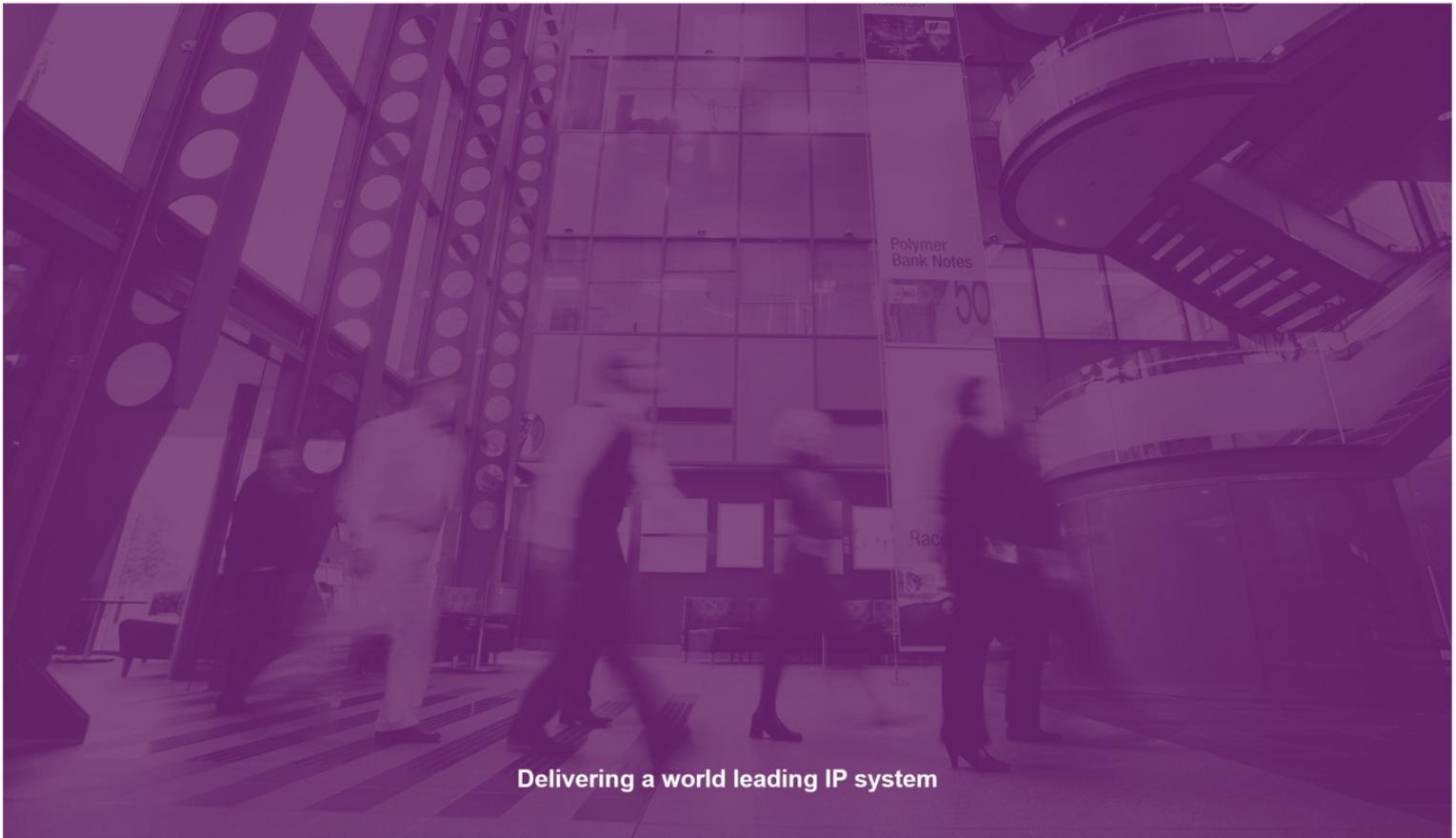




Australian Government
IP Australia

Exposure Draft of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016: Explanatory Statement

May 2016



Delivering a world leading IP system

Copyright

All content in this publication is provided under a Creative Commons Attribution 4.0 International (CC BY 4.0) licence.

<http://creativecommons.org/licenses/by/4.0/> with the exception of:

- the Commonwealth Coat of Arms,
- IP Australia's corporate logo
- photographs of our staff and premises
- content provided by third parties – including photographs, logos, drawings and written descriptions of patents and designs

Third party copyright

IP Australia has made all reasonable efforts to:

- clearly label material where the copyright is owned by a third party
- ensure that the third party has consented to this material being presented in this publication.

Permission may need to be obtained from third parties to re-use their material.

© Commonwealth of Australia 2016



Attribution

The CC BY licence is a standard form licence agreement that allows you to copy and redistribute the material in any medium or format, as well as remix, transform, and build upon the material, on the condition that you provide a link to the licence, you indicate if changes were made, and you attribute the material as follows:

Licensed from the Commonwealth of Australia under a Creative Commons Attribution 4.0 International Licence.

Contact us (www.ipaustralia.gov.au) if you have any enquiries about IP Australia's copyright licence or the use of material in this publication.

Contents

Introduction	1
Privacy Notice	2
Overview	3
EXPLANATORY STATEMENT	3
Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016	3
Legislative Authority	3
The Regulation	3
Purposes of the Regulation	3
Consultation undertaken on Regulation	4
No Regulatory Impact Statement required for the Regulation	4
Commencement of the Regulation	4
Details of the <i>Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016</i>	5
Explanatory notes to Schedule 1	6
Overview	6
Patents Regulations 1991	6
General operation of regulations for the patent attorney profession	6
Requirements for registration as a patent attorney	8
Trans-Tasman IP Attorneys Disciplinary Tribunal: establishment, constitution and procedures	10
Transitional arrangements for attorney registration and disciplinary proceedings	18
Explanatory notes to Schedule 2	21
Overview	21
Trade Marks Regulations 1991	21
General operation of regulations	21
Requirements for registration	22
Trans-Tasman IP Attorneys Disciplinary Tribunal, and Trans-Tasman IP Attorneys Board	23
Transitional arrangements for attorney registration and disciplinary proceedings	25
Explanatory notes to Schedule 3	27
Overview	27
Designs Regulations 2004	27
Plant Breeders Regulations 1994	27

Introduction

This Explanatory Statement accompanies an Exposure Draft of the Intellectual Property Amendment (Single Economic Market) Regulation 2016, which is proposed to implement a number of measures in Schedule 4 of the *Intellectual Property Laws Amendment Act 2015*.

IP Australia invites interested parties to make written submissions on the Exposure Draft Regulation and this Explanatory Statement by **24 June 2016**.

Written submissions should be sent no later than 24 June 2016, to consultation@ipaustralia.gov.au.

For accessibility reasons, please submit responses by email in Word, RTF, or PDF format.

The contact officer is Lisa Bailey, who may be contacted on (02) 6222 3695 or by email at lisa.bailey@ipaustralia.gov.au.

Privacy Notice

Personal information collected during this public consultation is collected for the purposes of gaining stakeholder insights into proposed regulation changes and is protected by the Privacy Act 1988.

Please note that all submissions (along with any personal information provided as part of those submissions) will be published on the IP Australia website or made publicly available in full, unless you request in writing that your submission, or part thereof, is withheld from publication or treated as confidential.

Your information may also be used by IP Australia or disclosed to interested parties for the purpose of briefing on the results of the consultation in general, or about specific issues on which you have commented.

