



NEW ZEALAND INSTITUTE OF PATENT ATTORNEYS INC

12 September 2008

Mr Brendan Bourke
IP Australia
Advisory Council on Intellectual Property
PO Box 200
Woden ACT 2606
Australia

Dear Mr Bourke

Comments on patentable subject matter issues paper

The New Zealand Institute of Patent Attorneys (NZIPA) provides the following written responses to the questions posed in the Issues Paper published July 2008.

1. Economic objectives of limiting patentable subject matter

1.1 Can placing limits on inherently patentable subject matter be justified on economic grounds?

No. We do not believe that economic grounds should be used to place limits on patentable subject matter.

1.2 Should the subject matter of each individual invention be assessed to determine whether a patent is necessary to encourage innovation, or should such an assessment be done for entire fields of technology?

The subject matter of each individual invention should be assessed to ensure the invention is new, involves an inventive step and is capable of industrial application.

The subject matter should **not** be assessed to determine whether a patent is necessary to encourage innovation.

The assessment should **not** be done for entire fields of technology. Article 27(1) of TRIPS prevents discrimination as to the field of technology.

2. Economic effect of inherent patentability test

2.1 What would be the consequences on innovation of imposing or removing limits on patentable subject matter?

We believe that imposing limits will reduce innovation.

2.2 Are you aware of any empirical data on such consequences?

No.

3. Ethical reasons for limiting patentable subject matter

3.1 Can placing limits on inherently patentable subject matter be justified on ethical grounds?

No. We do not believe that ethical grounds should be used to place limits on patentable subject matter.

3.2 Is it appropriate for legislation to predetermine ethical limitations on patentable subject matter, or is it more appropriate for courts to determine such limitations on a case-by-case basis?

No. We believe the Courts should determine such limitations if any.

3.3 Is patent law an appropriate avenue for dealing with ethical issues?

No. We do not believe that patent law is an appropriate avenue for dealing with ethical issues.

3.4 If not, what is an appropriate avenue?

In New Zealand, therapeutic products are regulated by Medsafe, the New Zealand Medicines and Medical Devices Safety Authority. Medsafe is a business unit of the Ministry of Health. Medsafe administers the Medicines Act 1981 and Regulations 1984. Products covered include:

- medicines
- related products
- herbal remedies
- medical devices
- controlled drugs used as medicines.

Embryonic stem cell research in New Zealand is regulated by the following:

- Human Assisted Reproductive Technologies Act 2000
- NZ Public Health and Disability Act 2000
- Human Tissue Act 2008
- Ministry of Health “Guidelines for using cells from established human embryonic stem cell lines for research: 2006.

Devices suitable for suicide are regulated in New Zealand by the Crimes Act. Section 179 imposes a prison term on anyone who aids or abets any person in the commission of suicide.

In New Zealand we already have many statutes and organisations that deal with any ethical issues arising from the use of some inventions. Patent law is not an appropriate avenue for dealing with such inventions.

4. Ethical effect of inherent patentability test

4.1 What would be the ethical consequences of imposing or removing limits on patentable subject matter?

We do not believe there would be any ethical consequences of imposing or removing limits on patentable subject matter. The patentability of inventions should not be affected by ethical consequences.

4.2 Are you aware of any examples of such consequences?

No.

5. Other reasons for limiting patentable subject matter

5.1 Other than economics, ethics and national security, can placing limits on inherently patentable subject matter be justified on any other grounds?

No. We do not believe that limits should be placed on patentable subject matter on economic or ethical grounds.

We do not believe limits should be placed on patentable subject matter on any ground other than national security.

6. Content and structure of current Australian law

6.1 Does the content of current Australian law meet the objectives of the system?

Yes. We believe the content of current Australian law meets the objectives of the system.

6.2 Are decision makers focussing on the appropriate principles?

We make no comment on whether decision makers are focussing on the appropriate principles.

6.3 Is the legislative structure of current law appropriate for the content?

Yes. We believe the legislative structure of current law is appropriate.

6.4 Is the current law clear to decision makers and users of the system?

Yes. We believe the current law is clear to both decision makers and users of the system. The term “manner of manufacture” has a rich body of associated common law. The common law is well placed to adapt to new technologies.

6.5 Does the content or structure of the current test cause you any significant problems?

No. Neither the content nor structure of the current test causes us any significant problems.

7. Issues with current Australian law

7.1 Do you have any comments on the following issues?

- *combination of flexible and proscriptive tests*
- *value of existing body of case law*
- *general inconvenience, mischievous to the state and hurt of trade*
- *archaic language*
- *threshold of inventiveness*
- *threshold of utility*
- *scope of rights awarded*
- *requirement for grant.*

We make no comment on any of these issues.

8. International integration

8.1 Is it more important to achieve best practice or to harmonise with a major jurisdiction?

It is preferable to achieve best practice rather than harmonise with a major jurisdiction.

8.2 Are any jurisdictions preferable over others?

We believe common law jurisdictions would be preferable over civil jurisdictions. If harmonisation is necessary, we would like to see harmonisation with the United States where possible.

9. International compliance of current Australian law

9.1 Is current Australian law compliant with our international obligations?

We are not in a position to comment on compliance. We have not followed closely various bilateral treaties entered into by Australia.

10. Preferred patentable subject matter

10.1 According to what you believe are the appropriate objectives and constraints of the patent system, what sorts of subject matters do you think should be inherently patentable and what should not?

We believe that no subject matter should be legislated against.

10.2 Would your preferred content be compliant with Australia's international obligations?

Yes. This preferred content would be compliant with TRIPS. We can't comment on other agreements.

11. Legislative structure

11.1 What sort of legislative structure would be appropriate to achieve your preferred content identified in Question 10?

The current legislative structure achieves our preferred content. No amendment is necessary.

11.2 Are any foreign structures preferred?

We don't prefer any other foreign structures to that already in place in Australia.

11.3 In principle, when should statutory provisions excluding specific subject matters be used?

We don't believe that there should be any statutory provisions excluding specific subject matter.

11.4 Should such provisions be expanded, such as by including the exceptions from patentability allowed under TRIPS?

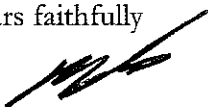
We don't believe that exclusion provisions should be expanded.

12. Do you have any other comments?

No.

Please let us know if you require further information.

Yours faithfully



Matt Adams
New Zealand Institute of Patent Attorneys