

25 September 2009

Ms Jacqueline Carroll
ACIP Secretariat
PO Box 200
WODEN ACT 2606

Jacqueline.carroll@ipaaustralia.gov.au

Dear Ms Carroll,

Re: ACIP Review of post-grant Patent Enforcement Strategies

Thank you for your invitation to comment on the ACIP Interim Report dealing with "Post-Grant Patent Enforcement Strategies". We welcome the opportunity to respond.

We note that the Report has taken a broad view of the impact of patent enforcement strategies, recognizing that patents operate within a broad societal framework. However, there were only 16 submissions to this review and all were from individuals and organisations with a vested interest in the management of patents. We do not dispute the importance of having expert input to a review such as this, but are concerned that there has been limited input from the broader community. We recognize that ACIP issued a broad invitation for contributions, and the lack of responses does not reflect on the intent of ACIP or the authors of this Report. Nonetheless, this lack of broader societal input makes it all more important that ACIP consider the broader issues in developing its Final Report.

The Report notes the importance of pre-grant opposition, recognizing that it may be both more efficient and appropriate to prevent concerns regarding a patent other than seeking to effect a cure after the event. The College notes the recommendation that there be a review of pre-grant opposition (page 60) and suggest that this should be included as a formal recommendation/proposal in the Final Report.

The list of proposals seems reasonable, but the specifics lie outside the scope of our expertise. But we would like to draw attention to a key element of Proposal 1. It is suggested that the funding for the dispute resolution centre would be on the basis of "user pays". Whilst this may be appropriate for large commercial entities wishing to resolve patent issues, it is not a level playing field. The report makes note of the challenges facing small companies seeking to challenge or defend a patent in the face of opposition from a much larger opponent (pages 23 and 42). The situation is even more inappropriate if one of the parties has no commercial interest in the patent. For example, should a professional organisation wish to challenge the granting of a patent on a gene, the organisation may challenge this on the basis of a patent being invalid (and thereby denying any revenue stream from royalties) rather than the patent being owned by the organisation (and thereby delivering a revenue stream to offset the cost of the challenge). We submit that the funding basis for the dispute resolution centre deserves further attention. In particular, it needs to be some mechanism for pro bono challenges.

The same principle would apply to Proposal 3. We submit that the development of training programs, education modules, and guidelines should be funded from a more general source rather than on the basis of "user pays".

Yours sincerely,

A handwritten signature in black ink, appearing to read "Debra Graves". The signature is fluid and cursive, with the first name "Debra" being more prominent than the last name "Graves".

Dr Debra Graves
Chief Executive Officer