

Professional Standards Board

Disciplinary Guidelines for Registered Patent and Registered Trade Marks Attorneys

These guidelines set out the procedures that the Professional Standards Board (the **Board**) will follow in investigating a registered patent attorney or a registered trade marks attorney (**attorney**) and deciding whether or not to commence disciplinary proceedings.

Overview

- 1 The legislative basis of the Board's role in disciplinary proceedings is regulation 20.33 of the *Patents Regulations 1991* (the **Regulations**). Also relevant are regulations 20.32, 20.34 and 20.35 of those Regulations. All those regulations apply in relation to registered trade marks attorneys through regulation 20.15 of the *Trade Marks Regulations 1995*.
- 2 These disciplinary procedures are aimed at assisting the Board to be satisfied whether or not an attorney has a reasonable likelihood of being found guilty, by the Disciplinary Tribunal, of an offence under subregulation 20.33(2) of the Patents Regulations.
- 3 A decision that an attorney is guilty of an offence may be only made by the Disciplinary Tribunal. The focus of the Board's disciplinary procedures is to decide whether or not to commence proceedings before the Tribunal. The disciplinary process is concerned with the conduct of registered attorneys and whether disciplinary action should be taken against them. The Board is not empowered to order or provide restitution to clients of attorneys. Claims seeking restitution for such matters as overcharging or failure to perform services, compensation for damage or for loss of profits, or the return of documents, would need to be pursued by the client in other forums. It should be noted, however, that neither the Board nor the Secretary to the Board is able to provide legal advice.
- 4 An offence under the Regulations is described in these procedures as an 'offence'. Although the terms 'offence' and 'guilty' are used in the regulations the investigation and disciplinary processes are administrative in nature and not criminal proceedings.
- 5 In carrying out their functions in relation to disciplinary procedures, the Board and the investigating officer will also observe the other routine elements of statutory decision making such as avoiding conflicts of interest, bias and prejudgement, not taking into account irrelevant considerations and confining their focus to the decision as set out in the legislation.

Offences

Unsatisfactory professional conduct

- 6 One category of offence is 'unsatisfactory professional conduct'. This category of offence is the less serious of the 2 categories.
- 7 The Regulations¹ provide that unsatisfactory professional conduct includes:

 'conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney.'
- 8 The Regulations also provide that failure, without reasonable excuse, to provide information required by the Board - under its legislative power to require an attorney to provide information - is itself 'unsatisfactory professional conduct'².
- 9 The Board has a discretion whether or not to commence proceedings in the Disciplinary Tribunal if the Board is satisfied that there was reasonable likelihood of the attorney being found guilty of unsatisfactory professional conduct.

Other offences (professional misconduct, registration issues etc)

- 10 The regulations also establish a more serious category of offences for which the Board must commence proceedings if it was satisfied that there is a reasonable likelihood of the attorney being found guilty. These offences are:
- (a) The attorney has been engaged in 'professional misconduct' (defined as set out below); or
 - (b) at the time of registration, the attorney did not hold the academic qualifications and knowledge requirements set out in the regulations; or
 - (c) the attorney obtained his or her registration by fraud.
- 11 The regulations³ define professional misconduct as:
- unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or
 - any other conduct, whether occurring in connection with practice as an attorney or otherwise, that shows that the attorney is not of good fame, integrity and character; or
 - any contravention of a law that is declared by the regulations to be professional misconduct.

¹ Regulation 20.32 of the Patents Regulations

² Subregulation 20.34(2) of the Patents Regulations

³ Regulation 20.32 of the Patents Regulations

The investigation process

Initiating an investigation

- 12 The Board can act on 'information' (eg a complaint) from a client of an attorney (or other persons), or the Board can initiate an investigation 'of its own motion'. There is no express threshold test that must be met before the Board can decide to initiate an investigation.

Confidentiality of complainants

- 13 Generally, the Board is not able to guarantee the confidentiality of a complainant. Fairness to an attorney and transparency of the process will usually require that the substance of the complaint be put to the attorney.
- 14 On occasion, fairness would require the identification of the complainant or the facts as put to the attorney may reveal the identity of the complainant. A complainant who wishes to remain anonymous should consult the Board about whether this would be practicable in the particular situation.
- 15 In this context, the documents produced by or on behalf of the Board in an investigation process are also subject to the Freedom of Information Act and production under any relevant Court subpoena. If a matter proceeds to the Disciplinary Tribunal, the identities of a complainant and people who have given evidence are likely to be revealed.

