

# Patentable Subject Matter – Consultation on an objects clause and an exclusion from patentability

**Submission by:**

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I make this submission in my individual professional capacity – that is, as an academic and professional lawyer with more than 25 years’ experience in intellectual property matters, with a particular focus on patents.

I disclose that I was a member of the Advisory Council on Intellectual Property (ACIP) during the time that ACIP conducted its *Review of Patentable Subject Matter*, out of which came the proposals under consultation that are addressed in this submission. I further disclose that I was the chair of the ACIP Working Group responsible for undertaking that Review.

## **Objects Clause**

**I support the introduction of an objects clause into the *Patents Act 1990 (Cth)*.** The public debates that led to, and that have followed from, the various inquiries into the patenting of genetic inventions show that the stakeholder interests in the patent system are varied, conflicting and contentious. Although an objects clause can’t directly settle individual controversies relating to the patent system, it can elaborate the general principles that are to be taken into account when a policy-maker or court is called upon to resolve those controversies. It is in the national interest that Australia’s patent legislation sets out, at a general level, its purpose.

**I support the wording of the objects clause proposed as Option 2 in the Consultation Paper.** I see Option 2 as consistent with, and a slight elaboration of, the principles espoused by ACIP as contained in the wording of Option 1. The elaboration contained in Option 2 is desirable. It is helpful to seek to describe, albeit at a general level, how the system enhances the well-being of Australians. Option 2 states – appropriately, I consider – that this is done by promoting innovation and the dissemination of technology. It is also helpful and appropriate to include patent applicants in the list of stakeholders whose interests are to be balanced by the system.

## **Patentability Exclusion**

**I support the introduction of a patentability exclusion based on ethical considerations into the *Patents Act 1990 (Cth)*.** The international treaties to which Australia is a party – including, in particular, the TRIPS Agreement and the Australia-United States Free Trade Agreement – entitle Australia to exclude inventions from patentability on ethical (as well as other) grounds. It is in the national interest that Australia takes advantage of this entitlement. The public can be expected to have greater confidence in, and an increased respect for, a patent system that expressly recognises ethical issues.

**I support the particular wording of the patentability exclusion proposed by ACIP.** I consider that the proposed exclusion is compliant with Australia's international obligations, in that it is within the scope of exclusions permitted by Article 27(2) of the TRIPS Agreement and by Article 17.9.2 of the Australia-United States Free Trade Agreement. I also consider that the proposed exclusion is sound in principle. Where the ordinary reasonable and fully informed member of the Australian public would consider the commercial exploitation of an invention to be wholly offensive, it is appropriate that the patent system not be seen as providing an incentive, through the grant of an exclusive right, to commercially exploit that invention. The exclusion's focus on the offensiveness of the commercial exploitation of the invention, rather than on the invention itself, is appropriate, because a patent grants the exclusive right to commercially exploit the invention. It would be ethically wrong to grant a patent for an invention – and, thereby, the exclusive right to commercially exploit that invention – where the invention's commercial exploitation would be wholly offensive to the public.

### **Implementing the Patentability Exclusion**

**I support amending the *Patents Act 1990* (Cth) to give the Commissioner explicit power to seek advice on ethical matters.** When a decision is required to be made on grounds of morality or ethics, it is appropriate that the decision-maker has access to the perspective of informed and representative members of the public. Doing so engenders public confidence in, and respect for, the decision-making process. Doing so also can be expected to improve the quality of the decisions made under that process. For this reason, it is appropriate that the Commissioner of Patents be entitled to seek advice on the application of the proposed ethically-based exclusion from patentability.