



IPRIA Newsletter – December 2009

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- Details of IPRIA public seminars / forums, copies of the associated presentations (where available) and past events can be accessed from the IPRIA website at our Past Events page.
- If you wish to be advised of forthcoming workshops, and public seminars / events, please subscribe to our events notification service [here](#).

Selected Projects / Research Studies

The following are updates on selected projects / research studies being undertaken or recently completed.

History of Australian Patent Policy

Chris Dent

The first phase of this research, which looks into the development of Australian patent law and policy, has now been completed. This initial stage of the project considered the patent system as it existed in England, up until the passing of the Statute of Monopolies in 1624. It may seem surprising that such an arcane topic is the focus of research today; however, the Patents Act 1990 still includes reference to that Act and the Advisory Council on Intellectual Property is currently undertaking a review of the tests of patentability (with the “generally inconvenient” test from the Statute of Monopolies being of particular importance to the review). One of the key

outcomes of this phase of the research was a submission to the ACIP review — a submission that was based on an article to be published in the Melbourne University Law Review.

Metrics on Knowledge Transfer from Universities to Businesses and Industry in Australia

Paul H. Jensen, Alfons Palangkaraya, Elizabeth Webster

It has been widely accepted that knowledge creation and application is the primary driver of economic growth. It has also been widely recognised that university is a principal source of new knowledge. Therefore, it is very important for all stakeholders to have a fuller understanding of the mechanisms of knowledge transfer (KT) from universities to the economy in general and to the industry in particular.

In this report, we build upon existing works in Australia and overseas to come up with a guideline on how quantitative and qualitative metrics for measuring the extent of KT from universities to businesses and industry in Australia can be constructed using readily available data. To achieve this, we take a broad approach to identifying activities that universities undertake, rather than just a narrower set of commercialisation activities (e.g. number of patents or licensing activity) currently available. This is to ensure that the metrics reflect the wide variation in the absorptive capacity of businesses as well as the level of difficulty in codifying the new knowledge.

The report, which was completed in September 2009, is available from <http://www.ipria.org/publications/occasionalpapers.html>

Submissions

IPRIA continued being actively involved in the formation of public policy through regular submissions to the Advisory Council on Intellectual Property, as well as reports for departments of the Commonwealth government on Intellectual Property related issues.

The following submission was made between June and December 2009.

Title	Author	Date
Post-Grant Patent Enforcement Strategies Submission made to The Advisory Council on Intellectual Property	Chris Dent	September 2009

Forthcoming Events

Seminar — The Protection of Brands: A Contemporary Look at Acquisition, Scope and Market Realities

This free public seminar presented by IPRIA, in association with IPTA, will be held in Sydney (7 December), Brisbane (8 December) and Melbourne (10 December) — 1pm - 2:30pm. The three sessions per seminar are:

1. Acquisition of Legal Protection : registrability and maintenance issues relating to the new types of trade marks and trends in trade marking and common pitfalls in making trade mark applications and including a commentary on the recent Federal Court decision in *Chocolate Guylian NV v Registrar of Trade Marks*. The presenter is Trevor Stevens, Partner of Davies Collison Cave.

2. Scope of Legal Protection: the ability of traders to prevent the unauthorised use of their trade marks and brands on non-competing goods and services plus a commentary on the Federal Court decisions in *E&J Gallo Winery v Lion Nathan Pty Ltd* and on the European Court of Justice decision in *L'Oreal SA v Bellure NV* .

The presenter is Janice Luck, Senior Lecturer at the University of Melbourne.

3. Market Realities of Acquiring and Protecting Brands: how brands enhance firm value and will address threats to brand value from marketing and traders' management practices. The presenter is Don O'Sullivan, Senior Fellow Melbourne Business School.

For more information about the seminar view [here](#).

Conferences



Pacific Rim Innovation Conference 2010

Over fifty academic speakers will present at this conference to be held at the University of Melbourne on 21 and 22 January 2010.

