

# **SUBMISSION**

## **TOWARDS A STRONGER AND MORE EFFICIENT IP RIGHTS SYSTEM**

### **GETTING THE BALANCE RIGHT**

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\* a copy of Dimitrios' CV is available in the schedule attached to this submission

## Introduction

1. In March 2009, the Australian Government, through IP Australia its administrator of Intellectual Property Rights (IPR) acquired by registration or grant, issued two consultation papers for comment by interested stakeholders.<sup>1</sup>
2. The Consultation Papers have invited written submissions directed towards the object of the paper, namely encouraging discussion on certain proposed changes and their impact on business and innovation.<sup>2</sup>
3. I understand the invitation to make written submissions is predominantly in the areas raised by the Consultation Papers and the questions posed. However, I have made a brief reference to several other areas of concern with the current Australian patent law, which in my opinion inhibit innovation and therefore come under the wider agenda of the government to work toward a stronger and more efficient IP rights system.
4. In this regard, the Consultation Papers indicate that if the IPR are less likely to be invalidated and more likely to be enforced, this confidence will reflect in a greater investment in research leading to innovation.
5. This submission relates to the Balance Paper.

## Background

6. The government initiative through the Consultation Papers is a commendable step. It acknowledges the importance of the patent system as a mechanism designed to promote investment leading to innovation.<sup>3</sup> The incentive provided by the statutory monopoly is tempered and tolerated not only for the immediate availability of inventions but for the disclosure of information which may *'help subsequent innovators to build on previous innovations...'*<sup>4</sup> (the 'patent theory').

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<sup>1</sup> IP Australia Consultation Papers March 2009:

'Towards a Stronger and More Efficient IP Rights System – Getting the Balance Right' (the 'Balance Paper'); 'Towards a Stronger and More Efficient IP Rights System – Exemptions to patent infringement' ('the Experimental Use Paper').

<sup>2</sup> The Introduction to the Balance Paper and the Experimental Use Paper.

<sup>3</sup> The Balance Paper at [1].

<sup>4</sup> Ibid

7. The Consultation Papers have identified a number of matters which may be hindering innovation by broadening the reach of the patent, and thereby upsetting the balance. A catalyst and litmus for such an inquiry is the treatment of the subject areas in other countries such as the US, the European Union and Japan.
8. This represents an acknowledgement that Australian patent law, which in 1900 was nothing more than a duplication of the then UK Patents Act, has developed its own jurisprudence, and now considers the position of other countries.
9. As the Balance Paper seeks to identify matters which will enable the patent system to maintain a balance between the scope of the exclusive rights and public access to new technology,<sup>5</sup> it is in my opinion, beneficial to be aware of some perspectives of the immediate history of the balance since 1990. The reason for this being that the period 1990 – 2000 represents a low water mark in the use of patents as a vehicle to inspire and encourage innovation.
10. In approximately 1995, Burchett J of the Federal Court of Australia, a Judge known for many decisions in the intellectual property area, addressed members of the Intellectual Property Society of Australia and New Zealand (IPSANZ), at a conference in Noosa on the Queensland Sunshine Coast. His Honour informed the delegates that there had not been a patent enforced in Australia for a period of seven years.
11. In 2000, a judge of the Federal Court his Honour Mr Justice Drummond, delivered a paper entitled “*Are the Courts Down Under Properly Handling Patent Disputes?*”<sup>6</sup> In the paper his Honour accepted the high mortality rate of patents between 1990 and 2000, but explained the high casualty rate as being attributable to a low scrutiny level at IP Australia’s examination stage. His Honour considered that the Federal Court was in fact sorting the wheat from the chaff, by revoking patents which should never have been granted in the first place.
12. His Honour identified the role of patents more narrowly than the Consultation Papers, as a marketing tool for patentees:

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<sup>5</sup> The Balance Paper at [2]

<sup>6</sup> The 14th IPANZ Conference 2000.

