

Guidelines

on

Exemptions from Courses of Study for

Patent Attorneys

All candidates are required to pass or be exempted from each of the nine topic groups (A to I) specified in Schedule 5 of the Regulations.

A topic group may be *passed* either by passing an examination conducted by the Board (prior to 2005), or by successfully completing a course of studies offered by a university or any other institution that has been accredited by the Board in relation to that topic group.

Power to grant exemptions

The Board may exempt a candidate from having to satisfy all or some of the requirements of a topic group on the basis of previous studies in a non-accredited course (including a course previously or subsequently accredited, but that was not accredited for the particular year in which the candidate completed it).

Before granting an exemption, the Board must be satisfied that the candidate has passed the course of study at a satisfactory level and that the course has outcomes that are the “same as, or similar to, those of an accredited course for the topic group for which the exemption is sought” (Regulation 20.3 of the Patent Regulations 1991).

Formal study is required

The regulations stipulate that the requisite knowledge must be gained through formal study at a university or other approved institution. Knowledge gained by experience is *not* an acceptable substitute.

Information required by the Board

In assessing an exemption application, the Board seeks extensive information about the course. This normally includes:

- a mapping of the topic requirements (see below) against the course undertaken, together with evidence of the inclusion of the particular component;
- whether the course is based on a law that is the same or similar to the Australian law applying to the topic group;
- duration and workload; and
- methods of assessment (In looking at the methods of assessment the Board needs to be satisfied that the applicant has been assessed on a broad selection of the course).

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Applicants frequently fail to provide sufficient evidence to satisfy the Board that a particular course has met the requirements. The inclusion of a relevant item in a course outline will not suffice. The Board needs to be assured that the time allocations permit the subject matter to be studied in sufficient depth. For this reason, candidates are urged wherever possible to provide detailed course outlines *for the year in which the course was taken by the candidate*. Where such outlines are unavailable, candidates may need to obtain a letter or statement from someone involved in teaching the course that can provide the necessary information.

Outdated studies

Where studies were completed some years previously, the Board takes care to ensure that they are relevant to current practice. For example, the Board may decline to grant an exemption where the law has changed significantly, rendering the prior studies inappropriate or obsolete. This situation is less likely to arise in areas dealing with concepts of enduring relevance.

Overseas qualifications

International qualifications may be submitted to gain exemptions. However, the Board does not grant exemptions purely on the basis that a qualification from another jurisdiction has satisfied the requirements of that jurisdiction. It generally requires that the law should be similar to that in Australia and/or that the legal institutions and their workings are similar.

Status of exemptions granted by universities

Universities and other accredited providers customarily grant exemptions or waivers of prerequisites for subjects in their academic programs so as to enable students to progress to advanced studies or to satisfy requirements for their degrees or diplomas. The Board recognises the right of a university to grant exemptions for its own academic purposes, but they cannot be binding on the Board. The Board has a statutory responsibility to make its own assessment of the relevance and adequacy of the prior studies on which an exemption is sought in accordance with its own criteria (see above).

Thus for example an institution may grant an exemption from Patent Law on the basis that the candidate has previously studied that area overseas, or as part of a general course on Intellectual Property, and allow the candidate to enrol in Patent System (or some equivalent). As explained below, however, it is unlikely that the Board will be satisfied that those prior studies will justify an exemption for Topic Group E.

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Applications for Exemptions

Forms

Applications for exemption should be made in the approved form. **It should be noted that the form comes in two parts.**

Part 1 is the cover form; **and**

Part 2 relates to the particular topic group in which the exemption is sought.

- Group A - Legal Process and Overview of Intellectual Property
- Group B - Professional Conduct
- Group C - Trade Mark Law
- Group D - Trade Mark Practice
- Group E - Patent Law
- Group F - Patent System
- Group G - Drafting Patent Specifications
- Group H - Interpretation and Validity of Patent Specifications
- Group I - Designs

An example of the completed forms is attached. Candidates making applications are required to complete **both parts** of the application and provide in addition:

- a certified copy of the academic record or similar record indicating successful completion of the course(s) of study on which the application for exemption is based;
- syllabus details showing detailed information of the course(s); and
- information on the assessment regime for each course and evidence that the assessment covered relevant topic areas.

