

COMMONWEALTH OF AUSTRALIA

**Patents Act 1990
Patents Regulations 1991, Chapter 20**

TRANS-TASMAN IP ATTORNEYS BOARD and MASSANG

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Introduction

1. Mr Jaime Massang, registered patent attorney, is a principal of **Aspides** Patent and Trademark Attorneys in Brisbane, Queensland. As a registered patent attorney, he is required to comply with the *Code of Conduct for Trans-Tasman Patent and Trade Mark Attorneys 2018*.
2. Mr Massang has been charged by the Trans-Tasman IP Attorneys Board with nine charges of unsatisfactory professional conduct, being breaches of the Code arising from Aspides' engagement by **The FIRM** International Cruise Line Pty Ltd between February and May 2020 pursuant to which Mr Massang prepared two provisional patent applications.
3. The proceedings were commenced by a **Notice** pursuant to sub-regulation 20.35 of the *Patents Regulations* 1991 (Cth) dated 22 December 2021. The Notice identifies three subjects relevant to the charges, namely:

The **Idea** being “*a system of individual ownership in a hybrid ocean cruiser residential retirement facility.*”

The **First Specification** entitled “*Permanent retirement and cruising facility.*”

The **Second Specification** entitled “*System of individual ownership in a hybrid ocean cruiser residential retirement facility.*”

4. The Idea was presented to Mr Massang by Mr John Ibbitson, a director of The FIRM, at a meeting on 19 February 2020. It is a concept for a cruise ship to operate as a retirement and cruising facility in which clients purchase title to individual cabins. The First Specification and the Second Specification were intended to protect the Idea and were drafted by Mr Massang during March and April 2020. Broadly, the First Specification describes structural aspects of the retirement and cruising facility and was sometimes referred to in the proceedings as the “Ship” specification. The Second Specification describes the system of individual ownership in that facility and was sometimes referred to in the proceedings as the “Method” specification.
5. The charges in the Notice can be summarised as follows:

Charges 1 to 3 – Unsatisfactory Professional Conduct – Breach of paragraph 17 of the Code by failing to adequately and properly disclose to The FIRM information that was materially relevant to the work undertaken, namely the

difficulties or risks associated with the grant of patents in relation to the Idea and the alleged inventions the subject of the First Specification and the Second Specification.

Charges 4 to 6 – Unsatisfactory Professional Conduct – Breach of paragraph 14 of the Code by failing to act to the requisite standard of competence and due skill and care of a registered patent attorney carrying out the work he was engaged to undertake, by not advising, or not adequately and properly advising, The FIRM in relation to the difficulties or risks associated with the grant of patents in relation to the Idea and the alleged inventions the subject of the First Specification and the Second Specification

Charges 7 to 9 – Unsatisfactory Professional Conduct – Breach of subparagraph 13(2) of the Code by failing to maintain requisite standards of professional practice as a registered patent attorney, by not documenting his advice.

6. Mr Massang filed his Response on 16 March 2022 and, by consent, an Amended Response on 30 March 2022 and a Further Amended Response on 16 September 2022. Mr Massang denies all of the charges.
7. The Board’s evidence in chief comprised statutory declarations from the directors of The FIRM, Mr Ibbitson and Mr Paul McCafferty, and three expert reports by retired patent attorney, Mr Jack Redfern. Mr Massang’s evidence in chief comprised his statutory declaration and an expert report by Mr Matthew Sulman, patent attorney. All witnesses were cross-examined.
8. Additional evidence comprising subpoenaed documents produced by The FIRM, Mr Ibbitson and Piper Alderman, Lawyers (solicitors for The FIRM) was also received.
9. On 17 August 2022, the Tribunal directed that the issues of liability and penalty be heard separately.¹
10. At the hearing on 27 to 29 September 2022 and 14 October 2022, Mr Stephen Rebikoff of Counsel instructed by Mills Oakley appeared for the Board and Dr Dmitri Eliades of Counsel instructed by James Varitimos Solicitor appeared for Mr Massang.

¹ See *Pham v Legal Service Commissioner* [2016] VSCA 256 at [166] – [167]; *Forge v Australian Security and Investments Commission* [2004] NSWCA 448 at [425] – [427].

11. This was the first matter heard by the Trans-Tasman IP Attorneys Disciplinary **Tribunal** constituted as a Panel pursuant to regulation 20.36 of the Regulations.

Legislative framework and standard of proof

12. Section 228 of the *Patents Act* 1990 (Cth) provides for the making of regulations including, at sub-section 228(2)(r), the power to make regulations:

228 Regulations

- (1) The Governor-General may make regulations, not inconsistent with this Act:

....

- (2) Without limiting subsection (1), that subsection includes the power to make regulations:

....

- (r) for the control of the professional conduct of registered patent attorneys and the practice of the profession and, for that purpose, making provision for and in relation to all or any of the following:
 - (i) making complaints, and hearing charges, against registered patent attorneys about their professional conduct;
 - (ia) assessing the professional conduct of registered patent attorneys by reference to standards of practice established by the Board from time to time;
 - (ii) imposing penalties on registered patent attorneys, including issuing a reprimand and suspending or cancelling registration;
 - (iii) summoning witnesses;
 - (iv) requiring persons to give evidence on oath (whether orally or otherwise);
 - (v) administering oaths to persons giving evidence (whether orally or otherwise);
 - (vi) requiring persons to produce documents or articles;

13. Regulations of this nature are found in the Regulations at Chapter 20, *Part 8 – Discipline*. Regulation 20.33 sets out the role of the Board in disciplinary proceedings. Relevantly, the Board has the sole responsibility for commencing and conducting disciplinary proceedings against an attorney. Its role includes investigating, either as a result of information received or of its own motion, whether a registered attorney has engaged in professional misconduct or unsatisfactory professional conduct. The Board *may* commence proceedings before the Tribunal if it is satisfied there is a reasonable likelihood of an attorney being found guilty of unsatisfactory professional conduct. In deciding whether or not an attorney has engaged in unsatisfactory professional conduct, the Board must consider whether or not the attorney has complied with the Code.

14. “unsatisfactory professional” conduct is defined in Regulation 20.32²:

unsatisfactory professional conduct includes conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney.

15. The standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney is to be objectively ascertained by the Tribunal aided by evidence from independent experienced patent attorneys as to the standards observed by the profession and by reference to the Code and other rules of practice.³

16. As noted by the Tribunal in *Re Blenkinship*⁴:

A person who is registered as a patent attorney under the Regulations is no different to a legal practitioner or other regulated professional in that high standards of competence and diligence are expected of such persons when dealing with clients, other registered practitioners and the relevant patent authorities: see Law Society of New South Wales v Foreman (1994) 34 NSWLR 408 at 412 per Kirby P. The reasons for this is so that members of the public, clients, other registered practitioners and the relevant authorities can have confidence in 'the integrity of those who enjoy special privileges' as a registered practitioner.

