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ARTICLES

Patent opposition and the Constitution: Before or after? – Chris Dent

The opposition procedure in Australian patent law is an effective tool for improving the quality of granted patents. The current, pre-grant process is, however, open to abuse by opponents who merely wish to delay the grant of a patent. Received wisdom has it that a post-grant procedure would be contrary to the Australian *Constitution* – ie for a delegate of the Commissioner of Patents to decide an opposition post-grant would be an improper exercise of judicial power. This article details the various tests for judicial power to assess the veracity of this wisdom. The conclusion, after a review of the High Court precedents and commentary, is that a post-grant opposition procedure, assuming it is substantially similar to the current pre-grant process, would not offend the *Constitution*. 217

The practical value of defensive trade marks – Joel Masterson

This article considers defensive registration of well-known trade marks and whether, despite its under-utilisation in Australia and its abandonment in other jurisdictions, it has any continuing practical value or relevance. The conclusion reached is that despite there being no support for defensive registration overseas, those traders who own defensive registrations are provided with a far more convenient avenue to relief from misuse than any of the available alternatives. The article also considers the history of defensive registration and suggests that its under-utilisation has been caused by difficulties that previously existed, but which no longer exist, in obtaining it in accordance with the relevant legislative tests. 232

Revisiting the Commonwealth Parliament's legislative authority for patent and patent-like schemes under the Constitution – Charles Lawson

While there may still in theory be some limits to the *Constitution* s 51(xviii) "patents for inventions" legislative power, the introduction of the concept of other products of intellectual effort in *Nintendo Co Ltd v Centronics Systems Pty Ltd* (1994) 181 CLR 134 and its restatement in *Grain Pool (WA) v Commonwealth* (2000) 202 CLR 479 appears to have established an almost limitless scope for this power. In addition, the *Constitution* s 51(xxix) "external affairs" legislative power considerably expands the scope for possible patent and patent-like legislative schemes. This article reviews the existing precedents and addresses the remaining potential limits to the Commonwealth Parliament's legislative authority to implement patent and patent-like legislative schemes that promote pro-competitive innovations without unduly restricting desirable competition. The analysis concludes that any present constraints on the Commonwealth Parliament's legislative authority are unlikely to be for want of expansive constitutional powers. 243

Lawyers' decisions in Australian patent dispute settlements: An empirical perspective – *Chris Dent and Kimberlee Weatherall*

Patent litigation is an expensive proposition for all parties concerned. Settlement avoids much of the cost, but occurs out of the spotlight: little is therefore known about how much is going on, when it happens, or what factors are taken into account. This article uses the results from a mail-out questionnaire administered to patent lawyers, to provide empirical evidence relating to the extent, timing and outcomes of settlement of patent litigation in Australia, and the factors considered by lawyers when advising their clients on settlement decisions. The results indicate that, consistent with conventional wisdom, financial cost is a very important factor when considering settlements, but that many other factors are also important. Some factors that might be expected to be important, including the psychological factors relating to litigation reputations, were indicated to be much less important. The article also comments on the merits of using a questionnaire to examine legal practice. 255

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