

EXPLANATORY STATEMENT

Select Legislative Instrument No. , 2016

Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016

Issued by the Authority of the Minister for Industry, Innovation, and Science

Patents Act 1990

Trade Marks Act 1995

Designs Act 2003

Plant Breeder's Rights Act 1994

Intellectual Property Laws Amendment Act 2015

The *Patents Act 1990* ('Patents Act'), *Trade Marks Act 1995* ('Trade Marks Act'), *Designs Act 2003* ('Designs Act') and *Plant Breeder's Rights Act 1994* ('Plant Breeder's Rights Act') (collectively 'the Acts') provide for the registration, examination and enforcement of Intellectual Property (IP) Rights.

Legislative Authority

Subsection 228(1) of the Patents Act, subsection 231(1) of the Trade Marks Act, subsection 149(1) of the Designs Act, and subsection 80(1) of the Plant Breeder's Rights Act provide that the Governor-General may make regulations prescribing matters required or permitted by the Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Acts.

The Regulation

The Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016 ('Regulation') amends the *Patents Regulations 1991* ('Patents Regulations'), *the Trade Marks Regulations 1995* ('Trade Marks Regulations'), *the Designs Regulations 2004* ('Designs Regulations'), and the *Plant Breeder's Rights Regulations 1994* ('Plant Breeder's Rights Regulations') to prescribe matters required under the provisions of the Acts as amended by Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* ('IP Laws Amendment Act').

In particular, Schedule 4 to the IP Laws Amendment Act provides for a single trans-Tasman register of patent attorneys, with registration giving a person the right to practise as a patent attorney in both countries. It also establishes a single set of qualifications for registration, a single trans-Tasman IP Attorneys Board and permits the Patents Regulations to provide for the new Trans-Tasman IP Attorneys Disciplinary Tribunal to discipline patent attorneys for their conduct in New Zealand.

The Regulation also makes minor amendments to ensure compliance with international obligations.

The Acts do not specify any conditions that must be met before the power to make the Regulation may be exercised.

The Regulation is a legislative instrument for the purpose of the *Legislation Act 2003*.

Purposes of the Regulation

The Regulation:

- amends the Patents Regulations and the Trade Marks Regulations to enable the implementation of a single, trans-Tasman patent attorney regime (Schedules 1 and 2);
- amends the Designs Regulations and the Plant Breeder's Rights Regulations to allow an address for the service of documents to be in New Zealand (Schedule 3);
- amends the Patents Regulations and Trade Marks Regulations to ensure consistency with international treaties (Schedule 4);
- amends the Trade Marks Regulations to allow the Registrar of Trade Marks to identify, and refuse to protect, unclearly specified goods or services set out in international trade mark applications (Schedule 5);
- amends the Trade Marks Regulations and the Plant Breeder's Rights Regulations to reflect the changes to the administration of Norfolk Island made in July 2016 (Schedule 6).

Consultation

The public was consulted on an exposure draft of the provisions in Schedules 1 to 3 to the Regulation. Four submissions were received. As a result of those submissions, item 113 in Schedule 1 to the Regulation was changed so that any member of the Trans-Tasman IP Attorneys Disciplinary Tribunal must have at least five years of experience as a patent attorney, as a trade marks attorney or as a legal practitioner.

Consultation was not undertaken on the amendments in Schedules 4 to 6, because they are required for Australia's compliance with international treaties, or are of a minor or machinery nature.

No Regulation Impact Statement required

The Office of Best Practice Regulation ('OBPR') does not require a Regulation Impact Statement for any of the measures in the Regulation. The measures in Schedules 1 to 3 fall within the scope of exemption obtained for the IP Laws Amendment Act (OBPR reference numbers 13005, 13240). The measures in Schedules 4 to 6 are exempt as they are of a minor or machinery nature (OBPR reference numbers 20181-3, 20927-8, and 21247).

Commencement of the Regulation

The Regulation commences as follows:

- Schedules 1 to 3 commence at the same time as Schedule 4 to the IP Laws Amendment Act commences. Schedule 4 to the IP Laws Amendment Act commences on a single day to be fixed by Proclamation. This must be no later than 24 February 2017, or else Schedule 4 to the IP Laws Amendment Act is automatically repealed. This means that Schedules 1 to 3 to the Regulation cannot

commence any later than 24 February 2017. If they do not commence by that date, they can never commence, and would be automatically repealed with the rest of the Regulation (on 2 July 2017), as set out in Division 1 of Part 3 of Chapter 3 of the *Legislation Act 2003*;

- Schedule 4 to Schedule 6, Part 1 commence on the day after the Regulation is registered on the Federal Register of Legislation;
- Schedule 6, Part 2 commences on 1 July 2017.

Details of the Regulation are set out in the Attachment.

Schedule 1 – Single economic market amendments relating to patents

Schedule 1 amends the Patents Regulations to enable the legislative implementation of a single, trans-Tasman patent attorney regime in Australia and New Zealand, an intellectual property initiative being undertaken as part of Australia’s broader Single Economic Market agenda with New Zealand. The amendments allow for a single application and registration process for applicants seeking to register as a patent attorney; establish the Trans-Tasman IP Attorneys Disciplinary Tribunal and provide measures for its operation and procedures; and allow an address for postal service to be in either Australia or New Zealand.

General operation of regulations for the patent attorney profession

Items 1 to 3 amend subregulation 1.3(1) of the Patents Regulations to repeal definitions which are no longer required, and insert new definitions (discussed below) for terms in the amendments to the Patents Regulations.

Item 1 repeals the definition of “Disciplinary Tribunal” and substitutes:

Disciplinary Tribunal means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61.

This new Disciplinary Tribunal replaces the previously-existing Patent and Trade Marks Attorney Disciplinary Tribunal (‘the former Disciplinary Tribunal’).

Item 2 repeals the definition of “former attorneys Regulations” and substitutes:

former attorneys Regulations means the Patent Attorneys Regulations as in force under the 1952 Act immediately before 30 April 1991.

Item 3 inserts the following definitions:

New Zealand has the meaning given by section 29 of the Interpretation Act 1999 of New Zealand, as in force at the commencement of this definition.

Ordinarily resident: a person is taken to be ordinarily resident in a country if:

- (a) the person has his or her home in that country; or
- (b) that country is the country of his or her permanent abode even though he or she is temporarily absent from that country.

However, the person is taken not to be so resident if he or she resides in that country for a special or temporary purpose only.

Panel Chair, in relation to a Panel of the Disciplinary Tribunal, means:

- (a) the President; or

- (b) if the President is unable to perform his or her functions in proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) to be the Panel Chair for the proceedings.

Panel of the Disciplinary Tribunal means a Panel constituted under regulation 20.36 or 20A.11.

President means the President of the Disciplinary Tribunal.

Tribunal member means a member of the Disciplinary Tribunal and includes the President.

Items 4–7 amend subregulation 3.2C(2) of the Patents Regulations to allow an address for service for the purpose of an application made under the Patent Cooperation Treaty to be in either Australia or New Zealand. This allows persons in New Zealand to provide a postal address for service there, without having to maintain an Australian address for service (as they previously had to).

Item 8 inserts new regulations 20.1B and 20.1C into Chapter 20 of the Patents Regulations (Chapter 20 governs the regulation of the patent attorney profession). The purpose of these regulations is to ensure that the regulation of patent attorneys in New Zealand can take place under the Patents Regulations without any jurisdictional issues.

New subregulations 20.1B(1)–(2) provide that functions and powers conferred on a person or body under Chapter 20 of the Patents Regulations may be exercised in Australia or New Zealand.

New subregulation 20.1B(3) provides that, subject to new regulation 20.1C, it is immaterial whether an act or omission mentioned in Chapter 20 took place in New Zealand.

New subregulation 20.1B(4) provides that, subject to new regulation 20.1C, it is immaterial whether a matter mentioned in Chapter 20 took place in New Zealand.

New regulation 20.1C provides that a person is not liable to be prosecuted for an offence under Chapter 20 of the Patents Regulations if the act or omission constituting the offence occurred in New Zealand. The New Zealand legislation enabling the single patent attorney regime in New Zealand provides offences for conduct in New Zealand that are equivalent to those provided under Chapter 20 of the Patents Regulations. Such offences in New Zealand are subject to prosecution by the authorities in New Zealand.

Items 9–12 make various amendments to existing definitions set out in regulation 20.1 of the Patents Regulations.

Item 9 removes a redundant paragraph number.

Item 10 repeals the definition of the Professional Standards Board for Patent and Trade Marks Attorneys ('the Board') in regulation 20.1 of the Patents Regulations. The Board is succeeded by the new Trans-Tasman IP Attorneys Board which is established on commencement of Schedule 4 to the IP Laws Amendment Act.

Item 11 inserts a new definition of the term “Board Chair” into regulation 20.1 of the Patents Regulations. “Board Chair” means the Chair of the Board mentioned in paragraph 227A(2A)(a) of the Patents Act inserted by Schedule 4 to the IP Laws Amendment Act.

Item 12 repeals the definition of Chairperson in regulation 20.1 of the Patents Regulations, which is no longer required.

Requirements for registration as a patent attorney

Item 13 inserts a definition of the acronym “NZQF” into regulation 20.1 of the Patents Regulations. “NZQF” is defined as the New Zealand Qualifications Framework established under section 248 of the *Education Act 1989* of New Zealand, as in force at the commencement of this definition. The NZQF is equivalent to the Australian Qualifications Framework (‘AQF’). The AQF regulates qualifications in the Australian education and training system. In conjunction with the amendment to regulation 20.6 (discussed at items 16 and 17), this amendment allows the Board to take into account qualifications which have been obtained in either Australia or New Zealand when determining if a person may be registered as a patent attorney.