17. The question of whether the attorney’s impugned conduct fell short of the requisite standards is to be judged by the civil standard on the balance of probabilities.

Summary of Decision

18. Charges 1, 3, 4 and 7 are dismissed.
19. Charges 2, 5, 6, 8 and 9 are proven. Mr Massang is guilty of unsatisfactory professional conduct, in that he:
- (a) failed to adequately and properly disclose to The FIRM information that was materially relevant to the work undertaken, namely the difficulties or risks

² The more serious charge of *professional misconduct* is also defined at Regulation 20.32. The Board *must* commence proceedings before the Tribunal if it is satisfied there is a reasonable likelihood of an attorney being found guilty of professional misconduct: sub-reg. 20.33(4).

³ *Re Nuttall and Kelly* (unreported, Patents and Trade Mark Attorneys Disciplinary Tribunal, 28 February 1997) at [60]; *Re Blenkinship* (unreported, Patents and Trade Marks Attorneys Disciplinary Tribunal, 9 October 2008) at [106]-[107]; *Re Gahan and Professional Standards Board for Patent and Trade Marks Attorneys* [1998] AATA 474 at [80]-[83].

⁴ *Re Blenkinship* at [109]

associated with the grant of patents in relation to the alleged invention the subject of the First Specification (Charge 2);

- (b) failed to act to the requisite standard of competence and due skill and care of a registered patent attorney carrying out the work he was engaged to undertake, by not advising, or not adequately and properly advising, The FIRM in relation to the difficulties or risks associated with the grant of patents in relation to the alleged inventions the subject of the First Specification and the Second Specification (Charges 5 and 6);
- (c) failed to maintain requisite standards of professional practice as a registered patent attorney, by not documenting his advice (Charges 8 and 9).

The Facts

Instructions, advice and the preparation of the provisional patent applications

- 20. The material facts are as follows. Where facts were disputed, we have explained our findings.
- 21. On or around 17 February 2020, Mr Ibbitson received an invitation to connect with Mr Massang via LinkedIn. Mr Ibbitson stated in his declaration that he thought this was a “*fortunate coincidence*” since from late 2019 he and Mr McCafferty had been working on a structure for how the Idea could be achieved and were also engaged in discussions with Norwegian Cruise Line (NCL) to purchase cruise ships for carrying out the Idea. They had concluded that they needed to investigate what could be done to protect the intellectual property associated with the Idea. Mr Ibbitson sent a private message to Mr Massang that The FIRM was looking for an IP lawyer.
- 22. On 18 February 2020, Mr Ibbitson and Mr Massang communicated by telephone and text message. During the telephone call, they discussed the Idea and the possibility of filing a provisional patent application and related trade mark applications. A meeting was arranged for the following day. Mr Massang has produced a contemporaneous diary note which includes the entry:

“.....Suggest

1. *TM's – The F.I.R.M. (43)??*
2. *Prov to floating retirement village.*”

23. A follow-up text message from Mr Ibbitson contained a link to The FIRM's website and ended with, "*Thank you and look forward to see what we can preserve*".
24. Mr Massang says that the link went to a business plan. He reviewed the business plan prior to the meeting and noted that it was dated 28 September 2019. He noted that the business plan referred to previous communications and a meeting with Norwegian Cruise Lines (NCL) and to a preliminary test launch **Email Blast** in January 2019 with 120 enquiries. It does not appear that Mr Massang was provided with a copy of the Email Blast that was sent to The FIRM's newsletter recipients database, and nor does it appear that Mr Massang asked to be provided with a copy of it.
25. Mr Massang points to the business plan as a driving factor of his view that it was imperative to file provisional patent applications urgently to protect the Idea before another organisation copied it. He says he conveyed this to Mr Ibbitson and Mr McCafferty at the meeting the following day. In a follow up email to Mr Ibbitson on the afternoon of the meeting, he advised, "*Please withdraw any prior disclosure of the idea **asap** to avoid the potential allegation of self publication as this can negate your right to a valid patent.*"
26. Mr Ibbitson disputes that a business plan was shared by the text message on 18 February 2020. He says that it is not his practice to share confidential business documents with someone prior to first meeting them and also points out that the link in the text message goes to a page containing general information for members of The FIRM's "Travel Club". He says that he first sent the business plan to Mr Massang by email on 27 February 2020. That email and its attachment, being a document entitled *Business Plan Executive Summary FLAGSHIP First Residential Cruise Ship for over 60's* (the **Business Plan**), are in evidence.
27. We find that the Business Plan was not received by Mr Massang until 27 February 2020. None of the texts or emails exchanged prior to 27 February 2020 mention a business plan. Nonetheless, it was likely that some, if not all, of the points of concern to Mr Massang outlined above were made known to him at the meeting on 19 February 2020. All parties agree that the Idea was explained to Mr Massang at the meeting and that they discussed that The FIRM was in negotiations with NCL (although the content of those negotiations is disputed, as discussed below). The Business Plan may even have been referred to, but Mr Massang did not obtain a copy of it until 27 February 2020.

28. It is common ground that, at the meeting on 19 February 2020, Mr Massang advised that two patents would be needed to protect the Idea. However, the witnesses' versions of what other advice was given at that meeting and subsequently is greatly at odds.
29. Mr Massang's evidence was that he advised Mr Ibbitson and Mr McCafferty that they should request Patent Cooperation Treaty (PCT) Article 15(5) international-type searches after the provisional applications were lodged to identify any relevant prior art (his contemporaneous diary note records "Art 15/5 search").
30. In his declaration, Mr Massang recollected initially thinking that aspects of the Idea might involve a computer-implemented method and mentioning to Mr Ibbitson and Mr McCafferty that *'business system patents need a technical solution; either a change to a computer itself or how the computer works'*; however, upon hearing their further explanation, he *"concluded that the inventions were not dependent on any innovative use of computer technology"*. He recollected cautioning the *"possibility that a computer implemented business method or any other patent application could ultimately be rejected as the granting of a patent is only after examination and they were only at the beginning stage of lodging provisional applications."* As noted below at paragraphs 113 to 114, Mr Massang's position on whether the Idea did or did not involve a computer-implemented method shifted during the course of the initial investigations and the proceedings.
31. Mr Massang also declared in his evidence in chief that, consistent with his own concerns, Mr Ibbitson told him there was an urgency to file the provisional applications before meeting with NLC.
32. He declared that neither Mr Ibbitson nor Mr McCafferty asked him to give advice on prospects of the final applications being approved. Further:

"I did not say anything about whether their applications would proceed to grant as there are other factors which might deny the ultimate grant. Nor would I have made such a comment without any documentary evidence, such as the Article 15/5 searches and further documentary evidence about the inventions. I was initially trained to and have throughout my career never unilaterally express an opinion as to whether an application would proceed to grant even if asked, because one can never know how the application will be considered."

