



IPRIA Newsletter – Issue 10, December 2008

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New director for IPRIA



At the beginning of July this year, Associate Professor Beth Webster was appointed as the new Director of IPRIA with former Director, Professor Andrew Christie, choosing

to focus on new academic challenges. During Professor Christie's term as Director, the Institute established itself as a world class research organisation engaging in a range of leading edge research projects involving key research teams from across the University of Melbourne, nationally and internationally.

Associate Professor Beth Webster is also Principal Research Fellow at the Melbourne Institute of Applied Economic and Social Research where she successfully manages the Industrial Economics program. She received her PhD from Cambridge University in the UK and her Master of Economics at Monash. She has previously worked at the Bureau of Immigration Research, the Victorian Government and the Centre of Policy Studies at Monash University. Her interests include the economics of innovation and intellectual property, intangible investment and labour economics. She has at various times been an advisor to IP Australia, Victorian Departments of Treasury and Finance; Premier and Cabinet; Auditor-General, Sustainability and Environment; the Commonwealth Departments of Industry, Tourism and Resources; and Education, Science and Training, Employment; Employment and Workplace Relations; Family and Community Services; Immigration and Multicultural Affairs; The Australian Fair Pay Commission, OECD and the New Zealand Treasury. In 2008, she was part of Minister Kim Carr's Automotive Industry Review panel. Recent collaborative work has been undertaken with IBM, CTG, the Productivity Commission, Austrade, IBISWorld, the Australian Institute of Family Studies, Asialink and PricewaterhouseCoopers inter alia. Associate Professor Webster has published over 60 articles in top tier journals in areas such as patent systems, trade mark and branding, measuring intangible assets, firm performance, environment, training and education labour markets and wage determination.

IPRIA projects summary

From Melbourne Law School



IPRIA researchers based in the Melbourne Law School are enjoying a productive period with work progressing in a wide range of projects with a diverse set of outcomes.

Two of the larger projects are funded by the Australia Research Council (ARC). The first is a comparative examination of the operation of the opposition procedure in patent law, and the second, a comparative analysis of patent examination procedures in Australia, the United States and at the European Patent Office. The latter research, supported by IP Australia and the Institute of Patent and Trade Mark Attorneys of Australia (IPTA), commenced at the beginning of the year and is, therefore, in its early

stages. We have appointed a new Research Fellow, Catherine Macneil, to work on this project.

Other projects include research into the effective allocation of benefits that arise from innovations created by a worker in the course of their employment and work into the manner in which the copyright regime operates to regulate the behaviour of members of the public. Preliminary results of the latter research will be presented at an academic conference later on this year. The work to date on the former project has shown that it is of vital importance to the fostering of innovation in the workplace; we have, as a result, submitted an application to the ARC for funds to carry out a large scale empirical project into how benefits of worker innovation are currently allocated and how they should be allocated in order to best promote innovation in Australia.

We are also maintaining our commitment to sharing the outcomes of our work with the wider community. Recent activities have included a public seminar to celebrate World IP that focused on preliminary results from the worker innovation research, seminars to practitioners on the role of professional privilege in the patent system (these seminars were co-presented by IPTA) and a one day course, “Mastering the Trade Mark System”, aimed at raising the level of knowledge of this aspect of intellectual property in the business community.

From Melbourne Business School



The past few months have been busy and productive for the IPRIA researchers based at Melbourne Business School. Ian Williamson (MBS and IPRIA) and Deepak Somaya (Maryland) published an exciting paper titled “Rethinking the War for Talent” in the prestigious Sloan Management Review. It examines the movement of patent attorneys among top US patent law firms, and shows that the former employer can sometimes benefit from employee mobility. Their study suggests that managers should adopt a new mindset towards employee mobility.

Meanwhile, Kwanghui Lim (MBS and IPRIA), Henry Chesbrough (Berkeley) and Ruanyi (NUS in Singapore) had a paper accepted for publication in a special issue of the International Journal of Technology Management on Open Innovation. The paper studies the patenting trajectories of three microprocessor firms – Intel, AMD and IBM – and examines how changes in cooperation and competition among these firms affected their patenting behavior and knowledge interdependence. You can download this IPRIA working paper by following the link below.

The MBS-based research teams continued to make good progress on various projects. Ian and his co-authors are collecting a second wave of data for his research project on

Management Innovation. Kwanghui and his team (Nisvan Erkal and Catherine de Fontaney from Melbourne University and Richard Mollard from Monash) have been busy interviewing scientists to learn more about their career choices. In addition, Kwanghui and his collaborators from the National University of Singapore (Poh-Kam Wong and Wenyue Zhuang) presented two papers at the Academy of International Business Conference in Milan on the diffusion of knowledge.

In August, both Kwanghui and Ian attended the Academy of Management Conference in Anaheim, California. Ian and Deepak presented their paper on “Outsourcing Knowledge-Based Services: The Dynamics of Capabilities and Governance”. Kwanghui co-organized a workshop on patents with Riitta Katila (Stanford) and chaired a session on Technological Positioning, Innovation and Imitation. Kwanghui also acted as a panellist at the Australian Business Higher-Education Roundtable Conference in September, while Ian presented papers at the University of Chicago and Northwestern University.