Item 14 repeals the definition of “higher education sector” in subregulation 20.1(2) of the Patents Regulations. This definition is no longer required, as a result of amendments to regulation 20.6 of the Patents Regulations (discussed at items 16 and 17), which now allows suitable qualifications from vocational education providers, as well as from universities.

Item 15 removes the requirement in paragraph 20.3(1)(a) of the Patents Regulations that an applicant for registration as a patent attorney must provide evidence that he or she is ordinarily resident in Australia. This provision is no longer required as a result of the repeal of paragraph 198(4)(a) of the Patents Act on commencement of Schedule 4 to the IP Laws Amendment Act.

Item 16 amends paragraph 20.6(1)(a) by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF, or NZQF, qualification”. This is intended to make it clear that a qualification may be obtained from a university *or* a vocational education provider, provided that the qualification is at least level 5 or above. There is no disadvantage to applicants from either Australia or New Zealand, as the AQF and NZQF are aligned.

Item 17 amends paragraph 20.6(1)(b) by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF, or NZQF, qualification”. This is intended to make it clear that a qualification may be obtained from an overseas university or vocational education provider, provided that the qualification is equivalent to at least level 5 or above of the AQF or NZQF.

Item 18 adds the term “or NZQF” following references to the AQF in regulation 20.6 of the Patents Regulations. This ensures that New Zealand applicants for registration as a patent attorney are subject to the same academic qualification requirements as Australian applicants.

Items 19–24 amend the employment requirements that applicants for registration as a patent attorney must meet under regulation 20.10 of the Patents Regulations.

Item 19 amends paragraph 20.10(1)(a) to provide that the employment must have been in Australia, New Zealand, or both countries. The purpose is to ensure that a prospective attorney has experience that is relevant to the Australian and New Zealand situation, including dealing with the unique needs of clients in these countries.

Item 20 amends subparagraph 20.10(1)(a)(ii) to replace the requirement that the applicant must have experience in preparing, filing, and prosecuting patent applications in Australia; the new requirement is that relevant experience must be “in relation to Australia and New Zealand” applications. This ensures that applicants have the required level of experience to practice before the Patent Offices of both Australia and New Zealand.

Item 21 amends subparagraph 20.10(1)(a)(iii) by omitting the words “in other” and substituting “in relation to the other” so that the applicant must have experience in preparing, filing, and prosecuting patent applications in relation to other countries. This is intended to make it clear that an applicant needs experience only in prosecuting patent applications filed in other countries, rather than suggesting that the applicant must have experience working in other countries.

Item 22 amends subparagraph 20.10(1)(a)(iii) to refer to countries and organisations that are major trading partners with both Australia *and* New Zealand, rather than just Australia. This ensures that applicants for registration as a patent attorney have suitable experience of overseas prosecution to allow them to serve the needs of clients in both Australia and New Zealand.

Item 23 repeals and substitutes the example of major trading partners in subregulation 20.10(1) so that it correctly refers to the European Union, rather than the European Community. It also replaces a reference to New Zealand with a reference to Korea, an increasingly major trading partner of both Australia and New Zealand.

Item 24 inserts new subregulations into regulation 20.10 to define the terms “employed in Australia” and “employed in New Zealand”.

New subregulation 20.10(3) provides that a person is “employed in Australia” only if the person is, in accordance with the terms of his or her employment, required to undertake (and does undertake) the duties of his or her employment in Australia. The intention of this amendment is to ensure that the person undertakes the employment within the geographical boundaries of Australia.

New subregulation 20.10(4) applies an equivalent definition to employment undertaken in New Zealand.

Item 25 repeals subregulation 20.12(1) of the Patents Regulations, and substitutes a new provision extending the offences which may prevent an applicant from being registered as a patent attorney to include offences against the intellectual property legislation of New Zealand. The new provision also includes offences under the plant breeder’s rights legislation of both countries, which ensures that all relevant Acts are included.

Trans-Tasman IP Attorneys Disciplinary Tribunal: establishment, constitution and procedures

Items 26 and 27 amend regulation 20.28B of the Patents Regulations to update references as a result of the constitution of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, which is composed of a panel rather than a single member as the former Disciplinary Tribunal was.

Item 26 amends paragraph 20.28B(4)(c) by replacing a reference to the former Disciplinary Tribunal with a reference to “a Panel of” the Disciplinary Tribunal.

Item 27 amends paragraph 20.28B(5)(c) by replacing a reference to the Disciplinary Tribunal with a reference to “the President” of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 28 amends subregulations 20.35(1) and (3) of the Patents Regulations to omit references to the former Disciplinary Tribunal and replaces them with references to the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal. Under the new arrangements, it is the President who receives notice of the commencement of proceedings and notifies the registered patent attorney.

Item 29 repeals regulation 20.36 of the Patents Regulations (which set out procedures for the former Disciplinary Tribunal) and inserts new provisions to govern the constitution and procedure of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

New regulation 20.36 provides that, except as otherwise provided, the powers and functions of the Trans-Tasman IP Attorneys Disciplinary Tribunal are to be exercised by a Panel of that Tribunal. A Panel consists of a Panel Chair, and two other members, as determined by the Panel Chair. At least one member of the Panel (the Panel Chair or another member) must be ordinarily resident in the same country as the registered patent attorney who is the subject of the disciplinary proceedings, to ensure that at least one member of the panel has experience of professional practice under similar circumstances to the registered patent attorney who is the subject of disciplinary proceedings (this requirement is subject to new subregulation 20.36E(5), discussed below).

New regulation 20.36A provides that the Panel Chair must convene such meetings as the Panel Chair considers necessary, and preside at all meetings of the Panel. All members of a Panel must be present at its meeting and questions are to be decided by a majority vote. If the Panel is reduced in number (in accordance with paragraph 20.36D(2)(a) or subregulation 20.36E(5)), then questions must be decided by a unanimous vote. In the absence of agreement between the Panel members there is no decision.

New regulation 20.36B sets out the procedures of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal. These procedures are essentially equivalent to those of the former Disciplinary Tribunal in repealed regulation 20.36.

New regulation 20.36C provides that, if the Panel Chair ceases to be available to complete the hearing of a particular matter before it has been determined, then the matter must be re-heard by a new Panel constituted in accordance with regulation 20.36. The new Panel may have regard to the record of proceedings of the earlier Panel for the purpose of completing the proceedings.

New regulation 20.36D provides that if a member of the Panel (other than the Panel Chair) ceases to be available, then, subject to regulation 20.36E, the Panel Chair may determine:

- that the matter is to be completed by the remaining members of the Panel; or
- that the matter is to be reheard by a new Panel constituted in accordance with regulation 20.36.

The new Panel may have regard to the record of proceedings of the earlier Panel for the purpose of completing the proceedings.

New regulation 20.36E sets out the procedure to occur if—before a particular matter has been determined—a member of the Panel (other than the Panel Chair) ceases to be available, and as a result neither of the remaining members is ordinarily resident in the same country as the registered patent attorney. In this circumstance, this regulation provides that the Panel Chair must notify the patent attorney of the situation and advise that the patent attorney may elect to continue the proceedings before the remaining Panel members, or have the matter reheard by a new Panel constituted in accordance with regulation 20.36.

If the Panel Chair does not receive a response from the patent attorney within the period specified in the notice, then the Panel Chair must arrange for the matter to be reheard by a new Panel constituted in accordance with regulation 20.36. The new Panel may have regard to the records of the earlier Panel for the purpose of completing the proceedings.

This new regulation avoids disadvantaging a patent attorney who is the subject of disciplinary proceedings, while also ensuring that proceedings are not unreasonably drawn out in cases where a panel no longer has a member who is ordinarily resident in the same country as the registered patent attorney.

Item 30 repeals subregulations 20.37(1) and (2) of the Patents Regulations, which governed the former Disciplinary Tribunal's notification of a hearing of disciplinary proceedings. New subregulation 20.37(1) establishes that it is the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal who fixes a time and place for the hearing, and notifies the registered patent attorney and the Board of the hearing.

Items 31–47 and 51 amend regulations 20.38, 20.39, 20.40 and 20.41 of the Patents Regulations, and the headings thereto, to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 48 amends subparagraph 20.41(3)(a)(iii) of the Patents Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 to the Regulations. This provides a clear basis for setting the levels of expenses and allowances.

Item 49 repeals paragraph 20.41(3)(b) of the Patents Regulations. It is no longer required, because the amendment made by item 48 makes it unnecessary for expenses and allowances to be determined by the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 50 consequentially amends paragraph 20.41(4)(b) of the Patents Regulations in light of items 48 and 49, so that it correctly refers to subparagraph 20.41(3)(a)(iii).

Items 52–54 make amendments to regulation 20.42 of the Patents Regulations, which provided protection and immunity from prosecution for the former Disciplinary Tribunal in the performance of its duties. The amendments expand the protections so that they cover all members of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 52 repeals the heading “Protection of person constituting Disciplinary Tribunal, witnesses, etc.” to regulation 20.42 of the Patents Regulations and replaces it with “20.42 Protection of certain persons”.

Item 53 repeals the former Disciplinary Tribunal’s immunity provision in subregulation 20.42(1) and replaces it with an equivalent provision which refers to members of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than to the former Disciplinary Tribunal.

Item 54 amends subregulations 20.42(3) and 20.42(4) to insert a reference to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 55 repeals the heading “Decision of Disciplinary Tribunal” to regulation 20.43 of the Patents Regulations and replaces it with “Decision of Panel of Disciplinary Tribunal”.

