

30th April 2004

Dr Rod Crawford
ACIP Secretariat

Dear Rod

Thank you for the invitation to comment upon the ISSUES PAPER regarding Patents and Experimental Use.

The paper comprehensively addresses the issues so I will not go into them.

Rather, I would like to make some comments from the practical perspective of someone who (many years ago) conducted scientific research in Australia and overseas and now is MD of a company that invests in and commercialises research. I also consult to WIPO on the commercialisation of intellectual property.

1) Researchers, particularly in a university, are generally unaware that they could be infringing patent rights in the course of experimental research.

2) I do not think the patent system as the major impediment to research, at least in universities, partly because of (1) but also because there are more significant impediments to research with commercial potential.

3) However, uncertainty with respect to the legality of using patented work for experimental purposes needs to be removed despite (1) in order to remove litigation risk for researchers and their (university) employer.

4) Researchers should be permitted to undertake experimental work within the scope of an invention's claims not only to test the invention but also to advance the technical field of the invention or improve the invention itself.

5) There is a distinction between activities in (4) and using an invention for the purpose of obtaining an economic benefit which is a justification for having a patent system..

6) I agree with the references on p18 (ref 40 Wegner) and (ref 41 Eisneberg) and in particular that a fundamental tenet of the patent system is that patent rights are granted subject to disclosure of the invention to the public. If the public were prohibited from experimental use of the disclosed information, without a licence from the patent owner, there would be little point in requiring the disclosure in the first place.

7) If experimental work is not permitted innovation could be stifled in the patent field and this is contrary to the principles of disclosure of inventions as a pre-condition for grant of a patent.

8) In summary, uncertainty should be removed and experimental use of patents permitted without infringing patent owners rights. The definitions of experimental use as set out by Canada to the WTO (page 18, ref 39) are reasonable and practical.

Thank you again for the opportunity to comment.

Kind regards

John

John V Turner, PhD FAIM
Managing Director
Flinders Technologies Pty Ltd
Mark Oliphant Building
Science Park Adelaide
Laffer Drive
Bedford Park
South Australia 5042

Tel +61 8 8201 7788
Fax+61 8 8201 7888
Email John.Turner@flinders.edu.au