

## ➤ Review of the Discipline Regime for Patent and Trademark

30 November 2006

Mr Greg Powell  
Project Manager  
Attorney Review Implementation  
IP Australia  
PO Box 200  
WODEN ACT 2606

Dear Mr Powell

### **Review of the discipline regime for patent and trade mark attorneys**

Thank you for seeking the comments of the Administrative Review Council (the Council) on the new discipline and regulatory review regimes for patent and trade mark attorneys. The Council was established by the *Administrative Appeals Tribunal Act 1975* ('AAT Act'). The Council's role is to monitor and provide advice to Government, through the Attorney-General, in relation to Commonwealth administrative review and administrative law generally.

The Council has a history of offering advice across many areas where administrative review arises, including patents, as covered in its 43<sup>rd</sup> report, published in 1998, titled *Administrative Review of Patent Decisions*. Chapter four of that report specifically covered administrative review of patent attorneys. For your background information, a copy of that report has been included with this letter.

The comments below are in response to issues raised in the Consultation Papers issued by IP Australia in September 2006.

#### Overview of comments

1. The Council recommends that provisions with a significant impact on individual rights or liberties, or where procedural requirements are so significant that they constitute the essence of a legislative scheme, should be implemented in Acts of Parliament rather than through Regulations.
2. The Council is supportive of the proposed appeal rights from reviewable decisions of the Disciplinary Tribunal to the Administrative Appeals Tribunal (AAT).
3. The Council is supportive of all decisions of the Disciplinary Tribunal being published and would encourage all AAT decisions relating to disciplinary appeals for patent and trade mark attorneys to likewise be published.

4. The Council suggests that consideration should be given to a statutory requirement that the Disciplinary Tribunal publish an annual report each financial year.

5. In respect of the regulatory regime, the Council suggest that a merits review mechanism should be available so that patent and trade mark attorneys have access to independent review of adverse decisions regarding qualifications and registration.

### 1. Implementation by amendments to regulations

The Council notes that the legislative framework for the new discipline regime is to be implemented by amendments to the *Patents Regulations 1991* and the *Trade Mark Regulations 1995*. As a general principle, the Council considers that those provisions with a significant impact on individual rights or liberties, or where procedural requirements are so significant that they constitute the essence of a legislative scheme, should be implemented in Acts of Parliament rather than through regulations. The issue of what is appropriate to be dealt with by regulation was covered in detail in the Council's report No.35 titled *Rule Making by Commonwealth Agencies*. A copy of that report has also been included with this letter. These matters are also covered in the *Legislation Handbook*.

The Council notes that the current arrangements for disciplinary action against patent and trade mark attorneys are contained in the Regulations. Whilst it may be more expedient to amend the existing regulations, the Council suggests that consideration be given to deleting the provisions from these Regulations and inserting the new provisions into the *Patents Act 1990* and the *Trade Marks Act 1995*.

The Council notes that s.198 of the *Patents Act* currently confers jurisdiction on the AAT in respect of decisions to refuse to register a person as a patent attorney. This part of the Act (Chapter 20, Part 1) would provide an appropriate location for the provisions to be inserted. Similarly, s.228A of the *Trade Marks Act* currently contains provisions dealing with registration and de-registration of trade mark attorneys. This part of the Act (Part 21, Division 3) would also provide an appropriate location for the provisions to be inserted.

### 2. Appeal Rights

The Council is supportive of the proposed appeal rights from reviewable decisions of the Disciplinary Tribunal to the AAT. In its report *Administrative Review of Patent Decisions* the Council was supportive of extending appeal rights to decisions that affect the interests of a person but not those decisions relating to the conduct and assessment of examinations.

The Council suggests that careful consideration will need to be given to the issue of appropriate notification of appeal rights when a person is advised of an adverse decision by the Disciplinary Tribunal.

### 3. Publication of decisions

The Council is supportive of all decisions of the Disciplinary Tribunal being published and would encourage all AAT decisions relating to disciplinary appeals for patent and trade mark attorneys likewise to be published. The Council notes that the AAT currently provides electronic copies of its decisions to the AUSTLII database daily, and this practice should be continued in respect of disciplinary appeals for patent and trade mark attorneys.

This position is consistent with the recommendation of the Council in its 39<sup>th</sup> report titled *Better Decisions: A Review of Commonwealth Merits Review Tribunals*. Recommendation 68 of that report stated “review tribunals should make their decisions as accessible as possible. Summaries of significant review tribunal decisions should be included in the tribunals’ annual reports.” The Council also noted that tribunal decisions can serve an educational purpose and assist other practitioners and advisers as well as contributing to accountability. A copy of that report has also been included with this letter.

### 4. Annual report

The Council suggests that consideration should be given to a statutory requirement that the Disciplinary Tribunal publish an annual report each financial year. Publication may mean simply publication to a website maintained by the Disciplinary Tribunal or it may mean something more formal like the tabling before Parliament of a report. As with publication of decisions, publication of an annual report would assist in improving accountability in the profession and also serve an educational purpose.

### 5. Merits review

In respect of the regulatory regime, the Council suggest that a merits review mechanism should be available so that patents and trade mark attorneys have access to independent review of adverse decisions regarding qualifications and registration. For your background information on this issue, a copy of the Council publication titled *What Decisions Should be Subject to Merits Review?* has been included with this letter.

The Council would be delighted to continue its involvement on this issue and would be able to provide more detailed comments once the provisions are drafted. The Council’s Executive Director, Margaret Harrison-Smith, can be contacted on (02) 6250 5800 or by email at [margaret.harrison-smith@ag.gov.au](mailto:margaret.harrison-smith@ag.gov.au).

Yours sincerely

Jillian Segal AM  
President

