

Trans-Tasman IP Attorneys Board 14 & 15 November 2024

The Trans-Tasman IP Attorneys Board met on 14 and 15 November 2024 in Sydney, Australia.

The Board welcomed its second New Zealand member, Dr Duncan de Geest. Dr de Geest's deep knowledge and informed perspective on New Zealand IP practice are a valuable addition to the Board, and I am very pleased to be working with him.

Strategic matters

Competencies Review

The Board's Competencies Review – a review of the competencies required for IP attorneys to effectively serve the users of the IP system – is well underway.

In October 2024, IP Australia on behalf of the Board surveyed members of the professions for their views on the current IP attorney competencies. Your engagement was demonstrated by the excellent 20% participation rate. In the survey the Board sought your feedback on the effectiveness of the current competency framework, including on the Board's Curriculum of Studies, the accredited courses, and the Continuing Professional Education (CPE) requirements.

At the end of the first day of its meeting, the Board held a hybrid *Connect, Network, Learn* event for attorneys and stakeholders of the profession to discuss the results of the survey. A panel of the Board's Accreditation and Competencies Sub-Committee members – Ms Michelle Goldsmith as the Convenor, Ms Lynell Tuffery Huria and Dr Belinda Hartmann – facilitated the discussion.

The survey showed a substantial majority of attorneys consider that: (i) the Board's current Curriculum of Studies is fit for purpose, no topics should be removed from it, but some topics should be added to it; (ii) the currently accredited courses have content of good quality, have tutors with sufficient expertise, but have some deficiencies; and (iii) the current CPE requirements are sufficient, but could be improved by requiring more hours and by the provision of more Board-facilitated activities.

I thank those who attended the event, as well as Ms Veg Tran and King & Wood Mallesons for hosting it. To those who missed the event, you can watch the recording [here](#).

I am pleased to announce that [SPP](#) was the selected consultant to assist the Board in the next stage of the Competencies Review. Consultation with the professions and other key stakeholders of the IP

system is a crucial component of the review. SPP has already obtained extensive feedback from some of you, and this feedback will shape the Final Report on the Competencies Review. I sincerely thank those who participated, and remind you that your time can be claimed as CPE.

If you have new or additional feedback to provide on IP attorney competencies, please write to the [Board Secretary](#).

Session with the New South Wales Law Society

The Board welcomed the NSW Law Society ('NSWLS') Ethics Committee Chair Mr David Miller and the NSWLS Senior Ethics Solicitor Mr Paul Monaghan to speak about the NSWLS ethics and professional conduct procedures.

The key insights from the session were the NSWLS Ethics Committee's active role in offering non-binding guidance to solicitors unsure of their ethical obligations, and its extensive education program tailored to junior, middle and senior levels within the legal profession.

Equally noteworthy was the NSWLS Professional Conduct Committee's structural separation from the Ethics Committee and the manner in which the Professional Conduct Committee manages the investigation and decision-making on complaints about the professional conduct of solicitors.

The session was highly informative and will assist the Board with its discipline role.

Operational matters

Academic qualifications

One of the roles of the Board is to assess whether an applicant for registration as a Trans-Tasman patent attorney has an academic qualification in a field of science or technology that contains potentially patentable subject matter, at a depth sufficient to provide an appropriate foundation for practise as a patent attorney.

At its recent meeting, the Board considered and approved 6 academic qualifications required to become a patent attorney. The qualifications were:

- Bachelor of Biomedical Science, and Masters of Drug Discovery and Development
- Bachelor of Applied Science with Honours
- Bachelor of Engineering with Honours in Mechatronics, and Doctor of Philosophy
- Bachelor of Engineering, and Doctor of Philosophy (Engineering)
- Bachelor of Engineering with Honours (Mechanical)
- Bachelor of Technology (Chemical), and Master of Environmental Engineering

The Board noted the high standard of these qualifications and believes this is an indication of the good quality of prospective entrants to the Trans-Tasman patent attorney profession.

Course accreditation

The Board approved applications for accreditation from the University of Auckland, New Zealand, for the following courses:

- LAWCOMM 785 Patent Practice (Topic Group F – Patent System)
- LAWCOMM 463 Trade Marks and Related Rights (Topic Group C – Trade Mark Law)
- LAWCOMM 433 Copyright and Designs (Topic Group I – Designs Law and Practice)



The courses have been accredited for 5 years, commencing 15 November 2024.

This is a positive outcome, especially for New Zealand-resident candidates for attorney registration. With the accreditation of LAWCOMM 785 Patent Practice, New Zealand candidates can now enjoy local access to accredited courses in all of the Board's Knowledge Requirement Topic Groups.

Professional conduct

The Board is responsible for investigating attorney conduct matters and determining whether there is a reasonable likelihood that such conduct would be found to be unsatisfactory professional conduct or professional misconduct by the Disciplinary Tribunal.

One of the conduct matters before the Board involves an attorney 'white labelling' work provided to their client – that is, purporting that the work was undertaken by them when in fact it was undertaken by a third-party attorney, unbeknownst to the client.

It is crucial for attorneys to disclose to their client all materially relevant information about the work being performed, including who is performing it. If you intend to contract out work to a third-party attorney, this must be specified in your engagement letter and communicated to the client.

[The Board's Guidelines to the Code of Conduct](#) discuss the importance of sufficient disclosure. Specifically, at paragraph 17.4 the Guidelines state that:

A client should know the identity of the person who has undertaken attorney work for them. Unless informed otherwise, a client is likely to assume that attorney work was undertaken by the registered attorney that the client instructed, or by a member of that attorney's firm. Thus, the Code section 17 duty of disclosure includes a duty to identify any person by whom attorney work was undertaken for the client, where that person is not the registered attorney or a member of the registered attorney's firm.

Next Board Meeting

The Board's next meeting is in Wellington, New Zealand, on Thursday 10 April 2025 and Friday 11 April 2025. We will hold a hybrid *Connect, Network, Learn* event for attorneys in the evening of Thursday 10 April 2025.

Further details of the event will be sent to attorneys via email and published on the Board's [LinkedIn](#) profile. Free tickets for in-person attendees will be available through EventBrite, and those unable to attend will be able to register for the online event. I hope to see you there.

Andrew Christie

Chair

Trans-Tasman IP Attorneys Board