IP Australia will not otherwise use or disclose your personal information without your consent, unless authorised or required by or under law.

If you do not provide your contact details, IP Australia may not be able to make full use of your submission.

All personal information you provide is handled in accordance with [IP Australia's Privacy Policy](#).

The Privacy Policy contains relevant information, including:

- how you may seek access to and correction of the personal information we hold;
- how you may make a complaint about a breach of the Privacy Act and how we will deal with your complaint; and
- IP Australia's Privacy Contact Officer details.

By making a public submission, you provide your consent to your personal information being handled in accordance with this privacy notice and the IP Australia Privacy Policy.

Overview

EXPLANATORY STATEMENT

Select Legislative Instrument No. , 2016

Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016

Issued by the Authority of the Minister for Industry, Innovation, and Science

Patents Act 1990

Trade Marks Act 1995

Designs Act 2003

Plant Breeder's Rights Act 1994

Intellectual Property Laws Amendment Act 2015

Legislative Authority

Subsection 228(1) of the *Patents Act 1990* ('Patents Act'), subsection 231(1) of the *Trade Marks Act 1995* ('Trade Marks Act'), subsection 149(1) of the *Designs Act 2003* ('Designs Act'), and subsection 80(1) of the *Plant Breeders Rights Act 1994* ('Plant Breeders Rights Act')—collectively, 'the Acts'—provide that the Governor-General may make regulations prescribing matters required or permitted by the Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Acts.

The Acts do not specify any conditions that must be met before the power to make the Regulation may be exercised.

The Regulation

The Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016 ('Regulation') amends the Patents Regulations 1991 ('Patents Regulations'), the Trade Marks Regulations 1995 ('Trade Marks Regulations'), the Designs Regulations 2004 ('Designs Regulations'), and the Plant Breeder's Rights Regulations 1994 ('Plant Breeder's Rights Regulations') to prescribe matters required under the provisions of the Acts as amended by Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* ('Amendment Act').

In particular, Schedule 4 to the Amendment Act provides for a single trans-Tasman register of patent attorneys, with registration giving a person the right to practise as a patent attorney in both countries. It also establishes a single set of qualifications for registration, a single trans-Tasman IP Attorneys Board and a single trans-Tasman IP Attorneys Disciplinary Tribunal.

The Regulation is a legislative instrument for the purposes of the *Legislation Act 2003*.

Purposes of the Regulation

The first purpose of the Regulation is to enable the legislative implementation of a single, trans-Tasman patent attorney regime in Australia and New Zealand, an intellectual property initiative being undertaken as part of Australia's broader Single Economic Market agenda with

New Zealand. These regulation amendments follow from amendments made to the Patents Act by Schedule 4 of the Amendment Act.

The second purpose of the Regulation is to amend the Trade Marks Regulations as a result of the implementation of the single patent attorney regime. These regulation amendments follow from amendments made to the Trade Marks Act by Schedule 4 of the Amendment Act.

A third purpose of the Regulation is to amend the Designs Regulations and the Plant Breeder's Rights Regulations to allow an address for service to be in New Zealand. This will make the two Acts consistent with the amendments made to other IP rights in Schedules 1 and 2 of the Regulation. These regulation amendments follow from amendments made to the Plant Breeder's Rights Act and Designs Act by Schedule 4 of the Amendment Act.

Consultation undertaken on Regulation

The public was provided with a consultation paper setting out the nature of the policy changes proposed to the respective regulations between 3 December 2014 and 15 February 2015.

The present consultation seeks public comment on the specific amendments proposed to implement the single trans-Tasman patent attorney regime.

No Regulatory Impact Statement required for the Regulation

The Office of Best Practice Regulation ('OBPR') does not require a Regulation Impact Statement for any of the measures in the Regulation, as these fall within the policy approval obtained for the Act (OBPR Reference Number 13005).

Commencement of the Regulation

The Regulation commences as follows:

- Schedule 1 to the Regulation commences at the same time as Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* commences.
- Schedule 2 to the Regulation commences at the same time as Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* commences.
- Schedule 3 to the Regulation commences at the same time as Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* commences.

Details of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016

Schedule 1 would amend the Patents Regulations to enable the legislative implementation of a single, trans-Tasman patent attorney regime in Australia and New Zealand, an intellectual property initiative being undertaken as part of Australia's broader Single Economic Market agenda with New Zealand. The proposed amendments would allow for a single application and registration process for applicants seeking to register as a patent attorney; establish the Trans-Tasman IP Attorneys Disciplinary Tribunal and provide measures for its operation and procedures; and allow an address for service to be in either Australia or New Zealand.

Schedule 2 would amend the Trade Marks Regulations to make amendments governing trade marks attorney registration (including transitional registration); disciplinary proceedings for trade mark attorneys; and allow an address for service to be in either Australia or New Zealand.

Schedule 3 would amend the Designs Regulations and the Plant Breeder's Rights Regulations to allow an address for service to be in New Zealand. This will make the two Acts consistent with the amendments made to other intellectual property rights in Schedules 1 and 2 of the Regulation.

Explanatory notes to Schedule 1

Overview

This schedule would amend the Patents Regulations to give effect to the amendments made by Schedule 4 of the Amendment Act. These amendments allow for a single patent attorney regime between Australia and New Zealand, and establish measures for the regulation of the regime.

The regulations:

- provide for the general operation of regulations for the patent attorney profession;
- update the requirements for registration as a patent attorney;
- provide for transitional arrangements for applicants seeking registration as a patent attorney and for the conduct of disciplinary proceedings;
- establish the Trans-Tasman IP Attorneys Disciplinary Tribunal and provide for its constitution and procedures;
- provide for the procedures of the Trans-Tasman IP Attorneys Board.

Patents Regulations 1991

General operation of regulations for the patent attorney profession

Items 1-3 would amend subregulation 1.3(1) to repeal definitions which are no longer required, and insert new definitions (discussed below) for terms in the amendments to the Patents Regulations.

Item 1 would repeal the definition of “Disciplinary Tribunal” and substitute:

Disciplinary Tribunal means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61.

Item 2 would repeal the definition of “former attorneys Regulations” and substitute:

former attorneys Regulations means the Patent Attorneys Regulations as in force under the 1952 Act immediately before 30 April 1991.

Item 3 would insert the following definitions:

New Zealand has the meaning given by section 29 of the Interpretation Act 1999 of New Zealand, as in force at the commencement of this definition.

Ordinarily resident: a person is taken to be ordinarily resident in a country if:

- (a) the person has his or her home in that country; or
- (b) that country is the country of his or her permanent abode even though he or she is temporarily absent from that country.

However, the person is taken not to be so resident if he or she resides in that country for a special or temporary purpose only.

Panel Chair, in relation to a Panel of the Disciplinary Tribunal, means:

- (a) the President; or

- (b) if the President is unable to perform his or her functions in proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) to be the Panel Chair for the proceedings.

Panel of the Disciplinary Tribunal means a Panel constituted under regulation 20.36 or 20A.11.

President means the President of the Disciplinary Tribunal.

Tribunal member means a member of the Disciplinary Tribunal and includes the President.

Items 4-7 would amend subregulation 3.2C(2) of the Patents Regulations to allow an address for service to be in either Australia or New Zealand.

Item 8 would insert new regulations 20.1B and 20.1C into Chapter 20 of the Patents Regulations (Chapter 20 governs the regulation of the patent attorney profession). The purpose of new regulations 20.1B(1)-(2) would be to provide that functions and powers conferred on a person or body under Chapter 20 of the Patents Regulations may be exercised in Australia or New Zealand.

