COMMONWEALTH OF AUSTRALIA

Patents Act 1990
Patents Regulations 1991, Chapter 20

DISCIPLINARY TRIBUNAL FOR PATENTS AND TRADE MARKS ATTORNEYS

IN THE MATTER OF: **JAMIE RICARDO MASSANG** a Patent Attorney

COMPLAINT BY: **AB**

Tribunal: S. Higgins

Date: 24 November 2009

Place: Sydney

Decision:

1. The attorney is reprimanded pursuant to paragraph 20.23(2)(2)(a) of the *Patents Regulations* 1991 as they applied prior to 1 July 2008.

2. The Commissioner of Patents is directed, pursuant to sub-regulation 20.24 of the *Patents Regulations* 1991 as they applied prior to 1 July 2008, to publish in the *Official Journal* a copy of the notice of the Tribunal in regard to these proceedings issued under sub-regulation 20.23(6) of the Regulations.

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Sigrid Higgins
Patent and Trade Marks Disciplinary Tribunal

CATCHWORDS

DISCIPLINARY PROCEEDINGS – regstered patent and trade marks attorney - finding of unsatisfactory conduct - consequential orders – warning - reprimand – publiction of written notice of finding – non publication order of the complainant's identity

Patents Regulations 1991 reg 20.1, 20.23, 20.24, 20.27, 20.49, 20.50

Patents and Trade Marks Legislation Amendment Regulation 2008 (No 1)
Legal Profession Act 2007 (Qld)

Clyne v The New South Wales Bar Association (1960-1961) 104 CLR 186
Jamie Ricardo Massang, Patent and Trade Marks Attorneys Disciplinary Tribunal (10 June 2009)
John Peter Gahan and Professional Standards Board for Patent and Trade Marks Attorneys (1998) 27 AAR 517; [1998] AATA 479
Law Society of New South Wales v Foreman (1994) 34 NSWLR 408
Law Society of NSW v Pullman (1994) 34 NSWLR 408
Legal Services Commissioner v Douglas John Winning [2008] LPT 13
The New South Wales Bar Association v Evatt [1968] 117 CLR 177
New South Wales Bar Association v Meakes [2006] NSWCA 340.
Professional Standards Board for Patent and Trade Marks Attorneys Disciplinary Tribunal (2002) 70 ALD 592; [2002] AATA 728
Ziems v Prothonotary of the Supreme Court of New South Wales (1957) 97 CLR 279

REASON FOR DECISION

Introduction

1. On 10 June 2009, the Tribunal published its decision and reasons for decision in regard to a charge of unsatisfactory conduct and/or unprofessional conduct made against Jamie Ricardo Massang (**'the attorney**') by the Professional Standards Board for Patent and Trade Marks Attorneys ('**the Board**') pursuant to Reg. 20.20 of the *Patents Regulations 1991* ('**the Regulations**'): see *Jamie Ricardo Massang, Patent and Trade Marks Attorneys Disciplinary Tribunal* (10 June 2009) ('**the Tribunal's earlier decision**'). The charge arose from a complaint made against the attorney, in October 2007, by [AB] ('**the complainant**').

2. In its earlier decision the Tribunal found that the attorney was guilty of unsatisfactory conduct as charged, in part. The Tribunal's findings were in the following terms:

    (a) The patent attorney is guilty of unsatisfactory conduct in that it was not necessary for the attorney to take the 5 comparative photographs of the complainant on 10 November 2003 for the purpose of processing her patent application and furthermore that he conducted himself in such a manner at this time when taking all 10 photographs that the complainant was intimidated by him and allowed herself to be photographed by him in circumstances where she felt she had no option but to comply with his request.

(b) The patent attorney is guilty of unsatisfactory conduct in that on 23 July 2007 during a telephone conversation with the complainant and with the complainant's husband, the attorney shouted and used expletives which had the effect of intimidating the complainant and her husband.

