

Dear Kay,

I hope that the following brief comments in relation to Option D1 of ACIP's Experimental Use Options Paper may be of some value, notwithstanding the fact that I am unable to make a detailed submission at the moment.

1. "Although ACIP is attracted to the principled approach of this option, the large scale of the change to patent law and the potential breaching of TRIPS and the AUSFTA present major problems."

Comments:

(i) The scale of the change to the law required to implement Option D1 may not be as significant as ACIP implies. In particular, the proposed amendment arguably represents a more coherent and principled interpretation of the EXISTING doctrine of fair basis and/or the concept of an invention. In other words, it could be argued that D1 has a clear foundation in existing case law (ie. the case law regarding fair basis and the concept of an invention) and merely represents a better interpretation and/or rationalisation of that existing body of law, namely, an interpretation which is consistent with the true purpose and spirit of the doctrine of fair basis and the concept of an invention.

Option D1 would clearly affect the interests of product patentees to a significant extent, however, the question seems to me to be whether or not the cost is justified in terms of generating a more principled patent law. Further, to the extent that the philosophy which informs Option D1 is thought to be correct, the changes arguably do not affect the LEGITIMATE interests of product patentees.

(ii) Some aspects of D1 may actually be TRIPS-compliant, namely, those aspects which relate to patented processes rather than patented products.

2. "significant transition period while granted patents age to expiry"

Comments:

I assume this means that ACIP does not intend D1 to apply to patents which have already been granted but only to patents which are granted subsequent to the date of any amendment. However, D1 could apply to the construction of the proper scope of the claims of patents which have already been granted, for eg, in the context of post-grant litigation. However, such a change would obviously encounter the objection of retrospectivity, namely, that any amendment to the law would retrospectively restrict the rights of patentees in respect of already-granted patents.

3. "the consequences extend beyond experimental uses to other uses ... "

Comments:

Why is this consequence bad per se, particularly if it is assumed that the patentee is only properly entitled to a monopoly in respect of disclosed uses/utilities?

Although I am making these comments in my own name they could not have been made without the opportunity to conduct research in relation to this issue whilst employed as a Research Fellow at IPRIA.

I hope that the above comments are of some use.

Yours sincerely,  
Saba Elkman