*'So used, patenting is not a reward by the community for the public disclosure of information potentially useful to advance technology, but rather an aid to marketing a newly created need.'*<sup>7</sup>

13. In 2001, I presented a paper to the Queensland Law Society entitled *'Intellectual Property – What Went Wrong?'*<sup>8</sup> In this paper I identified the court's influence on the examination process:

*'If the level of scrutiny of applications by IP Australia is relatively low, this may account for the poor performance of patents under Court scrutiny. However, the Court has considered this to be the preferable position.*

In *Commissioner of Patents v Microcell Limited* the High Court said:

*'It is well settled that the Commissioner ought not to refuse acceptance of an application and specifications unless it appears practically certain that letters patent granted on the specifications would be held invalid.'*<sup>9</sup>

The Court went on to say:

*'Moreover, whereas refusal of acceptance is final, acceptance is not... and if a patent is granted, its validity is open to attack in proceedings for infringement or for revocation.'*<sup>10</sup>

14. My submission is therefore, that in considering the balance, some awareness is required of the immediate history of patent enforcement in Australia. As it is seen as an integral part of encouraging innovation, that both local innovators and foreign stakeholders have confidence in the validity and enforceability) of granted patents,<sup>11</sup> it is important to avoid a repeat periods of high patent mortality.

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<sup>7</sup> At page 8.

<sup>8</sup> D.G. Eliades, *"Intellectual Property – What Went Wrong!"* (2001) 14(5) *Intellectual Property Law Bulletin* 49 (copy attached).

<sup>9</sup> (1959) 102 CLR 232 at 244 –245.

<sup>10</sup> See also *McDonald v Commissioner of Patents* (1913) 15 CLR 713.

<sup>11</sup> The Balance Paper at [7]

## Responses to the Questions for Consideration

15. The Consultation Paper identifies the importance in a global economy of facilitating confidence in the validity (and I suggest the enforceability), of patents. This is explained by reference to the goal of:

- (a) Exporting technology by encouraging local innovation; and
- (b) Attracting technology and knowledge into the country, by instilling confidence in foreign countries that their patents will be more likely to be held valid and that be held :

*Strong and aligned thresholds and confidence in the validity of granted patents encourages inventors to exploit their inventions and invest in foreign markets where they have confidence that their inventions are afforded similar levels of protection imitation.*

16. Particular emphasis therefore is placed on the identification of how foreign countries deal with a matter. Aligning our law with that of foreign countries, particularly trade partners, is seen as a means of not just harmonising but a step toward ensuring the importation of knowledge and technology.

17. Taking into account the history I have briefly described as to the lack of enforcement of Australian patents in the 1990s and the perceived imbalance in favour of patents in several areas such as sufficiency and the test for obviousness, the proposed changes may create a greater balance than has been seen before in this country.

18. My observations of the proposed changes are dictated by an adherence to the patent principles set out in the Consultation Paper.<sup>12</sup> It is fundamental in this balance that the limits of the invention be as accurately defined as possible so that the patentee receives no more or less than their entitlement and permitting other innovators with some clear understanding of the limits of the patent.

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<sup>12</sup> At [1].

## *Full description*

19. The patent principle operates best in theory when there is disclosure of the invention and the period of exploitation is fully enjoyed without imitators. Anything less than full disclosure by the inventor offends the 'bargain', as the monopoly is granted on the basis that the information regarding the invention is disclosed. Disclosure enabling something to be produced from each claim, but not necessarily all alternative means limits the information available to the public and therefore limits the ability of other innovators to advance the known state of the art.
20. I agree with the general observation of the Consultation Paper as to the limited nature of the disclosure. In *Kimberley-Clark Australia Pty Ltd v Arico Trading International Pty Ltd* (2001) 207 CLR 1 at [19], the High Court in considering the term 'invention' in the context of the phrase 'describe the invention' for the purpose of s 40(2)(a), limited the description to the embodiment and the claims that lead to that embodiment:

*In argument on the present appeal, there was some debate as to the sense in which the complete specification is required by s 40(2) fully to describe "the invention" and end with a claim or claims "defining the invention". The point was explained, with reference to s 40 of the 1952 Act, by McTiernan J in *AMP Incorporated v Utilux Pty Ltd*. His Honour said:<sup>13</sup>*

*"'Invention' does not have the meaning which is given it in s 6, the definitions section and it does not mean 'inventive step'. I take it to mean 'the embodiment which is described, and around which the claims are drawn'."*

21. In such a manner, the description is tied to the embodiment as reflected in the claims, not all methods to attain the embodiment.
22. Accordingly, the full court of the Federal Court in *Pfizer*<sup>14</sup> noted the above passage from *Kimberley-Clark* and stated at [328]:

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<sup>13</sup> (1971) 45 ALJR 123 at 127.