Items 56–73 amend regulations 20.43, 20.44, 20.45, 20.46, and 20.47 of the Patents Regulations so that they correctly refer to decisions which are made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 74 repeals regulation 20.48 of the Patents Regulations and substitutes a new regulation 20.48, which allows a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against a registered patent attorney. These could be in disciplinary proceedings under the current regulations, or in proceedings under the former attorneys regulations (that expression is defined by item 2).

Items 75–87 amend regulations 20.49, 20.50, 20.51 and 20.52 of the Patents Regulations, and the headings thereto, to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole. In particular, these amendments ensure that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal which notifies the attorney and publishes the findings of the Panel.

Administration of the Trans-Tasman IP Attorneys Board

Item 88 repeals the heading “Division 1 – Professional Standards Board for Patent and Trade Marks Attorneys” in Part 10 of Chapter 20 of the Patents Regulations, and replaces it with the new heading “Division 1 – Trans-Tasman IP Attorneys Board” (“the Board”), which is renamed on commencement of Schedule 4 to the IP Laws Amendment Act.

Item 89 repeals regulation 20.54 (constitution of the Board) and regulation 20.55 (term of office for Board members) of the Patents Regulations, as they are no longer required. Item 41 of Schedule 4 to the IP Laws Amendment Act inserts new subsections 227A(2A)–(2M) of the Patents Act, setting out the constitution of the Trans-Tasman IP Attorneys Board.

Item 90 amends subregulation 20.56(1) of the Patents Regulations so that it refers to the members of the Board—that is, those mentioned in new paragraphs 227A(2A)(a),(d), and (e)

of the Patents Act inserted by item 41 of Schedule 4 to the IP Laws Amendment Act—who may resign by giving the Minister their resignation in writing.

Item 91 amends subregulation 20.56(2) of the Patents Regulations to omit a reference to the removal of the Chairperson of the Board, and substitutes a new reference to terminating the appointment of the Board Chair. This new terminology is established on commencement of Schedule 4 to the IP Laws Amendment Act.

Item 92 amends paragraph 20.56(2)(a) of the Patents Regulations to remove an obsolete reference to regulation 20.60.

Item 93 amends paragraph 20.56(2)(b) of the Patents Regulations to include a reference to New Zealand, so that it refers to a person who has been convicted of an offence in Australia or New Zealand. This ensures that persons ordinarily resident in New Zealand are not able to serve on the Board if convicted of a crime in New Zealand, equivalent to the treatment of members of the Board ordinarily resident in Australia.

Item 94 amends paragraphs 20.56(2)(c) and (e) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 95 amends subregulation 20.56(3) to omit a reference to the removal of the Chairperson of the Board, and substitutes a new reference terminating the appointment of a member of the Board mentioned in paragraph 227A(2A)(d) or (e) of the amended Patents Act.

Item 96 amends paragraph 20.56(3)(a) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 97 amends paragraph 20.56(3)(b) of the Patents Regulations to include a reference to New Zealand, so that it refers to a person who has been convicted of an offence in Australia or New Zealand. This ensures that persons ordinarily resident in New Zealand are not able to serve on the Board if convicted of a crime in New Zealand, equivalent to the treatment of members of the Board ordinarily resident in Australia.

Item 98 amends subregulation 20.57(2) of the Patents Regulations to substitute a reference to the “Chairperson” with a reference to the “Board Chair”.

Item 99 amends subregulations 20.58(1),(2), and (3) of the Patents Regulations to substitute references to the “Chairperson” with references to the “Board Chair”.

Items 100 and 101 amend regulation 20.59 of the Patents Regulations to provide that, at a meeting of the Board, a quorum is formed by the majority of the members of the Board. Furthermore, at least one member of the majority must be ordinarily resident in Australia, and another must be ordinarily resident in New Zealand. This is to ensure that decisions of the Board cannot be taken without at least one member representing each country’s interests.

Item 102 repeals regulation 20.60 of the Patents Regulations, as it is no longer required.

Administration of the Trans-Tasman IP Attorneys Disciplinary Tribunal

Item 103 repeals the heading “Establishment of Disciplinary Tribunal” in Division 2, Part 10 of Chapter 20 and substitutes a new heading “Division 2 – Trans-Tasman IP Attorneys Disciplinary Tribunal”.

Item 104 repeals regulation 20.61 of the Patents Regulations and substitutes a new provision establishing the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 105 inserts new regulation 20.61A into the Patents Regulations. This provision sets out that the functions of the Trans-Tasman IP Attorneys Disciplinary Tribunal are to hear and determine disciplinary proceedings commenced by the Board against registered patent or trade marks attorneys.

Item 106 repeals the heading “Disciplinary Tribunal – substantive appointments” to regulation 20.62 of the Patents Regulations and substitutes the new heading “Membership of the Disciplinary Tribunal etc.”.

Item 107 repeals subregulation 20.62 of the Patents Regulations and substitutes a new provision, which provides that the Trans-Tasman IP Attorneys Disciplinary Tribunal consists of a President and at least two other members. This is to ensure that there are at least three members of the Tribunal, sufficient to form a Panel when one is required (new regulation 20.36 inserted by item 29). All members will be appointed on a part-time basis by the Minister.

Items 108–110 and 112 amend subregulations 20.62(3)–(6) of the Patents Regulations by omitting expressions such as “person so appointed” and “remove a person so appointed from office”, and substituting expressions such as “Tribunal member” and “terminate the appointment of a Tribunal member”, to reflect that the Trans-Tasman IP Attorneys Disciplinary Tribunal is composed of multiple people.

Item 111 inserts a reference to New Zealand into paragraph 20.62(6)(b) of the Patents Regulations so that a person who has been convicted of an offence in New Zealand must have his or her appointment as a Tribunal member terminated. This ensures that persons ordinarily resident in New Zealand are not able to serve on the Trans-Tasman IP Attorneys Disciplinary Tribunal if convicted of a crime in New Zealand, equivalent to the treatment of members of the Tribunal ordinarily resident in Australia.

Item 113 repeals regulations 20.63, 20.64, and 20.65 of the Patents Regulations, and substitutes new provisions governing the eligibility and appointment of members to the Trans-Tasman IP Attorneys Disciplinary Tribunal.

New regulation 20.63 sets out the eligibility requirements for appointment as a member of the Trans-Tasman IP Attorneys Disciplinary Tribunal, including the appointment of the President of the Tribunal. A person is not eligible to be appointed as President unless the person is currently enrolled as a legal practitioner in Australia or New Zealand, and has been enrolled for at least seven years. This is equivalent to the experience requirement for the former single-member Disciplinary Tribunal.

A person is not eligible to be appointed as a Tribunal member (other than the President) unless the person has at least five years of appropriate professional registration or enrolment before being appointed:

- this could be at least five years registration as a patent attorney in Australia or New Zealand, or as a trade marks attorney in Australia. A person who had this period of registration does not need to be registered at the date of appointment. This allows patent and trade marks attorneys who have retired from practice to be appointed as Tribunal members (other than as the President); or

- this could be at least five years enrolment as a legal practitioner in Australia or New Zealand. At the date of appointment, the person must be enrolled as a legal practitioner and be registered as a patent or trade marks attorney. This allows a legal practitioner, who goes on to obtain registration as a patent or trade marks attorney, to be appointed as a Tribunal member (other than the President) without having to wait a further five years. For example, a legal practitioner might have many years of experience in trade marks law, but only be newly registered as a trade marks attorney. Such a person is immediately eligible to be a Tribunal member (other than as the President).

New regulation 20.63A provides that the Minister may appoint a person to act as President of the Tribunal during a vacancy, absence of duty, or if the President is otherwise unable to perform his or her duties. A person so appointed to be Acting President is subject to the same eligibility requirements as the President.

New regulation 20.63B allows for the appointment of acting Tribunal members (other than the President) in the same circumstances. The acting Tribunal members must likewise meet the same eligibility requirements as Tribunal members (other than the President).

New regulation 20.64 provides that if the President or another Tribunal member discovers a conflict of interest that could interfere with the performance of his or her duties or functions, then that person must tell the parties to the proceeding about the interest and must not perform the duties or functions without consent of the parties.

In the event of a conflict of interest by the President, the Minister may appoint another person to act as the Panel Chair. If an ordinary member discloses a conflict of interest, then the Panel Chair may appoint another member to the Panel for the proceedings.

Incorporated patent attorneys: general operation of regulations

Item 114 inserts new regulations 20A.1A and 20A.1B into the Patents Regulations. (All regulations in Chapter 20A, and amendments to Chapter 20A, relate to incorporated patent attorneys). The purpose of these regulations is to ensure that the regulation of incorporated patent attorneys in New Zealand can take place under the Patents Regulations without any jurisdictional issues.

New regulation 20A.1A provides that a function or power conferred under Chapter 20A of the Patents Regulations may be exercised in either Australia or New Zealand. It is immaterial whether an act, omission or other matter mentioned in Chapter 20A occurred in, or relates to something that occurred in, New Zealand. This is subject to new regulation 20A.1B.

New regulation 20A.1B provides that a person is not liable to be prosecuted for an offence against these Regulations if the act or omission occurred in New Zealand. The New Zealand legislation enabling the single patent attorney regime in New Zealand provides offences for conduct in New Zealand that are equivalent to those provided under Chapter 20A of the Patents Regulations. Such offences in New Zealand are subject to prosecution by the authorities in New Zealand.

Item 115 amends subparagraph 20A.3(b)(ii) of the Patents Regulations by inserting a reference to the *Companies Act 1993* of New Zealand, so that an application for registration of an incorporated patent attorney must provide evidence of registration as a company in either Australia or New Zealand.

Incorporated patent attorneys: discipline

Item 116 amends paragraph 20A.10(1)(a) of the Patents Regulations to omit the words “is found guilty” and substitutes “has, at any time” been found guilty. This is so any previous findings of professional misconduct can be taken into account.

