a Panel member who is ordinarily resident in the same country as the trade marks attorney.

NZIPA does not support this amendment. We acknowledge that it is important that the Panel has expertise in Australian trade marks law. However it is equally important that the Panel has expertise in the day to day operating environment of trade mark practice in New Zealand when ruling on a matter involving a New Zealand resident trade marks attorney.

Where a New Zealand resident trade marks attorney appears before the Panel, NZIPA maintains that the Panel include at least one trade marks attorney who is resident in New Zealand.

**Item 69** would insert new regulation 22.13 that would allow a registered patent attorney to apply for registration as a trade marks attorney within twelve months of commencement.

NZIPA maintains that the transitional period is too short and is unfair when the interests of candidates currently sitting exams to qualify as New Zealand patent attorneys are considered.

NZIPA believes the regulations should permit candidates currently sitting exams, and who complete them during the transitional period of four years, be permitted to apply for registration as a trade marks attorney within twelve months of qualifying as a New Zealand patent attorney.

Yours faithfully,



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