



## **Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018**

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The Trans-Tasman IP Attorneys Board establishes the following Code of Conduct as a standard of practice under subparagraph 228(2)(r)(ia) of the *Patents Act 1990* and subparagraph 231(2)(ha)(ia) of the *Trade Marks Act 1995*.

Dated: 14 December 2017

The Trans-Tasman IP Attorneys Board

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## Part 1—Preliminary

### 1 Name of code

This code is the Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018.

### 2 Commencement

This code commences on 23 February 2018.

### 3 Authority

This code is made under subparagraph 228(2)(r)(ia) of the *Patents Act 1990* (Cth) and subparagraph 231(2)(ha)(ia) of the *Trade Marks Act 1995* (Cth), and in accordance with the *Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys* signed in March 2013.

### 4 Definitions

In this code:

**ancillary business** means a business providing services in relation to intellectual property that are ancillary to the attorney professional services provided by a registered patent attorney or a registered trade marks attorney and that are directed to, or likely to be utilised by, a client of a registered attorney.

**associated person** means a person (including another registered attorney), other than a staff attorney or a foreign-registered attorney, who does work for a registered attorney under a contract or other arrangement, including a person who acts as the agent or representative of the registered attorney for the purposes of the Patents Act or the Trade Marks Act.

**Board** means the Trans-Tasman IP Attorneys Board.

**client** means the principal on whose behalf a registered attorney is acting.

**director** means a patent attorney director or trade marks attorney director.

**foreign-registered attorney** means an individual or a body corporate (however described) that is authorised, under a law of a country or region other than Australia or New Zealand, to do some or all of the following work:

- (a) applying for patents, trade marks, designs or protection for plant varieties;
- (b) obtaining patents, trade marks, designs or protection for plant varieties;

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- (c) preparing applications or other documents for the purposes of the laws of that country or region relating to patents, trade marks, designs or protection for plant varieties;
- (d) giving advice about the validity of patents, trade marks, designs or protection for plant varieties;
- (e) giving advice about the possible infringement of patents, trade marks, designs or protection for plant varieties.

**former client** means the principal on whose behalf a registered attorney once was, but no longer is, acting.

**guidelines** means the guidelines for understanding and interpretation of this code as published by the Board from time to time.

**incorporated attorney** means an incorporated patent attorney or an incorporated trade marks attorney.

**incorporated patent attorney** has the same meaning as in the Patents Act.

**incorporated trade marks attorney** has the same meaning as in the Trade Marks Act.

**informed consent** means, in relation to a client, consent given with knowledge of all the information that is reasonably necessary and legally possible to be provided to the client so that the client can make an informed decision.

**ownership group** means:

- (a) two or more incorporated attorneys, and any incorporated ancillary business, that constitute “associated entities” as that term is defined in the *Corporations Act 2001*; and
- (b) two or more partnerships or other non-incorporated combinations of registered attorneys, and any ancillary business, that would constitute “associated entities” as that term is defined in the *Corporations Act 2001* if such entities were incorporated.

**patent attorney director** has the same meaning as in the Patents Act.

**Patents Act** means the *Patents Act 1990* (Cth).

**person** has the meaning that it is given by the *Acts Interpretation Act 1901* (Cth).

**professions** means:

- (a) the patent attorney profession; and
- (b) the trade marks attorney profession.

**registered attorney** means a person to whom this code applies.

**registered patent attorney** has the same meaning as in the Patents Act.

**registered trade marks attorney** has the same meaning as in the Trade Marks Act.

**regulatory authority** means a body:

- (a) established by or under a law; or
- (b) otherwise established by a government;

with which a registered attorney may deal with while doing work as a registered attorney.

**staff attorney** means:

- (a) an individual who is a registered patent attorney and employed by an incorporated patent attorney; or
- (b) an individual who is a registered trade marks attorney and employed by an incorporated trade marks attorney.

**Trade Marks Act** means the *Trade Marks Act 1995* (Cth).

**trade marks attorney director** has the same meaning as in the Trade Marks Act.

## **5 Former Code of Conduct**

This code replaces the Code of Conduct that was established by the Professional Standards Board for Patent and Trade Marks Attorneys and registered on 23 October 2013.