33. Mr Ibbitson's evidence was that "*Mr Massang was confident and convincing during the meeting and did not raise any concerns about the potential patentability of our idea*". Mr Ibbitson had no recollection of discussing Article 15(5) searches. He did not believe that Mr Massang ever specifically mentioned computer implemented business methods. He said that Mr Massang may have said something general like '*any patent can be rejected*'.
34. Mr Ibbitson also rejected that there was urgency arising from the negotiations with NCL. He said, on the contrary, that the negotiations were in relation to the purchase of cruise ships. From his perspective there was minimal risk because The FIRM only approached NCL as a prospective vendor. In any event, the meeting with NCL was not scheduled until July.
35. He disputed that Mr Massang was not asked to give advice on prospects. Mr McCafferty had previously expressed concern that the Idea was not particularly novel and might not be able to be patented, so the purpose of the meeting with Mr Massang was to see whether the Idea could be protected. (The FIRM's board minutes of 18 February 2020 record a resolution, "*That advice be taken from a patent attorney relating to the protection of the company's intellectual property*").
36. Mr Massang sent a follow up email on the afternoon of 19 February 2020, with cost estimates and a request for the information and materials he would need to draft a provisional patent, being:

*"SUMMARY OF THE INVENTION in your own words
DETAILED DESCRIPTION in your own words
DRAWINGS or FLOW DIAGRAM (for the floating unit trust/title provisional)"*

37. Again, he cautioned, "*Please withdraw any prior disclosure of the idea ASAP to avoid the potential allegation of self publication as this can negate your right to a valid patent.*"
38. The next communication in evidence is a text message from Mr Ibbitson on 27 February 2020, inviting Mr Massang to meet with The FIRM's board to clarify and explain the trade mark classes. Mr Massang's text reply referred to the patents as being "*more critical*" than the trade mark applications and again cautioned against disclosure without first filing a patent application. Later that afternoon, Mr Ibbitson emailed the Business Plan to Mr Massang.

39. The meeting took place on 5 March 2020, attended by Mr Massang, Mr Ibbitson, Mr McCafferty and a third director, Ms Anne Glenister. Again, recollections differ as to what patent advice was given.
40. Mr Massang's evidence was that he repeated much of the advice that he had provided on 19 February 2020 for the benefit of Ms Glenister. He also raised concerns that the Business Plan contained a statement about The FIRM disclosing the Idea to NCL and he recommended appending the provisional specification to any non-disclosure agreements.
41. He recalled discussing the PCT application system and says that "*I may have also mentioned, I cannot specifically recall, the concept of "fair basis"*". He explained that "*provisional patents are not published or examined, and that only the final or 'complete' patent applications are examined for registration.*" He handed over cost estimate letters for preparing and drafting the two provisional patent applications and for searching, preparing and lodging the trade mark application.
42. Mr Massang has produced a diary note which includes the entry:
- "Ibbitson Board Meeting 5/3/20*
- *Provisional, Art. 15/5-PCT*
 - *Nat phase. Further costs*
 - *NCL meeting*
 - *Confid. agreement/prov.*
43. Mr Ibbitson disputed most of Mr Massang's recollection of the meeting on 5 March 2020. He declared that he "*cannot recall Mr Massang ever raising a concern that we had already disclosed the Idea to NCL.*" Nor does he recall Mr Massang ever discussing a non-disclosure agreement.
44. He disputed that Mr Massang had explained the difference between provisional patent applications and final patent applications or the examination process for final applications. He declared that "*From our perspective, the applications he had proposed were the applications that would eventually become the patents that protected the Idea. That was the basis on which we proceeded to engage him to prepare the applications.*"
45. The FIRM's minutes of the meeting, signed by the three directors on 08 March 2020, relevantly state:

- *Jaime Massang, Patent and Trade Mark Attorney, joined the meeting at 1.00pm and addressed the meeting on the importance of trade mark and patent protection for the ship's commercial activities. A discussion was had between Jaime and the directors. Jaime explained that the following steps were involved in the patent process:-*

Step 1

- *Lodgement of the provisional Patent Application with the Patents Office in Australia;*
- *The Provisional Patent Application is then automatically recognised by all member nations of the Patent Co-Operation Treaty (PCT).*
- *This gives us 12 months protection from competitors. Cost - AU\$8,772.50.*

Step 2

- *Within 12 months we must lodge the Provisional Patent Application with the PCT — Cost AU\$15,500.00.*

Step 3

- *Within a further 18 months we must lodge the Patent Application with all of the countries of interest. Cost unknown depending on the number of countries we select.*

When questioned on the prospect of the patent applications in their present state being registered by the Patents Office, Jaime stated that in his opinion he was confident that the patent applications would be registered in their present form. But if not, then any variations would be of a minor nature.

It was resolved that:-

- *The company pay to ASPIDES AUD \$9,069.00 for registration of the ship's trade mark.*
- *The company pay to ASPIDES AUD \$8,772.50 for a provisional patent application entitled "Floating or Seagoing Over 50's Retirement Village".⁵*

46. This iteration of the patent process, in particular the additional steps from provisional patent applications to PCT patent applications, contradicts Mr Ibbitson's recollection and corroborates Mr Massang's. The questioning on the prospect of the patent applications being registered in their "present form" shows that the directors did ask about prospects and were confused about the process. The terminology "present form" is odd since no

⁵ Copies of Aspides' cost estimate letters are in evidence. They refer to:

"Preparing and drafting a provisional patent application entitled A SYSTEM TO PROVIDE TITLE TO A FLOATING OR SEA GOING RETIREMENT VILLAGE"; and
"Preparing and drafting a provisional patent application entitled A FLOATING OR SEA GOING RETIREMENT VILLAGE."

drafting had been done at that stage; however, Mr McCafferty the author of the minute was not cross-examined on what was meant by it.