<sup>14</sup> *Pfizer Overseas Pharmaceuticals v Eli Lilly and Company* [2005] FCAFC 224 (31 October 2005) ('Pfizer') at [327].

*‘For the purpose of assessing sufficiency the complete specification is to be read in the light of the common general knowledge and the art before the priority date. The Court is required to place itself ‘in the position of some person acquainted with the surrounding circumstances as to the state of [the] art and manufacture at the time’ – Kimberly-Clark at 16 [24] citing British Dynamite Co v Krebs [1879] 13 RPC 190 at 192. The relevant question formulated by the High Court in Kimberly-Clark at 17 [25] is:*

*“... will the disclosure enable the addressee of the specification to produce something within each claim without new inventions or additions or prolonged study of matters presenting initial difficulty?”*

And further at [330]:

*In Lockwood Security the High Court held at 17 [60] that for the purposes of s 40(2)(a) it is not necessary for the inventor to disclose all alternative means of performing the invention. It is enough that the disclosure enables the addressee ‘to produce something within each claim without new inventions or additions or prolonged study of matters presenting additional difficulty’. In so doing the Court repeated what had been said in Kimberly-Clark.*

23. Accordingly, the requirement of sufficiency in description, which is satisfied in Australia if something may be produced within each claim, is not as demanding as the requirements identified in the Consultation Paper in the US, Europe and Japan. In addition, it is not making a full disclosure of the invention in accordance with the patent rationale and thereby releases only a limited portion of the information behind the invention. The public should have all the information to make anything for which the patent claims to have exclusive rights to do.

### ***Fair basis***

24. In *Pfizer* it was stated at [268] that:

*‘It is a requirement for the specification of a patent that the claim or claims made in it must be ‘fairly based on the matter described in the specification’ (s 40(3)). The history and content of the term ‘fairly based’ was discussed at some length in the judgment of the Full Court in *CCOM Pty Ltd v Jiejing Pty Ltd* (1994) 122 ALR 417 at 432-437 (Spender, Gummow and Heerey JJ). It became part of Australian patent law with the enactment of ss 40 and 45 of the *Patents Act 1952* (Cth). As the Full Court said in *CCOM* (at 496):*

*‘It was used to describe the relationship between the claims defining the invention and the matter described in the complete specification ..., and as a criterion for fixing the*

*priority date of the claim of a complete specification fairly based on matter disclosed in the preceding provisional specification...'*

25. And further at [271]:

In *Lockwood Security* the court said that the comparison called for by s 40(3) is not analogous to that between a claim and an alleged anticipation or infringement. It is wrong to apply an 'over meticulous verbal analysis' or isolate in the body of the specification essential integers or features of an invention and inquire whether they correspond with the essential integers of a claim – at 20 [69]. What is required is 'a real and reasonably clear disclosure', words taken from the judgment of Fullagar J in *Société Des Usines Chimiques Rhône-Poulenc v Commissioner of Patents* [1958] HCA 27; (1958) 100 CLR 5 at 11. The court in *Lockwood Security* quoted with approval a passage taken from the judgment of Gummow J in *Rehm Pty Ltd v Websters Security Systems (International) Pty Ltd* (1988) 81 ALR 79 (at 95), where his Honour said, inter alia:

*'... the question is whether there is a real and reasonably clear disclosure in the body of the specification of what is then claimed, so that the alleged invention as claimed is broadly, that is to say in a general sense, described in the body of the specification.'*