Item 117 repeals paragraph 20A.10(1)(c) of the Patents Regulations and substitutes a new paragraph. The new provision removes a reference to the suspension or cancellation of a patent attorney’s registration by the former Disciplinary Tribunal for professional misconduct, and replaces it with a reference to the cancellation of the registration of the patent attorney under subregulation 20.44(1) (‘Penalties – professional misconduct’). This is to ensure that any finding of professional misconduct may be used in an application to cancel or suspend an incorporated patent attorney’s registration, regardless of whether the finding was made by the former Disciplinary Tribunal or by the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 118 corrects a typographical error by omitting a reference to “an incorporated” patent attorney in subregulation 20A.10(2) of the Patents Regulations and replacing it with a reference to “the incorporated” patent attorney.

Item 119 adds a new paragraph to subregulation 20A.10(4) of the Patents Regulations so that it is clear that the Board must send the application for cancellation or suspension of an incorporated attorney’s registration to the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 120 repeals regulation 20A.11 of the Patents Regulations and substitutes new regulations 20A.11–20A.11E, which govern disciplinary proceedings for incorporated patent attorneys.

These provisions mirror those for individual attorneys in new regulations 20.36–20.36E (discussed at item 29), with minor differences in order to manage proceedings for an incorporated patent attorney, rather than an individual registered patent attorney.

New subregulations 20A.11(1–4) have the same effect as those for constituting panels for individual attorneys in regulation 20.36 (item 29). Subregulation 20A.11(4) provides that a Panel must include at least one member (the Panel Chair or another member) who is ordinarily resident in the country in which the incorporated patent attorney is registered, to ensure that at least one member of the panel has experience of professional practice under similar circumstances to the incorporated patent attorney which is the subject of disciplinary proceedings. This requirement is subject to new subregulation 20A.11E(5).

New regulations 20A.11A–20A.11D have the same effect as regulations 20.36A–20.36D.

New regulation 20A.11E is identical to regulation 20.36E, except that regulation 20A.11E refers to the country in which the incorporated patent attorney is registered (as a company).

Item 121 repeals subregulations 20A.12(1) and (2) of the Patents Regulations and substitutes a new provision as per item 30 but with reference to an incorporated patent attorney, rather than an individual patent attorney.

Items 122–137 and 141 amend regulations 20A.13, 20A.14, 20A.15 and 20A.16 of the Patents Regulations, and the headings thereto, to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole as appropriate throughout those regulations.

Item 138 amends subparagraph 20A.16(3)(a)(iii) of the Patents Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 to the Regulations. This makes the provision consistent with amended subparagraph 20.41(3)(a)(iii), which relates to individual patent attorneys (item 48).

Item 139 repeals paragraph 20A.16(3)(b) of the Patents Regulations, as it is no longer required as a result of the amendment made by item 138.

Item 140 consequentially amends paragraph 20A.16(4)(b) in light of items 138 and 139 so that it correctly refers to subparagraph (3)(a)(iii).

Items 142–144 amend regulation 20A.17 of the Patents Regulations, which provided protection and immunity from prosecution for the former Disciplinary Tribunal in the performance of its duties. The amendments expand the protections so that they cover all members of the Trans-Tasman IP Attorneys Disciplinary Tribunal, and mirror those for individual attorneys in amended regulation 20.42 (discussed at items 52–54).

Item 145 repeals the heading “Decision of Disciplinary Tribunal” to regulation 20A.18 of the Patents Regulations and replaces it with “Decision of Panel of Disciplinary Tribunal”.

Items 146–148 amend regulation 20A.18 of the Patents Regulations so that it correctly refers to decisions made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 149 repeals paragraphs 20A.18(3)(d) and (e) of the Patents Regulations, and substitutes new paragraphs 20A.18(3)(d) and (e) which allow a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against an incorporated attorney or its employees or officers in any other proceedings before a relevant disciplinary tribunal.

Item 150 inserts a new subregulation (4) into regulation 20A.18 of the Patents Regulations to define the term “relevant disciplinary tribunal”. This term is defined to mean the former Disciplinary Tribunal established by regulation 20.61, as in force prior to the commencement of this regulation, or any transitional proceedings before that tribunal. The definition also includes the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 as in force on commencement of this regulation. Items 149 and 150 together ensure that any previous findings may be considered by the Tribunal regardless of whether the previous finding was made by the former Disciplinary Tribunal or by the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Items 151–160 amend regulations 20A.19 and 20A.20 of the Patents Regulations, and the headings thereto, to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole as appropriate throughout those regulations. In particular, these amendments ensure that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal which notifies the incorporated attorney and publishes the findings of the Panel.

Item 161 amends subparagraph 20A.22(2)(b)(ii)—the first occurring—of the Patents Regulations to insert a reference to the *Companies Act 1993* of New Zealand, so that an incorporated patent attorney that is a company registered in New Zealand is able to have its name restored to the Register of Patent Attorneys (‘Register’).

Item 162 corrects a numbering error by amending the second occurring subparagraph 20A.22(2)(b)(ii) by omitting the reference “(ii) evidence”, and substituting “(iii) evidence”.

Administration and address for service

Items 163–167 amend regulation 22.10 of the Patents Regulations to provide that an address for service can be in New Zealand. Subregulation 22.10(5) provides that service by post is a prescribed means of service of documents for the purpose of subsection 221(1) of the Patents Act. As with items 4–7, this allows persons in New Zealand to provide a postal address for service there, without having to maintain an Australian address for service (as they previously had to).

Item 168 repeals paragraphs 22.13(c) and (d) of the Patents Regulations and substitutes new provisions which include the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal and the Board in the list of persons to whom declarations in electronic form may be given.

Items 169 and 170 amend paragraph 22.26(2)(d) of the Patents Regulations to replace references to the former Disciplinary Tribunal with references to a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Transitional arrangements for attorney registration and disciplinary proceedings

Item 171 inserts a new Part 3 in Chapter 23 of the Patents Regulations, which governs transitional arrangements for amendments in Schedule 1 to the Regulation and prescribes several matters required under the transitional provisions in Part 2 of Schedule 4 to the IP Laws Amendment Act.

New regulation 23.38 defines terms used in Part 3 of Chapter 23 of the Patents Regulations.

“Commencement day” means the day on which Schedule 4 to the IP Laws Amendment Act commences. This ties the operation of several of the transitional provisions to the commencement of the Act changes that empower their making.

The term “old regulations” means the Patents Regulations as in force immediately before the commencement day.

New regulation 23.39 prescribes the limited circumstances in which the name of a patent attorney registered in New Zealand must be removed from the Register for

misconduct before the commencement day. The Designated Manager must remove an individual's name from the Register if:

- the individual was registered as a patent attorney in New Zealand;
- on or after the commencement day, the New Zealand Commissioner of Patents advises the Designated Manager that a New Zealand court has determined that the person should not practise as a patent attorney;
- the conduct giving rise to the court's determination occurred before the commencement day; and
- all rights of appeal have been exhausted or expired.

All New Zealand registered attorneys are automatically moved to the Register upon commencement (item 81 in Schedule 4 to the IP Laws Amendment Act)—making it the single trans-Tasman register of patent attorneys. The purpose of new regulation 23.29 is to ensure that New Zealand attorneys later found to be unfit to practise due to conduct occurring before commencement day can be removed from the Register.

New regulation 23.40 provides that, for the purpose of paragraph 198(4)(g) of the Patents Act—which governs patent attorney registration, and management of the Register—if an individual from New Zealand has had his or her name removed from the Register under new regulation 23.39, then the Designated Manager can restore the name to the Register only after receiving written advice from the New Zealand Commissioner of Patents that a court in New Zealand has determined that the name can be entered in the Register. This is consequential to the previous amendment and ensures that a removed attorney may be restored in appropriate circumstances.

New regulation 23.41 prescribes the transitional arrangement by which applicants for registration in New Zealand who have already commenced their qualifying examinations may register as a patent attorney under the new trans-Tasman regime. There is a four year period during which transitional candidates are able to seek registration relying on those examinations (subitem 82(1) in Schedule 4 to the IP Laws Amendment Act). If an applicant has passed all of the specified New Zealand examinations, at least one of which was passed before the commencement day, and the remainder of the examinations were passed within four years from the commencement day, then the applicant is able to seek registration as a patent attorney. The applicant is also required to meet the usual requirements for registration set out in section 198 of the Patents Act (as modified by item 82 of Schedule 4 to the IP Laws Amendment Act and subregulation 23.41(2)).

This provision ensures that individuals in New Zealand who commenced their examinations under the previous arrangements are not disadvantaged by the implementation of the new Trans-Tasman regime.

New regulation 23.42 provides for the continuation of disciplinary proceedings against a registered patent attorney which were commenced, but had not been completed, before the commencement day. In these circumstances, the proceedings continue before the former Disciplinary Tribunal and in accordance with the old regulations (defined in new regulation 23.38). The Minister may, if necessary, appoint a person under regulation 20.63 or 20.64 of the old regulations, for the purpose of completing the proceedings.

New regulation 23.43 makes the same provision as in regulation 23.42 for the continuation of disciplinary proceedings against incorporated patent attorneys.

New regulation 23.44 provides that the Minister must, in writing, terminate the appointment of the person constituting the former Disciplinary Tribunal conducting any transitional proceedings, as soon as is practicable after the Minister is satisfied that all such proceedings (including all appeals) have been completed.

