



## HIGH COURT OF AUSTRALIA

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4. The Commissioner disagrees with the issues formulated by the appellant (**Aristocrat**) in Part II of its submissions (**AS**). Properly understood, the Full Court’s approach involved the application of the principles of manner of manufacture laid out by this Court; did not wrongly inquire into novelty or inventive/innovative step; and properly directed attention to the invention as claimed, considered as a matter of substance, not form.

### **PART III JUDICIARY ACT 1903 S 78B**

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5. No notice is required to be given under s 78B of the *Judiciary Act 1903* (Cth).

### **PART IV CONTESTED FACTS**

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6. The Commissioner adds the following to the narrative statement of facts in AS Part V.
- 10 7. As to AS [7], the proper characterisation of the invention in claim 1 of the 967 Patent is at the heart of the issue raised by this appeal and is not merely a question of fact.
8. As to AS [8], the statement of the common general knowledge is incomplete. At the priority date, a “*gaming machine*” or **EGM** typically consisted of a number of standard hardware and software components, including a display; credit input and output mechanisms; meters for monitoring credits; a random number generator; buttons for user interaction; and a “*game controller*” comprising a processor and memory for executing software to implement the game: PJ [30]-[31] (CAB 15-16); FCJ [7] (CAB 72). These corresponded with integers 1.1 to 1.6 of claim 1 of the 967 Patent as identified by the Courts below: PJ [69] (CAB 25-26); FCJ [6], [131] (CAB 71-72, 108-109). Thus the
- 20 hardware and software aspects of the “*gaming machine*” referred to in the claim were conventional in character and differed from other gaming machines only in relation to the rules or features of the particular game being implemented. This was confirmed by passages in the specification of the 967 Patent<sup>1</sup> and the expert evidence.<sup>2</sup>
9. As to AS [9], the findings below do not illuminate precisely how the hundreds of standard patents granted to Aristocrat and its competitors were “*similar*” to the 967 Patent. To the extent that they were “*similar*”, this tends to reinforce the need for an appropriate filter on the patentability of such inventions through the principles outlined below.

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<sup>1</sup> 967 Patent, pp 1.12-15, 4.13, 4.26-38, 5.6-13, 5.23-26, 6.1-4, 6.10-17, 7.29-31, 8.5-11, 16.9-15 (ABFM 7, 10-14, 22). See also FCJ [131], [136]-[137] (CAB 108-110).

<sup>2</sup> *Yorg* at [42]-[44] (RBFM 9-10); *Nicely* at [82]-[83] (RBFM 6); T 100.45-104.35 (RBFM 12-16).

10. Finally, as to AS [10]-[11], the Commissioner disputes Aristocrat’s characterisation of the reasoning of the primary judge and the Full Court as outlined below.

## **PART V ARGUMENT IN ANSWER ON THE APPEAL**

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### **Overview of the Commissioner’s position**

11. It is well-established that the question whether an allegedly patentable invention is a “*manner of manufacture*” depends upon the construction of the patentee’s claim in the light of the specification as a whole and the relevant prior art, which in this case is the common general knowledge; and that this is to be determined as a matter of substance, not merely by the form of the claim. So characterised, the invention claimed in claim 1 of the 967 Patent is an abstract idea, being a scheme or set of rules for playing a game, which is implemented using conventional computer technology for its well-known and well-understood functions. Such an “*invention*” is not a proper subject of letters patent according to the principles which have been developed for the application of s 6 of the *Statute of Monopolies*, and is thereby not a manner of manufacture.
12. As submitted below, the injunction against the grant of patents for abstract ideas has long been established. Business, commercial and financial schemes as such have never been considered patentable, in the same way that the discovery of a law or principle of nature is not patentable. Games, and the rules for playing them, have also never been considered patentable. The recent Full Court decisions, including that of the Full Court below, correctly recognise that an unpatentable abstract idea does not change its legal character merely because it is implemented by a computer. This is consistent with the need to consider the claimed invention as a matter of substance, not form.