New regulation 20.1B(3) would provide that, subject to regulation 20.3C, it is immaterial whether an act or omission mentioned in Chapter 20 took place in New Zealand.

New regulation 20.1B(4) would provide that, subject to regulation 20.3C, it is immaterial whether a matter mentioned in Chapter 20 took place in New Zealand.

New regulation 20.1C would provide that a person is not liable to be prosecuted for an offence in Chapter 20 of the Patents Regulations if the act or omission constituting the offence occurred in New Zealand. If a person commits an offence in New Zealand, this would be prosecuted by the authorities in New Zealand.

Items 9 and 9A, 10, 11, and 12

These items would make various amendments to existing definitions set out in regulation 20.1 of the Patents Regulations.

Item 9 would delete paragraph “(1) In”, and substitute “In”.

Item 10 would repeal the definition of the Professional Standards Board for Patent and Trade Marks Attorneys (“the Board”) in regulation 20.1 of the Patents Regulations. The Board would be succeeded by the new Trans-Tasman IP Attorneys Board.

Item 11 would insert a new definition of the term “Board Chair” into regulation 20.1 of the Patents Regulations. “Board Chair” means the Chair of the Board mentioned in paragraph 227A(2A)(a) of the Amendment Act (this paragraph continues the Board as it existed immediately before commencement of the Amendment Act, as the Trans-Tasman IP Attorneys Board).

Item 12 would repeal the definition of Chairperson in regulation 20.1 of the Patents Regulations, which is no longer required.

Requirements for registration as a patent attorney

Item 13 would insert a definition of the acronym “NZQF” into regulation 20.1 of the Patents Regulations. “NZQF” is defined as the New Zealand Qualifications Framework established under section 248 of the *Education Act 1989* of New Zealand. The NZQF is equivalent to the Australian Qualifications Framework (“AQF”). The AQF regulates qualifications in the Australian education and training system. In conjunction with the proposed amendment to regulation 20.6 (discussed at Items 16 and 17), this amendment will allow the Board to take into account qualifications which have been obtained in either Australia or New Zealand.

Item 14 would repeal the definition of “higher education sector” in subregulation 20.1(2) of the Patents Regulations. This definition is no longer required, as a result of amendments to regulation 20.6 of the Patents Regulations (discussed at Items 16 and 17), which would now allow suitable qualifications from vocational education providers, as well as universities.

Item 15 would remove the requirement in regulation 20.3(1)(a) of the Patents Regulations that an applicant for registration as a patent attorney must provide evidence that he or she is ordinarily resident in Australia. This provision is no longer required as a result of the repeal of paragraph 198(4) of the Patents Act. Instead of the requirement to provide evidence of residency in Australia, an applicant will have to provide an address for service in either Australia or New Zealand.

Item 16 would amend subparagraph 20.6(1)(a) by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF, or NZQF, qualification.” This is intended to make it clear that a qualification may be obtained from a university or vocational education provider, provided that the qualification is at least level 5 or above. There would be no disadvantage to applicants from either Australia or New Zealand, as the AQF and NZQF are aligned.

Item 17 would amend subparagraph 20.6(1)(b) by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF, or NZQF, qualification.” This is intended to make it clear that a qualification may be obtained from an overseas university or vocational education provider, provided that the qualification is at least level 5 or above. There would be no disadvantage to applicants from either Australia or New Zealand, as the AQF and NZQF are aligned.

Item 18 would add the term “or NZQF” following references to the AQF in regulation 20.6 of the Patents Regulations. This would ensure that New Zealand applicants for registration as a patent attorney are subject to the same academic qualification requirements as Australian applicants.

Items 19, 20, 21, 22, 23, and 24

These items would make amendments to the employment requirements that an applicant for registration as a patent attorney would have to meet under regulation 20.10 of the Patents Regulations.

Item 19 would amend paragraph 20.10(1)(a) to provide that the employment would have to have been in Australia, New Zealand, or both countries.

Item 20 would amend subparagraph 20.10(1)(a)(ii) to replace the requirement that the applicant must have experience in preparing, filing, and prosecuting patent applications in Australia; the new requirement would be that relevant experience must be “in relation to

Australia and New Zealand” applications. This would ensure that applicants will have the required level of experience to practice in both Australia and New Zealand.

Item 21 would amend subparagraph 20.10(1)(a)(iii) by omitting the words “in other” and substituting “in relation to the other” so that the applicant must have experience in preparing, filing, and prosecuting patent applications in relation to other countries. This is intended to make it clear that an applicant only needs experience in prosecuting patent applications in other countries, rather than suggesting that the applicant must have experience working in other countries.

Item 22 would amend subparagraph 20.10(1)(a)(iii) to refer to countries and organisations that are major trading partners with both Australia *and* New Zealand, rather than just Australia.

Item 23 would amend the example of major trading partners in subregulation 20.10(1) so that it correctly refers to the European Union, rather than the European Community. It would also replace a reference to New Zealand with a reference to Korea.

Item 24 would insert new subregulations into regulation 20.10 to define the terms “employed in Australia” and “employed in New Zealand”.

New subregulation 20.10(3) would provide that a person is “employed in Australia” only if the person is, in accordance with the terms of his or her employment, required to undertake (and does undertake) the duties of his or her employment in Australia. The intention of this amendment is to ensure that the person undertakes the employment within the geographical boundaries of Australia.

New subregulation 20.10(4) would apply an equivalent definition to employment undertaken in New Zealand.

Item 25 would repeal subregulation 20.12(1) of the Patents Regulations, and substitute a new provision extending the offences which may prevent an applicant from being registered as a patent attorney to include the intellectual property legislation of New Zealand. The new provision will also include offences under the plant breeders rights legislation of both countries.

In particular, new subregulation 20.12(1) provides that an offence against any of the following Acts is a prescribed offence for s.198(4)(e) of the Patents Act:

- (1) An offence against any of the following Acts is a prescribed offence for paragraph 198(4)(e) of the Act:
 - (a) the Act;
 - (b) the *Designs Act 2003*;
 - (b) the *Plant Breeder’s Rights Act 1994*;
 - (c) the *Trade Marks Act 1995*;
 - (d) the *Designs Act 1953* of New Zealand;
 - (e) the *Patents Act 1953* of New Zealand;
 - (f) the *Patents Act 2013* of New Zealand;
 - (g) the *Plant Variety Rights Act 1987* of New Zealand;
 - (h) the *Trade Marks Act 2002* of New Zealand.

Trans-Tasman IP Attorneys Disciplinary Tribunal: establishment, constitution and procedures

Items 26 and 27 would amend regulation 20.28B of the Patents Regulations to update references as a result of the constitution of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Subregulation 28B(4)(c), as amended, would replace a reference to the former Disciplinary Tribunal with a reference to “a Panel of” the Disciplinary Tribunal.

Subregulation 28B(5)(c) would replace a reference to the Disciplinary Tribunal with a reference to “the President” of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 28 would amend subregulations 20.35(1) and (3) of the Patents Regulations to omit a reference to the former Disciplinary Tribunal and replace it with reference to the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal. It is the President who would receive notice of the commencement of proceedings and notify the registered patent attorney.