New regulation 23.45 ensures that applicants who commence, or propose to commence, a course of study with a view to applying for an exemption to the knowledge requirements, are not disadvantaged when the single patent attorney regime commences. Accordingly, new regulation 23.45 provides that, if an applicant for registration as a patent attorney has, before 1 January 2018:

- passed a course of study that has outcomes that are the same as, or similar to, those of a knowledge requirement mentioned in Schedule 5 to the old regulations: and
- has passed the course at a satisfactory level;

then the applicant may still apply for an exemption to the knowledge requirement under regulation 20.9 of the Patents Regulations. A course of study is not a degree program, but an individual subject (for example, a one-semester introduction to Australian legal institutions and processes).

This means that Schedule 5 to the old regulations has some limited ongoing effect for the purpose of the Board making a decision to grant an exemption to the applicant under regulation 20.9. This is the case, even after Schedule 5 to the old regulations is amended by Schedule 1 to the Regulation.

Amendments to knowledge requirements

Item 172 repeals Clause 2 of Part 2 of Schedule 5 to the Patents Regulations, which sets out the knowledge requirements regarding legal process and overview of intellectual property required by an applicant for registration as a patent attorney. A new provision is substituted, which includes a reference to the legal system of New Zealand. The new provision provides that a course of study must have provided for a student to have an appropriate level of understanding of both the Australian and New Zealand legal systems, and how intellectual property rights may be protected. This ensures that following commencement, registered patent attorneys have sufficient knowledge of the relevant legal environment for both jurisdictions.

Item 173 amends Clause 5 of Part 5 of Schedule 5 to the Patents Regulations to include a reference to New Zealand's systems of protecting and exploiting trade marks, patents, and designs, as well as the systems in Australia and other countries.

Item 174 repeals the note at Schedule 8 to the Patents Regulations (note to Schedule heading) and substitutes a new note to provide correct references to subregulations 20.41(3) and 20A.16(3).

Schedule 2 – Single economic market amendments relating to trade marks

Schedule 2 amends several provisions of the Trade Marks Regulations governing trade marks attorney registration (including transitional registration) and disciplinary proceedings for trade marks attorneys. Schedule 2 also amends the Trade Marks Regulations to allow a postal address for service to be in either Australia or New Zealand. This gives effect to amendments made to the Trade Marks Act by Schedule 4 to the IP Laws Amendment Act, and is also a consequence of the amendments made to the Patents Regulations by Schedule 1 to the Regulation.

General operation of regulations

Items 1–3 amend regulation 2.1 of the Trade Marks Regulations to repeal definitions which are no longer required, and insert new definitions used in the amendments to the Trade Marks Regulations.

Item 1 repeals the definition of “Board”.

This definition is no longer required as a result of the amendment made by item 70 of Schedule 4 to the IP Laws Amendment Act, which amends subsection 6(1) of the Trade Marks Act to define “Board” as having the same meaning as in the Patents Act (that is, the Trans-Tasman IP Attorneys Board continued in existence by section 227A of the Patents Act).

Item 2 repeals the definition of “Disciplinary Tribunal” and substitutes:

Disciplinary Tribunal means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 of the *Patents Regulations 1991*.

This new Disciplinary Tribunal replaces the previously-existing Patent and Trade Marks Attorney Disciplinary Tribunal (‘the former Disciplinary Tribunal’).

Item 3 inserts the following definitions:

Panel Chair, in relation to a Panel of the Disciplinary Tribunal, means:

- (a) the President; or
- (b) if the President is unable to perform his or her functions in proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) of the *Patents Regulations 1991* to be the Panel Chair for the proceedings.

Panel of the Disciplinary Tribunal means a Panel constituted under regulation 20A.11.

President means the President of the Disciplinary Tribunal.

Items 4–11 amend paragraphs and subregulations 17A.16(3)(b), 17A.17(3), 17A.34H(2), 17A.34H(5), 17A.37(3), 17A.42B(1)(a), 17A.48H(2) and 17A.50(5) to insert references to New Zealand, so that references to an address for service include an address for service in

either Australia or New Zealand. This allows persons in New Zealand to provide a postal address for service there, without having to maintain an Australian address for service (as they previously had to).

Item 12 repeals subregulation 17A.74(2) and substitutes a new provision providing that an address for the service of documents under the Trade Marks Act or Trade Marks Regulations must be an address in either Australia or New Zealand. The address must be one to which it is practicable and reasonable for a person providing mail delivery services to deliver mail.

Item 13 removes a redundant paragraph number.

Requirements for registration

Item 14 repeals the definition of “higher education sector” in subregulation 20.1(2) of the Trade Marks Regulations. This definition is no longer required as a result of amendments to regulation 20.6 of the Trade Marks Regulations (discussed at item 15).

Item 15 repeals paragraph 20.6(a) of the Trade Marks Regulations, and substitutes a new paragraph which provides that an academic qualification must be a Level 5 AQF qualification or higher. This is intended to make it clear that a qualification may be obtained from a university *or* vocational education provider, provided that the qualification is equivalent to at least Level 5 or above of the AQF.

Item 16 amends paragraph 20.6(b) of the Trade Marks Regulations by omitting the words “an AQF qualification from the higher education sector” and substituting “a level 5 or higher AQF qualification”. This is intended to make it clear that a qualification may be obtained from an overseas university *or* a vocational education provider, provided that the qualification is at least Level 5 or above.

Item 17 amends regulation 20.11 of the Trade Marks Regulations, which governs the requirements that applicants must meet when applying for their initial registration as a trade marks attorney.

Regulation 20.11 of the Trade Marks Regulations applies the knowledge requirements in Schedule 5 to the Patents Regulations, with necessary modifications for applicants seeking registration as a trade marks attorney. While this continues in general to be a satisfactory arrangement for setting out the knowledge requirements, some of the amendments to Schedule 5 to implement the new trans-Tasman patent attorney regime should not be applied to applicants for registration as a trade marks attorney. This is because the new trans-Tasman patent attorney regime does not extend to trade marks attorneys—there is not a joint trade marks attorney regime with New Zealand.

To allow regulation 20.11 of the Trade Marks Regulations to continue incorporating the relevant parts of the Patents Regulations, while excluding requirements which should apply only to patent attorneys, an amendment is required to the Trade Marks Regulations.

Accordingly, this item amends regulation 20.11 of the Trade Marks Regulations to preserve the knowledge requirements for trade marks attorneys as they were before commencement of Schedule 1 to the Regulation, rather than incorporating references to the legal system and intellectual property systems of New Zealand (at Schedule 1, item 172). This amendment also

preserves the knowledge requirement that an applicant must have a sufficient understanding of the system for protecting and exploiting trade marks in Australia, and in other countries.

This ensures that applicants for registration as a trade marks attorney, and universities seeking accreditation for a course in trade marks law and/or practice, legal process, or intellectual property, can continue to meet the same knowledge requirements as they did before commencement of Schedule 1 to the Regulation.

Trans-Tasman IP Attorneys Disciplinary Tribunal, and Trans-Tasman IP Attorneys Board

Item 18 amends regulation 20.15 of the Trade Marks Regulations by inserting new paragraphs (f) to (i). The effect of these paragraphs is to omit references to the Patents Regulations, such that a registered trade marks attorney who is the subject of disciplinary proceedings is not entitled to have a Panel member who is ordinarily resident in the same country as the trade marks attorney.

This is in contrast to the Patents Regulations. If a registered patent attorney who is ordinarily resident in New Zealand is subject to disciplinary proceedings, then the Panel must have at least one member who is ordinarily resident in New Zealand (at Schedule 1, item 29, new regulation 20.36).

These differences between the Trade Marks Regulations and the Patents Regulations are because there is not a joint trade marks attorney regime with New Zealand.

Item 19 amends paragraph 20A.10(1)(a) of the Trade Marks Regulations to omit the words “is found guilty of professional misconduct under Division 5 of Part 20” and substitutes “has, at any time, been found guilty of professional misconduct in accordance with Division 6 of Part 20”. This corrects the incorrect reference to Division 5, and makes it clear that previous findings of professional misconduct can be taken into account.

Item 20 repeals paragraph 20A.10(1)(c) of the Trade Marks Regulations and substitutes a new paragraph, so that it correctly refers to the cancellation or suspension of a trade marks attorney’s registration under Division 6 of Part 20 of the Trade Marks Regulations, rather than to cancellation or suspension by the former Disciplinary Tribunal.

Item 21 omits a reference to “an incorporated” trade marks attorney in subregulation 20A.10(2) of the Trade Marks Regulations and replaces it with a reference to “the incorporated” trade marks attorney.

Item 22 adds a new paragraph to subregulation 20A.10(4) of the Trade Marks Regulations so that it is clear that the Board must send the application for cancellation or suspension of an incorporated attorney’s registration to the President of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 23 repeals regulation 20A.11 of the Trade Marks Regulations and substitutes new regulations 20A.11–20A.11D. These provisions mirror those for incorporated patent attorneys in new regulations 20.36–20.36D of the Patents Regulations (Schedule 1, item 120), except that an incorporated trade marks attorney which is the subject of disciplinary proceedings is not entitled to have a Panel member who is ordinarily resident in the same country in which the incorporated trade marks attorney is registered. These differences

between the Trade Marks Regulations and the Patents Regulations are because there is not a joint trade marks attorney regime with New Zealand.

Item 24 repeals subregulations 20A.12(1) and (2) of the Trade Marks Regulations and substitutes a new provision, so that it is clear that it is a Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal who must organise the hearing of the disciplinary proceedings, and notify the Board and the incorporated trade marks attorney accordingly.

Items 25–28 amend regulation 20A.13 of the Trade Marks Regulations to replace references to the former Disciplinary Tribunal with references to a Panel or the Panel Chair of the new Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 29 repeals the heading “Representation before Disciplinary Tribunal” to regulation 20A.14 of the Trade Marks Regulations and substitutes the new heading “Representation before a Panel of Disciplinary Tribunal”.