### **Overview of response to Aristocrat’s case**

13. Aristocrat accepts the principle that “*mere schemes (plans or methods) are not patentable subject matter*”: AS [12]. However, it mischaracterises the reasoning of the Full Court in this case, and the other recent decisions in this area, as having failed to apply the principles laid out by the High Court and falling into error in various ways: AS [14]-[15], [32]-[54], [62]-[84], [89]-[91]. As explained below, the Full Court applied the principles laid out by this Court, and did not fall into the various errors asserted.
14. The language used by the Full Court in this case and the other recent decisions should not be understood as imposing any “*new test*” or “*rigid formula*”, but rather, as seeking to

describe the conceptual distinction between a manner of manufacture and an unpatentable abstraction, and as explaining that an abstract idea, such as a “*mere scheme*”, does not change its legal character merely because it is implemented by a computer. The test remains that laid out by this Court: whether the invention is a proper subject of letters patent according to the principles which have been developed for the application of s 6 of the *Statute of Monopolies*. As Aristocrat accepts, a “*mere scheme*” is not.

15. It should be noted that Aristocrat’s case has changed significantly. In the Courts below, it did not challenge the correctness of the other recent Full Court decisions.<sup>3</sup> Nor did it do so in its application for special leave. To the contrary, it contended that those decisions involved the development of the principles laid out by this Court, and that the Full Court’s approach in this case was inconsistent with those decisions.<sup>4</sup> This was no doubt because special leave had been refused from two of those decisions on the basis that they were “*plainly correct*” or applied “*established principles*”.<sup>5</sup> Aristocrat now argues that the other recent Full Court decisions involved numerous errors, and that the decision of the Full Court in this case represents the “*culmination of a combination of these errors*” and “*is not an outlier*”: eg, AS [14]-[15], [32]-[54], [90]. In this context, it is important to observe that Aristocrat’s criticisms of the reasoning in the other recent decisions were never put to the Full Court below. Further, it follows that Aristocrat’s appeal now depends upon it establishing that the other recent decisions were wrong.
- 20 16. The difficulties with Aristocrat’s proposed approach to assessing manner of manufacture in this area are addressed below. For present purposes, however, it may be noted that the approach includes the following features: (i) it involves asking whether the claimed invention is a “*mere scheme*”; and (ii) it involves assessing the “*substance*” of the invention for this purpose by focusing on some “*aspects*” of the claimed invention over others: see AS [68], [80] and paragraph 62 below. These features of Aristocrat’s approach undermine many of its criticisms of the reasoning of the Full Court in this case and the other recent decisions. Further, properly applied to this case, these same criteria produce the result that the claimed invention is not a manner of manufacture.

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<sup>3</sup> Specifically, *Research Affiliates LLC v Commissioner of Patents* (2014) 227 FCR 378; *Commissioner of Patents v RPL Central Pty Ltd* (2015) 238 FCR 27; *Encompass Corp Pty Ltd v InfoTrack Pty Ltd* (2019) 372 ALR 646; and *Commissioner of Patents v Rokt Pte Ltd* (2020) 277 FCR 267, discussed further below.

<sup>4</sup> Application for Special Leave to Appeal dated 22 December 2021 at [11], [55].

<sup>5</sup> See *RPL Central Pty Ltd v Commissioner of Patents* [2016] HCASL 84 at [2]; *Rokt Pte Ltd v Commissioner of Patents* [2020] HCASL 202 at [1].