Item 29 would repeal regulation 20.36 of the Patents Regulations (which set out procedures for the former Disciplinary Tribunal) and insert new provisions to govern the constitution and procedure of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

New regulation 20.36 would provide that, except as otherwise provided, the powers and functions of the Trans-Tasman IP Attorneys Disciplinary Tribunal are to be exercised by a Panel of that Tribunal. A Panel would consist of a Panel Chair, and two other members, as determined by the Panel Chair. At least one member of the Panel must be ordinarily resident in the same country as the registered patent attorney who is the subject of the disciplinary proceedings (this requirement is subject to new regulation 20.36E(5), discussed below).

New regulation 20.36A would provide that the Panel Chair must convene such meetings as the Panel Chair considers necessary, and preside at all meetings of the Panel. All members must be present at a meeting and questions are to be decided by a majority vote. If the Panel is reduced in number [in accordance with paragraph 20.36D(2)(a) or subregulation 20.36E(5)] then questions must be decided by a unanimous vote.

New regulation 20.36B would set out the procedure of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal. Procedures for convening Panel meetings and conducting the business of the Panel are to be determined by the Panel Chair. Disciplinary proceedings are to be conducted quickly and informally. The Panel is not bound by the rules of evidence, but may be informed on any matter in the manner it chooses. The Panel may take evidence on oath or affirmation, which may be administered by the Panel Chair.

New regulation 20.36C would provide that, if the Panel Chair ceases to be available to complete the hearing of a particular matter before it has been determined, then the matter would be re-heard by a new Panel constituted in accordance with regulation 20.36C. The new Panel would be able to have regard to the record of proceedings of the earlier Panel for the purposes of completing the proceedings.

New regulation 20.36D would provide that if a member of the Panel (other than the Panel Chair) ceases to be available, then, subject to regulation 20.36E, the Panel Chair may determine:

- that the matter may be completed by the remaining members of the Panel; or
- that the matter may be reheard by a new Panel constituted in accordance with regulation 20.36.

The new Panel would be able to have regard to the record of proceedings of the earlier Panel for the purposes of completing the proceedings.

New regulation 20.36E would set out the procedure which would occur if – before a particular matter has been determined – a member of the Panel (other than the Panel Chair) ceases to be available, and neither of the remaining members is ordinarily resident in the same country as the registered patent attorney. In this circumstance, the Panel Chair must notify the patent attorney of the situation and advise that the patent attorney may elect to continue the proceedings before the remaining Panel members, or have the matter reheard by a new Panel constituted in accordance with regulation 20.36.

If the Panel Chair does not receive an election within the period specified in the notice, then the Panel Chair must arrange for the matter to be reheard by a new Panel constituted in accordance with regulation 20.36. The new Panel may have regard to the records of the earlier Panel for the purposes of determining the proceedings.

Item 30 would repeal subregulations 20.37(1) and (2) of the Patents Regulations, which governed aspects of the notification of hearing of disciplinary proceedings. New subregulation 20.37(1) would establish that it is the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal who fixes a time and place for the hearing, and notifies the registered patent attorney and the Board of the hearing.

Items 31, 32, 33, and 34

These items would amend regulation 20.38 of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 35 would repeal the heading “Representation before Disciplinary Tribunal” at regulation 20.39 of the Patents Regulations and replace it with the heading “Representation before Panel of Disciplinary Tribunal”.

Items 36, 37, 38, and 39

These items would amend regulation 20.39 of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Items 40 and 41

These items would amend regulation 20.40 of the Patents Regulation to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 42 would repeal the heading “Offences by persons appearing before Disciplinary Tribunal” at regulation 20.41 of the Patents Regulations and replace it with the new heading “Offences by persons appearing before a Panel of Disciplinary Tribunal”.

Items 43-47 would amend regulation 20.41 of the Patents Regulations to replace references to the former Disciplinary Tribunal in the offence provisions with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 48 would amend subparagraph 20.41(3)(a)(iii) of the Patents Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 of the Regulations. It is not necessary for expenses and allowances to be determined by the former Tribunal (in accordance with Part 2 of Schedule 8) as required under to-be-amended subparagraph 20.41(3)(a)(iii).

Item 49 would repeal paragraph 20.41(3)(b) of the Patents Regulations. It is no longer required, as a result of the amendment made by **Item 48**.

Consequently, **Item 50** would amend paragraph 20.41(4)(b) so that it correctly refers to subparagraph 20.41(3)(a)(iii).

Item 51 would amend paragraph 20.41(5)(b) of the Patents Regulations, to refer to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal.

Items 52-54 would make amendments to regulation 20.42 of the Patents Regulations, which provides protection and immunity from prosecution for members of the Trans-Tasman IP Attorneys Disciplinary Tribunal in the performance of their duties.

Item 52 would repeal the heading “Protection of person constituting Disciplinary Tribunal, witnesses, etc.” at regulation 20.42 of the Patents Regulations and replace it with “20.42 Protection of certain persons”.

Item 53 would repeal the existing immunity provision in subregulation 20.41(2) and replace it with an equivalent provision which refers to members of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than to the former Disciplinary Tribunal.

Item 54 would amend subregulations 20.42(3) and 20.42(4) to insert a reference to “a Panel” of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 55 would repeal the heading “Decision of Disciplinary Tribunal” at regulation 20.43 of the Patents Regulations and replace it with “Decision of Panel of Disciplinary Tribunal”.

Items 56-73 would amend regulations 20.44, 20.45, 20.46, and 20.47 of the Patents Regulations so that they correctly refer to decisions which would now be made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 74 would repeal regulation 20.48 of the Patent Regulations and substitute a new regulation 20.48, which would allow a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against a registered patent attorney in previous disciplinary proceedings under the current regulations or former attorneys regulations.

Item 75 would repeal the heading “Findings of Disciplinary Tribunal” at regulation 20.49 of the Patents Regulations and replace it with “Findings of Panel of Disciplinary Tribunal”.

Items 76-79 would amend regulation 20.49 of the Patents Regulations so that references to the findings of the former Disciplinary Tribunal are replaced with references to the Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 80 would repeal the heading “Notification and publication of decisions of Disciplinary Tribunal” at regulation 20.50 of the Patents Regulations and substitute the heading “Notification and publication of decisions of Panel of Disciplinary Tribunal.”

Items 81-83 would amend regulation 20.50 of the Patent Regulations, so that references to the former Disciplinary Tribunal are replaced with references to the Panel. The effect is that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal which would notify the attorney and publish the findings of the Panel.

Items 84-87 would amend regulations 20.51 and 20.52 of the Patent Regulations so that references to the former Disciplinary Tribunal are replaced with references to the Panel or the Panel Chair of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 88 would repeal the heading “Division 1 – Professional Standards Board for Patents and Trade Marks Attorneys” in Part 10 of the Patents Regulations, and replace it with the new heading “Division 1 – Trans-Tasman IP Attorneys Board” (“the Board”).

Item 89 would repeal regulation 20.54 (constitution of the Board) and regulation 20.55 (term of office for Board members) of the Patents Regulations, as they are no longer required. Item 41 of the Amendment Act inserts a new provision at section 227A(2) of the Patents Act, setting out the constitution of the Trans-Tasman IP Attorneys Board.

Item 90 would amend subregulation 20.56(1) of the Patents Regulations so that it refers to the members of the Board – ie those mentioned in new section 227A(2)(2A)(a),(d), and (e) of the Patents Act – who may resign by giving the Minister their resignation in writing.

Item 91 would amend subregulation 20.56(2) of the Patents Regulation to omit a reference to the removal of the Chairperson of the Board, and substitute a new reference to terminating the appointment of the Board Chair.