Items 30–32 amend regulation 20A.14 of the Trade Marks Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Items 33 and 34 amend subregulation 20A.15(1) of the Trade Marks Regulations to replace references to the former Disciplinary Tribunal with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 35 repeals the heading “Offences by persons appearing before Disciplinary Tribunal” to regulation 20A.16 of the Trade Marks Regulations and replaces it with the new heading “Offences by persons appearing before a Panel of Disciplinary Tribunal”.

Items 36–40 amend regulation 20A.16 of the Trade Marks Regulations to replace references in the offence provisions with references to the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal or to the Panel as a whole.

Item 41 amends subparagraph 20A.16(3)(a)(iii) of the Trade Marks Regulations so that it refers to expenses and allowances that have been paid in accordance with Part 2 of Schedule 8 to the Patents Regulations. This provides a clear basis for setting the levels of expenses and allowances.

Item 42 repeals paragraph 20A.16(3)(b) of the Trade Marks Regulations, because the amendment in item 41 makes it unnecessary for expenses and allowances to be determined by the Tribunal.

Consequently, Item 43 deletes the reference in paragraph 20A.16(4)(b) to paragraph 20A.16(3)(b), and substitutes a reference to amended subparagraph 20A.16(3)(a)(iii).

Item 44 amends paragraph 20A.16(5)(a) to insert a reference to “a Panel of” the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 45 repeals the heading “Protection of person constituting Disciplinary Tribunal, witnesses, etc.” to regulation 20A.17 of the Trade Marks Regulations and replaces it with the new heading “Protection of certain persons”.

Item 46 repeals the existing immunity provision in subregulation 20A.17(1) and replaces it with an equivalent provision which refers to members of a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than to the former Disciplinary Tribunal.

Item 47 amends subregulations 20A.17(3) and 20A.17(4) to insert a reference to “a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 48 repeals the heading “Decision of Disciplinary Tribunal” to regulation 20A.18 of the Trade Marks Regulations and replaces it with “Decision of Panel of Disciplinary Tribunal”.

Items 49–51 amends regulation 20A.18 of the Trade Marks Regulations so that it correctly refers to decisions made by a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Item 52 repeals paragraphs 20A.18(3)(d) and (e) of the Trade Marks Regulations and substitutes new paragraphs 20A.18(3)(d) and (e) which allow a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal to take into account any previous findings made against an incorporated attorney or its employees or officers in any other proceedings before a relevant disciplinary tribunal.

Item 53 inserts a new subregulation (4) into regulation 20A.18 of the Trade Marks Regulations to define the term “relevant disciplinary tribunal”. This term is defined to mean the former Disciplinary Tribunal established by regulation 20.61, as in force prior to the commencement of this subregulation, or any transitional proceedings before that tribunal. The definition also includes the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 as in force on commencement of this subregulation.

Item 54 repeals the heading “Notification and publication of decisions of Disciplinary Tribunal” to regulation 20A.19 of the Trade Marks Regulations and substitutes the heading “Notification and publication of decisions of Panel of Disciplinary Tribunal”.

Item 55 amends subregulation 20A.19(1) of the Trade Marks Regulations so that it is the Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal, which notifies the incorporated trade marks attorney of the Panel’s decision, and publishes the decision.

Items 56–63 amend regulations 20A.19 and 20A.20 of the Trade Marks Regulations to replace various references to the former Disciplinary Tribunal with references to the Panel, or Panel Chair, of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, as required.

Item 64 repeals paragraphs 21.6(3)(c) and (d) of the Trade Marks Regulations and substitutes new provisions that include the Panel Chair of the Trans-Tasman IP Attorneys Disciplinary Tribunal and the Board in the list of persons to whom declarations in electronic form may be given.

Item 65 inserts new regulation 21.7A which prescribes service by post as a means by which a document may be served on, or given or sent to, a person for the purpose of paragraphs 215(6)(a) and (b) of the Trade Marks Act.

Item 66 repeals and substitutes paragraph 21.35(2)(bb) of the Trade Marks Regulations to replace a reference to the former Disciplinary Tribunal with a reference to a Panel of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

Items 67 and 68 amend paragraph 21.35(2)(c) of the Trade Marks Regulations to insert references to a Panel of the new Trans-Tasman IP Attorneys Disciplinary Tribunal, rather than the former Disciplinary Tribunal.

Transitional arrangements for attorney registration and disciplinary proceedings

Item 69 inserts a new Division 3 in Part 22 of the Trade Marks Regulations, which governs transitional arrangements for Schedule 4 to the IP Laws Amendment Act and Schedule 2 to the Regulation.

New regulation 22.14 defines terms used in Division 3 of Part 22 of the Trade Marks Regulations.

“Commencement day” means the day on which Schedule 4 to the IP Laws Amendment Act commences.

The term “old Patents regulations” means the Patents Regulations as in force immediately before the commencement day.

The term “old regulations” means these Regulations as in force immediately before the commencement day.

New regulation 22.15 is made for the transitional arrangement in item 84 of Schedule 4 to the IP Laws Amendment Act. This allows a New Zealand patent attorney to apply for registration as an Australian-registered trade marks attorney within twelve months of the commencement day.

Transitional applicants do not need to meet the usual academic and knowledge requirements for registration as trade marks attorneys, but need to comply with the requirements in item 84 of Schedule 4 to the IP Laws Amendment Act and new regulation 22.15. This includes providing a statement of experience that satisfies the Designated Manager that the applicant’s level of competency in trade marks law and practice is sufficient to warrant the applicant becoming a registered trade marks attorney.

The applicant must also provide a declaration that the applicant has not been convicted of an offence against the Trade Marks Act, Designs Act, or Patents Act in the previous five years prior to making the application, or is not currently under a sentence of imprisonment in Australia or New Zealand for an offence of dishonesty. These offences are prescribed in new subregulations 22.15(4)–(5).

New regulation 22.16 provides for the continuation of disciplinary proceedings against a registered trade marks attorney which had commenced, but had not been completed, before the commencement day. In these circumstances, the proceedings continue before the former Disciplinary Tribunal and in accordance with the old Patents regulations (as they applied to trade marks attorneys in accordance with Division 6 of Part 20 of the Trade Marks Regulations).

New regulation 22.17 makes an equivalent provision as in regulation 22.16 for the continuation of disciplinary proceedings against incorporated trade marks attorneys.

Schedule 3 – Other amendments relating to the single economic market

This schedule amends the Designs Regulations and Plant Breeder's Rights Regulations to give effect to the amendments made by Schedule 4 to the IP Laws Amendment Act. The amendments to the Designs Regulations and Plant Breeder's Rights Regulations allow an applicant for design rights or plant breeders' rights to provide an address for service in either Australia or New Zealand. These amendments are consistent with the amendments made in Schedules 1 and 2 to the Regulation.

Designs Regulations 2004

Items 1–4 amend regulation 11.19 of the Designs Regulations to allow an address for service to be in Australia or New Zealand.

Item 5 inserts new subregulation 11.19(5) of the Designs Regulations to prescribe service by post as a means by which a document may be served on, or given or sent to, a person for the purpose of subsection 145(1) of the Designs Act.

Plant Breeder's Rights Regulations 1994

Item 6 inserts new regulation 3DA of the Plant Breeder's Rights Regulations, to prescribe service by post as a means by which a document may be served on, or given or sent to, a person for the purpose of section 73 of the Plant Breeder's Rights Act.

Schedule 4 – Amendments relating to international obligations

This Schedule amends the Patents Regulations and the Trade Marks Regulations to ensure that the regulations are consistent with Australia’s international obligations under the *Patent Co-operation Treaty* (‘PCT’), the *Paris Convention for the Protection of Industrial Property* (‘Paris Convention’) and the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Trade Marks* (‘Nice Agreement’).

Patents Regulations 1991

Changes to the PCT in relation to the publication of information in patent applications made under the PCT took effect from 1 July 2016. Patent applications and associated documents are eventually published in full or made publicly available, to ensure that the public benefits from knowledge of the invention. However, some PCT applications include sensitive personal or financial information which is not essential to understanding the invention.

To avoid having to reveal this sensitive information in the future, the *Regulations under the Patent Co-operation Treaty* (‘PCT Rules’) have been amended so that the International Bureau of the World Intellectual Property Organization (‘International Bureau’) can both omit from publication and restrict access to sensitive information. As Australia is a receiving office for PCT applications, it is bound by the PCT Rules, and is therefore required to amend the Patents Regulations to ensure that they are consistent with the PCT Rules.

Item 1 inserts new paragraphs 4.4(7)(c)–(e) of the Patents Regulations to exclude public inspection of documents containing sensitive personal or financial information which is not essential to the working of an invention, but is nonetheless contained in applications (or related documents) made under the PCT.

Item 2 inserts new subregulation 4.4(7A) of the Patents Regulations, which allows the Commissioner of Patents to make available a copy of an excluded document from which the sensitive information has been redacted. If the document would have ordinarily been open to public inspection in accordance with paragraph 4.4(6)(b), then once the sensitive information has been redacted from the copy, it is open to public inspection.

Trade Marks Regulations 1995

An amendment to the Trade Marks Regulations is required to correct an inconsistency with the Paris Convention. Article 6ter of the Paris Convention provides that the flag of a member country cannot be registered as a trade mark in another member country. Although formal notice about this may be given if a member country wishes to do so, this notice is not obligatory—the member country national flags are intended to be protected by right under the treaty. However, as currently drafted, the Trade Marks Act and Trade Marks Regulations protect flags only of member states which have provided notice to Australia by the International Union of Industrial Property (the International Union of Industrial Property is the name used by the collective members of the Paris Convention, and the related secretariat). This amendment ensures that all flags of member states are protected from registration as a trade mark in Australia.