## **Part 2—Overview**

### **6 Application of code**

This code applies to:

- (a) a registered patent attorney; and
- (b) a registered trade marks attorney.

### **7 Objective of code**

The objective of this code is to explain the professional conduct required of a registered attorney by setting out the standards of practice to which a registered attorney is required to adhere.

### **8 Guidelines to code**

- (1) From time to time the Board may publish guidelines to assist registered attorneys and their clients to understand this code and the conduct it covers.
- (2) Any guidelines published by the Board are informative, are illustrative, are not exhaustive, do not form part of this code and are not binding for the purposes of interpreting this code.

### **9 Rights of clients not affected**

This code does not affect or reduce the rights of a client of a registered attorney in relation to the registered attorney's conduct.

### **10 Administration of code**

- (1) The Board is responsible for:
  - (a) publicising this code to ensure widespread awareness of its purpose and provisions; and
  - (b) implementing measures to ensure that registered attorneys are aware of this code's purpose and provisions; and
  - (c) conducting periodic reviews of this code's effectiveness, and of the procedures in this code, with a view to possible changes; and
  - (d) preparing annual and other reports relating to this code.
- (2) This code is a legislative instrument for the purposes of the *Legislative Instruments Act 2003* and is available on the Federal Register of Legislation website (<https://www.legislation.gov.au/>).



- (3) The Board's contact details are available on the Board's website (<https://www.ttipattorney.gov.au/>).

## **Part 3—Professional conduct**

### **11 Core obligations**

- (1) A registered attorney must act as a patent attorney or a trade marks attorney:
  - (a) in accordance with the law; and
  - (b) in the best interests of the registered attorney's clients; and
  - (c) in the public interest; and
  - (d) in the interests of the registered attorney's profession as a whole.
- (2) If a registered attorney is unable to comply equally with all of the obligations mentioned in subsection (1), the registered attorney must treat the obligations as an order of priority in which paragraph (1)(a) is the highest priority.

### **12 Responsibility**

- (1) A registered attorney who is an individual is responsible for:
  - (a) the registered attorney's own work, acts and defaults; and
  - (b) the work, acts and defaults of each associated person of the registered attorney.
- (2) A registered attorney who is a director is responsible for:
  - (a) the director's own work, acts and defaults; and
  - (b) the work, acts and defaults of each associated person of the director; and
  - (c) the work, acts and defaults of each staff attorney employed by the incorporated attorney of which the director is a director.
- (3) A registered attorney that is an incorporated attorney is responsible for:
  - (a) the incorporated attorney's own work, acts and defaults; and
  - (b) the work, acts and defaults of each director of the incorporated attorney; and
  - (c) the work, acts and defaults of each staff attorney of the incorporated attorney; and
  - (d) the work, acts and defaults of each associated person of the incorporated attorney.

### **13 Integrity**

- (1) A registered attorney must not act as a patent attorney or a trade marks attorney in a way that is fraudulent, deceitful or knowingly misleading.
- (2) A registered attorney must maintain standards of professional practice as a patent attorney or a trade marks attorney that are courteous, ethical and well-informed.

**14 Competency**

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

**15 Diligence**

- (1) A registered attorney must carry out the work that the registered attorney undertakes in a timely manner.
- (2) A registered attorney must:
  - (a) act in a timely manner on the instructions of a client or a prospective client; or
  - (b) inform the client or prospective client in a timely manner of the registered attorney's inability to do so.

