



**THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
FICPI AUSTRALIA**

17 March, 2005

Secretariat  
Advisory Council on Intellectual Property  
PO Box 200  
WODEN ACT 2606

Attention: Mr Sean Applegate

Dear Sirs,

RE: Options Paper on Patents and Experimental Use

The following submissions in response to the ACIP options paper are made on behalf of the Australian Federation of Intellectual Property Attorney's (FICPI Australia). We thank the Secretariat for the extended opportunity to make our submissions.

In our original submissions of 14 May 2004, we noted that FICPI Australia is strongly of the view that clarity if required on whether or not an experimental use exemption does exist in Australia and what the form of the exemption is, and supported the European model of distinguishing between research on a patented invention and research with or using a patented invention. Following on from this, of ACIP's Preferred Options, we believe that option C8 provides the most clarity.

In supporting option C8, we have assumed that the proposed exemption will be applied to each claim of the patent independently of any other claim. Thus, a use that is an exempted experimental use of one claim in the patent should not necessarily be an exempted use of another independent claim in the same patent.

We also note that the proposed exemption in option C8 of "to investigate (an invention's) properties" is not clearly encompassed by the listed exemptions. We suggest that the first listed permitted act might be amended to "determining how an invention works or what its properties are" in order to resolve this.

FICPI Australia also has some concerns with the last of the listed permitted acts "developing an improvement to the invention". Since the whole point of the proposed exemption is to clearly permit research on inventions, whereas "developing" can have strong commercial implications, we suggest that "researching improvements to the invention" may provide greater clarity in terms of the proposed exemption than the current wording.

**PRESIDENT:**  
**PETER HUNTSMAN**  
1 Nicholson Street  
Melbourne 3000  
Australia

Telephone  
(03) 9254 2777  
International  
+613 9254 2777  
Facsimile  
(03) 9254 2770  
International Facsimile  
+613 9254 2770  
E-Mail  
phuntsman@davies.com.au

**SECRETARY:**  
**GREG CHAMBERS**  
21<sup>st</sup> Floor  
367 Collins Street  
Melbourne 3000  
Australia

Telephone  
(03) 9614 1944  
International  
+613 9614 1944  
Facsimile  
(03) 9614 1867  
International Facsimile  
+613 9614 1867  
E-Mail  
greg.chambers@pof.com.au

**TREASURER:**  
**STEPHEN KROUZECKY**  
Level 4, The Quadrant  
1 William Street  
Perth WA 6000  
Australia

Telephone  
(08) 9216 5100  
International  
+618 9216-5100  
Facsimile  
(08) 9216 5199  
International Facsimile  
+618 9216 5199  
E-Mail  
stevek@wray.com.au

Finally, in relation to option C8, we recommend that consideration be given to including the listed permitted acts in the regulations, rather than the Patents Act, so as to give greater flexibility to "tweaking" them when necessary.

We will be happy to amplify or further explain these comments if desired.

Yours faithfully

A handwritten signature in black ink, appearing to read 'P. 222' with a long horizontal flourish extending to the right.

**PETER HUNTSMAN**  
**President**  
**FICPI AUSTRALIA**