

23 November 2017

**By email**  
senator.sinodinos@aph.gov.au

Dear Senator the Hon Arthur Sinodinos

**Re:** IPTA submission regarding requested change to the Temporary Skill Shortage (TSS) visa to include Patent Attorneys and Trade Mark Attorneys previously provided for under the abolished 457 visa subclass

We refer to the announcement on 18 April 2017 by the Department of Immigration and Border Protection (DIBP) that the Temporary Work (Skilled) visa (subclass 457 visa) was being abolished and replaced with the completely new Temporary Skill Shortage (TSS) visa which would support businesses in addressing genuine skill shortages. As a result, 'Patent Attorney' and 'Trade Mark Attorney' are no longer sponsorable occupations. That is, an employer can no longer sponsor a work visa for registered a Patent Attorney, Trademark Attorney, IP Lawyers or general legal professionals (code: 271214). As of 18 April 2017, category 271214 was also removed from the consolidated list.

On behalf of the Institute of Patent & Trade Mark Attorneys (IPTA), we provide the following submissions requesting a change to the Temporary Skill Shortage (TSS) visa to include Patent Attorneys and Trade Mark Attorneys previously provided for under the abolished 457 visa subclass.

### **About IPTA**

IPTA is a voluntary organization representing registered patent attorneys, registered trademarks attorneys and student members in the process of qualifying for registration as a Trans-Tasman Patent or Trade Mark attorney. The membership of IPTA includes over 87% of registered patent attorneys located in Australia and it is believed that its members make up more than 90% of registered patent attorneys in active practice in Australia. The membership of IPTA includes registered patent attorneys in private practice as well as patent attorneys working in industry, universities, research institutes and others that practice as barristers. IPTA members represent large local and foreign corporations, SMEs, universities, research institutes and individual inventors. IPTA members work with New Zealand and Australian clients to assist them in developing strategies for protecting and enforcing their intellectual property rights in New Zealand, Australia and overseas, and also represent overseas individuals and companies in their efforts to obtain and enforce their intellectual property rights in Australia and New Zealand.

### **Submissions**

On 18 April 2017, the Department of Immigration and Border Protection (DIBP) announced that the Temporary Work (Skilled) visa (subclass 457 visa) would be abolished and replaced with the completely new Temporary Skill Shortage (TSS) visa which will support businesses in addressing genuine skill shortages. As a result, 'Patent Attorney' and 'Trade Mark Attorney' are no longer

sponsorable occupations. That is, an employer can no longer sponsor a work visa for registered a Patent Attorney, Trademark Attorney, IP Lawyers or general legal professionals (code: 271214). As of 18 April 2017, category 271214 was also removed from the consolidated list.

The Australian Patent Attorney profession is relatively small, with approximately 1,200 registered Patent Attorneys, but is absolutely critical in supporting Australian innovation.

There is a shortage of registered Patent Attorneys and Trade Mark Attorneys in Australia. Without qualified IP attorneys to protect Australian innovation, there will be a detrimental effect on Australian research, development and commercialisation of innovative technologies.

The profession's sole purpose is to offer clients professional advice on a wide range of IP services (internationally) integral to the success of their business.

Patent Attorneys assist with the following:

- Developing and implementing IP strategies, policies and procedures;
- IP decision-making support;
- IP audit services;
- IP education;
- Investor support, including due diligence reporting;
- Filing and prosecuting patents, designs and trademarks;
- IP portfolio and cost management;
- IP specific information management solutions;
- Troubleshooting, both defensive and aggressive;
- IP dispute resolution and litigation support;
- IP investigations, including verification, watching, searching and mapping;
- Commercialisation support, including freedom to operate reporting.