26. I am in agreement with the Balance Paper which identifies the interpretation of s 40(3) as being an exercise in identifying a consistency between the invention as stated in the claims and the description of the invention in the specifications.<sup>15</sup>

27. The question of whether a claim is fairly based on matter disclosed in a prior specification is a narrow one, addressing whether the claim as expressed "travels beyond matter disclosed in the prior specification": *Stack v Brisbane City Council* [1999] FCA 1279 per Cooper J

28. The comparison does not involve "an overly meticulous verbal analysis of the documents. It is sufficient if a new feature was a development along the same line of thought which constitutes or underlies the invention described in the earlier document, provided the additional feature does not involve a new inventive step or bring something new ... which represents a departure from

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<sup>15</sup> The Balance Paper at [16]



the idea of the invention described in the earlier document”: *Stack v Brisbane City Council* [1999] FCA 1279 per Cooper J para [129]).

29. The difficulty with the interpretation of s 40(3) is that there may be a consistency between what the specifications identify as the invention and the invention as claimed, but that is not conclusive on the question of whether the specifications support the scope of the claims.
30. The proposed amendment whereby the scope of the invention as claimed be enabled by the invention as stated in the specification, will add consistency with the named foreign countries. In particular, as US nationals are the greatest single number of Australian patent owners, the tighter controls on the relationship between the specifications and the claims will give the foreign countries greater certainty that the patent is less likely to be invalid on the ground under s 40(3).

#### *Date of amendments to specification*

31. The patent of course may under the Australian patents legislation be amended after filing and before grant<sup>16</sup> and after grant by the court in a proceeding.<sup>17</sup>
32. The Balance Paper suggests an advantage in favour of the patent applicant not shared by applicants in the US, the European Union and Japan – the ability to withhold a commitment to describe the invention or to include the best method as required by s 40(2)(a) until grant.
33. I acknowledge that this is different from the position in other countries, however it does not, in my submission, have the same effect a differences in the law regarding the interpretation of specifications in granted patents which are presented to foreign stakeholders such as in the cases of:
  - (a) A full description of the invention;
  - (b) The fair basing, and
  - (c) The different approach to the test for the skilled addressees in determining inventive step or obviousness.

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<sup>16</sup> *Patents Act 1990*, s 102

<sup>17</sup> *Patents Act 1990*, s 105; see *Pfizer Overseas Pharmaceuticals v Eli Lilly and company* [2005] 68 IPR 1 at [35]

34. In this case the foreign stakeholders will know the issues by the date of grant and if the issue is of such importance may oppose the grant, which may have the effect of triggering an amendment to remedy a perceived weakness, which will only assist in the strengthening of the patent.
35. In short, as the inconvenience to foreign stakeholders is of limited duration, unlike the other matters mention in the Consultation Report, the only logical basis I suggest to force the full descriptions and best method at the time of application is the fact that this is not how it is done overseas.
36. In addition, the ability to amend the specification is also consistent with other abilities the patent applicant has under the 1990 Act. Under the *Patents Act* 1952 the emphasis on the entitlement was placed on the person who made the application. In other words, it was critical to get it right as to the party applying for the patent.
37. The Industrial Property Advisory Committee (IPAC) in its report *Patents, Innovation and Competition in Australia*, August 1984 recommended that this be changed so that anyone could apply,<sup>18</sup> but that the critical issue was to whom the patent was to be granted.
38. Similarly, as a patent malady may be remedied before the grant on the issue of the party entitled to the grant, so too may the specifications be remedied before the grant. Fortifying this argument I suggest, is the fact that both entitlement and non compliance with s 40(2) or (3) are both grounds for revocation<sup>19</sup> and as revocation is such a fatal step, I suggest the indulgences have been allowed.
39. I note the Balance Paper speaks in terms of the issue of a subsequent invention being added after the complete application is filed. I also note that such an added invention must be included in the claims, however the *Patents Act* prevents the claim or claims relating to more than one invention.<sup>20</sup> As there presumably was an invention in the complete specification as filed, another invention could not be added.

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<sup>18</sup> *Patents Act* s 29.

<sup>19</sup> *Patents Act* s 138(3)(a) and (f) respectively.