Item 92 would amend paragraph 20.56(2)(a) of the Patents Regulations to remove an obsolete reference to regulation 20.60.

Item 93 would amend paragraph 20.56(2)(b) of the Patents Regulations to include a reference to New Zealand, so that it refers to a person who has been convicted of an offence in Australia or New Zealand.

Item 94 would amend paragraphs 20.56(2)(c) and (e) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 95 would amend paragraph 20.56(3)(b) of the Patents Regulations to include a reference to New Zealand, so that it refers to a person who has been convicted of an offence in Australia or New Zealand.

Item 96 would amend subregulation 20.56(3) to omit a reference to the removal of the Chairperson of the Board, and substitute a new reference terminating the appointment of a member of the Board mentioned in paragraph 227A(2A)(d) or (e) of the Amendment Act.

Item 97 would amend paragraph 20.56(3)(a) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 98 would amend subregulation 20.57(2) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 99 would amend subregulations 20.58(1),(2), and (3) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Items 100 and 101 would amend regulation 20.59 of the Patents Regulations to provide that, at a meeting of the Board, a quorum is formed by the majority of the members of the Board. At least one member of the majority must be ordinarily resident in Australia, and another must be ordinarily resident in New Zealand.

Item 102 would repeal regulation 20.60 of the Patent Regulations, as it is no longer required.

Item 103 would repeal the heading “Establishment of Disciplinary Tribunal” in Division 2, Part 10 of Chapter 20 and substitute a new heading “Division 2 – Trans-Tasman IP Attorneys Disciplinary Tribunal”.

Item 104 would repeal regulation 20.61 of the Patents Regulations and substitute a new provision establishing the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 105 would insert new regulation 20.61A into the Patents Regulations. This provision sets out that the functions of the Disciplinary Tribunal are to hear and determine disciplinary proceedings commenced by the Board against registered patent or trade marks attorneys.

Item 106 would repeal the heading “Disciplinary Tribunal – substantive appointments” at regulation 20.62 of the Patents Regulations and substitute the new heading “Membership of the Disciplinary Tribunal etc.”

Item 107 would repeal subregulation 20.62 of the Patents Regulations a new provision, which provides that the new Trans-Tasman IP Attorneys Disciplinary Tribunal consists of a President and at least two other members, which are to be appointed by the Minister on a part-time basis.

Items 108-111 would amend subregulations 20.62(3)-(6) of the Patents Regulations by omitting the words “person so appointed” and “remove a person so appointed from office” and substituting the term “Tribunal member”.

Item 111 would also insert a reference to New Zealand into paragraph 20.62(6)(b) of the Patents Regulations so that a person who has been convicted of an offence in New Zealand must have his or her appointment as a Tribunal member terminated.

Item 112 would amend subregulation 20.62(6) of the Patents Regulations by omitting the words “remove the person from office” and substituting the words “terminate the Tribunal member’s appointment.”

Item 113 would repeal regulations 20.63, 20.64, and 20.65 of the Patents Regulations, and substitute new provisions governing the eligibility and appointment of members to the Board.

New regulation 20.63 would set out the eligibility requirements for appointment as a member of the Trans-Tasman IP Attorneys Disciplinary Tribunal, including the appointment of the President of the Tribunal. A person is not eligible to be appointed as President unless the person is currently enrolled as a legal practitioner in Australia or New Zealand, and has been enrolled for at least seven years.

A person is not eligible to be appointed as a Tribunal member (other than the President) unless the person is or was a registered patent or trade marks attorney in Australia or New Zealand.

New regulation 20.63A would provide that the Minister may appoint a person to act as President of the Tribunal during a vacancy, absence of duty, or if the President is otherwise unable to perform his or her duties.

New regulation 20.63B would allow for the appointment of acting Tribunal members (other than the President) in the same circumstances.

New regulation 20.64 would provide that if the President or other Tribunal members discover a conflict of interest that could interfere with the performance of his or her duties or functions, then that person must tell the parties to the proceeding about the interest and must not perform the duties or functions without consent of the parties.

In the event of a conflict of interest by the President, the Minister may appoint another person to act as the Panel Chair. If an ordinary member discloses a conflict of interest, then the Panel Chair may appoint another member to the Panel for the proceedings.

Item 114 would insert new regulations 20A.1A and 20A.1B into the Patents Regulations.

New regulation 20A.1A would provide that a function or power conferred under Chapter 20 of the Patents Regulations may be exercised in either Australia or New Zealand. It is immaterial whether an act or omission constituting an offence subject to regulation 20A.1B occurred in, or relates to something that occurred in, New Zealand.

New regulation 20A.1B would provide that a person is not liable to be prosecuted for an offence against these Regulations if the act or omission occurred in New Zealand.

A person who commits an offence against these regulations in New Zealand would be prosecuted by the authorities in New Zealand.

Item 115 would amend subparagraph 20A.3(b)(ii) of the Patent Regulations by inserting a reference to the Companies Act 1993 of New Zealand, so that an application for registration of an incorporated patent attorney must provide evidence of registration as a company in either Australia or New Zealand.

Item 116 would amend paragraph 20A.10(1)(a) of the Patent Regulations to omit the words “is found guilty” and substitute “has, at any time,” been found guilty. This is so any previous findings of professional misconduct can be taken into account.

Item 117 would repeal paragraph 20A.10(1)(c) of the Patent Regulations and substitute a new paragraph. The new provision removes a reference to the suspension or cancellation of a patent attorney’s registration by the former Disciplinary Tribunal for professional misconduct, and replace it with a reference to the cancellation of the registration of the patent attorney under subregulation 20.44(1) (‘Penalties – professional misconduct’).

Item 118 would omit a reference to “an incorporated” patent attorney in subregulation 20A.10(2) of the Patent Regulations and replace it with a reference to “the incorporated” patent attorney.

Item 119 would add a new paragraph to subregulation 20A.10(4) of the Patent Regulations so that it is clear that the Board must send the application for cancellation or suspension of an incorporated attorney’s registration to the President.

Item 120 would repeal regulation 20A.11 of the Patents Regulations and substitute new regulations 20A.11-20A.11D, which govern disciplinary proceedings for incorporated patent attorneys.

These provisions mirror those for individual attorneys in new regulations 20.36-20.36D (discussed at **Item 29**), with minor differences in order to manage proceedings for an incorporated patent attorney, rather than an individual registered patent attorney.

Subregulations 20A.11(1-3) have the same effect as those constituting panels for individual attorneys in regulation 20.36. Subregulation 20A.11(4) provides that a Panel must include a member who is ordinarily resident in the country in which the incorporated patent attorney is registered.

Regulations 20A.11A – 20A.11C have the same effect as regulations 20.36A – 20.36C.

Regulation 20A.11D is identical to regulation 20.36D, although the requirement for a Panel member to be resident in the same country as the registered patent attorney subject to proceedings is amended, so that it refers to the country in which the incorporated patent attorney is registered.

Item 121 would repeal subregulations 20A.12(1) and (2) of the Patents Regulations and substitute a new provision as per Item 27 but with reference to an incorporated patent attorney, rather than an individual patent attorney.

Items 122-125 would amend regulation 20A.13 of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to a Panel or the Panel Chair of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 126 would repeal the heading “Representation before Disciplinary Tribunal” at regulation 20A.14 of the Patents Regulations and substitute the new heading “Representation before a Panel of Disciplinary Tribunal”.

