



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

17 September 2002

Mr Jeff Roberts
Secretary
Advisory Council on Intellectual Property
PO Box 200
Woden
ACT 2606

Dear Mr Roberts,

**Innovation Patent Review
Plant and Animal Subject Matter
Our Ref: NTB:PHH: GH:GF39215:GF39257**

I refer to Owen Malone's letter of 2 July 2002 and Peter Huntsman's telephone conversation with you on 6 September 2002, and thank ACIP for the opportunity for FICPI Australia to make representations on this topic.

FICPI Australia is an Australian association of a parent international body – FICPI (Fédération Internationale Des Conseils En Propriété Industrielle). FICPI members are Intellectual Property advisers and practitioners who work in private practice for many clients (but not for only one client). Accordingly, FICPI members represent the "free" profession. FICPI works with international bodies and various patent offices to monitor and enhance the intellectual property system and IP protection and enforcement procedures generally.

Members of FICPI Australia therefore act for and are well attuned to the needs of the developers of intellectual property and of the users of the IP systems in Australia.

FICPI Australia is strongly of the view that there is no logical reason why plant and animal subject matter has been excluded from the scope of protection available under the innovation patent system and that protection for both should be available under this system. The innovation patent system applies to all other areas of patentable subject matter including methods of treating diseases, pharmaceuticals and their uses and biotechnical treatments and developments. We are not aware of the nature of the concerns which brought about the exclusions to the innovation patent system and why it was plant and animal subject matter that was singled out. However, it is FICPI Australia's view that any social or other concerns should be addressed, where necessary, by targeted schemes rather than by incorporating restrictions in the patent legislation.

**PRESIDENT:
NOEL T BRETT**

3RD Floor
509 St Kilda Road
Melbourne 3004
Australia

Telephone
(03) 9243 8300
International
+613 9243 8300
Facsimile
(03) 9243 8333
International Facsimile
+613 9243 8333
E-Mail
noel.brett@griffithhack.com.au

**SECRETARY:
PETER HUNTSMAN**

1 Little Collins 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

**TREASURER:
GREG CHAMBERS**

21ST 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

The gap caused in IP protection by the exclusion of plant and animal subject matter from the innovation patent system is considered to present a problem, particularly to Australian SMEs, the very group that the innovation patent system was intended to help.

Under the present regime, researchers and developers of plant and animal subject matter have the option only of seeking protection for their work by the standard patent system and/or by way of Plant Breeder's Rights (PBR). The standard patent system can provide a monopoly for work that is inventive for up to 20 years, but has the disadvantage of being relatively slow to obtain grant and that some useful new advances are not entitled to a patent grant because they are considered insufficiently inventive. On the other hand, the PBR system has the major disadvantages to a developer of plant and animal subject matter that the PBR monopoly does not extend to the commercial use of seed harvested by farmers from PBR protected plants or to processes associated with the plant and animal subject matter.

Extending the innovation patent system to plant and animal subject matter would enable enterprises in this field to choose to obtain at least the same broad monopoly as is available under the standard patent system, for the potentially shorter term of 8 years, but more quickly. Such a choice is available to researchers and developers in all other fields of innovation to which the standard patent system applies. Prompt granting and certification of an innovation patent enables the patentee to take action for infringement earlier than with a standard patent.

Additionally, of course, extending the innovation patent system to cover plant and animal subject matter would also enable researchers and developers in this field to obtain protection for developments that are not susceptible to protection under the standard patent system because they are insufficiently inventive. Since innovation patents are published on grant, permitting protection by this route may bring innovations and inventions to the attention of the public, particularly other Australian researchers and developers in the field, that would not otherwise be published.

No national benefits are seen for excluding plant and animal subject matter from the innovation patent system. The only advantages would appear to accrue to users of the development, who do not have to pay appropriate compensation for the use if no standard patent protection has been obtained. The result of this is that less reward is available for the research and development effort and that less research may be conducted.

The issue of patent protection in Australia for overseas originating developments is not believed to be particularly relevant to whether or not plant and animal subject matter should be able to be protected by the innovation patent system. This is because very few other countries have a patent system that grants monopolies for developments of a lower inventive threshold than is applied to standard patents. Thus, any development overseas that is the subject of a patent application overseas is likely to be protected in Australia by way of a standard patent. Furthermore, it is unusual for patent protection to be sought overseas if it is not available where the development was made.

Extending the monopoly right under the innovation patent system to cover plant and animal subject matter is believed to be unlikely to affect non-IP right holders in a significant way. This is because patent protection would in any event only be available for subject matter that is new and at least innovative.

I trust you will find these comments of value in your deliberations, but we shall be happy to provide additional specific comments if desired or to participate in seminars, consultations and/or other discussion on the topic.

Yours sincerely



Noel T Brett
President
FICPI Australia