## General principles of patentability

17. The requirement in s 18(1A)(a) of the Act that an invention be “*a manner of manufacture within the meaning of section 6 of the Statute of Monopolies*” was considered in detail in *D’Arcy v Myriad Genetics Inc* (2015) 258 CLR 334. The Court confirmed its earlier finding in *National Research Development Corp v Commissioner of Patents* (1959) 102 CLR 252 (*NRDC*) at 269 that it is necessary for this purpose to ask whether the invention is a proper subject of letters patent according to the principles which have been developed for the application of s 6 of the *Statute of Monopolies*: at [18], [124], [221].
18. French CJ, Kiefel, Bell and Keane JJ also explained at [12] (footnote omitted):
- 10           *That inquiry requires a definition of the allegedly patentable invention. That definition depends upon the construction of the impugned claims read in the light of the specification as a whole and the relevant prior art. The prior art in this case was reflected in expert evidence at trial and set out in the scientific primer agreed between the parties and summarised later in these reasons.*
19. As their Honours observed, the prior art may comprise the “*common general knowledge*” against which the specification is to be read: at [39]. That is so in the present case. All members of the Court in *Myriad* read the specification in that context.
20. Importantly, as *Myriad* makes clear, the proper characterisation of the invention must be determined as a matter of substance, not form. Thus French CJ, Kiefel, Bell and Keane JJ
- 20           warned against elevating form over substance, and explained that while the claim in suit was in *form* directed to isolated nucleic acids created by human action, its *substance* was genetic information: at [87]-[91]. Gageler and Nettle JJ said that “[*t*]he way in which a claim is drafted cannot, however, transcend the reality of what is in suit ... Monopolies are granted for inventions, not for the inventiveness of the drafting with which applicants choose to describe them”: at [144]. Their Honours cited *Research Affiliates LLC v Commissioner of Patents* (2014) 227 FCR 378 at [107], which dealt with computer-implemented inventions, for the proposition that a claimed invention “*is to be understood as a matter of substance and not merely as a matter of form*”: at [145]. All members of the Court concluded that the invention was not a manner of manufacture.
- 30   21. The Court in both *NRDC* and *Myriad* also emphasised that the question of manner of manufacture is to be approached not by substituting any verbal formula, but rather by a common law methodology according to the principles developed by the courts for the

application of s 6 of the *Statute of Monopolies*: *NRDC* at 269; *Myriad* at [18]. In this regard, the language of an “*artificially created state of affairs of economic significance*” used in *NRDC* at 277 merely explained the qualities of the particular invention in suit, and did not represent a sufficient or exhaustive statement of the circumstances in which an invention will be a manner of manufacture: *Myriad* at [20]-[21], [125]-[126], [166]-[167], [272]-[278]. As the Court said in *NRDC*, “[t]o attempt to place upon the idea the fetters of an exact verbal formula could never have been sound”: at 271. For similar reasons, *Apotex Pty Ltd v Sanofi-Aventis Australia Pty Ltd* (2013) 253 CLR 284 and *CCOM Pty Ltd v Jiejing Pty Ltd* (1994) 51 FCR 260 (both relied on heavily by *Aristocrat*) are not to be understood as imposing any rigid test: *Myriad* at [20]-[21].

### Patentability of abstract ideas

22. The injunction against the grant of patents for abstract ideas has long been established. In *Grant v Commissioner of Patents* (2006) 154 FCR 62 at [14], the Full Court said that “[b]usiness, commercial and financial schemes as such have never been considered patentable ... in the same way that the discovery of a law or principle of nature is not patentable”. Patents have also been refused for “*working directions and methods of doing things*”, and “*methods of calculation, theoretical schemes, including business schemes and abstract plans*”: *Grant* at [15]-[16]. Games and the rules for playing them are another form of abstract idea for which patents have long been refused. This was recognised by the Full Court in this case, citing various decisions: FCJ [16] (CAB 75).
23. There is a difference between an abstract idea, which is not patentable, and a practical application of it to produce a useful result, which may be: *Grant* at [14]. In the context of games, this has been reflected in the proposition that the game itself, no matter its ingenuity, is not patentable, but the physical apparatus used for playing it (such as cards or a board) may be: FCJ [16] (CAB 75). It remains necessary, however, to consider the invention as a matter of substance, not form: *Myriad* at [87]-[94], [144]-[145].
24. These principles do not appear to be in dispute. As noted, *Aristocrat* accepts that “*mere schemes*” are not patentable: AS [12]. It also accepts that it is necessary to ask whether a computer-implemented invention is a “*mere scheme*”, and, in doing so, to have regard to the substance of the claimed invention, not merely its form: AS [68], [80].
25. As explained below, the point made by the recent Full Court authorities on computer-implemented inventions is that the implementation of an abstract idea in a computer,



using conventional computer technology for its well-known and well-understood functions, does not make it a manner of manufacture. The invention, considered as a matter of substance, not form, remains an unpatentable abstract idea.