The Topic Groups

The overall objective of a course of study is for a candidate to have an appropriate level of:

- (a) Knowledge and practical application so that the candidate can give advice about applicable categories of protection for particular activities;
- (b) Appreciation of the advantages of each form of protection for a client;
- (c) Understanding of how to get and maintain appropriate protection for a client; and
- (d) Understanding of the required standard of professional conduct.

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Set out below are what the Regulations have to say about each topic group, together with advice as the Board's usual practice in relation to applications for exemption.

Group A: Legal process and overview of intellectual property

Outcome

An understanding of the Australian legal system and how intellectual property rights may be protected.

Topics

1. The Australian legal system, including:
 - (a) appeal or review procedure;
 - (b) Parliament;
 - (c) the courts;
 - (d) precedent;
 - (e) statutory interpretation.
2. Overview of intellectual property rights:
 - (a) patents;
 - (b) trade marks;
 - (c) designs;
 - (d) copyright;
 - (e) circuit layouts;
 - (f) plant breeders' rights;
 - (g) confidential information and trade secrets;
 - (h) trade practices and anti-competitive practices;
 - (i) international intellectual property treaties.

Advice on Board practice

Legal process: Candidates possessing Australian law degrees are routinely exempted from this requirement and need only cite the degree in this part of the application (that is, there is no need to detail coverage of the areas set out in 1(a)–(e) above). The Board may also grant an exemption in relation to overseas studies, provided the legal system in question is a common law system.

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Overview of intellectual property: Candidates need to have completed either a general or “survey” subject on intellectual property, or a combination of subjects that cover the required areas. The absence of coverage of one of the “core” areas of patents, trade marks, designs or copyright will usually result in an exemption not being granted, but the Board will often accept studies even if they do not cover more minor areas such as circuit layouts.

The Board will also generally accept studies completed overseas, provided the laws studied are broadly similar in concept to their Australian equivalents, especially in the core areas listed above.

Group B: Professional conduct

Outcome

An understanding of the rights, privileges and responsibilities of a patent or trade mark attorney.

Topics

- (a) conflict of interest;
- (b) privilege;
- (c) confidentiality;
- (d) professional liability and negligence;
- (e) code of conduct;
- (f) maintenance of rights and monitoring systems;
- (g) fiduciary obligations to clients.

Advice on Board practice

The Board will usually grant exemption to those who have studied professional conduct as part of a law degree and/or practical legal training undertaken for the purpose of admission as a legal practitioner. Candidates who furnish evidence that they have been admitted as a legal practitioner in Australia will not be required in their application to detail coverage of the areas set out in (a)–(g) above.

Group C: Trade mark law

Outcome

An understanding of the principles of trade marks and the trade mark system in Australia.

Topics

- (a) passing off and unfair competition;

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- (b) advice on registrability;
- (c) comparison of business names and trade marks;
- (d) marks excluded from registration;
- (e) other provisions for trade indicia protection:
 - (i) Olympic insignia legislation;
 - (ii) domain names;
 - (iii) geographical indications;
 - (f) criteria that affect registrability:
 - (i) distinctiveness;
 - (ii) deception and confusion;
- (g) ownership — authorship of trade marks;
- (h) use:
 - (i) intention to use;
 - (ii) honest concurrent use;
 - (iii) prior continuous use;
- (i) protection:
 - (i) infringement;
 - (ii) well known marks.

Advice on Board practice

Study of trade mark law in another country, or as part of a general or “survey” course in intellectual property, will not usually be sufficient to gain exemption.

Group D: Trade mark practice

Outcome

Ability to advise and to handle the interests of a client in prosecution and maintenance of trade mark applications, including advice on the desirability of seeking trade mark protection and provision of alternative protection in Australia and other countries.

