



Australian Government

Professional Standards Board
for Patent and Trade Marks Attorneys

Professional Standards Board for Patent and Trade Marks Attorneys

IPTA CONFERENCE - 2014

Professional Conduct and the new Code of Conduct.

***Ms Lisa O'Neill
Chair***

Professional Standards Board for Patent and Trade Marks Attorneys



Professional Standards Board for Patent and Trade Marks Attorneys – overview of presentation

The Professional Standards Board



- *Members of the Board*
- *Functions of the Board*
- *Discipline role of the Board*



The attorney profession registered in Australia – an overview

From the Register of Patent Attorneys and the Register of Trade Marks Attorneys...

• Total patent attorneys	253
• Total trade marks attorneys	427
• Total patent and TM attorneys	627
• Total attorneys	1,304

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Roles – who does what and with whom...

Designated Manager (*Director General of IP Australia*)

- *registers new attorneys and renews annual registrations*

Professional Standards Board for Patent and Trade Marks Attorneys

- *approves academic qualifications for prospective patent attorneys*
- *approves applications for exemptions*
- *accredits institutions*
- *handles discipline/complaint matters*

Patent and Trade Marks Attorneys Disciplinary Tribunal

- *hears and decides upon complaint matters against attorneys brought by the Board.*



Board functions

- **Accreditation** of courses at institutions such as universities to meet the knowledge requirements of an attorney. Board has responsibility for curriculum.
- Granting **exemptions**
- Approval of **academic qualifications** – patent attorneys need to have a degree etc in a field of technology that contains potentially patentable subject matter – (differs from NZ)
- Consideration of **complaints** and discipline issues.
- Advising the Designated Manager on **continuing professional education** and pre-registration experience requirements.



Conduct and Discipline

- *13 complaints have been made to the Board since 1 July 2012 (6 in the 2013/14 year), against 17 attorneys (one twice but on essentially the same matter);*
- *Of these 1 was referred to the Disciplinary Tribunal but did not proceed as the Attorney was voluntarily removed from the register;*
- *9 were resolved as the Board decided to take not further action;*
- *1 ceased as the complainant and attorney settled the matter between them selves,*
- *1 could not proceed as the informant wanted to remain anonymous and would not agree to information being passed to the attorney :*



What type of conduct matters come to the Board's attention & who complains

- *Some extremely complex factually, some simple, some without basis.*
- *Conduct matters generally – can be related to professional role, or private conduct for example, the theft of an employer credit card;*
- *Information directly related to attorney role included:*
 - *Impeding transfer of client files;*
 - *Mishandled design application;*
 - *Poor management of patent application;*
 - *Provided false information on documents to regulatory authority;*
 - *Induced client to apply for patents unlikely to be granted/ over-servicing*
- *Other than being very patent focused, there are no real patterns of alleged breaches. The most common single allegation (3) was mishandling of routine transactions with due dates.*
- *Many alleged overcharging, though generally as a secondary allegation on the basis that the primary breach meant they had not got what they paid for.*



Types of complaints

- *5 had a background of disputes/ex-partners/legal action etc.*
- *10 primarily involved Patents, 1 primarily involved Designs;*
- *12 cases concerned attorneys directly the subject of allegations, and 1 concerned an attorney identified by the Board as the subject of the information in their capacity as the supervisor of the non-attorney alleged to have made the error*



How long does it take?

- *Of the 10 finalised matters, the longest took 11 months, the shortest was finalised within weeks, and the average time was about 6 months. This includes matters that, due to the timing of their initiation, took several months before the Board first met to discuss them.*
- *Why does it take so long?*
- *The Board has ‘cleared up’ a lot of exceptionally complex long standing matters recently.*



Conduct and discipline – processes – how does it work?

- *The Board will consider whether the attorney has complied with Code;*
- *Board can investigate and inform itself or can use commercial investigators;*
- *Board gathers information – usually asks attorney to respond to the “information” and may refer the response back to the complainant;*
- *Investigators – Investigating can be a slow process but use of investigators has speed up the process;*
- *Board applies rules of procedural fairness;*
- *Attorneys must comply with investigation – including investigators ;*
- *The New Code also requires attorneys to have an address for service of notices;*
- *Board gives reasons for its decisions.*



The Board's decisions – based on:

- *Provisions of the Patents Regulations 1991*
- *The Code of Conduct for Patent and Trade Marks Attorneys*
23.11.13
- *The Disciplinary Guidelines for registered patent and trade marks attorneys*
- *Case law may be applicable including decisions of the Tribunal*



Professional Misconduct - definition

professional misconduct means:

- (a) *unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or*
- (b) *any other conduct, whether occurring in connection with practice as an attorney or otherwise, that shows that the attorney is not of good fame, integrity and character; or*
- (c) *any contravention of a law that is declared by these Regulations to be professional misconduct.*

"unsatisfactory professional conduct" includes conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney



The New Code Of Conduct

- *Came into force on 23 November 2013 and replaced the 2008 Code;*
- *The Board conducted public consultation on the revised Code from in Australia and New Zealand;*
- *The new Code should to improve clarity around the expected behaviour and conduct of the attorney profession for its members and consumers of attorney services;*
- *The Intellectual Property Laws Amendment (Raising the Bar) Act 2012 made significant changes to the way in which registered attorneys can run their businesses (incorporation);*
- *The Code of Conduct is now a statutory instrument giving it greater force and effect;*



Code of Conduct New Features

- **Section 7—Objectives of code** attorneys will adhere to the Code of Conduct in all of their dealings with clients, other professionals and regulatory authorities such as IP Australia
- **Section 12—Competency** attorneys should have appropriate competency to perform specific work in their professional capacity
- **Sections 13 and 14—Information for new or prospective clients, and Information and services for existing clients**
- **Section 17—Honesty of statements and documents** attorneys should not to act in a fraudulent or deceitful manner
- **Sections 22 and 23—Additional obligations of directors and incorporated attorneys**



Hints and tips re conduct

- *Keep clients informed;*
- *Be courteous, professional, honest and open in your dealings with clients, your colleagues and professional agencies such as IP Australia and IPONZ;*
- *Provide written advice of estimated costs for new work ;*
- *If the scope of work changes advise the client in writing of the new estimate;*
- *Ensure appropriate supervision procedures exist within your practice;*
- *Keep detailed file notes;*
- *Read the Code of Conduct.*



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Thank you

Web: <http://www.psb.gov.au>

Email: mail.psb@ipaaustralia.gov.au

Code of Conduct:

<http://www.comlaw.gov.au/Details/F2013L01822>

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Chair

2014