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14 January 2014

Ms Terry Moore
IP Australia
By email

Dear Terry

On behalf of the University of Tasmania's Centre for Law and Genetics, we are pleased to provide the following submission in response to the IP Australia *Patentable Subject Matter Consultation Paper on an Objects Clause and Exclusion from Patentability*.

1. Do you have a preference for either of the two options proposed for the Objects Clause? If so, please explain the reasons for your preference. If you disagree with the wording of both of these options, please explain which elements you disagree with and why.

We support the introduction of an objects clause into the *Patents Act 1990* (Cth). We agree with the recommendation in the Consultation Paper that patent applicants should be included as well as patent owners and others. As such, we prefer the second of the option provided in the Consultation Paper.

One other constituency that is not mentioned in the objects clause is 'other creators of technology'. Patents should not impede competition in the development of new technologies. For this reason, patent claims need to be limited so that they do not provide protection to the patent owner that goes too far beyond the true nature of the invention. The amendments to section 40 of the *Patents Act 1990* (Cth) through the Raising the Bar Act deal with this issue. However, we submit that it would be appropriate to explicitly include other creators of technology as well as patent applicants and owners, users of technology and Australian society as a whole in the objects clause. It is unclear to us why special attention is being given to patent applicants, but no attention is

being paid to other creators.

2. Do you agree with the wording proposed by ACIP for the patentability exclusion?

If you disagree with the wording, please explain which elements you disagree with and why.

We have consistently stated in our submissions to the ALRC and Senate gene patent inquiries and to the ACIP patentable subject matter inquiry that an exclusion should be introduced into the *Patents Act 1990* (Cth) based on the TRIPS ordre public/morality exclusion. We continue to support the introduction of such an exclusion.

We submit that it is proper for there to be scope for dealing with ethical concerns in patent law, provided that these concerns relate solely to exploitation of the invention, as prescribed in TRIPS. It is important to separate out ethical concerns relating to patenting of technology and ethical concerns relating to the technology itself. The latter should not be dealt with through the patent system but through direct regulation of research and development activities. But there will be some instances where it would be contrary to morality to allow the patent system to be used to facilitate the commercial development of certain technologies. We expect that, as a general rule, very few patent applications will fall foul of an exclusion centred on ethical grounds. This is certainly the experience in Europe (although the applicability of this provision for excluding patents for inventions relating to embryonic stem cell technology is an area of continuing uncertainty). As such, we submit that the clear purpose of this exclusion should be well articulated, so that the non-expert reader does not see it as a panacea for problematic enforcement practices, like those associated with gene patents.

Nevertheless, we submit that it is appropriate that such an exclusion to be explicitly provided for in our patent legislation. For too long there has been debate around the applicability of the 'general inconvenience' exclusion (incorporated into Australian law from section 6 of the *Statute of Monopolies 1624*) for dealing with matters of morality and public policy. This uncertainty would be removed by the introduction of a clear and explicit exclusion for inventions, the commercial exploitation of which would be wholly offensive to the ordinary reasonable and fully informed member of the Australian public. We support the proposed wording of this provision.

3. Do you agree with amending the Patents Act to explicitly provide the Commissioner of Patents with powers to seek advice on ethical matters? If you disagree please explain why.

We believe that the Commissioner of Patents will not always be best placed to determine contemporary standards of morality in society. Given that the proposed test is whether commercial exploitation is wholly offensive to the ordinary reasonable and fully informed member of the Australian public, it is entirely appropriate that the Commissioner should be able to seek advice on such matters. Patent examiners do not have relevant training. The unanswered question is how the Commissioner undertakes this process. In our submissions to the ACIP Issues Paper and Options Paper on Patentable Subject Matter, we supported the creation of an advisory panel to assist the Commissioner on a range of matters, including the evaluation of contemporary public perceptions on issues of morality. We continue to support the establishment of some sort of mechanism for providing the Commissioner with the opportunity to obtain expert advice from individuals with relevant skills and training.

With best wishes

Professor Dianne Nicol

Mr John Liddicoat