### Patentability of computer-implemented inventions

26. The principles in *NRDC* and *Myriad* have been applied in the context of computer-implemented inventions in a line of recent decisions of the Full Court. These decisions recognise that an invention in this context must be examined to ascertain whether it is in substance an unpatentable abstract idea or whether it is something more. In this regard, a distinction is drawn between an abstract idea implemented using conventional computer technology for its well-known and well-understood functions, on the one hand, and an invention involving some improvement in computer technology, on the other. For there to be patentable subject matter, there must be invention in the way in which the abstract idea is implemented in the computer, as distinct from the idea itself.
27. In *Research Affiliates* (see paragraph 20 above), the claims in suit were directed to a computer-implemented scheme for generating a weighted index of a portfolio of assets: at [65], [71]. The essence of the patentee’s argument was that, because this was implemented in a computer, which involved physical effects in the transformation of data and the writing of information into RAM, it involved an “*artificially created state of affairs of economic significance*” which was patentable under *NRDC*: at [82], [103], [106], [110]. The Full Court characterised the issue for determination as being “*whether computer implementation of an otherwise unpatentable business scheme is sufficient to make the claimed method properly the subject of letters patent*”: at [1].
28. The Full Court held that there was no manner of manufacture. Their Honours referred to “*a distinction, between mere implementation of an abstract idea in a computer and implementation of an abstract idea in a computer that creates an improvement in the computer*”: at [104]. The question whether this was patentable in accordance with *NRDC* was to be determined “*not by some mechanistic application of the criterion of artificiality or physical effect*”, but rather by an understanding of the claimed invention “*as a matter of substance and not merely as a matter of form*” at [107]; see also [114], [118]. In this regard, the significance of the invention lay in the content of the data: at [118]. It was apparent from the specification that any ingenuity resided in the scheme for creation of the index, as distinct from the manner of the implementation of the scheme in the computer; and that the scheme did not involve any improvement in what might broadly



be called computer technology: at [115], [119]. In short, the claimed invention remained, in substance, an unpatentable scheme. This reasoning was plainly correct.

29. In *Commissioner of Patents v RPL Central Pty Ltd* (2015) 238 FCR 27, the claimed invention was a computer-implemented scheme for gathering evidence relevant to an assessment of an individual's competency relative to a recognised qualification standard, involving a series of steps: at [36], [38]. The patentee argued this was patentable because it involved the configuration of a suitably programmed computer, a new application of hardware and software and an improvement in computer technology: at [95]. The Full Court said at [96], in a passage quoted and applied in later cases:

10            *A claimed invention must be examined to ascertain whether it is in substance a scheme or plan or whether it can broadly be described as an improvement in computer technology. The basis for the analysis starts with the fact that a business method, or mere scheme, is not, per se, patentable. The fact that it is a scheme or business method does not exclude it from properly being the subject of letters patent, but it must be more than that. There must be more than an abstract idea; it must involve the creation of an artificial state of affairs where the computer is integral to the invention, rather than a mere tool in which the invention is performed. Where the claimed invention is to a computerised business method, the invention must lie in that computerisation. It is not a patentable invention simply to*

20            *“put” a business method “into” a computer to implement the business method using the computer for its well-known and understood functions.*

30. The Full Court also emphasised that it was necessary to consider the claimed invention as a matter of substance, not form: at [98]. After referring to *Research Affiliates*, the Full Court observed that the invention as claimed was such that it could not be carried out without computers, but that this did not necessarily make it a manner of manufacture. Rather, there had to be some invention in the way in which the computers were utilised to carry out the scheme: at [104], [107]. The specification did not disclose any invention in the operation of the computers or the implementation of the scheme; rather, the only ingenuity lay in the scheme itself: at [110], [112]-[113]. The invention, as a matter of
- 30            substance, was an unpatentable scheme. Again, this was plainly correct.

