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This submission represents my own personal views and does not necessarily reflect those of my employer.

Q1. No, but this is not surprising given its current, relatively limited role in enforcement activities. In order to increase the information available and keep it at the requisite level of quality, it will be necessary for IP Australia to work in co-operation with legal practitioners, the courts and businesses to gather and present the necessary content (just as was done for the useful, but often sadly-overlooked, “IP Toolbox” project), perhaps even in some formal consortium arrangement. The imperative to do all of this work will, in large part, depend on the outcomes from other parts of this present review; following this, though, some thought should also be given to additional financial support.

Q2. Again, depending on the outcome of this present review, the answer must be yes. Some years ago, this respondent taught a Masters degree course in “IP Exploitation”; in running this, the opening comment was always: “Well, you have your patent or other IP: now, what do you do with it?”. Historically, IP Australia’s education and training has, for obvious reasons, has been geared towards the grant process for patents (and, similarly, registration processes for trade marks and designs): the move now has to be made to a balanced, ‘whole of lifecycle’ approach to IP education and training issues. Likewise, it will be necessary to provide a ‘whole of IP’ approach by ensuring full co-operation of other parts of Government to gain necessary content or personnel (e.g. A-G on all copyright issues).

Q3. Some form of public awareness campaign must accompany increases in available information, education or training. Making clear that obtaining rights is not the end of the process is essential: people must be aware of the need to monitor activities of potential infringers and know how to act accordingly, just as a gardener has to weed the garden. Perhaps some advertising using the gardening imagery or similar might be useful?

Q4. Only to a limited extent; the reason for this caution is that the risk of providing incorrect or out-of-date information on the procedures and institutions in a foreign jurisdiction far outweighs the benefits of the information provided. Unless substantial funding is to be committed to websites and helpdesk facilities (see Q32 below on experiences with the EU IPR Helpdesk project), what could be most usefully done at present is to provide a list of English-language resources on or within the jurisdiction concerned and links to relevant websites.

Q5. Yes, given the global trend towards emphasis of post-grant opposition (PGO): any future Patent Law Treaty on substantive patent law is likely to tilt in this direction anyway. Both the US Hatch-Leahy Bill (S3818) and the UK’s procedure under s72, Patents Act 1977 provide useful pointers as to possible designs for any future Australian counterpart. The common criticism that PGO means that issues other than validity cannot be raised before grant is not always correct, depending, as it does, on the actual system

design in question (e.g. the UK patents system allows disputes as to *ownership* to be raised as part of a separate *pre-grant* 'entitlement determination' procedure: s8, PA 1977 (UK)). As to the lack of certainty inherent in PGO systems, this is somewhat overplayed: strict, short time limits for filing and prosecution can easily resolve the problem (when run through the Patent Office, UK time limits for filing statements, counterstatements and evidence are measured in by blocks of weeks, with comparatively strict rules on extensions).

Q6. Provided there is a clear procedural framework and a strict, short timetable, yes, patent owners could actually benefit from PGO. However, in order to reduce any possible inconvenience, it may also be prudent to allow for possible third party objections or other obstacles to be identified *pre-grant* by submission of 'observations on patentability' as under s21, PA 1977 (UK).

Q7. Yes, provided that there remains discretion to weed out 'frivolous and vexatious' or otherwise inappropriate requests (as per s74A, PA 1977 (UK)). Also, such opinions should be clearly marked as non-binding (see Q8 below).

Q8. No, not unless the courts, any future patent court (or tribunal) are correspondingly legally bound to defer to such an administrative decision and for all purposes (including infringement proceedings).

Q9. No, following on from Q8.

Q10. Yes. Such systems are commonplace in civil litigation elsewhere within the Australian legal system and experience has been, on balance, positive.

Q11. Yes. Such a facility, bearing the imprimatur of IP Australia, would certainly be a useful addition, especially to SMEs with 'shallow pockets'. However, there would be a need to revisit funding arrangements and a key decision as to whether the results should be binding as between the parties (in arbitral style); this respondent believes that this latter should be the case.

Q12. Yes. This is standard practice in many other parts of the civil litigation side of the Australian legal system. However, overseas experience shows that where mediation is voluntary in IP issues, bigger players will sidestep it to disadvantage SMEs and other smaller players. In addition, timetabling and placement within the wider spread of possible patent-related litigation has to be carefully thought out because of the importance of allowing a genuinely aggrieved plaintiff the possibility of getting an effective and enforceable interlocutory injunction or similar order(s) (i.e. there still has to be the possibility, independently, of seeking relief *ex parte* and at short notice to prevent destruction of evidence or transfer of funds in infringement cases).