Items 127-129 would amend regulation 20A.14 of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 130 and 131 These items would amend regulation 20A.15(1) of the Patents Regulation to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 132 would repeal the heading “Offences by persons appearing before Disciplinary Tribunal” at regulation 20A.16 of the Patents Regulations and replace it with the new heading “Offences by persons appearing before a Panel of Disciplinary Tribunal”.

Items 133-137 would amend regulation 20A.16 of the Patents Regulations to replace references in the offence provisions with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 138 would amend subparagraph 20A.16(3)(a)(iii) of the Patents Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 of the Regulations, rather than as determined by the Tribunal (in accordance with Part 2 of Schedule 8) as required under to-be-amended subparagraph 20.41(3)(a)(iii).

Item 139 would repeal paragraph 20A.16(3)(b) of the Patents Regulations, as it is no longer required as a result of the amendment made by **Item 138**.

Consequently, **Item 140** would amend paragraph 20A.16(4)(b) so that it correctly refers to subparagraph 20.41(3)(a)(iii).

Item 141 would amend paragraph 20A.16(5)(a) of the Patents Regulations, to refer to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal.

Item 142 would repeal the heading “Protection of person constituting Disciplinary Tribunal, witnesses, etc” at regulation 20A.17 of the Patents Regulations and replace it with the new heading “Protection of certain persons”.

Item 143 would repeal the existing immunity provision in subregulation 20A.17(1), which refers to the former Disciplinary Tribunal, and replace it with an equivalent provision which refers to members of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 144 would amend subregulations 20A.17(3) and 20A.17(4) to insert a reference to “a Panel” of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 145 would repeal the heading “Decision of Disciplinary Tribunal” at regulation 20A.18 of the Patents Regulations and replace it with “Decision of Panel of Disciplinary Tribunal”.

Items 146-148 would amend regulation 20A.18 of the Patents Regulations so that it correctly refers to decisions made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 149 would repeal subregulations 20A.18(3)(d) and (e) of the Patent Regulations, and substitute new subregulations 20A.18(3)(d) and (e) which would allow a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against an incorporated attorney or its employees or officers in any other proceedings before a relevant disciplinary tribunal.

Item 150 would insert a new paragraph (4) into regulation 20A.18 of the Patents Regulations to define the term “relevant disciplinary tribunal”. This term is defined to mean the Patents and Trade Marks Attorneys Tribunal established by regulation 20.61, as in force prior to the commencement of this regulation, or any transitional proceedings before that tribunal. The definition also includes the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 as in force on commencement of this regulation.

Item 151 would repeal the heading “Notification and publication of decisions of Disciplinary Tribunal” at regulation 20A.19 of the Patents Regulations and substitute the heading “Notification and publication of decisions of Panel of Disciplinary Tribunal.”

Item 152 would amend subregulation 20A.19(1) of the Patents Regulations so that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal, which would make the decision, notify the incorporated patent attorney, and publish the decision.

Items 153-160 would amend regulations 20A.19 and 20A.20 to replace various references to the former Disciplinary Tribunal with references to the Panel or Panel Chair, as required.

Item 161 would amend subparagraph 20A.22(2)(b)(ii) – the first occurring – of the Patents Regulations to insert a reference to the *Companies Act 1993* of New Zealand, so that an

incorporated patent attorney from New Zealand is able to have his or her name restored to the register.

Item 162 would correct a numbering error by amending the second occurring subparagraph 20A.22(2)(b)(ii) by omitting the reference “(ii) evidence”, and substituting “(iii) evidence.”

Items 163-167 would amend regulation 22.10 of the Patents Regulations to provide that an address for service can be in New Zealand. Subregulation 22.10(5) provides that service by post is a prescribed means of service of documents for the purposes of section 221(1) of the Patents Act.

Item 168 would repeal paragraphs 22.13(c) and (d) of the Patents Regulations and substitute new provisions which include the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal and the Board in the list of persons to whom declarations in electronic form may be given.

Items 169 and 170 would amend regulation 22.26(2)(d) of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to the Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Transitional arrangements for attorney registration and disciplinary proceedings

Item 171 would insert a new Part 3 at the end of Chapter 23 of the Patent Regulations, which would govern transitional arrangements for Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* and Schedule 1 of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016.

New regulation 23.38 would define terms used in Part 3 of Chapter 23 of the Patent Regulations.

“Commencement day” would mean the day on which Schedule 4 to the Amendment Act commences.

The term “old regulations” would mean the Patent Regulations as in force immediately before the commencement day.

New regulation 23.39 would describe the circumstances in which the name of a patent attorney registered in New Zealand can be removed from the register. The Designated Manager must remove an individual's name from the register if:

- the individual was registered as a patent attorney in New Zealand;
- the conduct giving rise to the court's determination occurred before the commencement day;
- on or after the commencement day, the New Zealand Commissioner of Patents advises the Designated Manager that a New Zealand court has determined that the person should not practice as a patent attorney; and
- all rights of appeal have been exhausted or expired.

New regulation 23.40 would provide that, for the purposes of paragraph 198(4)(g) of the Patents Act – which governs patent attorney registration, and management of the register of patent attorneys – if an individual from New Zealand has had their name removed from the register under new regulation 20.39, then the Designated Manager can restore the name to the register only after receiving written advice from the New Zealand

Commissioner of Patents that a court in New Zealand has determined that the name can be entered in the register.

New regulation 23.41 would describe the transitional arrangement by which applicants for registration in New Zealand who have already commenced their examinations may register as a patent attorney under the new Trans-Tasman regime. There would be a four year period during which transitional candidates would be able to seek registration. If an applicant has passed all of the specified New Zealand examinations, at least one of which was passed before the commencement day, and the remainder of the examinations were passed within four years from the commencement day, then the applicant would be able to seek registration as a patent attorney. The applicant would also be required to meet the usual requirements for registration set out in section 198 of the Patents Act (as modified by Item 82 of the Amendment Act).

This provision would ensure that individuals in New Zealand who have commenced their examinations would not be disadvantaged by the implementation of the new Trans-Tasman regime.

New regulation 23.42 would provide for the continuation of disciplinary proceedings against a registered patent attorney which were commenced, but had not been completed, before the commencement day. In these circumstances, the proceedings would continue under the former Disciplinary Tribunal and in accordance with the old regulations. The Minister may, if necessary, appoint a person under regulation 20.63 or 20.64 of the old regulations, for the purposes of completing the proceedings.

New regulation 23.43 would make the same provision as in regulation 23.42 for the continuation of disciplinary proceedings against incorporated patent attorneys.

New regulation 23.44 would provide that the Minister must, in writing, terminate the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting any transitional proceedings as soon as is practicable after the Minister is satisfied that all such proceedings (including all appeals) have been completed.

New regulation 23.45 would ensure that applicants who have already commenced a course of study with a view to applying for an exemption to the knowledge requirements, would not be disadvantaged when the single patent attorney regime commences. Accordingly, new regulation 23.45 would provide that, if an applicant for registration as a patent attorney has, before 1 January 2018:

- passed a course of study that has outcomes that are the same as, or similar to, those of a knowledge requirement mentioned in Schedule 5 to the old regulations: and
- has passed the course at a satisfactory level;

Then the applicant may still apply for an exemption to the knowledge requirement under regulation 20.9 of the Patents Regulations.

Schedule 5 to the old regulations would continue to apply for the purpose of the Board making a decision to grant an exemption to the applicant under regulation 20.9. This would be the case, even after Schedule 5 to the old regulations is amended by Schedule 1 to the *Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016*.