Topics

- (a) classification systems;

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- (b) searching;
- (c) types of application and registration;
- (d) trade marks office practice and procedure:
 - (i) filing;
 - (ii) examination;
 - (iii) hearings;
 - (iv) opposition;
 - (v) evidence;
 - (vi) extension of time;
- (e) removal for non-use;
- (f) rectification;
- (g) registration of security interests;
- (h) border controls;
- (i) exploitation:
 - (i) assignment;
 - (ii) licensing;
 - (iii) parallel imports;
 - (iv) managing a trade marks portfolio;
- (j) misuse and criminal sanctions;
- (k) international:
 - (i) treaties and conventions;
 - (ii) regional systems (eg CTM);
 - (iii) differences between systems (including requirements to use, first to file, first to use, post-acceptance, pre-acceptance, registration opposition and renewal requirements);
 - (iv) other classification systems;
- (v) unacceptable trade marks — restrictions on registrability;
- (vi) practical differences (eg legalised and notarised documents, powers of attorneys).

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Advice on Board practice

Study of trade mark practice in another country will not usually be sufficient to gain exemption.

Group E: Patent law

Outcome

An understanding of the principles of patents and the patent system in Australia.

Topics

(a) subject matter:

- (i) manner of manufacture;
- (ii) newness;
- (iii) novelty;
- (iv) inventive step;
- (v) secret use;
- (vi) exclusions from patentability;
- (vii) utility;

(b) section 40 (specifications):

- (i) description;
- (ii) claims;
- (iii) fair basis;

(c) infringement;

(d) inventorship;

(e) ownership;

(f) breach of confidence.

Advice on Board practice

Study of patent law in another country, or as part of a general or “survey” course in intellectual property, will not usually be sufficient to gain exemption.

Group F: Patent system

Outcome

Ability to advise and to handle the interests of a client in prosecution and maintenance of a patent application, including advice on the desirability of seeking patent protection and provision of alternative protection in Australia and other countries.

Topics

- (a) types of application:
 - (i) provisional;
 - (ii) complete;
 - (iii) divisional;
 - (iv) patent of addition;
 - (v) Convention;
 - (vi) priority dates;
- (b) Patent Office practice;
- (c) amendment;
- (d) opposition;
- (e) re-examination;
- (f) maintenance;
- (g) extension of term;
- (h) extension of time;
- (i) revocation;
- (j) treaties and conventions, including:
 - (i) Patent Cooperation Treaty;
 - (ii) Budapest Treaty;
 - (iii) Paris Convention;
- (k) searching;

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- (l) assignment;
- (m) licensing;
- (n) compulsory licences;
- (o) Crown use;
- (p) restrictions on exploitation:
 - (i) Patents Act 1990;
 - (ii) Trade Practices Act 1974;
- (q) circuit layout legislation and practice;
- (r) plant protection legislation and practice;
- (s) patentability in other countries;
- (t) patent procedure in other countries, particularly major trading parties (eg New Zealand, United States of America, European Community, People's Republic of China, Japan);
- (u) petty patents.

Advice on Board practice

Study of patent practice in another country will not usually be sufficient to gain exemption.

Group G: Drafting patent specifications

Outcome

Ability to obtain relevant information about an invention and from that, given the prior art, draft a specification to accompany a provisional application, a standard complete application, an international application and a petty patent application.

Advice on Board practice

Where a candidate has studied the principles of drafting patent specifications in another country that has a broadly similar patent system, the Board's usual practice is to grant an exemption, but to make that conditional on the candidate successfully completing a course of study that satisfies the requirements (either by accreditation or exemption) for Topic Group E – Patent Law.

Group H: Interpretation and validity of patent specifications

Outcome

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Ability to express an understanding of a patent specification and what it covers for the purpose of advising on infringement, validity over given prior art, section 40 of the Act and other grounds of revocation and amendment.

Advice on Board practice

Where a candidate has studied this area in another country that has a broadly similar patent system, the Board's usual practice is to grant an exemption, but to make that conditional on the candidate successfully completing a course of study that satisfies the requirements (either by accreditation or exemption) for Topic Group E – Patent Law.

Group I: Designs

Outcome

Ability to advise and to handle the interests of a client in prosecution and maintenance of a design application, including advice on the desirability of seeking design protection and provision of alternative protection in Australia and other countries.

Topics

- (a) registrability;
- (b) newness;
- (c) registration procedure;
- (d) maintenance;
- (e) office practice;
- (f) third party objection;
- (g) infringement;
- (h) expunction;
- (i) copyright;
- (j) international aspects of design practice.

Advice on Board practice

Study of designs law in another country, or as part of a general or "survey" course in intellectual property, will not usually be sufficient to gain exemption.