Some of the dangers for the individual working without a patent attorney include:

- Not providing enough disclosure of the invention to permit use of the provisional filing date to the benefit of the completed filing (e.g. international PCT application);
- Failure to monitor the one-year anniversary by which a complete application or non-provisional must be filed, or failure to provide themselves sufficient time to further experimentally support the breadth of their invention including not providing a patent attorney enough time to properly draft a complete application before the deadline;
- Relying on the provisional filing to protect rights while publicly disclosing additional inventions or improvements after the filing;
- Unnecessarily disclosing commercially confidential information not required to support the completed application or invention being claimed; and
- Making inaccurate statements such as incorrectly characterising prior inventions of others.

For many inventors, the services provided by a patent attorney could mean the difference between securing protection for their inventions or losing their innovation to overseas interests.

In order to qualify as an Australian patent attorney the candidate must hold a technical degree in Engineering, Physics, Biotechnology or Chemistry, and a PhD is often a pre-requisite for some technology areas such as biotechnology and chemical disciplines. The qualification process involves a rigorous series of exams, often through studying a Masters of Intellectual Property, as well as undertaking two years of supervised practical experience. The industry is tightly controlled through the Trans-Tasman IP Attorneys Board. It therefore takes a minimum of between 7 to 10

years (including academic and professional qualifications) before a candidate can qualify as a registered attorney in Australia.

Intellectual Property firms in Australia continue to have severe problems accessing the desired skills/practitioners in Australia. If recruitment of overseas qualified attorneys is abolished, patent attorney firms may no longer be able to keep up with work demands across all practice and technology areas. Across the board, patent attorney vacancies are listed on general career websites and social media markets. Given the extremely high academic requirements for patent attorneys, firms generally find it difficult to attract appropriately skilled Australian workers for vacancies and the industry has relied on accessing skilled workers from overseas when unable to find suitable Australian candidates or where the firms require specific overseas experienced attorneys.

Although the number of Australian patent attorneys decline, the amount of innovation and technological advances continues to increase at a fast pace. Due to the small pool of registered Patent Attorney's in Australia it is crucial that Australian firms are able to extend their search overseas.

Australian intellectual property firms offer professional development and skill training to the Australian workforce – we understand the importance of knowledge sharing and upskilling. We fund the total amount payable for a Master of Intellectual Property that is approximately \$30,000 per student with courses offered at the University of Melbourne and the University of Technology Sydney. Before a foreign qualified attorney can practice in Australia, they need to requalify under our Australian system to become locally qualified. This is good for the IP Industry, our universities and Australia.

IP firms in Australia offer professional development to its Australian workers. That is, internal training seminars, internal training from designated trainers, as well as external leadership and management courses.

Furthermore, a number of Partners and Senior Patent Attorneys have relocated to Australia on previous visas. They have been successful in contributing to the Australian economy and more specifically to the protection of Australian innovation. It would be extremely disadvantageous for the Australian patent attorney profession to not give other overseas qualified attorneys the opportunity to work in Australia, qualify under the Australian patent attorney requirements, develop their skill set and ultimately contribute to the Australian industry. Similarly it would be disappointing to have our local inventors look to overseas firms due to the shortage of local experienced patent attorneys.

Further, the Patent and Trade Mark Attorney profession is a global profession. Australian industry seeks and requires specific advice on international practice including patent and trade mark practice in Europe, United States, Japan, Korea, China, and South East Asian (ASEAN) countries. The vast majority of Australian patent and trade mark attorney firms engage in a considerable amount of work internationally for Australian industry. It is for this reason that many of the Australian firms have retained and employ a few select patent and trade mark attorneys with experience and registration from at least some of Europe, United States Japan, Korea, China, and South East Asian (ASEAN) countries, for example. It is in the best interest for Australian industry that the Australian patent and trade mark attorney profession can source and employ professional staff from overseas to build on its international services and expertise to the benefit of Australian innovation and industry.

IPTA strongly believes the Government's decision to remove Patent Attorney and Trade Mark Attorney from the Skilled Occupation list will have a substantial negative impact on the IP Industry and protection of innovative research and development in Australia.

We request that the department re-considers and moves Patent Attorney and Trade Mark Attorney to the Medium-Long Term list.

If the department has any questions in relation to these submissions, please contact the undersigned.

Yours faithfully  
John

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