47. Text messages exchanged between Mr Ibbitson and Mr Massang after the meeting on 6 and 7 March 2020 relevantly state:

“I am in the process to meet with NCL [sic] to cut a deal so I want to make sure I can speak openly with them without fear of repercussions [sic]”: Ibbitson 06 03 2020: 6.57pm

“As advised we need to lodge the provisionals first otherwise you disqualify your ability to apply for the patents”: Massang 07 03 2020: 7.05am

48. Mr Massang sent an email to Mr Ibbitson on 12 March 2020 pressing the urgency of filing provisional applications, to which Mr Ibbitson replied, “... *I am fully aware of what you are saying so you have opened the file now haven't you? If not why not as it has been approved! Speak to Paul for clarification!*”.
49. On 18 March 2020, Mr Massang called and emailed Mr McCafferty for the still outstanding information that he needed for the drafting. Mr McCafferty emailed him a different business plan. Mr Massang declared that he did not rely on this business plan as it was mostly financial information and was not relevant to the patent specifications.
50. There was a third meeting on 23 March 2020 between Mr Massang, Mr Ibbitson and Mr McCafferty. At this meeting, the detail of the mechanical systems for modifying the ships and some on-board medical services was discussed. Again, recollections differ as to the content of those discussions. Mr Massang's evidence was that Mr Ibbitson described separate water, sewage and air-conditioning systems to protect and quarantine against the spread of COVID or contagions. Mr Ibbitson countered that it was never part of the original idea that there would be something special about the mechanical systems on board the ship. It was simply envisaged that the ship would be equipped to provide care equivalent to a low to medium care retirement facility. He declared that “*It was only in the course of discussions with Mr Massang that an emphasis arose on the systems of water, sewerage and ventilation to be used in the ship.*”
51. On 26 March 2020, Mr Massang sent an email stating that, “*Based on Monday's discussions, I have tweaked the inventive steps in both patent drafts to include your input.*” He also asked for funds to be deposited. He had been requesting funds since at least 12 March 2020. The FIRM transferred funds that day amounting to 50% of the

multiclass trade mark application and 50% of one provisional patent application, with the balance to be paid on completion. Mr Massang requested a further amount to cover 50% of the second provisional patent application. Mr Ibbitson replied that there were sufficient funds to start the applications and the rest would be sorted out later, which Mr Massang appears to have acquiesced to.

52. On 30 March 2020, Mr Massang sent two draft provisional patent applications to Mr Ibbitson and Mr McCafferty for input and comment; the First (Ship) Specification then entitled “*A Cruising Retirement Facility*” and the Second (Method) Specification then entitled “*A Maritime and Real Property Hybrid Title of Ownership for An Ocean Cruising Retirement Facility*”. Over the next few weeks, the three men communicated amendments and refinements to the draft applications, by email, text and telephone, including adding drawings and flowcharts.
53. Critically for the Board’s case, on 2 April 2020, following discussions with Mr Ibbitson, Mr Massang sent a revised draft of the First Specification with what he believed to be the inventive step (being the physical systems used to isolate air and water supply to individual cabins) highlighted in Claim 1 and a request that, “*If you agree that this is what the inventive difference is over existing cruise ships, I will need you to describe in moderate detail how this is achieved.*” That description was never provided by Mr Ibbitson or Mr McCafferty and the alleged inventive step remained as articulated in the 2 April 2020 draft, including in a version sent on 10 April 2020 and in the final version sent on 01 May 2020. In fact, none of the claims in the First Specification were added to or altered after 2 April 2020.
54. On 6 April 2020, Mr McCafferty sent Mr Massang an email all in which he asked: “*Could you please inform us of the steps to be taken in the relevant timeframes leading to final examination and acceptance of patent applications?*” Mr Massang answered that:

“The provisional patent applications provide a 12 month international priority protection with the option of requesting an international search under the PCT system. This period also provides you to [sic] secure investment, basically to raise funds for the PCT applications which extend protection for a further 18 months in most countries to a total of 30/31 months from the provisional filing date”.
55. Both parties sought to make something of the fact that Mr Massang gave only a partial answer which covered-off on provisional patents but did not address final examination

and acceptance. Mr Massang says this reflected his understanding that his retainer was limited to drafting the provisional patent applications. The Board says it demonstrates incompetency.

56. On 21 April 2020, Mr Massang sent Mr Ibbitson and Mr McCafferty an email attaching the Second (Method) Specification and its drawings with a request, *“Please read the specification together with the drawings. If there are no changes, please approve so I can attend to preparing their lodgement”*. It was suggested that the final versions of both specifications were sent under this email. However, it is evident from the subject heading, the description of the attachments, the reference to *‘the specification’* (singular) and the attachments themselves, that this email only concerned the Second (Method) Specification and its drawings. This error continued in the Board’s Closing submissions. However, we find that the final version of the First (Ship) Specification was not sent to The FIRM until 1 May 2020, as described below.
57. On 22 April 2020, George Hatzis, Mr Massang’s business partner, sent an email thanking The FIRM for its business and noting part payment of Aspides’ total invoices.
58. On 30 April 2020, George Hatzis again requested final payment of all invoices. Mr Ibbitson replied, *“Can you please provide full details of everything that you are lodging for the final lodgement as per your statements please as there has been plenty of amendments and I require clarification.”*
59. On 1 May 2020, Mr Massang forwarded final versions of the First and Second Specifications by email with a request, *“ ... Please confirm your understanding that they will be lodged immediately on receipt of the balance of your funds.”* The FIRM did not remit the balance of funds to Aspides and Aspides did not file the provisional patent applications.
60. Instead, on 1 May 2020 Mr Ibbitson forwarded the First and Second Specifications to The FIRM’s commercial lawyers, Piper Alderman with a request that *“your patent lawyer cast his eye over the docs for a second opinion.”*

Second opinions and the complaint

61. The FIRM obtained two second opinions. The first, given via Piper Alderman around 18 May 2020, was from a partner of FB Rice and comprised just a few sentences. The second

was a letter of advice dated 22 May 2020 obtained by The FIRM directly from a patent attorney who requested has anonymity (but whose attorney registration at the relevant time has been confirmed).

62. It is not necessary to recite the second opinions, save to say that both attorneys were of the view that neither of the specifications claimed patentable subject matter. Both attorneys opined that what was described was clearly a business method or scheme and both commented on the difficulties of patenting computer software.
63. On 24 May 2020, Mr McCafferty wrote to Aspides regarding The FIRM's concerns about the patent applications and disclosing both opinions. Mr McCafferty's letter demanded a full refund and foreshadowed the complaint to the Broad if not refunded within five business days.
64. George Hatzis wrote back on 28 May 2020 on behalf of Aspides. In cross examination, Mr Massang agreed that he had had input to the drafting of this letter but said that he had not actually read the letter before it was sent.
65. The letter accused Mr Ibbitson and Mr McCafferty of engaging in a in "*shallow and vexatious attack*", sought their "*unequivocal withdrawal of all such allegations immediately*", suggested that "*that you not proceed with your false and vexatious threatened complaint*", and reserved all legal rights "*as against you and/or your company without further notice*".
66. In relation to the patent applications, the letter stated:

"It is clearly obvious from the draft patent specification approved by you and the drawings you provided that your invention is also a computer implemented business system"

and

"It was clearly emphasised to us that the exercise in lodging the provisionals and during the PCT and national phase is not a means to an end but to use the patent pending period to protect on a commercial basis the upcoming negotiations with the ship supplier/builder and as an ongoing marketing tool to investors. John Ibbitson particularly and forcefully made this point"

67. On 01 June 2020, Mr Ibbitson responded by email:

"If you can demonstrate to The FIRM that the opinions of the two patent attorneys are wrong, and the application for patents prepared by Mr Massang,

will be granted by the Patents Office, then please lodge the applications and we will settle your account. If not then please amend the applications so they will be granted approval.”