It is being organised by the Intellectual Property Research Institute of Australia (IPRIA) at the University of Melbourne, with support from the Institute of Innovation Research (Hitotsubashi University), the NUS Business School (National University of Singapore) and the University of Auckland Business School.

It will foster an inter-disciplinary exchange of knowledge by bringing together scholars working on the economics, management and law of innovation. The conference will focus on the effectiveness of intellectual property systems; markets for technology; the strategic management of R&D; and government innovation policies.

Keynote speakers will include Professors Rochelle Dreyfuss (New York University), Ivan Png (NUS School of Business), Peter Drahos (Australian National University),

Bruno Cassiman (IESE Business School, Barcelona) TBC, and Vincenzo Denicolo (Universita di Bologna) — with further speakers to be confirmed.

Information can be found [here](#). Enquiries: Ms Michelle Wilson, Executive Officer, IPRIA, on (03) 8344 2153 or by email <info@ipria.org>.

Seminars

Patent Infringement in Australia — Results from a Survey

This series of seminars, presented by IPRIA and sponsored by Blake Dawson, were held in Melbourne [9 June], at Blake Dawson; in Brisbane [10 June] at Blake Dawson, and were preceded by a presentation to IP Australia in Canberra [21 May]. The topic was on patent policy — the prevalence of (alleged) infringement and what steps are being taken to stop the copying activities, plus a discussion of what can be done to improve the efficacy of patent enforcement in Australia.

The presenters were Associate Professor Beth Webster and Kimberlee Weatherall, Senior Lecturer, TC Beirne School of Law, The University of Queensland. The event was sponsored by Blake Dawson.

Ambush Marketing

In June IPRIA held a seminar in Sydney, Brisbane and Melbourne which addressed the question: 'Should Australia extend its existing legislation dealing with ambush marketing?'

A Bill to prohibit ambush marketing activities in Victoria aims to increase private sponsorship fees for major events by, for example, excluding all suggestive advertising and associated activities by non-sponsors. It is hoped that this will enhance Australia's ability to attract 'footloose' international events. Emily Hudson raised issues about how the problematic definition of 'ambush marketing' could also cover standard marketing activity.

Dr Morgan discussed how the major events legislation in NZ is generic and introduces ambiguity in how it potentially also applies to any major event, not just sporting ones. He addressed doubts about the suitability of the Major Events Management Act 2007 ('MEMA') — given the protection already provided by existing law and that MEMA is poorly drafted, and the dominant interests seem to be those of event organisers as opposed to the interests of the general public.



At the Melbourne seminar (from left):

Associate Professor Beth Webster, Director IPRIA;

Mr Russell Thompson, Melbourne Institute; Ms Emily Hudson, The University of Melbourne.

Mr Graham Cowin, Vice President IPTA;

Dr Owen Morgan, The University of Auckland Business School.

The seminars were jointly organised by IPRIA and the Institute of Patent and Trade Mark Attorneys of Australia (IPTA). The seminars in Sydney and Melbourne were hosted by Davies Collison Cave, Patent and Trademark Attorneys, and the Forum in Brisbane was hosted by McCullough Robertson. The presenters were:

- Dr Owen Morgan, Senior Lecturer, The University of Auckland Business School
- Ms Emily Hudson, PhD Candidate, The University of Melbourne (Sydney and Melbourne)
- Mr Malcolm McBratney, Partner, McCullough Robertson Lawyers (Brisbane).

Patent Infringement in Australia — Results from a Survey

Associate Professor Beth Webster (IPRIA) presented this seminar in Adelaide [24 August] and in Perth [25 August]. The seminar, held in association with IPTA, looked at how much infringement actually goes on, and how much of that infringement leads to enforcement of an informal or formal kind. The presentation drew on IPRIA's survey of over 3,700 Australian inventors in order to estimate the prevalence of (alleged) infringement and what formal and informal steps were taken to stop the copying activities.



Do Australian Companies Value Trade Marks and Designs? — A Look at the Evidence.