Links:

- Ian and Deepak’s paper in the Sloan Management Review (free download for a limited period): <http://sloanreview.mit.edu/smr/issue/2008/summer/02/>
- Kwanghui’s working papers: <http://works.bepress.com/kwanghui/>
- Ian Williamson’s working papers: <http://www.ipria.org/publications/wp/wp2008.cfm>
- Readings and slides for the 2008 AOM Patent Workshop: <http://patentpdw.kwanghui.org/>

Submissions

Inquiry into Improving Access to Victorian Government Public Sector Information and Data

The Parliamentary Economic Development & Infrastructure Committee of the Victorian Government is currently conducting an inquiry into ‘Improving Access to Victorian Government Public Sector Information and Data’. In their submission to this inquiry, Assoc Prof Beth Webster and Dr Chris Dent argued that information and data add to social welfare by:

- Enabling businesses to make more accurate decisions about what to produce and where to produce it. This will reduce costs of production and enhance competition;
- Enabling community groups to more accurately monitor the welfare of their interest group; and
- Providing researchers with more accurate information on which to base their evidence-based policy advice.

If society wants to provide the optimal level of information and data, the fixed costs of its collection, cleaning and documentation should be paid through the public purse, but the data should be ‘sold’ at a price equal to its marginal cost. The latter includes the

additional costs of specially made requests. However, special consideration should be made for:

- Commercial confidentiality. Information and data should not be released in a way that transgresses commercial confidence;
- Personal privacy. Information and data should not identify individuals;
- The costs of cleaning and documenting the information and data which may be non-trivial; and
- The commercial basis (as a for-profit activity) of the collection. If, for example, the data was collected as a for-profit activity, then the price charged to consumers needs to reflect the full costs of collection and preparation.

In no circumstances should there be a blanket obligation to release the original data as this would contravene conditions under which the data was collected. Releasing the original data would be unethical and would ultimately cause many individuals and companies who supply the data to the public sector agency to refuse to supply the data in the future.

Dent and Webster have reservations about the blanket use of creative commons (CC) licenses because of the lack of capacity to modify, on a case by case basis, the terms of licences. IPRIA's research into open content licences concluded that it would not be feasible to adopt the CC licensing framework as the sole framework for governing the distribution of public sector information. This is because the simplicity of the CC framework does not adequately match the needs of the release of public sector information. In other words, the most significant advantage to developing a licensing framework separate to the CC licences is that it can be tailored to the needs of the government. Further, in some cases the documents to be released may include copyrighted material from a third party – that third party may not agree to licence that material under any of the available CC licences.

The full text of the submission is available [here](#).

A second submission for this period was made to the Australian Council on Intellectual Property on 'Review of Patentable Subject Matter'. The full text for this submission by Elizabeth Webster and Chris Dent is available [here](#).

Forthcoming Events – IPRIA and AIC Conference, February 2009

Commercialising Inventions – What's the Story?

Tuesday 17 February 2009

Customs House, The University of Queensland, Brisbane

Thursday 19 February 2009
The University of Melbourne

Intellectual Property Research Institute of Australia and the *Australian Institute of Commercialisation* are hosting a one-day conference in February 2009 on commercialising inventions. This conference will feature the results from several national surveys of inventors, including a survey of 4000 Australian inventors.

The conference is targeted at senior business managers, IP lawyers, patent attorneys and policy analysts. It is intended to inform people about how many inventions are developed; how many are successfully commercialised; what are the main characteristics of this success and what the value of most patents is.

This one-day conference will be held in both Brisbane and Melbourne.

Presenters:

A panel of international and local speakers has been assembled to ensure that this conference will be the premiere event of commercialising pathways. Presenters include:



Professor Bronwyn H. Hall, Professor in the Graduate School at the University of California at Berkeley, United States and Professor of Economics of Technology and Innovation at the University of Maastricht, Netherlands



Professor Alfonso Gambardella, Professor of Management, Università Commerciale “L. Bocconi”, Milan, Italy

Greg Smith, SciVentures Investments (Mel)

Dr Karl Rogrigues, CSIRO (Bris)

Dr Nigel Poole, CSIRO (Mel)

Glen Wightwick, IBM

Dr Rowan Gilmore, Australian Institute for Commercialisation

Assoc Prof Beth Webster, University of Melbourne

Dr Paul Jensen, University of Melbourne

Charlie Day, Melbourne Ventures Pty Ltd (Mel)

To register for this event, please download and complete the registration form at <http://www.ipria.org/events/conf/CommInventions/Web%20Registration%20Form.pdf> or visit the IPRIA website for further information www.ipria.org

IPRIA Seminars and Workshops

Over the course of this year, IPRIA has held a number of free public seminars across Australia on various aspects of Intellectual Property. These seminars, featuring local and international speakers, were very well received and attracted over a thousand attendees. Topics covered included 'The Value of Copyright', 'Privilege and the IP Professional' and 'Manner of Manufacture'.