3. Subject to objections from the parties, the Tribunal also made directions in regard to determining what disciplinary orders should be made, if any, as a result of the Tribunal's findings of unsatisfactory conduct. No objections were raised and the Tribunal has determined, on the basis of its earlier findings and on the papers filed by the parties, to reprimand the attorney in regard to his unsatisfactory conduct. These are the Tribunal's reason for that determination and the other ancillary orders that were sought by the Board.

The issues

4. It is not disputed that the disciplinary orders that are available to the Tribunal in these proceedings are those contained in sub-regulation 20.23(2) of the Regulations, as they applied prior to the 2008 amendments (see paragraph 1 of the Tribunal's earlier decision). That sub-regulation relevantly provides:

> 20.23(2) If the Disciplinary Tribunal finds a registered patent attorney guilty of unsatisfactory conduct or unprofessional conduct, that Tribunal may:
>
> (a) reprimand the attorney; or
>
> 170. suspend the attorney's registration for not more than 12 months; or
>
> 171. …

5. Nor is it disputed that the Tribunal's power under this provision is discretionary. The Board does not press a suspension of the attorney's registration, but submits that the appropriate disciplinary order is a reprimand. The attorney submitted that the appropriate disciplinary order was a warning and in the alternative, a reprimand. The former is of course not a formal order that the Tribunal has jurisdiction to make.

6. The Board also sought a direction, pursuant to sub-regulation 20.24 of the Regulations, that the Commissioner of Patents publish in the Official Journal a copy of the notice under sub-regulation 20.23(6).

7. The Board also seeks a non publication direction, pursuant to paragraph 20.27(2)(b) of the Regulations, restricting the publication of the complainant's identity in the written reasons for decision that the Board intends to publish on its website.

8. In submissions in reply the attorney submitted that the Board's requested directions in regard to the publication of the Tribunal's decision were onerous and outside the scope of the Tribunal's discretion.

Disciplinary Orders

9. As I have mentioned, the issue for determination is whether the attorney's conduct, found by the Tribunal to be unsatisfactory conduct, warrants a warning or a reprimand and in the event the Tribunal reprimands the attorney whether the Tribunal should direct the Commissioner of Patents to publish its notice of its findings in the *Official Journal*.

10. It is well accepted that the applicable principles in determining what, if any, disciplinary orders should be made following a finding of unsatisfactory conduct or professional misconduct by a registered patent and/or trade marks attorney are similar to those that apply to legal practitioners. In *Professional Standards Board for Patent and Trade Marks Attorneys Disciplinary Tribunal* (2002) 70 ALD 592; [2002] AATA 728 at [61], Deputy President the Hon. C.R. Wright QC adopted this approach and at [62] to [66] he set out what these principles were. In summary, they are as follows:

    (a) the powers to discipline a practitioner are entirely protective in character and no element of punishment is involved: see *Ziems v Prothonotary of the Supreme Court of New South Wales* (1957) 97 CLR 279 at 286 per Dixon CJ; *Clyne v The New South Wales Bar Association* (1960-1961) 104 CLR 186 at 201-2 and *The New South Wales Bar Association v Evatt* [1968] 117 CLR 177 at 183-4. That is, the power is to be exercised in a manner that is

'likely to achieve the maintenance of a high standard of conduct within the profession which will continue its good reputation, and so protect, not only the future of the profession, but also protect its clients from harm': see also *Law Society of New South Wales v Foreman* (1994) 34 NSWLR 408 at 441 and *New South Wales Bar Association v Meakes* [2006] NSWCA 340.

(b) the consequential orders involve 'no retributive element, no intention to express outrage, as there sometimes is in sentences for crime.' It is an order that is no more necessary than 'to maintain professional discipline and high standards of conduct'. It is however recognised that orders such as suspension or cancellation of registration will inescapably have a punitive consequence: see *Foreman* (supra) at 413

(c) the protection of the public is not confined to the protection of the public against further default by the [practitioner] in question. It extends also to the protection of the public against similar defaults by other practitioners and has, in this sense, the purpose of publicly marking the seriousness of what the instant [practitioner] has done.