68. Around this time, Mr Ibbitson made the complaint to the Board. Mr Massang had also pre-emptively contacted the Board.

The Experts’ opinions

Redfern

69. In discharge of its obligations to investigate under sub-reg 20.33(2) of the Regulations, the Board obtained statements and materials from The FIRM and Aspides, including copies of texts and emails and drafts of the First and Second Specifications.
70. The Board’s solicitors also commissioned expert reports from Mr John Redfern, a registered patent attorney for over 25 years and principal for over 20 years, now retired. Mr Redfern had been involved in Australian decisions on the patentability of schemes, business methods and computer-implemented inventions including *Research Affiliates LLC v Commissioner of Patents* [2014] FCAFC 150 and *Encompass Corporation Pty Ltd v InfoTrack Pty Ltd* [2019] FCAFC 161. The FIRM’s and Aspides’ statements to the Board were included in the brief to Mr Redfern.
71. Mr Redfern wrote three expert reports in the proceedings; comprising his initial Expert Report to the Board dated 23 August 2021, a Supplementary Expert Report dated 21 April 2022 which responded to Mr Massang’s Amended Response, and a Further Expert Report dated 12 August 2022 which responded to Mr Massang’s evidence.
72. It is of concern to the Tribunal that Mr Redfern’s initial brief did not contain a contiguous finalised copy of the First (Ship) Specification. Mr Redfern wrote that for the purposes of his report he had to infer from the multiple versions in the brief as to what constituted the final version intended to be filed with IP Australia. However, the Tribunal is satisfied⁶ that the claims in the First Specification remained unchanged from its first iteration under Mr Massang’s email dated 2 April 2020, through to its final iteration under Mr Hatzis’ email dated 1 May 2020 and that the variations that were made (such as the title) were immaterial. Importantly, the articulation of the claims did not change between 2 April and 1 May 2020. Prior to the hearing, counsel for the Board and counsel for Mr Massang

⁶ See paragraph 53 above.

identified and agreed on which of the documents in evidence constituted the final versions of the First and Second Specifications, and the witnesses were cross-examined on those versions.

73. Mr Redfern's evidence in chief and in cross-examination canvassed the approach he would have expected a competent patent attorney to have taken in the circumstances of this case. He concluded that a competent patent attorney should have:
- (a) been aware of the relevant court-defined exclusions from the concept of manner of manufacture, from a knowledge of the existence and import of the relevant case law applicable in Australia at the time (c. February to May 2020), including at least:
 - *Encompass Corporation Pty Ltd v InfoTrack Pty Ltd* [2019] FCAFC 161
 - *Rokt Pte Ltd v Commissioner of Patents* [2018] FCA 1988 (12 December 2018)⁷
 - *National Research Development Corporation v Commissioner of Patents* [1959] HCA 67
 - *D'Arcy v Myriad Genetics Inc* [2015] HCA 35
 - *CCOM Pty Ltd v Jiejing Pty Ltd* [1994] FCA 396
 - *Commissioner of Patents v RPL Central Pty Ltd* [2015] FCAFC 177
 - *Grant v Commissioner of Patents* [2006] FCAFC 120
 - *Research Affiliates LLC v Commissioner of Patents* [2014] FCAFC 150.
 - (b) been aware of the heightened risk of seeking patent protection for inventions of this type;
 - (c) recognised in relation to the Second Specification, that the alleged inventions defined by the claims were likely a business method or mere scheme and a computer-implemented invention and concluded that there were significant risks associated with their potential patentability;
 - (d) recognised in relation to the First Specification, that the paucity of detail in the claims gave rise to a validity risk under s 40(1) of the Act;
 - (e) understood that it is inherent in the retainer of a registered patent attorney that the attorney will advise in relation to any risks arising from the course of action instructed by the client and accordingly:
 - i. advised the client of the nature of those risks promptly and in writing, in a manner that was tailored and understandable to it, so that the client

⁷ The appeal decision at *Commissioner of Patents v Rokt Pty Ltd* [2020] FCAFC 86 was published on 21 May 2020 and would not reasonably have been taken into account.

could decide whether a patent application was the most suitable option for pursuing its commercial objectives in this case; and

- ii. if the client indicated that it was prepared to accept that risk, confirmed in writing before the specifications were finalised that the client understood and was willing to accept the risks and any consequences that flowed from them.

74. Insofar as Mr Massang failed to act in accordance with the approach outlined above, Mr Redfern concluded that his actions were neither reasonable nor appropriate and did not accord with standards set out in the Code.

Sulman

75. Mr Matthew Sulman is an experienced registered patent attorney and a solicitor. He was briefed with the Notice and Further Particulars, Mr Massang's first Amended Response, the First and Second Specifications and the Board's evidence in support, including Mr Redfern's Initial Report and Supplementary Report.

76. Counsel for the Board criticised parts of Mr Sulman's Report which, based on Mr Sulman's own research, made allegations concerning the veracity of some of The FIRM's public statements and the credentials of its management team. The Board argued that this amounted to advocacy for the Attorney and tainted the Sulman evidence overall. We disagree. Under cross examination Mr Sulman appeared measured and conscious of his obligations as an expert witness. He made appropriate concessions as identified below, and his evidence was of assistance to the Tribunal. The particular matters which prompted the Board's criticism are irrelevant to the matters to be decided by the Tribunal in this case and have not been taken into account.

77. Mr Sulman reported that he agreed in principle with most of the matters raised by Mr Redfern but with some reservations.

78. As to the First Specification, Mr Sulman agreed with Mr Redfern's conclusion that the paucity of detail in the claims threatened the validity of the protection sought. However, Mr Sulman put the responsibility on the client:

" ... The quality of the drafting needs to be considered in light of the quality and extent of technical disclosure provided to Mr Massang by the client by way of instruction. Such technical disclosure was sorely deficient in the instructions provided and Mr Massang, in my view, made the best of what he had available

to him. ... Without sufficient technical disclosure there is no invention. But that is an issue for the client as opposed to the attorney who is only able to act upon instructions.”