**16 Communication**

- (1) Prior to undertaking any work for a client, a registered attorney must ensure that the client is, or previously has been, clearly informed in writing of the following matters:
  - (a) that the registered attorney is registered as a patent attorney, a trade marks attorney or both, and is bound by this code; and
  - (b) that the registered attorney has appropriate competency to perform the work, including by drawing on technical expertise; and
  - (c) the procedures, timing and estimated cost of doing the work; and
  - (d) whether the registered attorney is an incorporated company and, if it is, whether the company is public or private; and
  - (e) where the registered attorney is a member of an ownership group – that fact and the identity of the other members of that group.
- (2) A registered attorney is not required to comply with paragraphs (1)(a), (b) and (c) if:
  - (a) the client is also represented by a foreign-registered attorney and the registered attorney is dealing with the client by dealing with the foreign-registered attorney; or
  - (b) the registered attorney has been requested to do work for the client by another registered attorney and the other registered attorney continues to act for the client in the work.
- (3) A registered attorney is not required to comply with paragraphs (1)(d) and (e) if:
  - (a) the client is also represented by a foreign-registered attorney, the registered

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attorney is dealing with the client by dealing with the foreign-registered attorney and the registered attorney has provided the information specified in paragraphs (1)(d) and (e) to the foreign-registered attorney; or

- (b) the registered attorney has been requested to do work for the client by another registered attorney, the other registered attorney continues to act for the client in the work and the registered attorney has provided the information specified in paragraphs (1)(d) and (e) to the other registered attorney.
- (4) Where any of the matters specified in subsection (1) become materially different from those that were, or that should have been, previously notified to a person to whom the registered attorney is required by this section to notify them, the registered attorney must clearly inform that person in writing of the changes.

### **17 Disclosure**

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

### **18 Confidentiality**

Unless permitted or required by law, a registered attorney must not use or disclose, or allow to be used or disclosed, confidential information obtained from or on behalf of a client, a former client or a prospective client without the informed consent of the client.

### **19 Loyalty**

#### *Client*

- (1) A registered attorney is a fiduciary in respect of the registered attorney's dealings with a client, and owes a duty of loyalty to a client.
- (2) A registered attorney must not prefer the registered attorney's own interests over the interests of a client.
- (3) Subject to subsection (4), a registered attorney must not prefer the interests of one client over the interests of another client.

- (4) Subject to subsection (5), a registered attorney must not act for a client in a matter knowing that the client's interests in that matter are adverse to the interests of another client of the registered attorney unless:
  - (a) both clients in writing have given informed consent to the registered attorney acting in the matter; and
  - (b) where the registered attorney holds confidential information relevant to the matter obtained from or on behalf of either client – the registered attorney has established an effective information barrier in relation to the relevant confidential information.
- (5) A registered attorney must not act for two or more clients in the same matter relating to a proceeding before a court, a tribunal, a like adjudicative body or an intellectual property office where the registered attorney knows the clients' interests are or are likely to be adverse.

*Former client*

- (6) A registered attorney must not act for a client in a matter knowing that the client's interests are adverse to the interests of a former client unless:
  - (a) the registered attorney does not hold confidential information relevant to the matter obtained from or on behalf of the former client; or
  - (b) where the registered attorney does hold confidential information relevant to the matter obtained from or on behalf of the former client – the registered attorney has established an effective information barrier in relation to the relevant confidential information.

## **20 Conflicts**

- (1) A registered attorney must take all reasonable steps to avoid creation of a situation giving rise to an actual conflict or the reasonable possibility of a conflict:
  - (a) between the registered attorney's interests and the interests of a client; and
  - (b) between the interests of one client and the interests of another client.
- (2) Upon becoming aware of a situation giving rise to an actual conflict or the reasonable possibility of a conflict of the types described in subsection (1), a registered attorney must, as soon as practicable, take all reasonable steps to resolve the actual conflict or the reasonable possibility of a conflict.

## **21 Independence**

- (1) Where a registered attorney is a member of an ownership group, a client of any member of the group of which the registered attorney is not independent is considered to be a client of the registered attorney for the purposes of sections 19 and 20.

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- (2) For the purposes of subsection (1), a registered attorney that is a member of an ownership group will not be regarded as independent of another member of the group unless the registered attorney operates independently of that other member in the provision to clients of attorney professional services.
- (3) Notwithstanding subsection (2), a registered attorney that is a member of an ownership group must not act for a client in a matter relating to a proceeding before a court, a tribunal, a like adjudicative body or an intellectual property office where the registered attorney knows that a client of another member of the group is involved in the matter and that the clients' interests are adverse unless the registered attorney's client in writing has given informed consent to the registered attorney acting in the matter.