11. These principles must of course be considered in the context of the express provisions of the Regulations that apply to registered patent and trade marks attorneys.

12. In support of his contention that the appropriate disciplinary order was a warning or alternatively a reprimand, the attorney filed and served the following material:

(a) a letter, dated 1 July 2009, from the attorney to the complainant and her husband in which the attorney said the following:

> '…[In] terms of the photographs, I apologise unreservedly for any embarrassment this has caused you. It was never my intention to intimidate you or make you feel ashamed of yourself, however I appreciate that I have done so. I am sorry for any anguish that my actions have caused you and your family. At the time I honestly thought it was necessary for the functionality of the garment to be demonstrated in drawings that were necessary to include in any patent application however, I now realise that this may not have been the case.

> In terms of the telephone conversations, I again apologise unreservedly if I have behaved in a manner which was perceived as aggressive or intimidating as this was never my intention. I consider myself to be a level headed character who does not lose his temper easily and I am sorry if my demeanour became offensive or rude to you.'

(b) Three references – two of which were dated 1 July 2009 and the other 30 June 2009. One reference was from the practice manager of the firm of which the attorney is a partner, another is from a professional colleague and the remaining reference is from the President of the attorney's Local Chamber of Commerce. The references all state that the attorney is a person of good character and a 'true'/'courteous' gentleman. However, there is no indication from the terms of the references that any of the referees were informed of the Tribunal's findings in regard to the complaint made by the complainant.

13. In his submissions the attorney relied on the findings in a recent decision of the Queensland Legal Practice Tribunal in *Legal Services Commissioner v Douglas John Winning* [2008] LPT 13. In those proceedings the legal practitioner, a solicitor, was charged in respect of the language he had used on 8 different occasions. The language was alleged to have been offensive and insulting. On a number of occasions the language included swearing. Of these 8 incidents, the Tribunal found that only 4 of the 8 charges were proven and proposed that he be reprimanded in respect of that conduct under the relevant provision of the *Legal Profession Act* 2007 (Qld). It was contended by the attorney that his conduct which the Tribunal has found to amount to unsatisfactory conduct was of lesser seriousness as the conduct was isolated incidents and it had occurred some time ago. Additionally, the attorney pointed to his voluntary and 'unreserved' apology to the complainant and her husband and the references as to his good character which had been filed.

14. The Board on the other hand submitted that the two incidents found by the Tribunal to have amounted to unsatisfactory conduct were of a serious nature that warranted a disciplinary order in the form of a reprimand, pursuant to sub-regulation 20.23(2) of the Regulations.

15. In my opinion the submissions of the Board are correct.

16. I do not consider the attorney's submission that his unsatisfactory conduct should be equated with that of Mr Winning is at all helpful. The circumstances surrounding the attorney's unsatisfactory conduct in these proceedings differs substantially to that of Mr Winning. Each case must be considered first and foremost on its own facts and circumstances, including the overall seriousness of the unsatisfactory conduct and any relevant mitigating factors.

17. In these proceedings the attorney's conduct when taking photographs of the complainant wearing her invention and other [comparable garments] was, in my opinion, serious. The conduct occurred at the complainant's home, when no one else was there. The complainant had invited the attorney to come to her home to give her professional advice, in his capacity as a registered patent attorney, for her invention. Accordingly, he was in a privileged position and one of trust that he would at all times conduct himself in accordance with the accepted standards of a registered patent attorney. This, the Tribunal has found he failed to do. Instead his conduct was such that the complainant felt intimidated and embarrassed (see at [88] and [124] of the Tribunal's earlier decision). She felt she had no alternative but to pose for the photographs that were taken and also felt embarrassed about doing so. The complainant's feeling of embarrassment has been ongoing and of the photographs taken, 5 were found to be completely unnecessary for the purpose for which his professional expertise had been sought.

18. The attorney's conduct in regard to the second incident while serious is in the opinion of the Tribunal of a lesser serious nature. It was however found to be of a threatening nature and done with the intention of intimidating the complainant (see at [163] of the Tribunal's earlier decision).