Item 3 inserts new paragraph 4.15(da) to provide that the national flag of a country which is a member of the International Union of Industrial Property cannot be registered as a trade mark.

Further amendments to the Trade Marks Regulations are required to ensure that the classification of goods and services in trade mark applications is consistent with the classification of goods and services agreed under the Nice Agreement ('Nice Classification').

Amendments were made to the Nice Classification, which commenced on 1 January 2016. As Australia is a party to the Nice Agreement, amendments are required to ensure the Trade Marks Regulations are consistent with the Nice Classification.

Items 4–10 amend Schedule 1 to the Trade Marks Regulations to make minor changes to the class headings for the classification of goods and services in trade mark applications.

Schedule 5 – International registrations

Schedule 5 amends the Trade Marks Regulations to make it clear that the Registrar may refuse to extend protection to an international trade mark registration designating Australia if the Registrar considers that its description of a good or service is too vague, incomprehensible, or linguistically incorrect.

Trade Marks Regulations 1995

The International Bureau of the World Intellectual Property Organization (‘International Bureau’) notifies the Registrar of each international trade mark registration designating Australia (‘IRDA’). An IRDA specifies the goods or services for which protection of the trade mark is sought in Australia.

When processing an IRDA, the International Bureau may identify terms in the specification of goods and services as being too vague, incomprehensible or linguistically incorrect. The Registrar is then able to refuse to extend protection to the trade mark for the identified term, under subregulation 17A.14(2) of the Australian Trade Marks Regulations. However, the existing provision does not permit the Registrar to refuse to extend protection of a trade mark for some unclear term that the International Bureau did *not* identify.

To remedy this, item 1 inserts new subregulation 17A.14(3) into the Trade Marks Regulations, empowering the Registrar to judge whether a term in an IRDA is too vague, and to refuse to extend trade mark protection for that unclearly specified good or service. The Registrar could still extend protection to the trade mark for any good or service that *is* specified clearly in the IRDA.

Item 1 inserts new subregulation 17A.14(3) to allow the Registrar of Trade Marks (‘Registrar’) to identify, and refuse to protect, unclearly specified goods or services contained in international trade mark applications.

Item 2 inserts a new application provision (new regulation 22.13) into Part 22 of the Trade Marks Regulations to make it clear that the amendment made by item 1 applies to any IRDA the Registrar receives from the International Bureau on or after the commencement of that item. This is intended to ensure that the prohibition in new subregulation 17A.14(3) cannot be raised as a ground for refusal of an IRDA received before commencement of item 1.

Schedule 6 – Amendments relating to Norfolk Island

Schedule 6, Part 1 amends the Trade Marks Regulations so that references in provisions governing the seizure by Customs officers of infringing goods imported into Norfolk Island correctly refer to the changed Customs administration on Norfolk Island.

Schedule 6, Part 2 amends the Plant Breeder’s Rights Regulations so that the Plant Breeder’s Rights Act applies to Norfolk Island.

Part 1—Amendments commencing day after registration

In March 2015, the Australian Government announced comprehensive reforms for Norfolk Island. Subsequently, on 1 July 2016, changes affecting trade marks legislation took place through the *Norfolk Island Legislation Amendment Act 2015*; the *Norfolk Island Continued Laws Amendment (2016 Measures No. 2) Ordinance 2016 (Cth)*; the *Norfolk Island Continued Laws Ordinance 2015 (Cth)*; and the *Norfolk Island Customs Ordinance 2016*. The latter repealed the *Customs Act 1913* of Norfolk Island, replacing it with the *Customs Act 1901 (NI)*. As a consequence, amendments are now made to the Trade Marks Regulations where they relate to Norfolk Island.

The affected provisions are contained in Schedule 3 to the Trade Marks Regulations. That schedule operates by modifying Part 13 (‘Importation of goods infringing Australian trade marks’) of the Trade Marks Act—applying the trade marks legislation in Norfolk Island by way of provisions that recognise Norfolk Island’s different customs status.

Trade Marks Regulations 1995

Items 1, 7, 8 – note before headings to Schedule 3, 4 and 5

These minor items insert notes before the headings to Schedules 3, 4 and 5 to the Trade Marks Regulations to direct the reader to existing regulations 13.7, 13.8 and 13.9 of the Trade Marks Regulations. By virtue of those regulations, Schedules 3, 4 and 5 respectively modify the customs seizure provisions in Part 13 of the Trade Marks Act as they apply to the external territories of:

- Norfolk Island;
- Christmas Island;
- the Cocos (Keeling) Islands.

The notes make it easier for the reader to understand and use the legislation.

Other than introducing the notes, no other no changes are made in respect of Christmas Island or the Cocos (Keeling) Islands.

The following items amend Schedule 3 to the Trade Marks Regulations to change how Part 13 of the Trade Marks Act is modified in its application to Norfolk Island.

Item 2 – amends item 1 of Schedule 3 to the Trade Marks Regulations

This item repeals and substitutes item 1 of Schedule 3 to the Trade Marks Regulations, so that it replaces the existing section 131A inserted into Part 13 of the Trade Marks Act by the Regulations.

Section 144 of the Trade Marks Act allows for the Trade Marks Regulations to modify or adapt parts of the Act. In this instance the Regulations may modify or adapt Part 13 of the Act in its application to Norfolk Island. The existing schedule 3 of the Regulations contains the current modifications to the Act.

The existing section 131A in item 1 of Schedule 3 to the Trade Marks Regulations defines the expression “designated owner” by reference to the *Customs Act 1913* of Norfolk Island, which was repealed with effect from 1 July 2016 (*Norfolk Island Continued Laws Ordinance 2015* sch 2, item 1). It also defines the expressions “Administration”, “Administrator” and “Collector”, which are no longer required with the repeal of items 4, 6 and 7 of Schedule 3 to the Trade Marks Regulations in item 5 of this Schedule.

The replacement section 131A defines the following two expressions:

Customs Act 1901 (NI) means the *Customs Act 1901* in its application to Norfolk Island in accordance with the *Norfolk Island Customs Ordinance 2016*.

This amendment is made because, in contrast to Commonwealth legislation generally, the *Customs Act 1901* does not extend to Norfolk Island of its own force. Instead, the *Norfolk Island Customs Ordinance 2016* applies the *Customs Act 1901* to Norfolk Island as the *Customs Act 1901 (NI)*.

designated owner, in relation to goods imported into Norfolk Island, means the person who is identified as the owner on the entry made in relation to the goods under section 68 of the *Customs Act 1901 (NI)*, or who is otherwise determined to be the owner of the goods in accordance with section 133A of the Trade Marks Act.

This amendment is made to ensure that the definition of “designated owner”, for the purposes of Norfolk Island, refers to the correct customs legislation.

Item 3 – amends item 2 of Schedule 3 to the Trade Marks Regulations

This item amends item 2 of Schedule 3 to the Trade Marks Regulations so that paragraph 133(1)(b) of the Trade Marks Act applies to Norfolk Island as if the reference to the *Customs Act 1901* were to the *Customs Act 1901 (NI)*. This amendment ensures that the Trade Marks Regulations refer to the correct customs legislation for Norfolk Island.

Item 4 – amends item 3 of Schedule 3 to the Trade Marks Regulations

This item repeals and substitutes item 3 of Schedule 3 to the Trade Marks Regulations so that section 133A of the Trade Marks Act applies to Norfolk Island as if a reference to the *Customs Act 1901* were to the *Customs Act 1901 (NI)*. This amendment ensures that the Trade Marks Regulations refer to the correct customs legislation for Norfolk Island.

In addition, the repeal of item 3 of Schedule 3 allows any officer of Customs (within the meaning of subsection 4(1) of the *Customs Act 1901*) to determine who is the designated owner of goods under section 133A of the Trade Marks Act. Currently, item 3 of Schedule 3 allows only the Comptroller-General of Customs to make those determinations; this is unnecessarily restrictive, as it may be impractical for the Comptroller-General to personally make all determinations.

Item 5 –inserts new items 3A, 3B, 3C, 3D, 3E, 3F, 3G, 3H of Schedule 3 to the Trade Marks Regulations

This item inserts new items 3A, 3B, 3C, 3D, 3E, 3F, 3G, 3H into Schedule 3 to the Trade Marks Regulations. These items modify several notes to provisions in Part 13 of the Trade Marks Act which refer to the expression “designated owner”. The modified notes direct the reader to the definition of that expression in section 131A of Part 13 of the Trade Marks Act as inserted by the Regulations, instead of the excluded definition in section 6 of the Trade Marks Act (see the notes on item 2 of this Schedule).

Item 6 – amends items 4, 6 and 7 of Schedule 3 to the Trade Marks Regulations

This item repeals items 4, 6 and 7 of Schedule 3 to the Trade Marks Regulations. This means that the provisions in Part 13 of the Trade Marks Act will no longer be modified to refer to an entity, legislation or office abolished by the *Norfolk Island Legislation Amendment Act 2015* or the *Norfolk Island Continued Laws Ordinance 2015*:

- The Administration of Norfolk Island;
- The *Customs Act 1913* of Norfolk Island;
- The Collector of Customs appointed under the *Customs Act 1913* of Norfolk Island.

As a result of these repeals, Part 13 of the Trade Marks Act could be administered on Norfolk Island by the Comptroller-General of Customs on behalf of the Commonwealth of Australia.

Part 2 – Amendments commencing 1 July 2017

Plant Breeder’s Rights Regulations 1994

Item 9 – regulation 3AA

This item inserts a new regulation into Plant Breeder’s Rights Regulations to prescribe that the Plant Breeder’s Rights Act extends to Norfolk Island.

