



Law Council  
OF AUSTRALIA

Via email: [mail.acip@ipaaustralia.gov.au](mailto:mail.acip@ipaaustralia.gov.au)

Mr Brendan Bourke  
Patentable Subject Matter Review  
ACIP Secretariat  
P O Box 20  
Woden aCT 2606

Dear Mr Bourke,

**ACIP Options Paper – Patentable Subject Matter**

I have pleasure in enclosing a submission which has been prepared by the Intellectual Property Committee of the Business Law Section of the Law Council of Australia.

The submission has been endorsed by the Business Law Section. Owing to time constraints, it has not been reviewed by the Directors of the Law Council of Australia Limited.

If you have any questions regarding the submission, in the first instance please contact the Committee Chair, Maurice Gonsalves, on 02-9296 2166.

Yours sincerely,

Bill Grant  
**Secretary-General**

12 May 2010

*Law Council of Australia, Business Law Section,  
Intellectual Property Committee,*

*Submissions in Response*

To

**The Advisory Council on Intellectual Property Patentable Subject Matter  
Options paper, September 2009**

In October 2008, the Intellectual Property Committee of the Business Law Section of the Law Council of Australia ('the IPC') made a submission in response to ACIP's Issues Paper on Patentable Subject Matter (July 2008). This response to the Options Paper (September 2009) is consistent with the approach taken by the Committee in the earlier submission.

**Part 1: Economic test**

**IPC supports option A - Retain the manner of manufacture test.**

The current definition as read in conjunction with relevant case law enables it to be understood by those whose activities are affected by it. Australian courts have developed from that archaic language a formidable body of well analysed principles, expressed in modern, easy to understand language. These principles are flexible and consequently able to be adapted and effectively applied in all situations. As such, reference to the archaic language is simply used as a touchstone to invoke the application of these clearly expressed principles. It is also flexible and adaptive so that it may be easily and effectively applied in all circumstances by the decision makers.

The interpretation of these words is so well developed that changing them would lead to the development of a whole different set of interpretations with attendant uncertainty in industry and commerce and increased litigation.

While Options B and C may replace the current definition with contemporary language, their weaknesses outweigh their perceived strengths. There is insufficient evidence of problems with the current definition to justify change.

IPC does not support Option D - deleting the requirement for an invention.

*In summary, IPC does not consider there are any substantial problems with the current language of the statute or the body of case law that has been developed.*

**Part 2: Social filters**

IPC supports Option E – retain current exceptions and filters. The Options Paper does not seek comment on the actual content of those exceptions. Nevertheless, IPC notes that the exceptions in s 50(1)(b) may no longer serve any useful purpose in the legislation.

## **Part 3: Enhancements**

### **H Inventiveness**

IPC supports the stated objective of Option H – to ensure that the legislation explicitly deals with inventiveness under the requirements that a patentable invention involves an inventive step. In addition to the confusion that exists for standard patents, this concept of a threshold of inventiveness is now being argued in the inappropriate context of the innovation patent (which requires no inventive step).<sup>1</sup>

### **I. Advisory Panel**

IPC considers that the Patent Office is best qualified to deal with these issues. To introduce other decision makers would in our view derail the legal purity, and effectiveness of the patenting process.

---

<sup>1</sup> *Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd* (2009) 177 FCR 239