



**THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
FICPI AUSTRALIA**

*Via Email Only*

20 October, 2006

Mr Greg Powell  
Project Manager – Attorney Review Implementation  
IP Australia  
PO Box 200  
WODEN ACT 2606

Dear Mr Powell,

**Re: Discipline Regime for Patent and Trade Marks Attorneys  
Consultation Paper**

FICPI Australia, as an organisation whose members are all registered patent attorneys or registered patent & trade marks attorneys that are partners or principals in patent attorney firms conducting business in Australia, welcomes the opportunity to comment on the Consultation Paper prepared by IP Australia following the Government Response of October 2005 to the Review of the Discipline Regime for patent and trade marks attorneys produced by the Professional Standards Board for Patent and Trade Marks Attorneys.

FICPI Australia appreciates the extension of time provided for submitting these comments but is disappointed at the very limited time that has been available for responding to the Consultation Paper given that it was developed over almost a year following the Government Response.

FICPI Australia supports the stated Outcomes in the Consultation Paper, as well as most of the proposed Outputs for achieving those Outcomes. Our detailed comments follow:

**Definitions of “Professional Misconduct” and “Unsatisfactory Professional Conduct”**

FICPI Australia agrees that the proposed definitions of both “Professional Conduct” and “Unsatisfactory Professional Conduct” are improvements on those previously recommended in the Disciplinary Review. We agree that there are advantages in bringing the definitions into line with those endorsed by the Standing Committee of Attorneys General for use within the legal profession.

With respect to proposed penalties, FICPI is concerned that the proposed framework for penalties is too rigid and considers that there should be a broad discretion for the Tribunal to impose alternative remedies. For example, in the proposed framework the penalty for being found guilty of

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unsatisfactory professional conduct is said to be suspension of registration for up to 12 months or a public reprimand. Anything else is said to be an addition. In appropriate cases FICPI Australia believes that the Tribunal should have a discretion to impose a fine without ordering suspension or alternatively requiring that the attorney refund any monies paid by a client where the services provided were unsatisfactory.

Similarly where an attorney is found guilty of professional misconduct, FICPI Australia considers that there should be a discretion vested in the Tribunal as to the nature of the penalty. Whilst the regulations should indicate the maximum penalties, there may be cases where a technical finding of professional misconduct may not warrant cancellation or suspension of registration. We consider that the Tribunal should be left with a broader discretion as to the penalties that can be imposed in these circumstances.

### **Dispute Resolution**

FICPI Australia supports the proposal of Option 2 namely that the dispute resolution process and the disciplinary process be separated. Nonetheless, we consider that it is important to maintain the status quo with respect to the information and documentation required of a complainant. In particular, FICPI Australia considers that it should be a pre-condition that any complaint be supported by a statutory declaration setting out the material facts and clearly identifying the nature of the complaint and the name of the registered patent attorney. As a complaint is likely to lead, at the very least, to an investigation by the PSB, FICPI Australia believes that it is important that the case against the attorney be clearly stated and that it be in a form where the complainant is required to attest to the veracity of the relevant facts. FICPI Australia believes that the statutory declaration requirement is important not only in discouraging frivolous complaints but also in recognition of the fact that a complaint is a very serious matter which could give rise to disciplinary proceedings where an attorney may either be suspended or removed from the register. At page 12 of the Consultation Paper it is suggested that the provision of a statutory declaration could be a barrier to resolving a dispute. We consider that this overstates the difficulty in making a statutory declaration. Relevant forms are available from most news agencies and if a complaint is serious enough to warrant the attention of the PSB then FICPI Australia regards the provision of the statutory declaration as involving no significant impediment or barrier.

FICPI Australia also believes that the Dispute Resolution Process should clearly allow for the PSB deciding as one of the possible options following the initial assessment that the attorney has no case to answer, that is, that there are in reality no grounds for the complaint.

With respect to the proposal for guidelines, FICPI Australia is in general agreement. However, we consider that some of the fundamental steps in the process should be enshrined in the regulations. In particular, we consider that it is crucial that the PSB be obliged to provide a copy of any complaint about an attorney to that person within a short period following the filing of the complaint. We suggest 7 days. We consider that it should be by regulation that the attorney is entitled to full copies of all documentation filed in support of a complaint. FICPI Australia also believes that the attorney should be provided with a reasonable period to respond to the complaint during the period of the initial assessment. We suggest a period of four weeks extendable on reasonable grounds by the PSB.

### **Discipline**

As indicated above, FICPI Australia supports the proposed output. We agree that the PSB should be solely responsible for prosecuting disciplinary actions before the Tribunal. However, for the reasons articulated above, we strongly urge the retention of the requirement that an informant file a statutory declaration setting out material facts of the alleged misconduct. With respect to the

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process, we note that the Consultation Paper does not set out proposed process guidelines. However, as a minimum, FICPI Australia considers that there should be fundamental parts of the process enshrined by regulation. Most relevantly we consider that the PSB should be obliged to advise the relevant attorney within a short period following the PSB's decision to start disciplinary action. We consider that a period of seven days is reasonable and that the advice to the attorney should include all of the information before the PSB which has led it to the decision to commence the disciplinary action. Further, the regulations should provide a reasonable time for the attorney to provide comments and information to be considered as part of the investigation prior to any decision being made as to whether there is a reasonable likelihood that the attorney would be found guilty of either professional misconduct or unsatisfactory professional conduct.

### **Appeals/Reviews**

FICPI Australia supports the proposed Output. We agree that a decision of the Tribunal should be reviewable by the AAT.

### **Extensions of Time in Disciplinary Processes**

FICPI Australia agrees with the proposed Output.

### **Publication of Tribunal Decisions**

FICPI Australia agrees that any ultimate decision of the Disciplinary Process should be published. However, we are of the view that the decisions of the Tribunal should not be published until after all appeal processes have been exhausted. An adverse finding against an attorney is likely to have very significant repercussions for the attorney in his or her dealings with clients and colleagues. As such we consider that equity dictates that the decisions not be published until the process (including appeals) has been completed.

### **Further Consultation**

If IP Australia considers that it would be useful for further input in connection with any of the matters raised we would be please to meet or otherwise discuss these issues by telephone.

Yours sincerely,  
**FICPI Australia**

A handwritten signature in black ink, appearing to read 'GREGORY CHAMBERS', with a stylized flourish at the end.

**GREGORY CHAMBERS**  
Secretary