Steps that the Board will take

- 16 It is possible that some complaints may be dealt with expeditiously without an investigation. The Board may consider that a complaint is spurious or vexatious and decide not to commence an investigation. In other circumstances it may be that early communication with the attorney concerned would deal with the issue in an efficient manner. These procedures are not intended to constrain the Board from operating flexibly in appropriate circumstances.
- 17 The decision to commence an investigation will be made by the Board.
- 18 The Board may expressly authorise at least one specified individual (the **investigating officer**) to carry out further inquiries on the matter, an investigation or a particular aspect of an investigation, on its behalf. An investigating officer may be a member of the Board, IP Australia or a consultant.
- 19 In conducting an investigation, the investigating officer:
- (a) Will act on behalf of the Board;
 - (b) Will report to the Board following the investigation, or at convenient points during the investigation;
 - (c) May discuss the issues and take evidence from a complainant. In obtaining evidence, the investigating officer should do so in a manner which would facilitate the Board putting together a brief of evidence if the matter was to go to the Disciplinary Tribunal;

- (d) May require information from the attorney;
- (e) May be assisted by legal or other advisers;
- (f) Will assess the behaviour of the attorney against the *Code of Conduct for Patent and Trade Marks Attorneys*;
- (g) May consider whether there is a pattern of behaviour by the attorney;
- (h) May ensure that, at an appropriate point, the attorney has an opportunity to respond to the issues raised in the matter.

Requiring information from the attorney

- 20 In undertaking its investigations into a registered attorney, the Board is provided with power under the Patents Regulations to request information from the attorney being investigated.⁴
- 21 If information is required in the course of the investigation, the investigating officer will, on behalf of the Board, request that information from the attorney. At what stage in the investigation this power is exercised will be a matter for evaluation in each particular case.
- 22 The failure of an attorney to provide information, without a reasonable excuse, is unsatisfactory professional conduct.⁵
- 23 Regulation 20.34 allows the Board to 'request' the attorney who is the subject of the investigation to provide information. The effect of the 'request' is to require the attorney to provide the information requested by the Board, unless the attorney has a reasonable excuse.

The Board's decision on commencing proceedings

- 24 A threshold test must be met in order for the Board to commence proceedings against an attorney in the Tribunal.
 - (a) The Board may commence proceedings before the Tribunal against an attorney if the Board is satisfied that there is 'a reasonable likelihood' of the attorney being found guilty of unsatisfactory professional conduct.⁶
 - (b) However, the Board must commence proceedings against an attorney if the Board is satisfied that there is a 'reasonable likelihood' of the attorney being found guilty of professional misconduct, or that the attorney, at the time of

⁴ Regulation 20.34 of the Patents Regulations

⁵ Subregulation 20.34(2) of the Patents Regulations

⁶ Subregulation 20.33 (3) of the Patents Regulations

his or her registration, did not hold the required academic qualifications or knowledge requirements or obtained his or her registration by fraud.⁷

- 25 In deciding whether or not an attorney has engaged in professional misconduct or unsatisfactory professional conduct, the Board must consider whether the attorney has complied with the *Code of Conduct for Patent and Trade Marks Attorneys*.
- 26 The Board is permitted to take into account 'patterns of behaviour' of the attorney when it is deciding whether or not it is satisfied that there is a 'reasonable likelihood' of the attorney being found guilty of an offence.

Commencing disciplinary proceedings

- 27 Once the Board determines that it will commence disciplinary proceedings, the Board must formulate charges and must give notice to the Tribunal.⁸
- 28 The notice to the Tribunal must be in writing and set out the charges against the attorney⁹.
- 29 A copy of the notice must be given to the attorney as soon as practicable after giving notice to the Tribunal.¹⁰

⁷ Subregulation 20.33(4) of the Patents Regulations

⁸ Regulation 20.35 of the Patents Regulations

⁹ Subregulation 20.35(2) of the Patents Regulations

¹⁰ Subregulation 20.35(3) of the Patents Regulations