The Institute of Patent and Trade Mark Attorneys of Australia

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23 July, 2008

Mutual Recognition Review
Productivity Commission
LB2 Collins Street East
Melbourne, Victoria 8003

Dear Sirs,

We refer to the Productivity Commission Issues paper entitled "Review of mutual recognition schemes" dated June 2008 and make the following submission for consideration in preparing its report.

The Institute of Patent and Trademark Attorneys of Australia ("IPTA") represents patents and trademark attorneys registered in Australia, both in private and corporate practice. As a result of the Trans-Tasman Mutual Recognition Agreement ("TTMRA"), a large percentage of patent attorney members of IPTA are also registered New Zealand patent attorneys. Although membership of IPTA is voluntary, over 90% of patent attorneys registered in Australia are members of IPTA, either as Fellows or as Ordinary Members of the Institute. Most of these members are also registered as trademark attorneys in Australia. In addition, the membership of IPTA includes other registered trademark attorneys who are not also registered as patent attorneys, and a large percentage of these other registered trademark attorneys are lawyers.

Although the review of the Mutual Recognition Agreement and the Trans-Tasman Mutual Recognition Agreement is being conducted over a broad range of areas, IPTA would like to confine its comments to Chapter 5 "Occupations" and Chapter 8 "Bilateral engagement with third countries".

Chapter 5 – Occupations

The TTMRA has been in place since 1 May 1998 and allows Australian patent attorneys to practice in New Zealand and vice versa. To practice in New Zealand, an Australian patent attorney must register with the New Zealand Patent Office ("IPONZ"). This registration procedure ensures that Australian patent attorneys operate under the New Zealand Patents Act. As both the New Zealand Patents Act and Australian Patents Act are derived from British law, there has been a relatively smooth transition for Australian patent attorneys to practice under the New Zealand Patents Act.

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Under the Australian Patents Act, it is more difficult to qualify as a patent attorney than it is for a New Zealander to qualify under the New Zealand Patents Act. In Australia a patent attorney must have a tertiary qualification in a field of technology that contains potentially patentable subject matter, typically engineering or science. There is no such requirement for registration as a New Zealand patent attorney. Although most New Zealand patent attorneys have such tertiary qualifications, we believe that the New Zealand entry level should be raised the same level as in Australia. In fact, the Patents and Trademarks Amendment Regulations 2008 which came into effect on 1 July 2008 has now effectively raised the bar for qualification as an Australian patent attorney, and has also introduced a Continuing Professional Educational (CPE) requirement. These new regulations have been introduced to ensure that the Australian public have access to competent intellectual property advice. As explained by Senator Kim Carr in his press release of 1 July 2008, "the new regulations changed the pre-registration requirements for patent attorneys with a focus on a more skills-based approach. This will result in attorneys being better placed to provide high-quality assistance". It would be an unfortunate consequence of the TTMRA if the efforts made in Australia to ensure a high level of qualification for patent attorneys were undermined by a lower qualification requirement in New Zealand. For this reason we believe that pressure should be applied to New Zealand to raise the qualification requirements for New Zealand patent attorneys to a level which at least approximates the qualification requirements for an Australian patent attorney. In this regard, a tertiary qualification in a field of technology that contains potentially patentable subject matter should be a mandatory requirement.

Chapter 8 - Bilateral engagement with third countries

IPTA is concerned that New Zealand may enter into bilateral or multilateral agreements with other countries which would include provision for mutual recognition of the patent attorney qualification. There does not appear to be any mechanism in the TTMRA, or the Patents Act 1990, which would prevent patent practitioners in those countries from becoming registered Australian patent attorneys. Given the lower qualification standards required in New Zealand to obtain registration as a patent attorney, and the fact that patent practitioners in those other countries would be very unlikely to have a good understanding of Australian patent law and practice, this action on the part of New Zealand could undermine efforts in Australia to maintain public confidence in the Australian patent attorney profession. IPTA believes that steps should be taken to ensure that patent practitioners from other countries cannot obtain registration as an Australian patent attorney through bilateral or multilateral agreements involving New Zealand.

Of greater concern is the recently published Patents Bill in New Zealand which opens the way for foreign patent attorneys to become registered as New Zealand patent attorneys without sitting New Zealand exams, and without needing to be a resident or citizen of New Zealand. This paves the way for foreign patent attorneys who are not resident in Australia or New Zealand to become registered Australian patent attorneys, without any reciprocal arrangement for Australian patent attorneys to be recognised or registered in these foreign countries. This is clearly an undesirable consequence of the TTMRA.

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Other matters

In order to achieve the most benefit from the TTMRA, the laws of Australia and New Zealand in respect of intellectual property should be harmonised as much as possible. At the moment, there are provisions in New Zealand Patent Law, and in the new Patents Bill, which adversely affect the ability of Australian patent attorney firms to conduct business in New Zealand. One provision prohibits mixed partnerships from acting as patent attorneys in New Zealand, even though mixed partnerships can act as patent attorneys in Australia. This provision could have an adverse impact on several medium to large Australian patent attorney firms which operate as mixed partnerships, with Solicitors and Accountants. Section 201 of the Patents Act 1990 provides recognition of mixed partnerships.

IPTA will be pleased to answer any queries which may arise from the above submissions, and to participate in any further discussions in connection with the review of Mutual Recognition Schemes.

Yours faithfully

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