79. Mr Sulman agreed that a competent patent attorney would have pursued further instructions and if the instructions were not available or not forthcoming, would have alerted the client in writing to the risk of relying upon minimal technical disclosure. He excused Mr Massang’s failure to do so on the basis that “*Mr Massang was never afforded the opportunity to provide that advice as the Client never provided final instructions to the effect that the specifications were suitable for filing*”. This ignores that Mr Massang advised the client by his emails on 21 April and 1 May 2020 that the specifications were ready for filing, subject only to the payment of Aspides’ fees.
80. Mr Sulman considered that the specifications could have been refined so as to include the necessary technical details over the course of the twelve-month lifespan of a provisional patent and that the client might have chosen to file a revised specification either as a further provisional or as a complete specification. In cross-examination, he conceded that this course would involve additional expense and a potentially the loss of the priority date, and that the client ought to have been warned about that.
81. As to the Second Specification, Mr Sulman was frank in his view that the Second Specification “*is poorly drafted*” characterising the drafting as “*imprecise and perhaps off topic*”, but he did not consider that it fell well short of the standards of a registered patent attorney especially “*when one considers the instructions with which Mr Massang was first forced to work with and the obvious commercial focus of the Client*”. He tentatively advanced a proposition that the alleged invention within was capable of being construed as a manner of manufacture and therefore patentable subject matter because it is based on, and is necessarily dependent upon, the mechanical inventions in the First Specification.
82. In cross examination, Mr Sulman accepted that the claims in the Second Specification were directed to a system and that there was a “*tangible*” and “*material*” risk that, as drafted, they did not disclose patentable subject-matter. He thought that the drafting deficiencies were not fatal and might easily have been remedied by amendment but conceded that the only remedy would be to file a new provisional which would give rise loss of priority, additional costs and risks.

The Attorney's response

83. Mr Massang's case is that he was retained by The FIRM for the narrow purpose of drafting provisional applications to protect the Idea in the forthcoming negotiations with NCL and potentially other competitors. He submits that the narrow scope of his retention is relevant to the disciplinary proceeding because the Charges are confined to the conduct of "*the work he was engaged to undertake*".
84. He submits that the disclosure obligation under paragraph 17 of the Code is limited to "*information of which the registered attorney is aware*", thus introducing an element of subjectivity. To this end, Mr Massang maintains that at all relevant times he believed that the alleged inventions were patentable. He further submits that at least in relation to the First Specification (which both experts agreed was at low risk of failing the test for manner of manufacture) any duty to advise otherwise had been implicitly fulfilled.
85. Mr Massang contends that he gave oral advice about the provisional patent applications, which was within the scope of his retainer. He never guaranteed that the provisional applications would proceed to grant and nor could he because there were other factors affecting that opinion such as Article 15(5) search results which would have influenced any opinion on novelty. He contends that he went beyond the scope of his retainer by promptly and repeatedly warned in writing of the risks of prior disclosure.
86. He also contends that competency cannot be convincingly determined in this case because the provisional applications were never filed so there is no independent arbiter as to whether they would have succeeded. The risks perceived by the Board's expert, Mr Redfern, but not perceived by Mr Massang, could only be tested by the filing of the provisional applications. The client prevented this because of the second opinions. Moreover, Mr Massang contends that the experts' concession that the First Specification was at low risk of offending the manner of manufacture requirement meant that the second opinions were wrong in that regard.

Discussion

Relevant patent law and procedure considerations

87. The following patent law and practice background is relevant to issues arising in the present matter.

88. Under Section 29 the Act a person may file a provisional patent application. The provisional application will lapse 12 months after its lodgement. It is never subject to examination and does not proceed to grant. The primary purpose of filing a provisional application is to establish a priority date in respect of the invention that is the subject of the provisional application. In this way, the applicant of a provisional application may make one or more complete applications for a standard patent⁸ associated with the provisional application within the prescribed period of 12 months from the date of filing of the provisional application.⁹ The applicant of the provisional application may additionally or alternatively file individual patent applications in other Paris Convention¹⁰ countries and/or may file an international patent application under the PCT, which claim the priority date of the provisional. In general terms, and although patent laws vary somewhat between jurisdictions, the priority date is the date as at which novelty and inventiveness of applications validly claiming priority from the provisional will be assessed.
89. Under Regulation 3.13C a claim of a complete application (in relation to which a request for examination was filed on or after the commencement of the *Intellectual Property Laws Amendment (Raising the Bar) Act* 2012 on 15 April 2013) that is associated with a provisional application is entitled to the priority date of the date of filing of the provisional application if the invention defined in the claim is “*clearly disclosed*” in the provisional application. The invention is “*clearly disclosed*” if the provisional application “*discloses the invention in a manner that is clear enough, and complete enough, for the invention to be performed by a person skilled in the relevant art.*”¹¹ This is the same as the requirement under sub-section 40(1), which is sometimes referred to as the “**Enabling Disclosure**” or enablement requirement and is sometimes also referred to in a short-handed way as “sufficiency”. However, the Enabling disclosure requirement is different from, and somewhat more onerous than, the sufficiency requirement which it replaced upon implementation of the Raising the Bar Act.

⁸ Since amendments to the Act that came into force on 26 August 2021, apart from divisional applications of standard or innovation patent applications filed before 26 August 2021, it has only been possible to file complete applications for a standard patent.

⁹ The Act, section 38 and regulation 3.10

¹⁰ The *Paris Convention for the Protection of Industrial Property* as concluded in 1883, revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and as amended in 1979.

¹¹ Regulation 3.12(4).

90. There are several reasons as to why an applicant may elect to file a provisional application, including that the applicant intends to pursue the grant of a standard patent in Australia or the grant of patent rights in one or more other countries ultimately claiming priority from the provisional application. Alternatively, the applicant may simply wish to establish a priority date while it considers the technical and commercial merits of the invention, because it intends to make a disclosure in relation to the invention and/or because it wishes to initiate commercial negotiations with another party in relation to the invention. Whatever the circumstances, there is unlikely to be any value in filing a provisional application unless there is at least an arguable position, based upon what is known to the applicant at the time, that the provisional application fulfils the following fundamentals: that it includes patentable subject matter (i.e. is in respect of a manner of manufacture¹²) that is novel¹³ and inventive¹⁴, and that the disclosure of this subject matter meets the Enabling Disclosure requirement in order to establish a valid priority date.
91. When determining whether a claim of a patent meets the novelty requirement, Section 7(1) of the Act, when read in conjunction with the definitions in Schedule 1, outlines that the invention defined in the claim is to be compared against the prior art base before the priority date of the claim, which includes information publicly available in a single document (or two or more related documents that would be considered to constitute a single source of information) or information made publicly available through doing an act (or two or more related acts that would be considered to constitute a single source of information), whether the document/s or act/s were made publicly available in Australia or elsewhere. To meet the novelty requirement, all of the essential elements of the claim must not have been clearly and unmistakably disclosed¹⁵ in prior art base information. Apart from an exception for certain prior publications made within 12 months of filing a complete application that may apply in particular circumstances (not applicable in this matter), the prior art base information will include public disclosures of the invention made by the applicant before the priority date of the patent claim. The subsequent

¹² The Act, section 19(1)(a).

