

**PROFESSIONAL STANDARDS BOARD FOR PATENT AND TRADE MARKS  
ATTORNEYS**

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## **GUIDELINES**

### **For Approval of Academic Qualifications**

#### **Background**

One of the functions of the Professional Standards Board for Patent and Trade Marks Attorneys (the Board) is to determine if a person has a qualification that satisfies the legislative requirements of regulation 20.3(1) (b). This requires that the Board be satisfied that the person has, or is entitled to the award of, an academic qualification of the kind mentioned in regulation 20.6.

The academic qualification **must** be:

- An Australian **Qualification Framework (AQF) qualification from the higher education sector**, or an equivalent qualification awarded by an overseas institution, and,
- **in a field of science or technology** that contains potentially patentable subject matter; and
- involve a **depth of study** that the Board considers is sufficient to provide an appropriate foundation for practice as a patent attorney.

The legislative requirement that the qualification be an AQF qualification from the higher education sector or an equivalent qualification awarded by an overseas institution is usually readily apparent and can be dealt with objectively.

However, the requirements that the qualification be in a field of science or technology that contains potentially patentable subject matter, and involve a depth of study that the Board considers is sufficient to provide an appropriate foundation for practice as a patent attorney,

may not be readily apparent and so may require a degree of deliberation. It is the difficulty in dealing with these issues that has led to the development of these guidelines.

### **Aim of these guidelines:**

The guidelines have been prepared by the Board to give some general guidance for those people considering patent attorney registration, particularly with regard to the expression “**in a field of science or technology**” as required by subregulation 20.6(2) (a), and the expression “**a depth of study** that the Board considers sufficient to provide an appropriate foundation for practice as a patent attorney” as required by subregulation 20.6(2) (b).

These guidelines are not designed to provide conclusive or definitive “rules” as to which qualifications fit the requirements of the legislation. They are designed to provide an insight into what the Board regards as important to meet the requirements and to show how the Board applies its subjective criteria in its deliberations.

### **Important points to note:**

- **Each application is determined on a case-by-case basis on its merits.**
- **The title of a course is not conclusive.**

The Board considers the qualification in detail, regardless of the title of the qualification. This is to both verify the presence of a field of a science or technology, and also to verify that that the qualification involves a depth of study that the Board considers sufficient to provide an appropriate foundation for practice as a patent attorney.

- **Seek early approval of qualifications.**

It is strongly recommended that anyone considering seeking patent attorney registration seek early approval of his or her academic qualification from the Board. This should ideally be **done before further** study is undertaken to obtain the knowledge requirements set out in regulation 20.8 and Schedule 5, and also before achieving the employment requirements set out in regulation 20.10.

**Failure to obtain early approval of the academic qualification may delay the final registration process, or may result in wasted study if the qualification is not approved.**

There is no fee for making an application for approval of an academic qualification and a request is made on Form 7 (see at the end of this set of guidelines). Note that there is no need for the qualification required for trade marks attorney registration to meet the requirements of Regulation 20.6 (2) of the Patent Regulations. For registration as a trade marks attorney it is sufficient that an applicant has, or is entitled to, an AQF qualification from the higher education sector, or an equivalent qualification awarded by an overseas institution, in any field of study.

## **General Principles**

- 1. The qualification should contain relevant studies in a field of science or technology.**
- 2. Each qualification is examined on its individual merits.**
- 3. There is no set list of relevant programs of study.**

The title of the course or program or award will play little role in the deliberation. For example, a degree in natural history may contain numerous chemistry, biology and biochemistry subjects (to second or third year level) or it may not. It is the subjects and their content that are relevant, not the title of the qualification.

- 4. The relevant studies must be in a field of science or technology.**

It is considered that patent attorneys need to have, amongst other things, strong and well-developed analytical skills in the technological aspects of science or engineering, and that the intellectual rigour of study in those areas is likely to equip a person to

function competently as a patent attorney. The Board thus looks for subjects that provide these skills. To do this, the Board should not only be provided with a list of subjects studied in obtaining the qualification, but also with a description of the content of those subjects.