<sup>20</sup> *Patents Act* s 40(4).

40. I would on these grounds not be in favour of adopting the proposed change in paragraph 3.2 of the Balance Paper.

*The level of disclosure required to support a priority claim*

41. I am in agreement with the proposed change contained in paragraph 3.3 of the Balance Paper on the same grounds that I have indicated in [23] to [29] above, namely:

- (a) For the reason of giving some accuracy to other innovators, that the specifications are not only consistent with the claims, but actually support the scope of what is claimed – in short that the specifications are more reliable and accountable;
- (b) For the reason of encouraging technology from foreign jurisdictions onshore by removing obstacles which could cloud an opinion on the validity of a patent;
- (c) In furtherance of a policy of harmonisation which will benefit local innovators interpreting laws in foreign jurisdictions, particularly those of regular trading partners.

*Inventive step*

Common general knowledge

42. In relation to this proposal it would seem to me that there would need to be more than the impetus that other foreign countries have a wider ambit from which the common general knowledge would be deemed to be drawn. There is no doubt that the world is a smaller place because of the Internet and online exchange of information, however the fact that Australia is geographically isolated from the US, Japan and Europe has a practical relevance.

43. The common general knowledge is derived not only from an online exchange of ideas but from a physical interaction between skilled addressees, and publications such as:

- (a) standard texts and handbooks;
- (b) standard English dictionaries;
- (c) technical dictionaries relevant to the field;
- (d) magazines and other publications specific to the field.<sup>21</sup>

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<sup>21</sup> *Re ICI Chemicals & Polymers Ltd and Lubrizol Corp Inc* (1999) 45 IPR 577 at 599 per Emmett J and approved by the full court of the Federal Court on appeal: *Re ICI Chemicals & Polymers Ltd v Lubrizol Corp Inc* (2000) 49 IPR 513 at [57].

44. Many of these publications may be local and it is hard to conceive that the identification by the parties of the existence of such evidence will not add to cost of the litigation, if not to the party seeking to rely upon it to the patentee seeking to show that the remote publication was not part of the common general knowledge.
45. It would also seem that if the common general knowledge were expanded, foreign opponents would have an advantage over local stakeholders by raising matters which could only be responded to through the expenditure of substantial sums to identify if the matter was common general knowledge in the world. Although the onus would be on the opponent, the local stakeholder would necessarily be thrust into additional expense to rebut such a claim.
46. Adding to this, there is little disadvantage to foreign stakeholders as the common general knowledge in Australia would be a limited category of information well know to the local skilled addressee.
47. Having said that it is noted that In the *W R Grace* case<sup>22</sup> the full Federal Court upheld the decision of Heerey J, who had determined that research and development scientist in Europe was a skilled addressee able to comment on the common general knowledge in Australia. It was argued that he could not provide any insight into what comprised the common general knowledge at the relevant date in Australia. The full Federal Court did not agree. There was no evidence to suggest that the skilled addressee, Signor Quacquarella's qualifications or expertise led him to make the choices he did or to perform the tests which he did. He was prompted by certain articles to test the relevant substance. The court found that a hypothetical skilled addressee in Australia would have received substantially the same kind of information as Signor Quacquarella did and would have proceeded to test it. The claimed invention was therefore obvious.
48. Notwithstanding, this decision however, I perceive mischief in broadening the common general knowledge not outweighed by the benefit of consistency with foreign countries. In *NutraSweet Australia Pty Ltd v Ajinomoto Co., Inc.*,<sup>23</sup> Finkelstein J stated at [37]:

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<sup>22</sup> *W R Grace & Co v Asahi Kasei Kogyo Kabushiki Kaisha* (1993) 25 IPR 481.

<sup>23</sup> [2005] FCA 1524 (28 October 2005).

