# Patent issue lacks clarity: Proceed with caution

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'TEQ Talk

Increasingly, academic institutions are filing patent applications to protect research findings. This means that researchers face the possibility that their use of patented research findings infringes the rights of the patent-holders. The issue is particularly relevant in light of a recent ruling in the U.S. Federal Court of Appeals.

The U.S. ruling that has attracted much attention is Madey v. Duke University. Madey was a professor who ran the free electron laser (FEL) laboratory at Duke. He was also the owner of two patents for FEL technology. When the laboratory continued to use some of the patented technology after Madey's resignation from Duke, he sued the university for patent infringement.

In defending its actions, Duke relied on the "experimental use" doctrine, which was recognized by U.S. courts as an exception to patent infringement. According to the doctrine, use of patented subject matter "solely for research, academic, or experimental purposes" does not constitute infringement.

However, the court interpreted the experimental use doctrine very narrowly, stating that the defense should be limited to use that is "for amusement, to satisfy idle curiosity or for strictly philosophical inquiry." Ruling in Madey's favour, the court found that any use of patented subject matter that is commercial in nature or connected with an infringer's "legitimate business" constitutes an act of infringement. The court found that Duke's experimental use of the patented subject matter was part of its legitimate business. This ruling suggests that in the U.S., proper authorization must be obtained before using patented subject matter for any academic research.

In Canada, researchers can take some comfort in knowing that patent rights and patent law do not cross international borders. That is, a patent granted in a country is governed by the patent laws of that country, and can only be infringed when unauthorized use of the patented subject matter occurs within that country.

The Canadian Patent Act (i.e., the legislation relating to Canadian patent law) states that it is not an infringement to use a patented invention if doing so is reasonably related to meeting regulatory requirements of the end product or process. The act suggests that this exemption applies to use of a patented invention "privately and on a non-commercial scale or for a non-commercial purpose," or "solely for the purpose of experiments that relate to the subject-matter of the patent."

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In some instances, Canadian courts have interpreted the act in favour of the party engaged in experimental use of the patented subject matter. For example, in Micro Chemicals Ltd. v. Smith Kline & French Inter-American Corp., the Supreme Court of Canada ruled that in making small quantities of a patented drug to test its manufacturing process prior to acquiring a compulsory license, Micro Chemicals did not infringe Smith Kline & French's patent rights. This ruling suggests that use of patented subject matter (i) to obtain information to be used for regulatory approval, and (ii) solely for the purpose of experimental testing before finalizing a commercial product, does not constitute infringement. It is not clear whether the exemption extends to basic research.

However, other court decisions give university researchers cause for concern. For example, in Harvard College v. Canada (Commissioner of Patents) (i.e., the "Harvard Mouse" case), the Canadian Biotechnology Advisory Committee recommended to the Supreme Court of Canada that the Patent Act should be amended to include an experimental use exception. The Supreme Court stated that the scope and nature of the experimental use exception was "uncertain." This uncertainty could provide a basis for a finding of infringement in litigation over experimental use.

Given the current lack of clarity in Canada regarding experimental use of patented subject matter, researchers should proceed with caution. One way to help avoid a possible legal confrontation is to search for the subject matter in the Canadian patent database at the Canadian Intellectual Property Office website (www. cipo.gc.ca). You can also contact Michael White, Queen's expert on patent databases, at the Engineering and Science Library, at ext. 36785. (Or you can register for his free workshop on patent searching, to be held on April 30.)

If you do find that the technology you are using is in a patent document, please call us. We at PARTEQ will gladly provide advice on this and related concerns.

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