

27 March 2024

Ms Jennifer Hutchinson
IP Australia
47 Bowes Street
Woden ACT 2606

By email: Jennifer.Hutchinson@ipaaustralia.gov.au

Dear Ms Hutchison

Regulation of agents conducting matters before IP Australia

1. This submission regarding the regulation of agents conducting matters before IP Australia is made by the Intellectual Property Committee of the Business Law Section of the Law Council of Australia (**IPC**).

Key Points

2. The IPC understands that the Institute of Patent and Trade Mark Attorneys (**IPTA**) has been in correspondence with IP Australia for some time over the issue of whether there should be greater regulation of agents conducting matters before IP Australia, specifically in matters relating to trade marks and designs. Our understanding is that IPTA's position on this issue was initially set out in a letter to Michael Schwager, Director-General of IP Australia, dated 21 July 2022, and that IPTA's refined position is set out in its letter to you dated 31 October 2023.
3. IPTA's general position, as outlined in these two letters, is that there are problems with the current state of affairs where parties other than 'locally-qualified practitioners' (defined as Trans-Tasman Patent Attorneys, Australian Trade Marks Attorneys and Australian/New Zealand legal practitioners) are able to act as agents in matters before IP Australia. IPTA's particular concerns relate to parties other than locally-qualified practitioners being able to act for applicants for registration of trade marks or designs, for registered owners of trade marks or designs, and for third parties in relation to proceedings involving applications for registration of or registered trade marks or designs.
4. IPTA has proposed legislative reform (on p 14 of its October 2023 letter). The suggested reform would require any agent used by 'any applicant or registrant ... to represent the applicant/registrant before IP Australia (which includes filing, prosecution, maintenance, renewal, opposition proceedings, removal proceedings or any other matter)' to be 'ordinarily resident in Australia or New Zealand' and be:

- 1) *An Australian Trade Marks Attorney (for trade marks and designs matters);*

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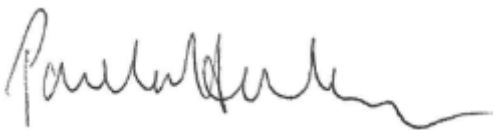
- 2) *Australian/New Zealand Lawyer holding a current practising certificate and who is registered with IP Australia as an authorised Trade Marks Agent and with a minimum of 2 years supervised experience in practising exclusively in trade mark and/or design matters (for trade marks and designs matters);*
 - 3) *A Trans-Tasman Patents Attorney (for patents, trade marks and designs matters); or*
 - 4) *An employee of the applicant or its subsidiary who is locally resident (for patents, designs or trade marks matters) and provided it does not otherwise breach relevant restrictions on practice.*
5. The IPC considers that the issue of whether parties other than locally-qualified practitioners should be able to act as agents before IP Australia, specifically in trade mark and design matters, warrants further investigation by IP Australia.
6. The IPC considers that IPTA has raised a number of issues of potential concern about the current state of affairs in Australia that need to be considered fully by IP Australia, in consultation with relevant stakeholders. Without being exhaustive, the IPC considers that:
- 6.1 The concerns expressed by IPTA on pp 8–10 of its October 2023 letter that a lack of regulation of agents who are not locally-qualified practitioners may increase the risk of fraudulent activity appear to raise especially serious matters that warrant further scrutiny.
 - 6.2 Further attention needs to be given to the significance of:
 - Part 5B.2, Division 2 of the *Corporations Act 2001* (Cth), which regulates foreign companies carrying on business in Australia, as noted on pp 2–3 of IPTA’s July 2022 letter and p 13 of IPTA’s October 2023 letter; and
 - State and Territory legislative regimes that prohibit anyone other than a legal practitioner engaging in ‘legal practice’ without a relevant exception applying (for example, for an individual engaged in legal practice under the authority of a law of the Commonwealth).
- It may be the case that these legislative regimes need to be considered more closely in determining whether tighter regulation of who may act as an agent before IP Australia, specifically in trade mark and design matters, is needed.
- 6.3 It is significant that a number of other jurisdictions take a more restrictive approach to who can act in trade mark and design matters than that taken in Australia, as noted on p 13 of IPTA’s October 2023 letter. Closer attention should be given to the regulatory regimes in place in those jurisdictions *in determining what approach Australia should take.*

7. The IPC does not at this stage seek to express a definite view as to the circumstances in which greater regulation of parties other than locally-qualified practitioners might be needed, or as to the precise form that any reforms to the law might take. Having said this, the IPC does not support the specific suggestion for reform, set out on p 14 of IPTA's October 2023 letter, that an agent who is an Australian or New Zealand legal practitioner holding a current practising certificate must be "registered with IP Australia as an authorised Trade Marks Agent and with a minimum of 2 years supervised experience in practising exclusively in trade mark and/or design matters". The IPC's view is that no further requirements should be imposed on Australian or New Zealand legal practitioners who hold a current practising certificate.
8. The IPC would very much welcome the opportunity to join IPTA and other stakeholders in meeting with you and other representatives from IP Australia to discuss the issues raised in IPTA's letters further, and to explore how the problems that have been identified might best be addressed.

Conclusion and further contact

9. The IPC would be pleased to discuss any aspect of this submission.
10. Please contact the chair of the IPC, Richard Hoad, on 03 9101 6825 or by email to rhoad@jonesday.com if you would like to do so.

Yours faithfully



Dr Pamela Hanrahan
Chair
Business Law Section