Item 172 would repeal Clause 2 of Part 2 of Schedule 5 of the Patents Regulations, which sets out the knowledge requirements regarding legal process and overview of intellectual property required by applicants for registration as a patent attorney. A new provision would be substituted, which will include a reference to the legal system of New Zealand. The new provision will provide that a course of study must have provide for a student to have an appropriate level of understanding of both the Australia and New Zealand legal systems, and how intellectual property rights may be protected.

Item 173 would amend Clause 5 of Part 5 of Schedule 5 of the Patents Regulations to include a reference to New Zealand's systems of protecting and exploiting trade marks, patents, and designs, as well as the systems in Australia and other countries.

Item 174 would repeal the note at Schedule 8 of the Patents Regulations (note to Schedule heading) and substitute a new note to provide correct references to subregulations 20.41(3) and 20A.16(3).

Explanatory notes to Schedule 2

Overview

This schedule would amend the Trade Marks Regulations to give effect to the amendments made by Schedule 4 of the Amendment Act.

Trade Marks Regulations 1991

General operation of regulations

Items 1-3 would amend regulation 2.1 of the Trade Marks Regulations to repeal definitions which are no longer required, and insert new definitions used in the amendments to the Trade Marks Regulations.

Item 1 would repeal the definition of “Board”.

This definition is no longer required as a result of the amendment made by Item 39 of Schedule 4 of the Amendment Act. Currently, section 6(1) of the Trade Marks Act provides that the term “Board” is defined as having the same meaning as in the Patents Act.

Item 39 of Schedule 4 to the Amendment Act amends section 227A of the Patents Act to provide that the body known as the Professional Standards Board for Patent and Trade Marks Attorneys immediately before commencement is continued in existence as the Trans-Tasman IP Attorneys Board. Item 40 of Schedule 4 of the Amendment Act replaces references to the Professional Standards Board with references to “the Board”.

Item 2 would repeal the definition of “Disciplinary Tribunal” and substitute:

Disciplinary Tribunal means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 of the Patents Regulations 1991.

Item 3 would insert the following definitions:

Panel Chair, in relation to a Panel of the Disciplinary Tribunal, means:

- (a) the President; or
- (b) if the President is unable to perform his or her functions in proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) to be the Panel Chair for the proceedings.

Panel of the Disciplinary Tribunal means a Panel constituted under regulation 20.36 or 20A.11.

President means the President of the Disciplinary Tribunal.

Items 4-11 would amend regulations 17A.16(3)(b), 17A.17(3), 17A.34H(2), 17A.34H(5), 17A.37(3), 17A.42B(1)(a), 17A.48H(2) and 17A.50(5) to insert references to New Zealand, so that references to an address for service include an address for service in either Australia or New Zealand.

Item 12 would repeal subregulation 17A.74(2) and substitute a new provision which provides that an address for the service of documents under the Trade Marks Act or Trade Marks Regulations

must be an address in either Australia or New Zealand. The address must be one to which it is practicable and reasonable for a person providing mail delivery services to deliver mail.

Item 13 would delete paragraph “(1) In”, and substitute “In”.

Requirements for registration

Item 14 would repeal the definition of “higher education sector” in subregulation 20.1(2) of the Trade Marks Regulations. This definition will no longer be required as a result of proposed amendments to regulation 20.6 of the Trade Mark Regulations (discussed at Item 15).

Item 15 would repeal paragraph 20.6(a) of the Trade Marks Regulations, and substitute a new paragraph which provides that an academic qualification must be a Level 5 AQF qualification or higher. This is intended to make it clear that a qualification may be obtained from a university *or* vocational education provider, provided that the qualification is at least Level 5 or above.

Item 16 would amend subparagraph 20.6(b) of the Trade Marks Regulations by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF qualification.” This is intended to make it clear that a qualification may be obtained from an overseas university *or* vocational education provider, provided that the qualification is at least Level 5 or above.

Item 17 would amend regulation 20.11 of the Trade Marks Regulations, which governs the requirements that applicants must meet when applying for their initial registration as a trade marks attorney.

Regulation 20.11 of the Trade Marks Regulations presently applies the knowledge requirements in Schedule 5 of the Patents Regulations, with necessary modifications for applicants seeking registration as a trade marks attorney. While this continues in general to be a satisfactory arrangement for setting out the knowledge requirements, some of the proposed amendments to Schedule 5 to implement the new trans-Tasman patent attorney regime should not be applied to applicants for registration as a trade mark attorney. This is because the new trans-Tasman patent attorney regime does not extend to trade mark attorneys – there will not be a joint trade mark attorney regime with New Zealand.

To allow regulation 20.11 of the Trade Marks Regulation to continue incorporating the relevant parts of the Patents Regulations, while excluding requirements which will apply only to patent attorneys, an amendment is required to the Trade Marks Regulations.

Accordingly, this item would amend regulation 20.11 of the Trade Marks Regulations to preserve the existing knowledge requirements for trade marks attorneys, rather than incorporating references to the legal system and intellectual property systems of New Zealand (proposed at Schedule 1, Item 173). This amendment would also preserve the existing knowledge requirement that an applicant must have a sufficient understanding of the system for protecting and exploiting trade marks in Australia, and in other countries.

This will ensure that future applicants for registration as a trade marks attorney, and universities seeking accreditation for a course in trade marks law and/or practice, legal process, or intellectual property, will be required to meet the same knowledge requirements as at present.

Trans-Tasman IP Attorneys Disciplinary Tribunal, and Trans-Tasman IP Attorneys Board

Item 18 would amend regulation 20.15 of the Trade Marks Regulations by inserting new paragraphs (f) to (i). The effect of these paragraphs is to omit references to the Patent Regulations, such that a registered trade marks attorney who is the subject of disciplinary proceedings would not be entitled to have a Panel member who is ordinarily resident in the same country as the trade marks attorney.

This is because there will not be a joint trade marks attorney regime with New Zealand. Registered trade marks attorneys practising under the Trade Marks Act will continue to practice under Australian law, regardless of where they ordinarily reside.

This is in contrast to the Patents Regulation. If a registered patent attorney who is ordinarily resident New Zealand is subject to disciplinary proceedings, then the Panel must have at least one member who is ordinarily resident in New Zealand. This is to ensure that the Panel has suitable expertise in patents law and practice in New Zealand.

Item 19 would amend paragraph 20A.10(1)(a) of the Trade Marks Regulations to omit the words “is found guilty of professional misconduct under Division 5 of Part 20” and substitute “has, at any time, been found guilty of professional misconduct in accordance with Division 6 of Part 20.” This will allow previous findings of professional misconduct to be taken into account.

Item 20 would repeal paragraph 20A.10(1)(c) of the Trade Marks Regulations and substitute a new paragraph, so that it correctly refers to the cancellation of a trade marks attorney’s registration under Division 6 of Part 20 of the Trade Marks Regulations, rather than to cancellation by the former Disciplinary Tribunal.

Item 21 would omit a reference to “an incorporated” trade marks attorney in subregulation 20A.10(2) of the Trade Marks Regulations and replace it with a reference to “the incorporated” trade marks attorney.

Item 22 would add a new paragraph to subregulation 20A.10(4) of the Trade Marks Regulations so that it is clear that the Board must send the application for cancellation or suspension of an incorporated attorney’s registration to the President of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 23 would repeal regulation 20A.11 of the Trade Marks Regulations and substitutes new regulations 20A.11-20A.11D, which govern disciplinary proceedings for incorporated trade marks attorneys.

