HIGH COURT OF AUSTRALIA

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### Details of Filing

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### Important Information

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IN THE HIGH COURT OF AUSTRALIA

SYDNEY REGISTRY No. S40 of 2022

BETWEEN: **ARISTOCRAT TECHNOLOGIES AUSTRALIA PTY LTD**

ACN 001 660 715

Appellant

and

**COMMISSIONER OF PATENTS**

Respondent

# IPTA'S OUTLINE OF ORAL ARGUMENT

## Part I:

1. I certify that this submission is in a form suitable for publication on the internet.

## Part II:

### A. The application of the Full Court's new test for manner of manufacture in fields other than poker machines, and the impact it would have on research and industry in Australia

2. The Full Court's statements at FCJ [26]-[27] are, or are likely to be applied as, a new test for manner of manufacture applying to all computer-implemented inventions.
3. Under the new test, any invention that is implemented using a computer would not be patentable unless it is an advance in computer technology.
4. Computers are now commonly included in claims in patents and patent applications in most fields of endeavour. The new test would lead to the refusal of many patent applications. It may also lead to the loss of many existing (granted) patents. That would reduce the incentive for research and development in fields other than computer technology.

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**B. The new test treats computer-implemented inventions differently from other inventions**

5. The Full Court's approach treats inventions that include computer implementation differently from other inventions. That is erroneous for the following reasons.

    a. First, there is no basis for it in the legislation.

    b. Secondly, it is inconsistent with Australia's international obligations.

    c. Thirdly, it makes the law of manner of manufacture inconsistent.

    d. Fourthly, it is unnecessary.

6. The correct approach for computer-implemented inventions is the same as the approach for all other inventions. The Court should ask: *"Is the invention, considering the subject-matter of the claim as a whole, no more than a mere scheme, method of doing business or abstract idea?"*

**C. Difficulties in practical implementation of the new test**

7. The Full Court's approach for manner of manufacture includes elements of novelty. That is erroneous because manner of manufacture is concerned not with newness, but with subject-matter. IPTA will adopt (but not repeat) Aristocrat's submissions on this issue.

8. IPTA further submits that the Full Court's approach would require the Court to accept and consider evidence about what was the prior art at the priority date. It would also import a temporal aspect to the test for manner of manufacture.

**D. The practical difficulties with the Full Court's approach to identifying the substance of the invention**

9. In seeking to identify the substance of the invention, the Full Court embarked on a search for newness that led it to disregard essential integers of the claim. Claims should be read as a whole. IPTA will adopt (but not repeat) Aristocrat's submissions on this issue.

10. IPTA further submits as follows.

    a. First, it has become common practice for patent examiners to, in the course of assessing the "substance" of the invention, disregard or exclude essential features of the claims. This has the result that patents that would previously have been granted are now being refused.

    b. Secondly, claim integers are commonly interdependent, so focusing on only some integers of a claim can give a distorted picture of what is claimed.

    c. Thirdly, the majority's approach results in a mismatch between how claims are read for the purpose of manner of manufacture, and how they are read for the purposes of infringement and novelty.

Dated: 9 June 2022

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