31. *Encompass Corp Pty Ltd v InfoTrack Pty Ltd* (2019) 372 ALR 646 involved claims to a computer-implemented method and apparatus for displaying information relating to one or more entities by a series of steps: at [27]-[28], [33]. A Full Court of five judges, after

referring to *NRDC* and *Myriad*, characterised the language in *Research Affiliates* and *RPL* as “seeking to describe the conceptual distinction between a manner of manufacture and an unpatentable abstraction” and “explaining that a claimed method that is unpatentable does not change its legal character merely because the method is implemented by the instrumentality of a computer”: at [91]; see also [94]. The Full Court then quoted the passage from *RPL* at [96] which is extracted in paragraph 29 above.

32. Turning to the case at hand, the Full Court in *Encompass* found that the method claims in suit were “in truth, no more than an instruction to apply an abstract idea (the steps of the method) using generic computer technology”: at [99]. Responding to an argument by the patentee to the effect that more than “generic software” was required to implement the invention, the Full Court observed the claims in suit did not secure, as an essential feature of the invention, any particular software or programming that would carry out the method; rather it was “left entirely to those wishing to use the method to devise, and then to implement, a suitable computer program for that purpose”: at [100]. The same applied to the apparatus claims: at [102]. Again, this reasoning was plainly correct.

33. In *Commissioner of Patents v Rokt Pte Ltd* (2020) 277 FCR 267, the Full Court was concerned with a claim to a computer-implemented method for linking a user to an advertising message by way of an intermediate engagement offer, involving a series of detailed processing steps: at [33]. Citing *Myriad* and *NRDC*, the Full Court referred to the importance of construing the patentee’s claim and characterising the invention as a matter of substance, not form: at [67]-[69]. The Full Court said at [74]:

... as we have noted, the task of construing the specification involves arriving at a characterisation of the invention claimed in order to determine whether or not it is in substance for a manner of manufacture. That involves the application of the common law principles developed to separate patentable inventions from schemes or methods of business. The latter can, in the context of computer implementation, appear to be dressed in the clothes of invention. In each of *Research Affiliates*, *RPL Central* and *Encompass*, the Full Court found the computer implemented inventions not to be patentable; each was a case of the Emperor’s new clothes.

34. The Full Court in *Rokt* also reiterated the point made in *Encompass* at [91], by reference to each of *Research Affiliates* and *RPL*, that “a claimed method that is unpatentable does not change its legal character merely because the method is implemented by the instrumentality of a computer”: at [80]. In the course of considering those decisions, the

Full Court again quoted the passage from *RPL* at [96] which is extracted in paragraph 29 above: at [84]. The Full Court in *Rokt* then said the following at [91]:

*... where the cases refer to “generic software” or to the use of computers for their “well-known” purpose ... it is a reference to computer technology that is utilised for its basic, typical or well-known functions. The means of determining that this is so is primarily by a careful review of the specification in order to ascertain, by construing that document, whether the invention described and claimed is in substance any more than a scheme that utilises computers in such a way.*

- 10 35. Applying those principles, the Full Court held that the claimed invention was relevantly indistinguishable from those in the earlier cases. It was properly characterised as an instruction to carry out a marketing scheme using computer technology for its well-known and well-understood functions, and there was no invention in the way in which the scheme was implemented in the computer. As such, even if the scheme itself was new and ingenious, it was not made patentable merely because it was implemented using computer technology: at [108]-[109], [114]-[115]. Again, this was plainly correct.

#### **Application to claim 1 of the 967 Patent**

- 20 36. It is convenient now to consider the application of the above principles to claim 1 of the 967 Patent. As noted, the proper characterisation of the claimed invention depends upon the construction of the claim in the light of the specification as a whole and the relevant prior art, which in this case is the common general knowledge; and importantly, this is to be determined as a matter of substance, not merely by the form of the claim.
37. Claim 1 refers to a “*gaming machine*” having various features. As the evidence revealed, a gaming machine is a computer designed for the playing of electronic games which, at the priority date, typically consisted of a number of standard hardware and software components: see paragraph 8 above. The specification, read in the light of the common general knowledge, confirms this. It indicates that the hardware and software features in claim 1 were standard features of other gaming machines, and that this gaming machine differed from others only in relation to the game being implemented.
- 30 38. The text of claim 1 was set out by the primary judge and the Full Court with the addition of agreed integer numbers: PJ [69] (CAB 25-26); FCJ [6], [131] (CAB 71-72, 108-109). Integers 1.1 to 1.6 define the hardware and software components that were standard features of gaming machines at the priority date. This is apparent from the specification