Item 24 would repeal subregulations 20A.12(1) and (2) of the Trade Marks Regulations and substitutes a new provision, so that it is clear that it is the Panel Chair who must organise the hearing of the disciplinary proceedings, and notify the Board and the incorporated trade marks attorney accordingly.

Items 25-28 would amend regulation 20A.13 of the Trade Marks Regulations to replace references to the former Disciplinary Tribunal with references to a Panel or the Panel Chair of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 29 would repeal the heading “Representation before Disciplinary Tribunal” at regulation 20A.14 of the Trade Marks Regulations and substitutes the new heading “Representation before a Panel of Disciplinary Tribunal”.

Items 30-32 would amend regulation 20A.14 of the Trade Marks Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Items 33 and 34 would amend regulation 20A.15(1) of the Trade Marks Regulation to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 35 would repeal the heading “Offences by persons appearing before Disciplinary Tribunal” at regulation 20A.16 of the Trade Marks Regulations and replace it with the new heading “Offences by persons appearing before a Panel of Disciplinary Tribunal”.

Items 36-40 would amend regulation 20A.16 of the Trade Marks Regulations to replace references in the offence provisions with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 41 would amend subparagraph 20A.16(3)(a)(iii) of the Trade Marks Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 of the Patent Regulations. This provides a clear basis for setting the levels of expenses and allowances.

Item 42 would repeal subparagraph 20A.16(3)(b) of the Trade Marks Regulations, because the amendment in Item 41 makes it unnecessary for expenses and allowances to be determined by the Tribunal.

Consequently, **Item 43** would delete the reference in subparagraph 20A.16(4)(b) to subparagraph 20A.16(3)(b), and would substitute a reference to amended subparagraph 20A.16(3)(a)(iii).

Item 44 would amend paragraph 20A.16(5)(a) to insert a reference to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 45 would repeal the heading “Protection of person constituting Disciplinary Tribunal, witnesses, etc” at regulation 20A.17 of the Trade Marks Regulations and replace it with the new heading “Protection of certain persons”.

Item 46 would repeal the existing immunity provision in subregulation 20A.17(1) and replace it with an equivalent provision which refers to members of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than to the former Disciplinary Tribunal.

Item 47 would amend subregulations 20A.17(3) and 20A.17(4) to insert a reference to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 48 would repeal the heading “Decision of Disciplinary Tribunal” at regulation 20A.18 of the Trade Marks Regulations and replace it with “Decision of Panel of Disciplinary Tribunal”.

Item 49-51 would amend regulation 20A.18 of the Trade Marks Regulations so that it correctly refers to decisions made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 52 would repeal paragraphs 20A.18(3)(d) and (e) of the Trade Marks Regulations and substitute new subregulations 20A.18(3)(d) and (e) which would allow a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against an incorporated attorney or its employees or officers in any other proceedings before a relevant disciplinary tribunal.

Item 53 would insert a new paragraph (4) into regulation 20A.18 of the Trade Marks Regulations to define the term “relevant disciplinary tribunal”. This term is defined to mean the Patents and Trade Marks Attorneys Tribunal established by regulation 20.61, as in force prior to the commencement of this regulation, or any transitional proceedings before that tribunal. The definition also includes the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 as in force on commencement of this regulation.

Item 54 would repeal the heading “Notification and publication of decisions of Disciplinary Tribunal” at regulation 20A.19 of the Trade Marks Regulations and substitutes the heading “Notification and publication of decisions of Panel of Disciplinary Tribunal.”

Item 55 would amend subregulation 20A.19(1) of the Trade Marks Regulations so that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal, which will make the decision, notify the incorporated trade marks attorney, and publish the decision.

Item 56-64 would amend regulations 20A.19 and 20A.20 of the Trade Marks Regulations to replace various references to the former Disciplinary Tribunal with references to the Panel, or Panel Chair, of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, as required.

Item 65 would insert new regulation 21.7A after regulation 21.7 of the Trade Marks Regulations. Proposed regulation 21.7A provides that service by post is a prescribed means by which a document may be served on, or given or sent to, a person for the purpose of paragraphs 215(6)(a) and (b) of the Trade Marks Act.

Item 66 would repeal paragraph 21.35(2)(bb) of the Trade Marks Regulations and substitute a new provision, so that it is clear that a decision made by the Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal under regulation 20A.18 is reviewable by the Administrative Appeals Tribunal.

Items 67 and 68 would amend paragraph 21.35(2)(c) of the Trade Marks Regulations to insert references to a Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal.

Transitional arrangements for attorney registration and disciplinary proceedings

Item 69 would insert a new Division 3 at the end of Part 22 of the Trade Marks Regulations, which will govern transitional arrangements for Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* and Schedule 2 of the Intellectual Property Legislation Amendment (Single Economic Market) Regulation 2016.

New regulation 22.12 would define terms used in Division 3 of Part 22 of the Trade Marks Regulations.

“Commencement day” means the day on which Schedule 4 to the Amendment Act commences.

The term “old Patents regulations” means the Patent Regulations 1991 as in force immediately before the commencement day.

The term “old regulations” means these Regulations as in force immediately before the commencement day.

New regulation 22.13 would be made for Item 84 of Schedule 4 of the Amendment Act. The new regulation would allow a registered patent attorney, who is not currently registered as an attorney under the Trade Marks Act, to apply for registration as a trade marks attorney within twelve months of the commencement of Item 84 of Schedule 4 to the Amendment Act.

The new regulation would set out the criteria that an applicant for registration under the transitional arrangements must meet. Transitional applicants will not need to meet the usual academic and knowledge requirements for registration, but will instead need to provide a statement of experience, which demonstrates the requirements set out in paragraph 22.13(3). The statement will need to satisfy the Designated Manager that the applicant's level of competency in trade marks law and practice is sufficient to warrant the applicant becoming a registered trade marks attorney.

The applicant will also need to provide a declaration that the applicant has not been convicted of an offence against the Trade Marks Act, Designs Act, or Patents Act, in the previous five years prior to making the application, or is not currently under a sentence of imprisonment in Australia or New Zealand for an offence of dishonesty.

New regulation 22.14 would provide for the continuation of disciplinary proceedings against a registered trade marks attorney which were commenced, but had not been completed, before the commencement day. In these circumstances, the proceedings will continue under the former Disciplinary Tribunal and in accordance with the old Patents regulations.

New regulation 22.15 would make an equivalent provision as in proposed regulation 22.13 for the continuation of disciplinary proceedings against incorporated trade marks attorneys.

Explanatory notes to Schedule 3

Overview

This schedule would amend the Designs Regulations and the Plant Breeders Regulations to give effect to the amendments made by Schedule 4 of the Amendment Act. These amendments would allow an applicant for designs or plant breeders rights to provide an address for service in either Australia or New Zealand. These amendments would also prescribe the means by which a document can be served on a person.

Designs Regulations 2004

Items 1 – 4 would amend regulation 11.19 of the Designs Regulations to allow an address for service to be in Australia or New Zealand.

Item 5 would insert new subregulation 11.19(5) of the Designs Regulations to prescribe service by post as a means by which a document may be served on, or given or sent to, a person for the purposes of subsection 145(1) of the *Designs Act 2004*.

Plant Breeders Regulations 1994

Item 6 would insert new subregulation 3DA(1) of the Plant Breeders Rights Regulations, to prescribe service by post as a means by which a document may be served on, or given or sent to, a person for the purposes of section 73 of the *Plant Breeders Rights Act 1994*.

