

17 July 2002

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

Dear Mr Roberts,

Review of Innovation Patent – exclusion of plant and animal subject matter

I refer to your recent invitation to Deputy Vice-Chancellors to express views about the exclusion of plant and animal subject matter from the scope of protection available under the innovation patent.

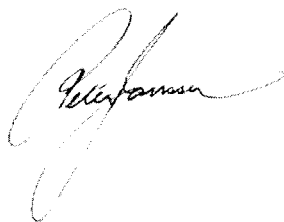
Your request has been referred to me by the University's Deputy Vice-Chancellor (Research), Professor T. Fred Smith, who has asked me to provide you with comments on his behalf.

1. As a first, general comment inventions from university researchers do not tend to run into problems with innovativeness. Our more usual concern is prior disclosure or usefulness. The lower innovativeness threshold offered by innovation patents may not be of direct benefit to us therefore.
2. Secondly, most patent filings by this University tend to be made at a fairly early stage of the research and development process. This is mainly due to the need to allow publications to proceed and to establish an early priority date. Inventions involving plant and animal subject matter tend to require a relatively long period of further R&D before there can be a marketable product. Taking this into account the shorter duration of innovation patents does not allow for a sufficient period of exclusivity for prospective industry partners or licencees.
3. Thirdly, most costs at the early stage of patenting are patent attorneys' fees. We standardly engage patent attorneys as this assists us (a) to ensure that the invention is properly identified and (b) to reassure prospective licencees that the patent specification has been competently framed. Hence there would be few cost savings to the University in filing an innovation patent rather than an application for a standard patent.

In summary, it is difficult to foresee the University making much use of innovation patents even if extended to plants and animals. Having said this I should be willing to participate in seminars or other consultative meetings about the matter.

I trust these comments are of use.

Yours sincerely,



Peter Janssen PhD
Contracts and Intellectual Property Officer