itself and the findings as to the common general knowledge.<sup>6</sup> Integers 1.7 to 1.12, on the other hand, define a scheme or set of rules for playing an electronic game involving the selection and display of symbols on reels and the awarding of prizes. That scheme or set of rules is defined by reference to a “*game controller*” executing “*program code*” so as to carry out the game (see integer 1.7), but the features or characteristics of the game controller and the program code are not otherwise specified. The game itself comprises two aspects: a “*base game*”, and a “*feature game*” which may be triggered during the base game, with the feature game being defined in integers 1.10 to 1.12.

- 10 39. Consistently with this, the description in the 967 Patent does not suggest that the invention requires anything other than standard hardware and routine programming, or involves any ingenuity in its implementation. The hardware is described in general terms, and no software for carrying out the claimed steps is characterised. The detail of these matters is left entirely to the skilled person implementing the disclosure. Various passages in the specification indicate that the hardware and software aspects of the invention are conventional or routine,<sup>7</sup> and this was confirmed by the expert evidence.<sup>8</sup>
- 20 40. Accordingly, the gaming machine in claim 1 is a conventional gaming machine used for its well-known and well-understood functions, to carry out an electronic game involving the selection and display of symbols on reels and the awarding of prizes. The substance of the invention, and what distinguishes this gaming machine from others, resides in the scheme or rules of the game itself. In terms of the recent Full Court decisions, the invention, as a matter of substance, involves an instruction to carry out an electronic game, using conventional computer technology for its well-known and well-understood functions; and there is no ingenuity in the implementation of the game, as distinct from the scheme or rules of the game itself. A scheme or set of rules for playing a game is an abstract idea of the kind that has never been considered patentable.

### **The approach of the primary judge**

41. The primary judge commenced his consideration of manner of manufacture, correctly with respect, by referring to the guidance given in *Myriad* and *Rokt*, and observing that

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<sup>6</sup> PJ [30]-[31] (CAB 15-16); FCJ [7] (CAB 72); and see the passages of the 967 Patent in fn 7 below.

<sup>7</sup> 967 Patent, pp 1.12-15, 4.13, 4.26-38, 5.6-13, 5.23-26, 6.1-4, 6.10-17, 7.29-31, 8.5-11, 16.9-15 (ABFM 7, 10-14, 22). See also FCJ [131], [136]-[137] (CAB 108-110).

<sup>8</sup> *Yorg* at [42]-[44] (RBFM 9-10); *Nicely* at [82]-[83] (RBFM 6); T 100.45-104.35 (RBFM 12-16).

the recent Full Court decisions involved consideration of “*whether or not a mere scheme, or plan, was nonetheless a manner of manufacture because invention lay not only in the scheme or plan, but also the means by which it was realised using computerisation*”: PJ [85]-[89] (CAB 31-32). However, his Honour then erred by adopting a two-stage inquiry for that assessment: PJ [91] (CAB 32). This involved an “*initial*” question as to whether the claimed invention was a “*mere scheme*”; followed by a “*second*” question, to be asked only if the first was answered “*yes*”, of “*whether the computer-implemented method is one where invention lay in the computerisation of the method*”.

