



THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS
FICPI AUSTRALIA

19 November, 2009

Patentable Subject Matter Review
ACIP Secretariat
PO Box 200
WODEN ACT 2606

Email: mail.acip@ipaaustralia.gov.au

Dear Sirs

**Re: ACIP Options Paper
"Patentable Subject Matter"**

This submission is made on behalf of the Australian Federation of Intellectual Property Attorneys (FICPI Australia) and is further to our response of 30 September 2008 to the ACIP Issues Paper also entitled "Patentable Subject Matter".

We note at the outset that we have had the opportunity to review a draft of the response to this Options Paper prepared on behalf of the Institute of Patent and Trade Mark Attorneys of Australia (IPTA). We fully support the submissions presented by IPTA in its response. In view of this position we do not propose to comment in detail on each of Options A to J presented in the Options Paper. We will, however, make a few general comments below, as follows.

We are strongly of the view that there is no demonstrable problem with the current legislative and case law regime as it relates to patentable subject matter. Indeed, the Australian system in this area may well be regarded as defining world's best practice. Unlike the situations in Europe with its inflexible and prescriptive exclusions and the US post-Bilski, Australia has a system that is flexible enough to deal with new technology developments and shifts in community ethics and which provides relative certainty as to the boundaries of patentable subject matter through the benefit of years of jurisprudence.

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While there are concerns sometimes voiced in relation to the archaic language embodied in the 'manner of manufacture' test, this of itself is no reason to contemplate legislative change. A far greater concern is that in effecting legislative change to clarify, replace or delete the current reference in the Patents Act 1990 to 'manner of manufacture', unintended consequences could result, which may serve to widen or narrow the currently well understood boundaries of patentable subject matter or to limit the flexibility of our patent system to respond to technology developments.

We are generally of the view that the patent system, as a commercial regime that offers patentees a right to exclude others from the market, is not the appropriate vehicle for setting community ethical standards; this is the role of separate legislation. In our view, a pure patent system not tarnished by social filters and exceptions is the ideal. However, we also recognise that removal of the filters and exceptions currently embodied in the Act is unlikely to be politically attractive. Furthermore, and far more importantly, the current exceptions and filters do not appear to cause any adverse effect, and are generally well understood by users of the system. As with our position on 'manner of manufacture' we would be extremely wary of any move to alter or remove the current filters and exceptions due to the likelihood of introducing uncertainty and unintended consequences.

In summary, therefore, you will understand the basic position of FICPI Australia to be that the current regime with regard to patentable subject matter is not broken, and there is therefore no need for it to be fixed – particularly given the risk of any so called fix leading to mischief.

Members of FICPI Australia will be available to discuss any aspect of this submission.

Yours faithfully
FICPI Australia

A handwritten signature in black ink, appearing to read 'Stephen Krouzecky', with a long horizontal stroke extending to the right and a large loop at the end.

Stephen Krouzecky
Secretary