Details of these public seminars, copies of the associated presentations (where available) and all past events can be accessed from the IPRIA website at our [Past Events](#) page. Further seminars are scheduled for 2009 in Perth, Adelaide, Brisbane, Sydney and Melbourne.

The IPRIA one day course, 'Mastering the Trade Mark System', was held on Friday 12 September 2008. The course had attendees from across Australia and provided an up-to-date overview of trade mark law and practice. Comments from attendees include:

- 'I was very happy with the course. Excellent information.'
- 'Terrific friendly approachable presenters. Thorough coverage of all aspects of trade mark law.'
- 'Broad range of topics covered and presented well by very good subject matter experts.'

The course is planned for every second year, on rotation with a similar one day course on the patent system. The next IPRIA workshop on 'IP in the Real World' will be held in 2009.

To be advised of workshops, public seminars and all future events, please subscribe to our events notification service [here](#).

Publications

Reports

Australian Patent Applications Scoreboard 2008

Editor: [Dr Paul H Jensen](#) and [Dr Alfons Palangkaraya](#)

2008, 34 Pages, A4, A\$25 per copy (including GST), ISSN 1832-1070

The Australian Patent Applications Scoreboard is a comprehensive collection of data about the number of patent applications made in Australia each year. It is a useful reference across a number of disciplines and industries.

As it contains a large amount of information about patent applications in an easily accessible form, the Scoreboard is a useful tool for enterprises that facilitate the commercialisation of research projects.

Other information contained in the Scoreboard includes tables showing:

- the number of patent applications filed in Australia each year;
- a breakdown of the technology areas in which applications are filed;
- the number of patent applications filed by individual patent attorney firms; and
- which patent attorney firms file the most patent applications in the various technology areas.

To order this publication, please click [here](#) to download an order form. An invoice will be sent with the report.

Working papers

When one office grants and another rejects the application for the same invention

A study by Paul Jensen, Alfons Palangkaraya and Elizabeth Webster has estimated the number of misclassified patent applications at the EPO and JPO – that is, applications that are incorrectly refused a patent (Type I error) and applications that are incorrectly granted a patent (Type II error). Using a proxy for inventive step as the predictor of the correct decision, we estimate that 6.1 and 9.8 per cent of patents are, respectively, incorrectly rejected and incorrectly granted. They found evidence that patent offices are *less* likely to make Type I and Type II errors the longer the duration of examination and the greater the applicant's experience with submitting applications. Furthermore, the likelihood of committing a Type II error is an increasing function of the speed of technological change. While many believe that over the last decade the USPTO has been increasingly liberal in its treatment of 'bad' patents, there is no evidence that this also occurred at the EPO and JPO.

[Intellectual Property Research Institute of Australia Working Paper No. 02/2008](#)

A comparison of outcomes and pendency times for patent applications at IP Australia, the USPTO, the EPO and the JPO

A further study by Paul Jensen, Alfons Palangkaraya and Elizabeth Webster has compared the average outcomes and pendency times for a sample of patent application families that were concurrently filed at IP Australia, JPO, EPO and USPTO between 1990 and 1995 and granted before the end of 2004 at the USPTO. They found substantial variation across the offices in terms of examination outcomes. For example, Japan only grants 40 per cent of those applications that are granted by both IP Australia

and the USPTO (although a large proportion of applications at the JPO are withdrawn). Compared to the JPO and EPO, IP Australia has the highest grant rate. Secondly, we also find substantial variation in patent pendency periods across the patent offices. The time taken to *examine* an application (i.e. after the request to examine has been made by the applicant) is on average shortest at IP Australia (approximately 14 months) and longest at the EPO (approximately 42 months). However, the request lag – the time between filing and requesting an examination – is, at zero, smallest in the USPTO.

[Intellectual Property Research Institute of Australia Working Paper No. 01/2008](#)

Staff Profile – Catherine Macneil



[Catherine Macneil](#) joined IPRIA in July 2008 as a Research Fellow. She has completed a law degree and a science degree (majoring in genetics) with honours in biochemistry and molecular biology at Monash University. Her honours research project focused on nuclear signaling of the rabies virus phosphoprotein; a viral protein that plays a role in the evasion of host cell anti-viral mechanisms. Prior to joining IPRIA, Catherine worked as a paralegal and completed her articles at a boutique intellectual property and commercial law firm. During this time, she worked on a variety of commercial matters, spending a large part of her articles year assisting with the preparation for and conduct of Federal Court litigation relating to a patent for a pharmaceutical. She has also worked as a freedom of information officer for the Department of Immigration and Citizenship, where she handled freedom of information requests. Catherine's research interests include pharmaceutical and biotech patent law, trade marks, and copyright. She is currently working on the Australian Research Council Linkage Project 'The Fingers of the Powers Above Do Tune the Harmony of this Peace: Australia and the Harmonisation of Patents' with Professor Andrew Christie and Dr Chris Dent.