- 10 42. The Commissioner respectfully submits that this approach was inconsistent with the requirements of the Act, the principles laid out by this Court, and the recent Full Court decisions, under which the assessment of manner of manufacture involves a single inquiry as to the proper characterisation of the claimed invention in the light of the specification as a whole and the relevant prior art, considering the claim as a matter of substance, not form. None of the previous cases involved a two-stage inquiry of the kind adopted by his Honour. To the contrary, the Full Court in *Rokt* at [68] referred to the “*single enquiry*” identified in *Myriad*, being “*whether, upon construction, claim 1 as read in the light of the specification as a whole in the light of the relevant prior art, which in the present case is the common general knowledge, is a manner of manufacture*”.
- 20 43. The two-stage inquiry involved an artificial distinction which was inconsistent with the authorities. One cannot answer the question whether a computer-implemented invention is a “*mere scheme*” or something more without regard to the context, including the specification as a whole and the relevant prior art; and in particular, without considering whether the implementation of the invention involves the use of conventional computer technology for its well-known and well-understood functions, or something more. By bifurcating the inquiry, the primary judge answered the “*initial*” question as to whether the claimed invention was a “*mere scheme*” without considering these matters, and did not address the “*second*” question, which was directed to the nature of the implementation or “*computerisation*” of the method: PJ [95]-[105] (CAB 33-37).
- 30 44. This approach was also inconsistent with the need to consider the claimed invention as a matter of substance, not form. This can be seen in the primary judge’s emphasis on the hardware and software components in claim 1 of the 967 Patent, and his Honour’s reliance on them to characterise the invention as “*a device of a specific character*”: PJ [96], [98] (CAB 34-35). See also his Honour’s reference to “*the danger of denuding an invention*

*of patentability by prematurely discounting elements of the claim*”: PJ [101] (CAB 35-36). Given the two-stage inquiry, his Honour considered the *form* of the hardware and software aspects of the claim and relied on them to conclude that the invention was not a “*mere scheme*”, without ever considering whether, as a matter of *substance*, they reflected the use of conventional computer technology for its well-known and well-understood functions. As submitted, the evidence made it clear that this was the case.

45. In short, such an approach is problematic because it allows the patenting of a new set of game rules by the device of framing the claim as a claim to a gaming machine with standard hardware and software components configured to implement those rules. Aristocrat did not “*invent*” any gaming machine in this case. Rather, it devised a scheme or set of rules for playing a game, which is not a manner of manufacture.

### **The approach of the Full Court**

46. The Full Court correctly held that the primary judge’s two-stage inquiry was erroneous. It led his Honour to mischaracterise the invention as “*a machine of a particular construction*”, rather than the use of a computer to implement an abstract idea in the form of a scheme or set of rules for playing a game. In doing so, his Honour failed to consider the invention as a matter of substance, not form: FCJ [19], [25], [28]-[29] per Middleton and Perram JJ (CAB 76, 78-79); [135] per Nicholas J (CAB 110).
47. The Full Court cited the relevant statements of principle from *NRDC* and *Myriad*: FCJ [2], [9], [29] per Middleton and Perram JJ; (CAB 69-70, 73, 78-79); [106] per Nicholas J (CAB 100). Their Honours proceeded to apply those principles to claim 1, characterising the invention by construing the claim in the light of the specification as a whole and the common general knowledge, and considering the invention as a matter of substance, not form. In doing so, their Honours found that the invention, so characterised, involved the use of a particular kind of computer, being a conventional gaming machine or EGM, to implement an abstract idea in the form of a scheme or set of rules for playing a game: see FCJ [15], [18], [34], [42], [50]-[56], [63]-[65] per Middleton and Perram JJ (CAB 74-76, 80, 82, 85-86, 88); [138]-[141] per Nicholas J (CAB 110-111). In this regard, their Honours’ approach is consistent with the other recent Full Court decisions.
48. In their reasons, Middleton and Perram JJ focused on the question whether the claimed invention, being a computer-implemented invention, could broadly be described as an advance in computer technology: FCJ [26], [57], [63]-[65] (CAB 78, 86, 88). This did



not involve error or the imposition of a “*new test*” (cf AS [62]). It is apparent that, in referring to a “*computer-implemented invention*”, their Honours had in mind one that involved the implementation of an otherwise unpatentable abstract idea, such as a scheme or plan, in a computer: FCJ [18], [23]-[24], [57] (CAB 75-78, 86). Further, as explained above, the concept of an advance or improvement in computer technology in this area is derived from, and consistent with, the other recent Full Court decisions: see, eg, *Research Affiliates* at [104]; *RPL* at [96]; *Encompass* at [95]; *Rokt* at [84].