¹³ The Act, section 18(1)(b)(i).

¹⁴ The Act, section 18(1)(b)(ii).

¹⁵ *General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd* [1972] RPC 457 at 485-486

removal or withdrawal from public accessibility of such disclosures does not remove them from the relevant prior art base for the novelty assessment.

The Charges

92. The charges are said by the Board to arise from two aspects of alleged unsatisfactory professional conduct, namely, the Attorney's failure to:
- (a) *warn* The FIRM of material risks or difficulties associated with the grant of a patent in relation to the Idea and/or the alleged inventions the subject of the First Specification or the Second Specification; and
 - (b) *document the advice* he gave The FIRM in relation the patentability of the Idea and/or the alleged inventions the subject of the First and Second Specifications.

Charges 1, 4 & 7: Charges relating to the Idea

93. Charges 1, 4 and 7 relate to the Idea. Mr Massang's recommendation to The FIRM that two separate provisional applications be prepared and lodged in preference to seeking patent protection in respect of the Idea *per se*, was in effect an acknowledgement that the Idea itself was not suitable subject matter for protection under the patent system. Once the recommendation to prepare and lodge two separate provisional applications was provided the Idea ceased to exist as a concept in relation to which Mr Massang had an obligation to advise.
94. Charges 1, 4 and 7 are dismissed.

Charges 2 & 3: Failure to warn of material risks

95. Charges 2 and 3 concern an alleged breach of paragraph 17 of the Code as a result of Mr Massang's alleged failure to adequately and properly disclose all information materially relevant to the work he was engaged to undertake, namely the difficulties or risks associated with the grant of a patent or patents in relation to:
- 1. the invention the subject of the First Specification; and
 - 2. the invention the subject of the Second Specification.

96. Paragraph 17 of the Code provides:

17 Disclosure

Unless prohibited by section 18 [confidentiality] or otherwise by law, a registered attorney that is an individual must disclose to a client all information of which the registered attorney is aware that is relevant to work being undertaken for the client.

The First Specification

97. The difficulty or risk associated with the First Specification was that, when it was sent to the client on 1 May 2020 purportedly ready for filing, it was, in fact, incomplete in a manner that gave rise to a risk of it not complying with the Enabling Disclosure requirement and not being effective in establishing a priority date.
98. The instructions which Mr Massang had requested on 2 April 2020, as to the detail of the physical systems used to isolate air and water supply to individual cabins, were never provided by Mr Ibbitson nor Mr McCafferty despite Mr Massang presenting them with another draft on 10 April 2020 before presenting the “final” version on 1 May 2020. This detail was essential because the cabin design was suggested by Mr Massang as “*the inventive difference over existing cruise ships.*” The technical detail was never provided.
99. This lack of enabling disclosure resulted in Mr Redfern having “... *serious reservations about the First Specification providing a solid basis for seeking valid patent protection in Australia for the invention defined in the claims*” and in Mr Sulman agreeing that there was “*definitely a problem with sufficiency*”. The difficulty for Mr Massang is that he was aware that the specification was incomplete because he had asked for the information which was needed to complete it.
100. Both experts agreed that in a situation where a client has failed to provide sufficient technical detail in relation to an invention, a competent attorney recognising this, would have advised the client that without further detail there was a risk that a complete patent claiming priority from the provisional application would not be valid. And yet from 2 April 2022 to 1 May 2020, despite several exchanges with the clients and despite not receiving the further technical details, Mr Massang did not advise Mr Ibbitson nor Mr McCafferty of the significant risk that filing that provisional application would not effectively establish a priority date for lack of Enabling Disclosure. Instead, Mr Massang settled the application for lodgement.

101. As the preparation of provisional applications that are effective in establishing a priority date is a key task of a patent attorney, a competent patent attorney would have been aware of the Enabling Disclosure requirement to establish a priority date and would have advised their client before a provisional application was finalised for lodgement if there was a risk that this requirement would not be fulfilled.
102. Charge 2 is proven.
103. Although not relied upon in deciding Charge 2, it is concerning to the Tribunal that Mr Massang twice warned The FIRM about its own prior public disclosure of the Idea in the Email Blast. However, instead of asking The FIRM to provide a copy of the Email Blast so that it could reviewed in order to form a view and advise about whether the disclosure might have deprived any subsequently filed patent application of novelty, Mr Massang recommended that The FIRM “*Please withdraw any prior disclosure of the idea **asap** to avoid the potential allegation of self publication as this can negate your right to a valid patent*”. Mr Massang was therefore clearly well aware of the potential validity negating effect of such a publication. A competent patent attorney would also have known that withdrawing the publication would not have negated its prior art effect, and would have advised their client of this risk accordingly.

The Second Specification

104. The difficulties or risks associated with the Second Specification are twofold.
105. First, Claim 1 is expressed as:
1. *A method of providing dwelling titles to purchases of dwellings in a combination Ocean cruising and residential retirement facility, the method comprising the steps of:*
 - determining a valuation for the entire facility to include vessel construction, dwellings, common areas, amenities and services;*
 - determining a valuation for each dwelling of the facility according to predetermined valuation criteria based on size, location and access to the common areas, amenities and services;*
 - issuing dwelling title instruments to each of the dwellings;*
 - offering for sale the dwellings to purchasers of value, wherein each dwelling title instrument reflects a purchaser's apportioned ownership, strata title or share in the facility;*

registering all title instruments with an appropriate legal authority, wherein registered titles can be transferred, sold or devolved in substantially the same manner as that of a parcel of land or a ship.

106. Mr Redfern reported, and we agree, that:

“ ... I am of the view that claim 1 is to a business method, or mere scheme, and falls within one of the court-defined exclusions as to what amounts to a manner of manufacture. Accordingly, I am also of the view that the invention defined by claim 1 was almost certainly not suitable subject matter in Australia for letters patent at the relevant time Mr Massang was advising the Client.”

107. Second, other claims appear to describe a computer-implemented invention which did not involve any improvement in computer technology. Mr Redfern opined that they too were at risk of being found not to meet the manner of manufacture requirement.

108. Mr Sulman’s report described claims 1, 2, 7 and 9 of the Second Specification as “problematic”. He noted that:

“ ... He has, however, expressed the disclosed invention in the claims as being a method, system, computer-based implementation of a method or an app for a SMART device which enables the performance of the method, system or computer-based method. In my view the Second Specification is poorly drafted in this respect.”