19. While the first incident occurred almost 6 years ago, the other incident is much more recent. The Tribunal does, however, note that there is no evidence of any other complaint having been made against the attorney in the 9 year period he has been registered under the Regulations.

20. In my opinion, very little weight can be given to the references for the reason I have already stated, namely no referee makes mention of having knowledge of the unsatisfactory conduct of the attorney and in light of that knowledge remaining of the view they have expressed. In his reference, the practice manager, states that he 'assumed' his current role in 2009. It is not clear when that was. It is noted that he has only known the attorney since January 2008, which is the time he joined the attorney's firm as a patent paralegal. It is surprising that he did not make mention of the Tribunal's findings of the attorney's unsatisfactory conduct. He does say that those persons who are 'unfamiliar' with the attorney's 'mannerisms' he 'may appear impatient and temperamental or terse, or even rude.' He goes on to say that in his opinion such an assessment would be 'superficial and unfair.' He says the attorney has never, in his presence while at work, used any expletives. In my opinion these comments are of little assistance. The unsatisfactory conduct by the attorney was at no time a question of his particular 'mannerisms'. He at all times denied he said and did what was alleged or he contended he was justified in doing what he did. Furthermore, without some evidence about the attorney's firm, the people in it, and how they interact, the statement about the non use of expletives is nothing more than being self serving.

21. The final mitigating factor put before the Tribunal is the apology that was written by the attorney to the complainant and her husband on 1 July 2009. In my opinion little weight can be given to this apology. It was made after the findings of the Tribunal and on the day on which the attorney had been directed to file and serve his submissions as to disciplinary orders. Up until then the attorney's position was that the complainant was making false allegations against him as to his conduct on 10 November 2003 and that he was justified in speaking to the complainant and her husband in the manner he did. An apology is a form of contrition. However, in my opinion, the terms of the attorney's apology show his ongoing reluctance to fully acknowledge that his conduct was not consistent with the accepted standard of practice of a registered patent and trade marks attorney.

22. The attorney, in his submissions in reply, contended that the behaviour of the complainant's husband and the unsubstantiated allegations by the complainant and her husband were also mitigating factors. In my opinion, neither amount to

mitigating circumstances. The fact that some of the allegations were not substantiated does not, in these proceedings, alter or impact upon those that were substantiated. The Tribunal does however, note that the attorney's conduct in prosecuting the complainant's patent applications was otherwise not found to have failed to maintain the high standard of conduct within the profession of registered patent and trade marks attorneys.

23. It is not clear how the conduct of the husband of the complainant could be a mitigating factor. Once again the attorney's submissions seem to suggest that his conduct was understandable because of the manner in which the complainant's husband behaved. As I have found previously the conduct of the attorney was not justified in the circumstances: see at [161] of the Tribunal's earlier decision.

24. The attorney's reluctance to fully acknowledge that his conduct failed to attain or sustain a professional standard that is consistent with the standard of practice of registered patent and trade marks attorneys causes me concern. As mentioned above, disciplinary powers such as those vested in the Tribunal (and the Board) are entirely of a protective nature and any disciplinary action that is taken must be no more than what is necessary to maintain professional discipline and high standards of conduct so as to protect members of the public. On the basis of the Tribunal's findings that the attorney's unsatisfactory conduct was serious and he has shown little contrition or insight to his unsatisfactory conduct, in my opinion the appropriate disciplinary action is to reprimand the attorney.

25. *Publication of Notice of finding* – As a consequence of a finding that the attorney be reprimanded the Tribunal is required, pursuant to sub-regulation 20.23(6) of the Regulation, to provide written notice, including particulars, of its findings to; (a) the complainant if the proceedings were brought by the complainant, (b) the attorney, (c) the Board, and (d) the Designated Manager.

26. Sub-regulation 20.24 of the Regulations gives the Tribunal the power to direct the 'Commissioner' (i.e. the Commissioner of Patents) to publish in the *Official Journal* a copy of a notice under sub-regulation 20.23(6), or an extract of that notice. Where the Tribunal does so direct the 'Commissioner' must publish the notice accordingly.

