

Dr Brett Sutton
Chief Health Officer
Department of Health and Human Services
50 Lonsdale St
Melbourne, VIC 3000
enquiries@dhhs.vic.gov.au

Dear Dr Sutton

RE: Urgent - Impact of Stage 4 restrictions on patent attorneys and trade marks attorneys practising in the Melbourne metropolitan region.

I write to you as the President of the Institute of Patent & Trade Mark Attorneys of Australia (IPTA), the peak body representing patent and trade marks attorneys in Australia.

Patent attorneys and trade marks attorneys practice in intellectual property law and are regulated by the Trans-Tasman IP Attorneys Board (www.ttipattorney.gov.au) and subject to Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018 (www.legislation.gov.au/Details/F2018L00031). Importantly, patent attorneys and trade marks attorneys are not required to be “legal practitioners” as that term is defined in the Patent Act 1990 (Cth) or The Legal Professional Uniform Law Application Act 2014 (Vic), although they are subject to analogous rules of professional conduct and ethical standards.

We understand that from 11:59pm on Wednesday 5 August all businesses operating in the Melbourne metropolitan region are subject to stage 4 business restrictions. Under these business restrictions employers that require their staff to attend a work site must issue a worker permit to their employees.

In reviewing the list of permitted workplaces we note that there is no specific inclusion of patent and trade marks attorneys, although under the heading “Justice Specific” appears the following activities for which worker permits may be issued:

- Administration of justice matters by legal practitioners for their clients where the matter cannot be undertaken reasonably and/or the client cannot participate reasonably in an online communication, teleconference or by means of an audio-visual link facility.

The work of patent and trade marks attorneys in connection with activities associated with securing, maintaining, and enforcing rights available under the law, including intellectual property (IP) rights (such as patents, designs, trade marks and plant breeders’ rights) available under the laws of Australia and overseas, or providing advice in connection with avoiding infringing such rights granted to others, is, in our view, entirely analogous to the work of legal practitioners in administration of justice matters, with the possible exception that deadlines for patent and trade marks attorneys to take actions to secure or maintain intellectual property rights are enforced more rigorously.

In this regard the failure to take an action by a specified deadline in connection with an application for an IP right, or in maintaining an IP right, can result in the irrevocable lapsing of that right. These are rights to which individuals, companies, Universities, research institutes and the like are entitled

under the laws of Australia and the laws of overseas jurisdictions. Obtaining, maintaining and enforcing such rights, with the assistance of patent and trade marks attorneys, are extremely important for these entities, for the viability, profitability and success of many Australian businesses, and for an Australian economy in which innovation is a key component for success.

As with legal practitioners, there are various actions that may need to be taken by patent and trade marks attorneys for their clients "where the matter cannot be undertaken reasonably and/or the client cannot participate reasonably in an online communication, teleconference or by means of an audio-visual link facility". Examples of such situations would be:

- where the retrieval of a paper file is needed to allow the patent attorney or trade marks attorney to view material necessary for that attorney to advise a client on a particular matter, or
- where an original document signed and witnessed (and possibly legalised at an appropriate consulate or Government office, or Notarised) must be collected from the office so that it can be transmitted to a foreign patent or trade mark office to meet a requirement by a specified deadline, or
- where the signing of a declaration, document or authorisation of agent or other document needs to be witnessed, due to requirements for overseas jurisdiction where electronic signing and witnessing is not permitted.

In light of the information above, and on behalf of our members, I request written confirmation that the limited exception for "administration of justice matters by legal practitioners" included under the "Justice Specific" heading in the list of permitted workplaces extends to, or will be extended to, patent attorneys and trade marks attorneys.

In view of the urgency of this request, since our members are already in the difficult situation of not being able to take action that may be needed to preserve their clients' rights, we respectfully request expedited attention to this submission.

If you have any questions please do not hesitate to contact me. My mobile no. is 0418340922.

Yours faithfully



Michael J Caine
President
Institute of Patent and Trade Mark Attorneys of Australia

6 August 2020