Associate Professor Beth Webster (IPRIA) presented this seminar in Adelaide [24 August] and in Perth [25 August] — held in association with IPTA. It addressed the scarcity of actual hard data on the value and importance of trade marks and designs. A summary of the available empirical evidence from

Australian surveys and administrative databases was presented and issues covered were the relative use of trade marks and registered designs by industry; the importance of trade marks and designs for companies' competitive advantage; and the contribution of trade marks and designs to company value.

Will Freeing Parallel Imports make Books Cheaper at the Cost of Authors?

In mid September IPRIA and the Centre for Media and Communications Law (CMCL) conducted a seminar '*Will Freeing Parallel Imports Make Books Cheaper at the Cost of Authors?*' — held in Melbourne and Sydney. IPRIA jointly hosted the seminar with the University of Technology Sydney.

A panel of experts discussed the relative merits of keeping the existing parallel import restrictions versus opening up the trade in books. Restricting parallel imports of books allows (international) copyright holders to price discriminate between countries. Presenters were Professor Allan Fels AO, Dean, Australia and New Zealand School of Government (ANZSOG) — Melbourne seminar only; Dr Rhonda Smith, Copyright Tribunal of Australia and High Court of New Zealand; Mr Graeme Connelly, Director and CEO, Melbourne University Bookshop; and Mr Arlen Duke, Melbourne Law School, The University of Melbourne.

Professor Sam Ricketson, Victorian Law Reform Commission and Melbourne Law School, The University of Melbourne, chaired the seminar. He is currently a panel member of the World Intellectual Property Organisation's dispute resolution body in relation to domain names, and is a member of the Victorian Law Reform Commission.



There is a podcast of the Melbourne seminar available for viewing on the IPRIA website: <http://www.ipria.org/events/seminar/Parallel_Importing.html>.

The Enforcement of Intellectual Property Rights in China: Institutional Challenges

This IPRIA Public seminar, held in Melbourne [7 September] in association with the Asian Law Centre (ALC), was presented by Professor Nie Jianqiang, Wuhan University, China, Professor of Law at Wuhan University, China and Vice-Director of its prestigious Institute of International Law.

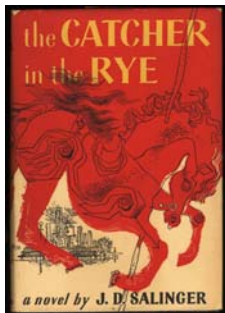
The topic was the enforcement of intellectual property rights in China and how they are enforced, and there was a focus on procedural and institutional challenges given the Chinese legal and political system.

Patents

An IPRIA public seminar ‘What difference does a patent make?’ was held in Adelaide and Perth (first week of October) jointly hosted with the Institute of Patent and Trade Mark Attorneys of Australia (IPTA). The presenters were Dr Jongsay Yong, Senior Research Fellow, Melbourne Institute, and Dr Robert Sanders, Managing Partner, Global IP Services, Singapore.

Unauthorised Sequels

On 8th October IPRIA hosted a seminar entitled ‘Piracy or Parody: Coming through the Rye still Banned in the USA’ held at the Melbourne Law School.



The presenters were Shaun Miller, Partner, Marshalls & Dent Lawyers; Colin Golvan SC Victorian Bar and author on copyright, writers and law; Ken Gelder Professor of English, School of Culture and Communications, University of Melbourne. The event was chaired by Megan Richardson, Professor, Melbourne Law School and Deputy Director of the Centre for Media and Communications Law. The seminar considered both legal and literary aspects of unauthorised sequels.

An Introduction to the Intellectual Property High Court of Japan.

On 9 November Judge Hiroki Morishita, who serves on Intellectual Property High Court of Japan, presented at an ALC/ IPRIA Occasional Seminar in Melbourne where he spoke on the Court’s establishment, jurisdiction and proceedings. The seminar commentator was Stacey Steele, Associate General Counsel at Standard and Poor’s.