*The state of the common general knowledge in Australia as at the priority date concerning the use of artificial sweeteners was as follows. There were technical, economic and health related reasons for the use of intense sweeteners, other than sucrose, in food. The technical reasons concerned, in the case of some food, the lack of stability of sucrose and the better taste of the combination of sucrose and an appropriate sweetener. The economic reason was that the unit cost of an artificial sweetener could be less than sucrose. The health factors included obesity, diabetes and dental care.*

49. In my submission this statement alone betrays a disadvantage to local stakeholders if it were submitted that the common general knowledge anywhere in the world was a particular matter. Only by exhaustive research in other parts of the world to establish 'technical, economic and health related reasons for the use of sweeteners, could such a case be able to be combated. This would not be an issue for countries within the European Union or Japan as there are numerous borders within the same comparable area.
50. I would oppose the proposed change in paragraph 4.1
51. There also seems to be a difference in suggesting that for novelty publications throughout the world impact on the validity of the patent and having a common general knowledge for obviousness throughout the world. An anticipation is what it is, however arguing that certain information is common general knowledge in the art in the world is a matter of degree and not as easily answered.
52. If anything the law teaches us, it is, that if it is not easily answered its going to be expensive.

### Prior art

53. In relation to the matters stated in [38] of the Balance Paper, there has been a recent Federal Court case to the effect that information found on the Internet (and cited as evidence of obviousness), did not mean the invention was obvious unless the information on the Internet formed part of the common general knowledge of the skilled addressee. I cannot readily locate the case, but it is not earth shattering to suggest that proposition. In order to deprive the patent of its validity the subject matter must form part of the common general knowledge in Australia. The fact that that information is derived from

overseas is not debilitating, but rather that the information, regardless of its source, be part of the common general knowledge in Australia.

54. The mere fact that there is much more information available electronically does not mean that it should automatically form part of the prior art base UNLESS it is information that a person skilled in the relevant art in the light of the common general knowledge could reasonably be expected to have ascertained, understood and regarded as relevant to work in the relevant art in Australia: *Firebelt Pty Ltd v Brambles Australia Ltd* [2002] HCA 21 (at para [37]).

#### Threshold test for inventive step

55. It is my understanding that the difference is that the Australian test requires that the skilled addressee is led to try a particular approach with a reasonable expectation of success 'as a matter of course' whereas the EPC requires that it was obvious to try a particular approach.
56. I cannot comment intelligibly on this issue because I would have thought (unlike what is said in [42]), that 'as a matter of course' testing 'takes into account situations where it is routine in the art to conduct testing or combine particular approaches...' and further that I would have thought that the concept of a routine experimentation was more aligned with inquiry 'as a matter of course' than something obvious to try.
57. The statement in [43] as to the 'global marketplace today, where greater than 85% of Australian patent applications are filed by overseas applicants', should not sway anyone and in fact is misleading in my opinion. The greatest single country, whose nationals own Australian patents has for many years been US nationals.
58. In 1990 of the 12515 standard patents granted, some 4913 were to US nationals, the next largest being Japan with 1779 patents, with Australians at 1059.
59. In 2000, there were 13545 standard patents granted. Of these, 6050 were to US nationals, the next largest being Japan with 1231 patents, with Australians at 1034.

60. In 2005, there were 10981 standard patents granted. Of these, 4394 were to US nationals, the next largest being Japan with 1134 patents, with Australians at 1162.<sup>24</sup>
61. In principle however, it is my submission that a threshold test for inventive step should be consistent with the foreign countries. This represents a more complex assessment and ability for those countries to determine their position for further innovation or challenge. This is a distinct situation, unlike the situation I refer to above where the establishment of the common general knowledge in Australia is not as an exhausting exercise and more than likely within the knowledge of the skilled addressee.
62. I am not able to comment on the 'Requirements considered during examination, re-examination and opposition' as I am not involved in the application, examination or re-examination processes.

### *Miscellaneous Matter*

63. As the government is inquiring into obstacles to innovation, I wanted to briefly mention an area of potential mischief, where Australia languishes far behind the laws introduced in the UK in the late 1980s and in the US in 1952.
64. The reference is the ground of revocation based on entitlement under s 15 of the *Patents Act*. Presently, entitlement is a ground for revocation which may be brought regardless of whether the person bringing about the application to revoke has an interest in the patent or not.<sup>25</sup>
65. It has been found that where a grant is made to some but not all of the inventors, the patent is invalid and incapable of remedy. In a world where collaborative research and innovation is encouraged and becoming more commonplace, the risk of leaving an inventor, someone who has made an inventive contribution, off the grant is unacceptably high.

