CLAW2209: Intellectual Property Sample

Patent Law

- Patent can be thought of as rights granted in relation to inventions that are 'new' and 'non obvious' that 'contribute to economic development' according to Fitzgerald and Eliades. It can be a device, substance, process or a combination of these
    - Examples include Victa Mower, cochlear implant, shoes and swim suits
- Patent has a high threshold to be awarded but offers exclusive rights for 20 years. The trade-off of obtaining a patent is that full disclosure in clear and specific terms must be made to public: s186-187
- The earliest form of patent legislation was with the *Statute of Monopolies Act* in 1624. Under s6 monopolies were banned in response to abuse. The exception was that patents would be certified for manner of new manufacture that did not contravene the law, was mischievous in raising commodity prices or was generally inconvenient. Legislation now covering patents includes *Patents Act 1990* and *Patents Regulations 1991*
- Two types of patents include:
    - Standard patent – has a term of 20 years: s65, 67 providing for annual renewal fees to be paid: s143. The duration of the standard patent can be extended to 25 years for pharmaceutical patents: s70. This is if there is a long application and approval process for drugs which is at least 5 years long
    - Innovation patent – this was introduced in 2001 to replace the petty patent. It does not require completely new inventions and only requires incremental advance on prior technology. Lasts for duration of 8 years: s65, 68. It also requires annual renewal fees

      The duration of standard patent and innovative patent are 20 years and 8 years respectively from the date of the patent. S65 states that the patent date is the date of the filing of complete specification or different date in regulation (can back date 12 months to the filing of provisional specification).

- There is often patent attorney for each science or engineering firm. Their obligations are outlined in s200 of the Patents Act. Under subsection 1 and 2 their role is to prepare documents and transact business for the purposes of the act
- The patentable elements are outlined in s18 and include:
    - Invention (threshold element)
    - Manner of manufacture
    - Novel (new, not anticipated)
    - Inventive step (not obvious) and for innovative patent: innovative step
    - Utility (does what it claims)
    - Not secretly used in the patent area before the specification date with authority of patentee
- Invention – must fall within the scope of what is known as an invention. If inventiveness is not relevant then the patent will be invalid. In *NV Philips Gloeilampenfabrieken v Mirabella*

International Pty Ltd (1995) the patent application for the fluorescent light bulb was rejected as it was making a claim for use of known materials and their known properties

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Manner of manufacture

- Manner of manufacture – according to *National Research and Development Corp v Cr of Patents (1959)* a manner of manufacture:
    - Means the useful arts not the fine arts
    - Mere discovery will not be patentable
    - There needs to be an industrial application to produce a *vendible product*. With 'vendible' meaning that an economically useful result and 'product' meaning an artificially created state of affairs

      In *NRDC v Cr Patents (1959)* it was held that there had been a manner of manufacture as the weed free crop had created economic value from an artificially created state of affairs

  Categories of decisions have been decided relating to manner of manufacture:

    - In the medical profession, patents were considered 'generally inconvenient' in the words of s6 of the Monopolies State for the purpose of public interest: *Joos v Cr Patents (1972)*. However, more recently patents of medical products has been approved for sleep disorders, *Anaesthetic Supplies Pty Ltd v Rescare Ltd (1994);* cancer treatment, *Bristol-Myers Squibb Co v FH Faulding & Co Ltd ;* and skin disorder (psoriasis) treatment, *Apotex Pty Ltd v Sanofi-Aventis Australia Pty Ltd* [2013].
    - Mere discoveries will not be a manner of manufacture. In *Grant v Cr of Patents (2006)* the method of structuring financial transactions to protect client's assets was not a manner of manufacture as it did not provide a vendible product or a measureable effect
    - Computer programs may be patentable. In *IBM Corp v Smith, Cr of Patents* (1991) a computer program responsible for constructing algorithmic curves was deemed a manner of manufacture as it created an economically useful result. See also *Welcome Real Time SA v Catuity Inc* [2001] for vendible product. However, in *Research Affiliates LLC v Commissioner of Patents* [2013] a program was deemed not be a manner of manufacture as it was simply reproducing statistics which could have been done by hand
    - Gene technology – *Cancer Voices Australia v Myriad Genetics Inc* [2013] demonstrated a case where technology had been utilised to isolate and detect human breast and ovarian cancer predisposed genes. There was no question that the invention had a vendible element in producing economically valuable results. The case turned on whether it created a 'product'. The court ruled that whilst there was discovery of a law of nature, it was utilised in a way that isolated nucleic acids which would not occur naturally – deemed a manner of manufacture...