

9 November 2009

Mr Brendan Bourke  
Advisory Council on Intellectual Property  
Strategy, Research & Ministerial Support  
IP Australia  
47 Bowes Street  
WODEN ACT 2606

[Mail.acip@ipaaustralia.gov.au](mailto:Mail.acip@ipaaustralia.gov.au)

Dear Mr Bourke,

**Re: ACIP Review of Patentable Subject Matter – Options Paper**

Thank you for asking the Royal College of Pathologists of Australasia to comment on the Options Paper. The College would like to submit the following in relation to Genetic Pathology.

Recommendation A: retain the current definition of invention.

The College does not support this on the following grounds. First, the statement that this definition "has been tested in a range of scenarios and a number of principles have been developed for its application" does not apply to gene patents. Gene patents have not been tested in an Australian court. The paper correctly identifies the major limitation of the current definition ie it relies on the statement that is 400 years old and is not a component of the patent legislation. Retaining the current definition is untenable.

Recommendation B: clarify the language.

The College supports this recommendation. The key features of an invention should be laid out explicitly in the legislation, there providing greater transparency in law.

Recommendation C: replace "manner of manufacture".

There is no specific merit in retaining or replacing this phrase, and the discussion lies outside our scope of expertise.

Recommendation D: delete the requirement for an invention.

The College does not support this recommendation. The paper correctly identifies the principal weakness of this recommendation ie "the prime economic test for identifying the subject matters for which patents should be available is removed". Patents represent a social contract whereby a person makes something that could conceivably be made by someone else, and the first person to achieve this manufacture has a limited monopoly. The social contract exchanges a monopoly for free disclosure of the method of manufacture. This social contract is grounded in the concept of an invention.

Recommendation E: retain the current exceptions and filters.

The College does not support this recommendation. As noted in the paper, "this option maintains the status quo". The paper goes on to note that there is some doubt about the application of the status quo. The very fact that there is doubt is sufficient to indicate that the matter should be clarified and hence this recommendation should be rejected.

Recommendation F: specific exclusions.

The College does not support this recommendation. This option would allow Parliament to develop a list to exclude specific subject matter. This would necessarily be reactive and problematic. Prevention is better than cure, and the potential inclusion of inappropriate subject matter should be addressed pro-actively as suggested in recommendations A-C.

Recommendation G: General filters.

The College supports this recommendation. It represents a pro-active approach, albeit in general terms, to identifying the boundaries within which patentable subject matter lies. One suggestion would be that the term "order public" be explicitly defined as it is currently used as jargon that is presumably understood by the IP industry but not necessarily by other stakeholders.

Recommendation H: inventiveness.

The College supports this recommendation. It is essential that legislation explicitly address the issue of inventiveness. The principle should be that we take measures to avoid inappropriate patenting rather than establish processes reactively after an inappropriate patent has been granted.

Recommendation I: usefulness.

The College supports this recommendation. The legislation and regulations regarding patentable subject matter should provide clarity and objectivity.

Recommendation J: advisory panel.

The College supports this recommendation. The paper suggests that the panel would provide advice on specific problematic cases. The College may wish to recommend a change in emphasis here. I submit that it would be more appropriate for the panel to provide advice on matters of general principle or interpretation rather than being a de facto review panel for specific applications. A panel that addressed highly technical matters would, of necessity, require a predominance of technical experts, thereby excluding community representation which might provide a less narrow view of the interpretation.

Yours sincerely,



Dr Debra Graves  
**Chief Executive Officer**