



Australian Government



New Zealand Government  
Te Kāwanatanga o Aotearoa

Trans-Tasman IP Attorneys Board

# Trans-Tasman IP Attorneys Board

## Post-Meeting Communiqué

### 29 March 2023

The Trans-Tasman IP Attorneys Board met on 29 March in Wellington, New Zealand. This was the Board's first opportunity in several years for a Meet & Greet event in New Zealand. There was a great turnout, and lively engagement from the attendees. I spoke on the Board's role in the IP ecosystem and, together with fellow Board members, responded to a wide range of questions – including on accredited courses, the educational requirements for attorneys, the granting of exemptions, supporting a trainee patent attorney, and the potential for regulation changes. The Board also hear helpful comments on the realities of practice in the New Zealand attorney marketplace. Many thanks to Dr Duncan de Geest and AJ Park for hosting the event.

In addition to the standard business of candidate applications and professional conduct matters, the Board considered questions about the potential impact of AI programs on assessment tasks within accredited courses, and possible enhancements to the CPE guidelines. Chris Barnaby of IPONZ provided the Board with an update on the Māori PVR Committee and recently enacted legislation in New Zealand, while Matt MacLeay and Edwina Lewis spoke about IP Australia's Indigenous Knowledge Workplan 2022-2023.

## Professional conduct

During this meeting five conduct matters were progressed, and several matters were concluded. Pleasingly, no new complaints were received in the period since the Board's previous meeting.

The cases currently before the Board raise a range of Code of Conduct obligations, including **competency, diligence, communication,** and **due skill and care**. Below are details of some of those cases.



A patent matter, where it is alleged the attorney provided advice lacking in due skill and care, did not hold appropriate qualifications for the particular work undertaken, and acted without seeking or receiving instructions. The client claimed that steps to progress a patent application were not explained fully, and that specific instructions to file a provisional patent application were neither sought nor given. The attorney claimed that verbal instructions were received but could not provide evidence of this. While the Board considered there was a reasonable likelihood of the attorney being found guilty by the Tribunal of unsatisfactory professional conduct, it exercised its discretion to not refer this matter to the Tribunal. Of relevance was that some of the client's assertions were contradictory and/or not supported by evidence, that the client continued to use the attorney after the actions complained of, and that the client's IP protection did not appear to have been jeopardised by the attorney's actions. The Board has reminded the attorney of the importance of seeking and receiving instructions in writing and will issue a Practice Note to the profession on the topic of record keeping.



A patent matter, where it is alleged the attorney did not act with due skill and care when they relied solely upon the client's statement about its standing to seek a s36 declaration, which was later found to be erroneous. This led to incorrect advice being provided, and incorrect actions being taken. The Board considers it to be essential that an attorney independently ascertain a client's standing in such a matter before advising on and undertaking action. In this case there was evidence that the attorney took appropriate and timely steps to remedy the error once it was discovered. This prompt action to ensure the client was not negatively impacted was a factor in the Board exercising its discretion to not refer the matter to the Tribunal.



A trade mark matter, where a client was not forwarded an adverse report until several months after it was issued. It is vital that attorneys act promptly when communicating with clients, and be mindful of the potential for adverse impact on the client of any delay in doing so. It may not be sufficient simply to act in accordance with timeframes specified in the relevant legislation. The Board considered there was a reasonable likelihood of the attorney being found guilty of unsatisfactory professional conduct. However, taking into account the relevant factors, including the limited detriment to the client, the Board concluded it was not in the public interest to commence proceedings in the Tribunal.



## Communication and outreach activities

For those who use LinkedIn, the [Board](#) and [Secretariat](#) profiles are a great source of information about the Board's activities, relevant forms and upcoming events.

At the recent IPTA conference in Hobart, Veg Tran, convenor of the Discipline sub-committee, presented a session on complaints and conduct matters before the Board. Her presentation covered feedback from the Code of Conduct Health Check, statistics of complaints and disciplinary matters considered by the Board and referred to the Tribunal, and what attorneys can do to mitigate a complaint being filed. The presentation can be accessed [here](#) on the Board's website.



Veg's presentation also referred to forthcoming enhancements to the [Guidelines to the Code of Conduct](#), which are now published. I will present a webinar on them, jointly hosted by the Board, IPTA and NZIPA, on Tuesday 27 June – details of which are [here](#).

The Board's next meeting will be in Brisbane on Wednesday 2 August – the first time the Board has met in Queensland since 2018. We will hold a Meet & Greet the day before, on Tuesday 1 August, at the offices of FB Rice in Brisbane. Please [register](#) for this free event. The Board is looking forward to meeting and hearing from members of the Brisbane-based profession.

Andrew Christie

Chair