## **22 Termination of services**

If a registered attorney withdraws the registered attorney's services, or ceases to act for a client, the registered attorney must take all reasonable steps:

- (a) to inform the client of any actions necessary to maintain the client's intellectual property rights; and
- (b) to cooperate with the client and any new representative of the client to ensure the client's intellectual property rights are maintained during transfer of responsibility.

## Part 4—Practice management

### 23 Ownership

- (1) A registered attorney may be a member of an ownership group.
- (2) Where a registered attorney is a member of an ownership group, that fact and the identity of the other members of the ownership group must be clearly disclosed to the public using means and words which can be reasonably expected to come to the attention of the public and be understood by the public.

### 24 Funds

- (1) A registered attorney must ensure that a cost, official fee or debt is paid in a timely manner after the registered attorney's client has given the relevant amount to the registered attorney.
- (2) A registered attorney must ensure that the funds of a client are kept and accounted for using an accounting standard that is appropriate to the circumstances of the registered attorney's practice.
- (3) A registered attorney must use money paid by a client only:
  - (a) for the purposes for which the client paid the money; or
  - (b) in accordance with any instructions given by the client before, during or after the payment of the money.
- (4) A registered attorney must, as soon as practicable, give to a client, or otherwise deal with as instructed by a client, any refund due to the client.

### 25 Client property

- (1) If a client or former client asks a registered attorney to return or make available to the client a document, sample or other material:
  - (a) that is the client's property; or
  - (b) to which the client may have access under an agreement between the registered attorney and the client; or
  - (c) in which the client has a legal or other interest that entitles the client to have access to the document, sample or material;
 the registered attorney must ensure that the document, sample or other material is returned or made available to the client.
- (2) A registered attorney is not required to comply with subsection (1) if the client has not satisfied a lien imposed in accordance with the *Patents Regulations 1991* (Cth), the *Trade Marks Regulations 1995* (Cth), the *Patents Act 2013* (NZ) or otherwise by law.

## **26 Address**

- (1) A registered attorney must:
  - (a) have a current address at which notices can be served for the purposes of this code; and
  - (b) ensure that the Board is notified of the current address; and
  - (c) notify the Board of a change of address within 14 days.
- (2) The Board will act on the assumption that a notice served on a registered attorney at an address notified to the Board under paragraph (1)(b) has been received by the registered attorney.



## **Part 5—Complaints and disciplinary proceedings**

### **27 Complaints**

- (1) A person or body may make a complaint to the Board, or provide information to the Board, about the conduct of a registered attorney.
- (2) A registered attorney must not:
  - (a) make a complaint to the Board, or provide information to the Board, under subsection (1) for an improper purpose; or
  - (b) threaten to make a complaint to the Board, or provide information to the Board, for an improper purpose.

### **28 Disciplinary proceedings**

- (1) The Board has the sole responsibility for commencing and conducting disciplinary proceedings against a registered attorney.
- (2) The Board can commence disciplinary proceedings against a registered attorney as a result of information it receives or on its own initiative.
- (3) The Board may commence proceedings before the Trans-Tasman IP Attorneys Disciplinary Tribunal against a registered attorney who is an individual if the Board is satisfied that there is a reasonable likelihood of that registered attorney being found guilty of unsatisfactory professional conduct.
- (4) The Board is required to commence proceedings before the Trans-Tasman IP Attorneys Disciplinary Tribunal against a registered attorney who is an individual if the Board is satisfied that there is a reasonable likelihood of that registered attorney being found guilty of professional misconduct.
- (5) The Board may apply to the Trans-Tasman IP Attorneys Disciplinary Tribunal to cancel or suspend the registration of an incorporated patent attorney or an incorporated trade marks attorney in accordance with subregulation 20A.10(1) of the *Patents Regulations 1991* (Cth) or subregulation 20A.10(1) of the *Trade Marks Regulations 1995* (Cth), as the case may be.

## **Schedule 1—Repeals**

### **1 *Code of Conduct for Patent and Trade Marks Attorneys 2013***

Repeal the instrument.