- 5. The qualification, or a course taken for the purpose of the qualification, must be in a field of science or technology that contains potentially patentable subject matter.**

The purpose of this provision is to ensure that patent attorneys have acquired an in depth understanding of the processes of *research*, design and inquiry that lead to discoveries and inventions in at least one area of technology in which patent applications may be lodged, and have developed an appreciation of the context in which patentable subject matter might arise in at least that one area. However, the presence of the word ‘potentially’ makes this part of the requirement quite broad, and usually easily met by most qualifications put before the Board. Given this, there is rarely any benefit in providing the Board with copies of granted Australian patents as evidence of subject matter that is potentially (or actually) patentable under Australian law. By the same token, it is not enough to show that a qualification is in a field that involves patentable subject matter. The qualification must still be in a field of science or technology. There are many disciplines in which *applications* of patented subject matter are studied as part of the knowledge base of the field, but which would not provide an acceptable qualification for registration as a patent attorney. In fields such as health care and information technology, for example, a curriculum might not provide a study of the scientific or technological concepts underlying subject matter patented in the area, nor a fundamental understanding of the processes of research and inquiry that lead to such patenting activity.

- 6. There must be sufficient depth of study to satisfy the Board that the qualification provides an appropriate foundation for practice as a patent attorney.**

It is not enough for a natural history qualification to have two first year introductory subjects (say, chemistry and biology) for that qualification to provide an appropriate foundation for practice as a patent attorney. The Board typically looks for the

presence of several subjects addressing aspects of science or engineering, ideally through to a final year undergraduate level. There is no set percentage or quantity of subjects for these deliberations - the Board will be looking for sufficient depth to provide the strong and well-developed analytical skills mentioned above.

7. **What is considered an acceptable qualification can change with time.**

Some fields of study that previously did not contain technological content or potentially patentable subject matter may qualify, as new insights or potential applications lead to the developments in the field

8. **“Old qualifications.”**

There may be some practical difficulties for the Board in considering a qualification completed many years ago. The Board is unable to speculate about the content of a qualification. If a person is not able to provide evidence of the content of a qualification, due to its age, the Board may be unable to approve the qualification. In the event that suitable evidence can be supplied, all of the above guidelines apply regardless of the age of the qualification.

9. **Overseas qualifications.** All of the above guidelines also apply regardless of the country in which the qualification was conducted and awarded. Subregulation 20.6(1)(b) provides for a qualification awarded by an overseas institution that the Board is satisfied **is equivalent** to an AQF qualification from the higher education sector. In some situations a person may be required to provide evidence of equivalence. However, again the Board is unable to speculate about the content of a qualification. A person applying on the basis of an overseas qualification will still be required to provide suitable evidence of the content of the qualification to show compliance with the Regulations.

## Approved Fields of Study

**The Board has determined that it will not list qualifications that have been approved in the past.**

It is not possible to provide an exhaustive list and each application must be considered on its own merits taking into account the course of study and the depth to which subjects are studied. There can be variations in respect of the same qualification studied at different institutions and possibly even within the same institution. A final decision by the Board requires a full analysis of a person's application to ensure that the requirements are met. It should also be appreciated that course content can change over time. The content of the subjects of a course conducted in the 1980's, for example, may be quite different to the same subjects taught today.

## Applications

Applications may be made to the Secretary of the Board at any time. The Board will consider applications for approval of academic qualifications at meetings held usually three times a year. The cut-off date for receiving applications by the Secretary is one month before the date of the meeting. Applicants are advised to contact the Professional Standards Board Secretariat for more details or check details on the [PSB web-site](#). The application form is available [here](#).

## Contact Details

The contact details for the Secretary, Professional Standards Board for Patent and Trade Marks Attorneys

Mail address:           The Secretary  
Professional Standards Board for Patent and Trade Marks Attorneys  
P O Box 200  
WODEN ACT 2606

Phone:                   (02) 6283 2345  
E-mail:                  [mail.psb@ipaustralia.gov.au](mailto:mail.psb@ipaustralia.gov.au)  
Web-site:                <http://www.psb.gov.au>