Section 9B of the Act provides that the Act does not extend to Norfolk Island unless the regulations prescribe. That section was inserted into the Act by the *Territories Legislation Amendment Act 2016*, so as to allow the extension of the Act to Norfolk Island to be deferred. It is appropriate to extend the Act to Norfolk Island with effect from 1 July 2017. The commencement date allows for transitional rules to be put in place. From that date, Norfolk Islanders can enjoy the same rights, entitlements and responsibilities under the Act as other Australians. In particular, plant breeders on Norfolk Island are able to seek protection for their new varieties for the whole of Australia (including Norfolk Island).

A separate legislative instrument to govern any required transitional matters will be made by the responsible Commonwealth Minister. It is appropriate for such an instrument to be made under the *Territories Legislation Amendment Act 2016*, not under the Plant Breeder’s Rights Regulations. That transitional rule would be proposed to be made and registered before 1 July 2017.

Statement of Compatibility with Human Rights

Prepared in accordance with Part 3 of the Human Rights (Parliamentary Scrutiny) Act 2011

Intellectual Property Legislation Amendment (Single Economic Market and other Measures) Regulation 2016

This Legislative Instrument is compatible with the human rights and freedoms recognised or declared in the international instruments listed in section 3 of the *Human Rights (Parliamentary Scrutiny) Act 2011*.

Overview of the Instrument

This Legislative Instrument amends the *Patents Regulations 1991* ('Patents Regulations'), the *Trade Marks Regulations 1995* ('Trade Marks Regulations'), the *Designs Regulations 2004* ('Designs Regulations'), and the *Plant Breeder's Rights Regulations 1994* ('Plant Breeder's Rights Regulations').

The amendments are primarily required to implement Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* ('IP Laws Amendment Act'), which will amend the *Designs Act 2003*, the *Patents Act 1990*, the *Plant Breeder's Rights Act 1994* and the *Trade Marks Act 1995*.

Minor amendments are also required to ensure compliance with international obligations.

The instrument is divided into six schedules:

- Schedule 1 amends the Patents Regulations to enable the legislative implementation of a single, trans-Tasman patent attorney regime in Australia and New Zealand. This initiative is being undertaken as part of Australia's broader Single Economic Market agenda with New Zealand.
- Schedule 2 amends the Trade Marks Regulations as a result of the implementation of the single patent attorney regime.
- Schedule 3 makes minor amendments to the Designs Regulations and the Plant Breeder's Rights Regulations to allow an address for service of documents to be in New Zealand. This is to ensure consistency with the amendments made to the Patents Regulations and Trade Mark Regulations as a result of the single patent attorney regime.
- Schedule 4 makes minor amendments to the Patents Regulations and Trade Marks Regulations to ensure that the regulations are consistent with international treaties.
- Schedule 5 makes minor amendments to the Trade Marks Regulations to allow the Registrar of Trade Marks to identify, and refuse to protect, unclearly specified goods or services contained in international trade mark applications.
- Schedule 6 amends the Trade Marks Regulations and the Plant Breeder's Rights Regulations to reflect the changes to the administration of Norfolk Island made in July 2016.

Human rights implications

This Legislative Instrument does not have a negative effect on human rights.

The Legislative Instrument engages, and is consistent with, the following human rights:

- the right to a fair hearing in Article 14(1) of the *International Covenant on Civil and Political Rights* (ICCPR);
- the right to non-discrimination in Articles 2(1) and 26 of the ICCPR, and Article 2(2) of the *International Covenant on Economic, Social and Cultural Rights* (ICESCR);
- the right to work in Article 6(1) of the ICESCR;
- the right to privacy in Article 17 of the ICCPR; and
- the right to enjoy and benefit from culture in Article 15 of the ICESCR.

The *Intellectual Property Laws Amendment Bill 2014* (which became the IP Laws Amendment Act) was examined and reported on by the Parliamentary Joint Committee on Human Rights (PJCHR).¹ The PJCHR reported that the Bill does not appear to give rise to human rights concerns, noting that the proposed single trans-Tasman patent attorney regime which will provide for a single set of standards for the accreditation, registration and discipline of patent attorneys in both Australia and New Zealand appears to be consistent with the right to a fair hearing, the right to non-discrimination, and the right to work.²

Right to a fair hearing

The right to a fair trial and public hearing in civil proceedings is protected by Article 14(1) of the ICCPR. This right includes the right to a fair and public hearing before a competent, independent and impartial tribunal established by law.

Article 14(1) permits limitation of the right to a public hearing. That is, the press and the public may be excluded from all or part of a trial on several grounds including privacy of the parties, or to the extent strictly necessary in the opinion of the court in special circumstances where publicity would prejudice the interests of justice.

In Schedules 1 and 2, respectively, the instrument amends the Patents Regulations and the Trade Marks Regulations to replace the existing single-member Patent and Trade Marks Attorneys Disciplinary Tribunal ('existing Tribunal') with the multi-member Trans-Tasman IP Attorneys Disciplinary Tribunal ('new Tribunal'). A disciplinary complaint is heard by a panel of three members of the new Tribunal, with one member being appointed the Panel Chair.

The new Tribunal will hear disciplinary proceedings against individuals who are trans-Tasman registered patent attorneys and/or Australian-registered trade marks attorneys. The instrument sets out the composition of the new Tribunal, and the processes and procedures for the hearing of a disciplinary complaint.

Generally, the hearing of a disciplinary complaint is public, although the Panel Chair can direct that the hearing be in private, or can restrict the disclosure or publication of evidence or matter in documents. To do this, the Panel Chair must be reasonably satisfied that it is desirable to do so, in the public interest, or because of the confidential nature of the evidence or that matter. The decision of the new Tribunal must be published. This is consistent with Article 14(1) of the ICCPR.

¹ PJCHR, *Fifth report of the 44th Parliament*, March 2014, pp 34-35.

² PJCHR, *Fifth report of the 44th Parliament*, March 2014, p 35, at [1.125].

The decisions of a Panel of the new Tribunal in a proceeding is subject to review by the Administrative Appeals Tribunal.

Right to non-discrimination

The right to non-discrimination is protected by Articles 2(1) and 26 of the ICCPR, and Article 2(2) of the ICESCR. This right guarantees to all persons equal and effective protection against discrimination on any ground such as race, colour, sex, language, religion, political or other opinion, national or social origin, property, birth or other status.

In Schedule 1, the instrument makes amendments to the existing qualifications and employment experience that a person seeking registration as a patent attorney must demonstrate, so that qualifications and experience obtained in New Zealand can be considered in an application for registration as an attorney.

These requirements do not discriminate against individuals on any of the grounds for protection against discrimination. Any person may apply for registration as a patent attorney, provided that they meet the prescribed requirements. The requirement for a prescribed level of knowledge and experience is to ensure that a person seeking to practise as a patent attorney can adequately represent the interests of their clients, and protects the interests of the public. This is consistent with the right to non-discrimination in Articles 2(1) and 26 of the ICCPR, and Article 2(2) of the ICESCR.

Right to work

The right to work is protected by Article 6(1) of the ICESCR. This includes the right of everyone to the opportunity to gain his or her living by work which he or she freely chooses or accepts.

As discussed above, the instrument (Schedule 1) makes amendments to the existing qualifications and employment experience that a person seeking registration as a patent attorney must demonstrate, so that qualifications and experience obtained in New Zealand can be considered in an application for registration as an attorney.

These requirements do not restrict the ability of any person to seek registration as a patent attorney. If an applicant meets the required level of knowledge and experience, the applicant is able to register as a patent attorney and to undertake work in that field. As discussed above, the requirement for a prescribed level of knowledge and experience is to ensure that a person seeking to practise as a patent attorney can adequately represent the interests of their clients, and therefore it protects the interests of the public. This is consistent with the right to work in Article 6(1) of the ICESCR.

Right to privacy

Article 17 of the ICCPR provides that no one shall be subjected to an arbitrary interference with their privacy.

Schedule 4 of the Instrument will amend the Patent Regulations to prevent the publication of certain personal and sensitive information in patent applications made under the *Patent Cooperation Treaty* (PCT).

Patent applications and associated documents are eventually published in full or made publicly available, to ensure that the public benefits from knowledge of the invention. However, some PCT applications include sensitive personal or financial information which is not essential to understanding the invention.

To avoid having to reveal this sensitive information in the future, the PCT Rules are being amended so that the International Bureau of World Intellectual Property Organization can omit from publication and restrict access to sensitive information. As Australia is a receiving office for PCT applications, it is bound by the PCT Rules. Australia is therefore required to amend the Patent Regulations to ensure that they are consistent with the PCT Rules.

Restricting the publication of sensitive personal information that is not essential to the working of an invention is consistent with the right to privacy under Article 17 of the ICCPR.

Right to enjoy and benefit from culture

Article 15 of the ICESCR recognises the right of an individual to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author, this includes knowledge and innovations.

Schedule 6 of this Instrument will amend the Plant Breeder's Rights Regulations to extend the Australian plant breeders' rights system to Norfolk Island. Norfolk Island did not previously have a plant breeders' rights system.

This extension will not restrict the freedom to enjoy and benefit from culture but will strengthen this right. Plant breeders' rights are exclusive commercial rights for a registered variety of plant. The plant breeders' rights system protects plant breeders and gives them a commercial monopoly for a period of time. This will provide an avenue of protection that was previously unavailable and will encourage plant breeding and innovation.

Extending the plant breeders' rights system to Norfolk Island is consistent with the right to enjoy and benefit from culture under Article 15 of the ICESCR.

Remaining Schedules

Schedules 3 and 5 do not raise any human rights issues.

Conclusion

The Legislative Instrument is compatible with human rights because it promotes the protection of human rights.

The Hon Greg Hunt MP, Minister for Industry, Innovation and Science