***UWA v Gray*: What Does it Mean for Universities?**

The Full Court of the Federal Court decision of *UWA v Gray* was the focus of three IPRIA seminars in November. Professor Ann Monotti presented at all three; Dr Jason Coonan of Melbourne Ventures presented in Melbourne (17 November); Mr Michael Finney of qutbluebox Pty Ltd, the technology transfer and commercialisation company for the Queensland University of Technology, presented in Perth (20 November, hosted by Minter Ellison lawyers); and Professor Paul Greenfield presented in Brisbane (23 November – hosted by the University of Queensland).

Attendance, and the contributions to the discussion by the audience, demonstrated the importance of this topic to the profession and the tertiary sector.

The decision of the Full Court focused on the ownership of patents for inventions that were developed while Professor Gray carried out research at the University of Western Australia. The conclusion was that UWA did not have a claim on the ownership of the patents. It, however, took hundreds of pages of judgments (in the Full Court appeal and in the original Federal Court decision) to reach that conclusion – covering a wide range of legal grounds and arguments, including the duties and obligations of employees, patent law and the validity of the regulations of the university.



From left to right:

Dr Jason Coonan, IP Portfolio Manager
Melbourne Ventures Pty Ltd, The University
of Melbourne.

Professor Ann Monotti, Professor and
Associate Dean (Postgraduate Studies),
Monash University Law School

The outcome of the case to date turned on its facts and, in particular on the internal regulations and practices of UWA. Much of the discussion in the seminars, however, focussed on the potential broader impact of the decision. First, there was an engagement with the mechanisms that could be adopted to ensure that universities retain some benefit of inventions that result from research that they support; and second, there was a consideration of the extent to which some of the findings of the Court could be applied to other research organisations established for public purposes. While the presentations and discussions were stimulating, the case is not over – many will be awaiting, with great interest, the outcome of the special leave application to the High Court to be heard in the new year.

Do Patents Matter for Commercialisation?

Associate Professor Beth Webster presented a seminar in Hobart on 19 November, 'Do Patents Matter for Commercialisation?' which was hosted by IPRIA in association with the Centre for Law and Genetics, The University of Tasmania.

The seminar discussed whether owning a patent has any effect on the likelihood that an attempt will be made to commercialise an invention. From the survey data on 3,700 Australian inventions, patent ownership raises the probability (by between 2 to 8 percentage points) of attempting to license or transfer to a spin-off company, attempting mass production and actually exporting.

Workshops

'IP in the Real World': Sidamo and Blackberry IP Management

In June IPRIA hosted a new workshop series, aimed at middle / senior managers. The seminars were based on case studies by IPRIA personnel and the first one, held in Melbourne and Sydney, was a practical introduction to the patent and trade marks systems, referring to two cases — the BlackBerry case and the Sidamo case (re: Ethiopian coffee).

The workshops were presented by Kwanghui Lim (pictured centre) Associate Director at IPRIA, together with Fiona Rotstein (at the Melbourne workshop) a Research Fellow at IPRIA, and with Jason Bosland (pictured right) Lecturer in Law at UNSW, at the Sydney workshop.



- The BlackBerry case was on a dispute between a US inventor and a Canadian technology company over patent infringement. The resulting legal battle threatened to shut down the BlackBerry system leaving millions of users, including essential government employees in the US and elsewhere, without their main communications tool.
- The Sidamo case was on a challenge by Starbucks to the Ethiopian Government's application for a US trade mark in relation to coffee. The case illustrates a sophisticated use of the trade mark system to create favourable terms of trade.

IPRIA Working Papers (June – December 2009)

Copyright, Governmentality and Problematisation: An Exploration'. Working Paper 12 / 2009. Chris Dent, Senior Research Fellow IPRIA. [Abstract](#) [PDF](#) [128K]

Staff

On 24 August Dr Lachlan Wilson, Research Fellow, Melbourne Law School, joined IPRIA. Lachlan is currently undertaking research into an analysis of patent activities of pharmaceutical companies to assess the validity of concerns raised over the ever-greening debate. Lachlan is a registered Patent and Trade Mark Attorney.



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