



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

29 September, 2008

Attention: Bill Moullakis – Forum Secretariat
Patent Consultation Group – IP Australia
PO Box 200
Woden ACT 2606

Dear Sirs,

**Patent Consultation Group Meeting – 6 August 2008
Patent Entitlement Issues**

We refer to the Discussion Paper 7 attached to the Agenda for the PCG meeting on 6 August 2008 and are very pleased with the direction taken by IP Australia in this in place of the Notice of Entitlement issues discussed at the PCG meeting of 13 May 2008.

We fully agree with the proposal that it should be possible to amend the Register after grant to correct the identity of the patentee, so that a patentee can be added, deleted or replaced as necessary to correctly reflect the facts.

We consider the current situation, where grounds for revocation exist in the case of a patent being in the name of some but not all of the inventors or their assignees and in the case of the patentees being or including one or more persons who are not inventors or their assignees, to be archaic.

We also agree that both the Court and the Commissioner should be able to resolve patent entitlement issues, with both having the power to rectify the Register in appropriate circumstances.

It is our view that amendment to Section 15 is the appropriate way to remove the concept that a patent is permanently invalid on the basis that it "should never have been granted (to the patentee(s)) originally".

If "not entitled to the patent" is to remain as a ground of opposition and/or revocation, we consider that the ground should be recognised as a last resort, where the correct patent entitlement really cannot be resolved. We would have some concern with the availability of rectifying the Register being excluded in the case of deceptive conduct if the correct patentee had no involvement in such conduct.

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We also agree that the proposed provisions should ensure that existing patents granted under the current legislative provisions would no longer be incurably invalid as a result of entitlement issues at the time of grant.

It is clear that some confusion may arise from the rectification of the Register to change one or more patentees. Examples include a patentee being deleted as a result of a correction of the identity of the inventors, when that patentee has lawfully (at the time) acted under the patent – for example by building a plant in Australia to manufacture a patented product or by granting an exclusive licence. The provisions may need to make clear what happens under these circumstances. At this time we do not know of corresponding provisions in, for example, the UK or USA.

We look forward to seeing your further proposals on this issue and to having the opportunity to comment on them or discuss them with you.

Yours faithfully,
FICPI Australia

A handwritten signature in black ink, appearing to read 'P. Huntsman', with a long horizontal flourish extending to the right.

PETER HUNTSMAN
President