

Mark Horsburgh  
Fisher Adams Kelly

> -----Original Message-----  
> From: Mark Horsburgh  
> Sent: Thursday, April 29, 2004 10:37 AM  
> To: 'rod.crawford@ipaaustralia.gov.au'  
> Subject: PATENTS AND EXPERIMENTAL USE ISSUES PAPER  
>  
> Dear Mr Crawford  
>  
> No doubt there will be detailed and extensive comments from various  
> organisations responding to the Issues Paper released by the  
Advisory  
> Council on Intellectual Property. Having read the paper there are  
> three points that summarise my thoughts:  
>  
> \* Experimental use is not an infringement in Australia  
because  
> such use does not fall within the definition of 'exploit'.  
>  
> "exploit", in relation to an invention, includes:  
> (a) where the invention is a product - make,  
hire, sell or  
> otherwise dispose of the product, offer to make, sell, hire or  
> otherwise dispose of it, use or import it, or keep it for the  
purpose  
> of doing any of those things; or  
> (b) where the invention is a method or process -  
use the  
> method or process or do any act mentioned in paragraph (a) in  
respect  
> of a product resulting from such use;  
>  
> The only word here that could lead to infringement is 'use', but  
the  
> accepted position has been that use in this context must be given a  
> meaning consistent with the rest of the definition, which has a  
clear  
> commercial flavour.  
>  
> \* Any commercial exploitation of the result of research,  
or  
> exploitation that leads directly to commercialisation, does fall  
> within the definition and is therefore actionable. A change in this  
> situation would give university commercialisation an unfair  
advantage  
> akin to a springboard doctrine situation.  
>  
> \* Australian Law is a combination of statute and  
precedent.  
> Codification has rarely led to improved clarity compared to  
precedent.  
>  
> \* A very small number of patents achieve appreciable  
commercial  
> return, an experimental use provision of the type discussed further  
> dilutes the value of the patent.

>  
> Mark Horsburgh  
> Partner  
> Fisher Adams Kelly  
> Phone: +61 7 3229 2655  
> Fax: +61 7 3221 0597  
> Email: mhorsburgh@fak.com.au  
> Website: www.fak.com.au <<http://www.fak.com.au/>>  
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