27. As pointed out by the Board in its submission, publication of a decision of the Tribunal promotes the protective object of disciplinary action in that it informs the general public and other practitioners of the standards that are to be expected of registered patent and trade mark attorneys and thereby attain those standards. In disciplinary matters for other regulated professions (e.g. lawyers), publication of decisions (i.e. findings) and reasons for decision of the relevant tribunal is now common. The Regulations that have been in force since 1 July 2008 also provide for the publication of the Tribunal's findings and reasons in those matters where the Tribunal finds the charge made against the registered patent and/or trade marks attorney to have been proven and it reprimands, suspends or cancel's the practitioner's registration: see sub-regulations 20.49 and 20.50. These provisions include an automatic publication of the notice in the *Official Journal.*

28. However, as I have said the relevant Regulations for the purposes of these proceedings are those that applied prior to 1 July 2008 (i.e. sub-regulation 20.23 and 20.24 as referred to above), which gives the Tribunal a discretion as to whether to direct the Commissioner of Patents to publish its notice. That discretion in my opinion should be exercised in accordance with the underlying objects of disciplinary proceedings.

29. I have given careful consideration to all the matters before the Tribunal, including the findings that have been made. In my opinion, on balance, in light of the seriousness of the misconduct and the underlying objects of disciplinary proceedings, it is appropriate for a direction to be made under sub-regulation 20.24 of the Regulations as they applied prior to 1 July 2008.

Prohibiting the publication of the name of the complainant

30. Sub-regulation 20.27(1) of the Regulations provides that a hearing before the Tribunal is to be in public. Sub-regulation 20.27(2) gives the Tribunal power to make directions (a) that a hearing in part or whole is to be in private and (b) to restrict or prohibit the publication of (i) evidence given before the Tribunal, or (ii) matters contained in documents lodged with the Tribunal or received in evidence, or (iii) any finding or decision of the Tribunal. However, that power can only be

exercised where the Tribunal 'is reasonably satisfied that it is desirable to do so in the public interest or because of the confidential nature of any evidence or matter.'

31. As I have already mentioned, the Board's application for a prohibition of the complainant's name is based on the Tribunal's findings that the complainant's embarrassment of the attorney taking photographs of her was ongoing (see at [88] of the Tribunal's earlier decision). The Board contends that this embarrassment will be compounded if the decision of the Tribunal is published in a form that identifies her. The attorney contends that the Tribunal does not have any power to make such an order.

32. In my opinion, there may be some merit in the argument of the attorney. However, as I have found that the complaint's ongoing embarrassment is not a sufficient basis on which to make the direction sought, it is unnecessary for the Tribunal to consider this any further.

33. As the Board has submitted, the Regulations expressly provide that disciplinary hearings before the Tribunal are to be open to the public unless the Tribunal directs otherwise pursuant to sub-regulation 20.27(2) of the Regulations.

34. During the hearing of these proceedings no application was made by the complainant for the suppression of her name. Prior to the hearing the complainant had requested that her address had not been disclosed to the attorney. This was consented to and no further orders were sought or made.

35. While the Tribunal has accepted that the complainant continues to be embarrassed about what happened on 10 November 2003, this alone in my view is not a basis to make a direction restricting the publication of her name. It is difficult to see how this embarrassment is of such a confidential nature that it is desirable, in public interest, to restrict publication of her name in the written decisions of the Tribunal and the notices that are issued in accordance with the Regulations. Accordingly, the Board's application for a direction that the publication of the name of the complainant is refused.

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Disciplinary Tribunal for Patents and Trade Marks Attorneys

Date of Hearing:	On the papers
Date of Decision:	24 November 2009
Appearance for the Board	Mr A Markus, solicitor
Appearance for the Patent Attorney	Mr T Tavoularis, solicitor
Solicitor for the Board	The Australian Government Solicitor
Solicitor for the Patent Attorney	McKays Solicitors