Q13. Yes, assuming mediation is in arbitral style and mandatory (see Q11 and Q12).

Q14. Yes, the tribunal approach is definitely worthy of further study. An alternative or supplement might be creation of a specialist first-tier Commonwealth court along the lines of the Patents County Court of England and Wales (see the 2003 review of its work by Judge Michael Fysh at <http://www.oiprc.ox.ac.uk/EJWP0303.pdf>); this has mediation facilities (use of which has increased considerably since the time of the review), a carefully controlled tight timetable and case loading system, and permits patent and trade mark attorneys to appear at the bar.

Q15. Yes. The Federal courts and State Supreme Courts are carrying such a volume of work that such a move would be justified on that ground alone. However, given the inherently specialist and increasingly complex nature of patent work, use of a correspondingly specialist tribunal is also an important consideration. In either case, one could reasonably expect to see a reduction in time (and, so, cost) of proceedings.

Q16. If properly mandated and operated on strict timetabling/case scheduling principles (e.g. use of electronic filing and process to the maximum extent possible), no. Indeed, it may actually cut cost and complexity (see Q15).

Q17. Probably not. However, leaving aside specialist *full* judicial bodies (see Q14 above), one might also consider use of an Appointed Person system (cf. UK trade mark disputes over registrability).

Q18. Yes. The system needs to be unified to the maximum extent possible; in this context PGO assessment represents a fundamentally logical activity for any future tribunal (or similar) to be involved with.

Q19. At present, no. The cover is hard to find, very restricted if obtained, and expensive to maintain. Until the market for such policies develops further, IP litigation insurance should not be recommended to SMEs (however, they should always check to see if their existing *general* legal cover stretches to IP disputes – they might be pleasantly surprised).

Q20. This is already largely identified in the report: uncertainty - sometimes the uncertainty of the very existence of the subject matter of the policy (e.g. How can an insurance company know for certain *ex ante* that a patent is valid? Even if it obtains legal advice, there are no guarantees).

Q21. Very little, unless the patent system is redesigned to make patents automatically and perpetually valid after grant. The IP insurance market is growing slowly as the relevant insurance companies are getting better at assessing risk, but this is a long-term problem that can only be resolved incrementally within the market itself. In the shorter term, all Government can (and should) do is concentrate on the time, costs and complexity of patent litigation (see above).

Q22. No. The cost of designing, implementing and operating such a system would be significant. Once operating, the rules on access and eligibility would be complex (again, creating costs for those accessing it, to the detriment of SMEs). It would also be

inevitably seen as a Commonwealth-sponsored ‘pillow’ by some less scrupulous patent owners and targeted accordingly. Again, the emphasis should lie in patent litigation reform.

Q23. N/a (see Q22).

Q24. No (see Q22).

Q25. No. There should be no need to provide such support if costs are lower to start with and it is not something that all taxpayers need to be saddled with – concentration on patent litigation reform is the key. Ultimately, because they enjoy a Commonwealth-sponsored monopoly (albeit temporarily, and a quasi-monopoly in the case of copyright), IP owners already receive a bounty from the public at large. Why should the latter pay twice? Put another way, the privileged position of IP owners means that, even if SMEs, they have to take at least some responsibility for enforcement and maintenance.

Q26. No (see by parity of reasoning with Q25).

Q27. N/a (see Q26 and Q27).

Q28. It depends on the width of definition of the planned offences; if these were to be limited to commercial dealings in infringing items (e.g. “knowingly selling or offering for sale”), then yes: if wider criminal liability is planned or sought, no.

Q29. Yes (see Q28).

Q30. In short, there is a need for a concerted push for a substantive Patent Law Treaty to complement the existing, process-centric one.

Q31. It may be possible (and would certainly be desirable) to pull together across all of Government the content and action plans referred to in the main brief, all of which are highly commendable. However, note the comments on possible risks from incorrect or out-of-date information referred to at Q4 above.

Q32. Yes, but again bear in mind costs and risks; such an effort would require an enormous and expensive team of contributors, editors, etc. (as personal experience with the EU IPR Helpdesk some years ago made painfully clear).

Q33. Pending full global harmonization of patents systems, not really.

Q34. Yes. Rectification of this anomaly is long overdue.