



Representing Australian Intellectual Property Owners Since 1965

18 September 2008

Mr Brendan Bourke
Secretariat
Advisory Council on Intellectual Property
P.O. Box 200
WODEN ACT 2606

Dear Brendan

Re: ACIP Review of Patentable Subject Matter

I have circulated the Issues Paper in relation to the above review to AMPICTA members for their information and comment. Following is AMPICTA's response to the issues paper generally and, in particular, to questions numbered 1 to 12 in Part 11 thereof.

For patentees, the major issues in connection with patentable subject matter are –

- Scope of patentability; and
- Certainty.

Whilst the concept of manner of manufacture has a long legal history of interpretation, the actual scope of protection is relatively uncertain. New technologies, by definition, have not been previously invented and it is therefore very difficult to anticipate the subject matter of new patents.

AMPICTA suggests that the Issues Paper fails to outline the fact that the reason why most companies patent an idea is to reserve rights to an invention and to disclose it to the public.

In the areas of biotechnology and pharmaceuticals, products generally take about 10 years of research to get them to the stage of being a saleable product. Manufacturers and investors need to be certain that the product they plan to commercialise will be worth the costs of research. Patents currently allow this.

Any product that requires a substantive degree of skill to commercialise should be patentable (provided it is also novel and inventive). This includes software, business methods, pharmaceuticals, gene therapies etc.

Our responses to the 12 questions in Part 11 of the Issues Paper follow:.

Question 1 – This question is anticipating a system wherein patentable subject matter is different for each field of invention. It would be an extremely difficult test to apply to a patent application. How could an invention be justified or tested on economic grounds? The vast majority of patents and patent applications are never commercialised nor used. Additionally, there is no reliable test to verify the potential success of a future invention. Patents are needed in all fields to stimulate innovation and open discussions.

Question 2 – We refer to the experiences in the USA where patentable subject matter definitions are much broader than Australia and innovation levels are also much higher.

Broad definition of patentable subject material provides the necessary reward for inventors to thrive. Inventors are reasonably certain of obtaining a patent so long as it is novel and inventive.

Question 3 – There is no ethical reason why any invention is not patentable subject material.

If the government believes that an invention is or is reasonably likely to be particularly harmful or unethical, it should outlaw the actual product, itself, not the patents associated with the product.

Patents do not give a right to manufacture or otherwise exploit an invention but rather a right to pursue and prevent infringers from using their inventions in an unauthorised manner.

Question 4 – see question 3

Question 5 – The only ground that seems justifiable as a ground for limitation is the national security argument. However, if the invention was a significant national secret then why would someone apply for a patent for it (i.e. it will be published)?

Question 6 – The current definition of patentable subject matter in Australia is “new manner of manufacture”. Whilst this term and its meaning is familiar to the legal profession and others experienced with the Australian Patent System, it is not a clear description to new patentees, decision makers, or general users of the system.

The main problem with the current definition is that courts change their views over time and the definition of a “new manner of manufacture” has mutated dramatically from its presumed original intention.

A clearer plain English definition is needed to promote further innovation in the future. This definition must be flexible and broad and able to adapt to new technologies as they are developed and invented. The very nature of the field of patents dictates that this definition must be flexible enough to cover new technologies not presently envisaged.

Question 7 – see Question 6

Question 8 – The broad changes to patentable subject matter should harmonise with USA, Europe and Japan as best we can. The US approach seems to be most adaptive whilst the European approach seems to be the least adaptive.

Question 9 – See Question 8

Question 10 – If Australia is to remain competitive in the international market place in respect of high tech goods, it should have a broad interpretation of patentable subject matter. Australian commercial research needs have access to patent protection to remain commercially viable on the international stage.

Question 11 – no comment at this time.

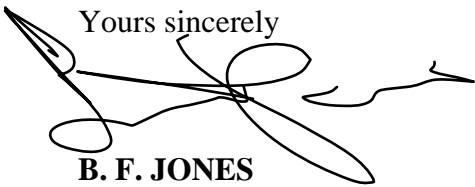
Question 12 – Prescriptive limitations on certain technologies (particularly in Europe) have substantively failed in the past. Methods of human treatment are not patentable subject matter in Europe; however there are thousands of patent claims relating to “Swiss Style” pharmaceutical claims.

Additionally in Europe, computer software is non-allowable subject material yet there are many claims directed to variations of computer software or hardware solutions. Prohibition of certain areas of technology fails to achieve the desired result and causes patent claims to become more obscure and removed from plain English interpretations

AMPICTA is grateful for the opportunity to comment on this ACIP Review of Patentable Subject Matter. In the event that ACIP decides to hold round table or one-on-one discussions in relation to this review, then AMPICTA would like to participate in any such discussions.

In the meantime, if we can assist this review any further please do not hesitate to contact the writer.

Yours sincerely

A handwritten signature in black ink, appearing to read 'B. F. Jones', with a large, stylized flourish extending to the right.

B. F. JONES
Secretary