109. In cross examination, Mr Sulman agreed that a competent attorney faced with claims expressed in that form would have advised the client of the risk of such claims being found not to be patentable subject matter.

110. Mr Massang’s position *viz* the character of the alleged invention in the Second Specification changed over the course of the proceeding. Aspides’ letter to Mr Ibbitson and Mr McCafferty of 28 May 2020 stated that:

“As part of obtaining your instructions it was explained that computer implemented patents need a technical solution (either a change to a computer itself or how the computer works).

Clear advices were given to you on at least two occasions as to this aspect due to the difficulty in drafting the provisional application directed to the computer implementation of the method and system of your invention.”

111. Mr Massang maintained that position in his response to the Board’s investigation, referring to the two occasions he provided this advice; being at the meeting on 19

February 2020 and again at the meeting on 5 March 2020. However, in evidence in chief, he declared that he at first thought that, *“this might be a “business system” patent: i.e. there may be a computer implemented method involved”* but upon further explanation, concluded that the inventions were *“not dependent on any innovative use of computer technology.”* Then in cross examination he maintained that he was *“not instructed in a computer-implemented invention.”*

112. On balance, we find that Mr Massang was aware that claims defining a computer implemented method lacking a technical solution were at risk of refusal. We are also satisfied that he disclosed that risk to Mr McCafferty and Mr Ibbitson on the two occasions of the meetings on 19 February 2020 and 5 March 2020.

113. Therefore Charge 3 is dismissed.

Charges 5 & 6: Failure to act to the requisite standard of competence and due skill and care

114. Charges 5 and 6 concern an alleged breach of paragraph 14 of the Code as a result of Mr Massang allegedly failing to act to the requisite standard of competence and due skill and care expected of a registered patent attorney, by not advising, or not adequately and properly advising, The FIRM of the difficulties or risks associated with the grant of patents in relation to:

1. the invention the subject of the First Specification; and
2. the invention the subject of the Second Specification.

115. Paragraph 14 of the Code provides:

14 Competency

- (1) *A registered attorney must have appropriate competency for the work that the attorney undertakes.*
- (2) *A registered attorney must carry out the work that the registered attorney undertakes with due care and skill.*

The First Specification

116. Both experts agreed that there was a risk that the First Specification failed to disclose the invention sufficiently to satisfy section 40(1) of the Act. Mr Massang himself held that view as of 2 April 2020, which is why he sought further instructions. Notwithstanding

that those instructions were not forthcoming, Mr Massang settled the specification for filing without further comment or advice to The FIRM. Both experts also agreed that a competent attorney would have advised their client that without the necessary detail the specification would not meet the test in Sub-section 40(1) of the Act

117. Charge 5 is proven.

The Second Specification

118. We have found that Mr Massang was generally aware that a computer implemented method lacking a technical solution was at risk of refusal and that he disclosed that risk to Mr McCafferty and Mr Ibbitson on the two occasions of the meetings on 19 February 2020 and 5 March 2020. However, he did not revisit that advice during the drafting of the Second Specification when the risk must have revealed itself more acutely. Also, at this time, the character of the alleged invention as a business method, or mere scheme should have been obvious. Mr Massang's failure to advise about these problems demonstrates a lack of competency in relation to the work he undertook for The FIRM.

119. Charge 6 is proven.

Charges 8 & 9: Failure to document advice

120. Charges 8 and 9 concern an alleged breach of sub paragraph 13(2) of the Code as a result of Mr Massang allegedly failing to maintain appropriate standards of professional practice as a patent attorney by not documenting his advice in relation to the patentability or the difficulties or risks associated with the grant of patents in relation to:

1. the invention the subject of the First Specification; and
2. the invention the subject of the Second Specification.

121. Paragraph 13(2) of the Code provides:

13 Integrity

(1)

(2) *A registered attorney must maintain standards of professional practice as a patent attorney or a trade marks attorney that are courteous, ethical and well-informed.*

122. There is no doubt that Mr Massang failed to properly document his advice, to the extent that he gave advice. The patent attorney profession, as noted by Mr Redfern, is in general “*bias towards more recordkeeping over the less*” owing to the core work of patent drafting requiring access to good quality information about many factors concerning the invention, including matters relating to the timing and the fact that the process of applying for, obtaining, maintaining and enforcing a patent can span many years and typically requires detailed knowledge about events and personalities connected with the invention.
123. Moreover, the nature of the profession requires frequent communication with the attorney’s client to provide advice about risks that are, or are likely to be, material to a given matter. Mr Redfern also noted the advice is typically provided sooner rather than later, in writing, and is intended to ensure that the client is aware of the risk and the recommended risk management option and to prompt early, responsive instructions. Mr Redfern reported that:

“It would not be unusual in my experience for a client who received written advice about a material risk to then contact the patent attorney by telephone to discuss in more detail the risk, and the possible risk management strategies. It would also not be unusual in my experience, if there were no response to the written advice from the client, for the patent attorney to contact client by telephone to initiate that discussion.”

124. We agree with Mr Redfern’s assessment that advice about risks that are, or are likely to be, material to a given matter should be provided sooner rather than later to ensure that the client is aware of the risk and the recommended risk management option, and to prompt early, responsive instructions. Preferably this advice is provided in writing, although there will be instances where it is given orally. In such situations a prudent patent attorney would prepare a contemporaneous file note that details the verbal advice provided.
125. The difficulties and risks associated with the grant of patents in relation to the inventions the subject of the First and Second Specifications are outlined above. As to which, Mr Massang did not provide The FIRM with any meaningful documented advice and retained only the most cursory diary notes of any verbal advice regarding risks having been provided. It is evident from Mr Redfern’s and Mr Sulman’s evidence that proper documentation is a core part of a competent patent attorney’s practice.

126. Satisfactory professional conduct requires the attorney's conduct to meet the standard of competence, diligence and behaviour that an ordinary member of the public is entitled to expect of an attorney. The Board cited paragraph 13(2) of the Code in charges 7 to 9. Other paragraphs are also apt, such as the core obligation under paragraph 11(1)(b) to act in the best interest of the attorney's clients, the due care obligation under paragraph 14(2) and the disclosure obligation under paragraph 17, to the extent that such disclosures should generally be in writing.
127. Charges 8 and 9 are proven.

Disposition

128. We direct that these reasons be published in accordance with regulation 20.50.
129. By 4 p.m. on 27 July 2023, the Board is to file and serve written submissions on penalties of not more than 5 pages and to notify the Secretariat if it wishes to make oral submissions on penalties.
130. By 4 p.m. on 10 August 2023, Mr Massang is to file and serve written submissions in response of not more than 5 pages and to notify the Secretariat if he wishes to make oral submissions on penalties.

13 July 2023

Siobhán Ryan KC
Dr Patrick McManamny
Mark Roberts