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<sup>24</sup> <http://www.ipaustralia.gov.au/about/statistics.shtml#pap>

<sup>25</sup> *Patents Act* s 138(3)(a).

### *Mis-joinder and Non-joinder*

66. In a well known Intellectual Property case, *Stack v Brisbane City Council*,<sup>26</sup> which involved a revolutionary water meter device, the integrity of the patent was undermined on the simple basis that there were two (2) inventors but the patent was only granted to one of two inventors. As such one of two inventors did not come within the definition of inventor in s 15(1)(a) of the *Patents Act*.
67. In *Stack*, the court was simply not able to remedy the situation by adding the second inventor as a patentee, as the grant had already been made to one only of two inventors.
68. This situation of a non-joinder, was complimented in the decision of *Conor v Med Systems*<sup>27</sup> where persons who had purportedly obtained their interest in the patent from persons they believed to be inventors, had a defective title as their assignors were in fact not inventors. The patent was held jointly by two corporations, one of whom had taken from the actual inventors the other co-owner taking from persons who they thought were inventors but were not.
69. In *Conor*, Emmett J expressed the view that the patent would be invalid.
70. In both of these cases, the case of non-joinder of a party entitled and the mis-joinder of a person not entitled, have led to the revocation of a valuable patent or the indication that it is invalid.
71. Such a result over what can only be described as a technicality has been addressed and avoided in the United States and the United Kingdom for many years.
72. Since approximately 1952, the result of judicial dissatisfaction, amendments were made to the US *Patents Code* to allow the patent to be rectified and to specifically state that the patent would not be invalid where the non-joinder or mis-joinder occurred by error.

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<sup>26</sup> *Stack v Davies Shephard Pty Ltd* (1999) 47 IPR 525 (Trial Judge); *Davies Shephard Pty Ltd v Stack* (2001) 51 IPR 513 (Full Court) ('*Stack*').

<sup>27</sup> *Conor Medsystems, Inc v The University of British Columbia (No 2)* [2006] FCA 32, [8]



73. In the UK, amendments in 1980's to the 1977 Act the legislation went far beyond the US amendments. These gave the Comptroller, the equivalent to our Commissioner of Patents, wide powers to remedy any situation where there has been a party omitted as inventor or where there has been a party or parties added as inventors who in fact were not inventors.
74. The mischief that the Australian current law can create would be incredibly harmful to research and innovation in this country. There is an acknowledge trend to collaborative research where not only several inventors come together from different organisations, but teams of persons who potentially could make an inventive contribution collaborate in the development of a product or service which may attract patent protection. On the current law the addition or omission on any one person who has made an inventive contribution would be fatal to the patent.

## **Schedule**

### **DR DIMITRIOS G. ELIADES**

Dimitrios is a graduate of the University of Sydney (LLB), The University of Queensland (LLM) and Queensland University of Technology (SJD), concentrating on IP and IP related subjects. He has had a long association as an author with LexisNexis Butterworths in their publications “Patents and Related Rights Bulletin”, the “Copyright Bulletin” and the “Trade Marks Bulletin” as part of the commentary by Professor James Lahore.

He has been briefed to advise various government departments on Intellectual Property issues and strategies and has had consultation briefs from the Federal Government Advisory Council on Intellectual Property in relation to amendments to the Trade Mark and Patent legislation. Dimitrios answered a call to the Brisbane Bar in October 1998 where he is now in private practice predominantly in the field of intellectual property. He also lectures the intensive Master’s courses: Patent Enforcement and Commercialisation (LWN 147) and Intellectual Property (LWN099) at QUT. In addition to being a regular contributor to various legal publications, Dimitrios is a co-author of the third edition of Dr Anne Fitzgerald’s book ‘IP Nutshell’ and is a member of the QLS Technology and Intellectual Property Sub-Committee.