49. In his separate reasons, Nicholas J considered and applied the same authorities, including the passage from *RPL* at [96] quoted above: FCJ [114] (CAB 103-104). His Honour focused instead on the question whether the invention involved the use of computers for their well-known and well-understood functions: FCJ [112]-[120], [140] (CAB 102-105, 111). This did not involve any fundamental difference in principle. As submitted, the relevant distinction is between an abstract idea implemented using conventional computer technology for its well-known and well-understood functions, on the one hand, and an invention involving some advance or improvement in computer technology, on the other. These are two sides of the same coin, as *RPL* at [96] itself makes clear.
50. Nicholas J addressed the use in this area of the term “*generic*”, a term Middleton and Perram JJ found not to be especially helpful: FCJ [35]-[40], [112] (CAB 80-81, 102-103). Again, this is a difference in terminology, not principle. References to “*generic*” software or computers denote conventional computer technology used for its well-known and well-understood functions, and involve a restatement of the distinction between computer-implemented inventions that involve an advance in computer technology and those that do not: *Rokt* at [91]; FCJ [39] (CAB 81). As with its other recent decisions, the language of the Full Court in this case should not be understood as imposing rigid rules, but rather in the sense described in *Encompass* at [91] (see paragraph 31 above).
51. In characterising the invention in claim 1 of the 967 Patent, the Full Court was correct to find that a “*gaming machine*” is simply a particular kind of computer used for the implementation of games; the claimed features of the gaming machine in this case were common to other gaming machines at the priority date, aside from the scheme or set of rules for playing the game; and the claim left it entirely up to the person designing the gaming machine to do the programming necessary to implement that game: FCJ [6]-[15], [30]-[34], [42]-[49], [63]-[65] per Middleton and Perram JJ (CAB 71-75, 79-80, 82-85, 88); [131]-[132], [136]-[141] per Nicholas J (CAB 108-111). This approach reflected the



need to consider the invention against the background of the common general knowledge, and as a matter of substance, not form, consistently with *Myriad*.

52. It may be noted that, in adopting this approach, the Full Court focused on the feature game defined by integers 1.10 to 1.12 of the claim, as distinct from integers 1.7 to 1.12 which also incorporate the base game: eg, FCJ [10]-[12], [54]-[57], [63]-[64] (CAB 73, 86, 88); [136], [141] per Nicholas J (CAB 110-111). This was consistent with the emphasis in the specification on the feature game, including the title of the 967 Patent itself: “*A system and method for providing a feature game*”: FCJ [1], [125] (CAB 69, 107). If attention is directed instead to integers 1.7 to 1.12, being the entirety of the scheme or set of rules for playing the game, the same result follows. Either way, the substance of the claimed invention is an unpatentable abstract idea, not a manner of manufacture.
53. Middleton and Perram JJ suggested that *Myriad* might appear to warrant an assessment of the invention other than by reference to the claims defining it: FCJ [59]-[62] (CAB 87-88). The Commissioner respectfully submits that *Myriad* does not stand for such a proposition. Rather, as submitted, it emphasises that the proper characterisation of the claimed invention is to be determined as a matter of substance, not merely by the form of the claim: *Myriad* at [87]-[91], [144]-[145]. It remains necessary to have regard to the whole of the claim, as Middleton and Perram JJ plainly did. The point is that, as *Myriad* demonstrates, and as Aristocrat accepts in this case (see AS [68], [80]), when construing the claim to identify the invention as a matter of *substance*, it may be necessary and legitimate to focus on some aspects of the claimed invention over others.
54. Middleton and Perram JJ were correct to find that the appeal could be resolved on the material before the Full Court and that, in any event, Aristocrat’s notice of contention was procedurally misconceived: FCJ [94]-[96] (CAB 96). That Nicholas J would have remitted certain matters to the primary judge does not support any different result: FCJ [143]-[144] (CAB 111-112). This is addressed further in Part VI below.

### **Response to Aristocrat’s submissions**

55. Aristocrat’s criticisms of the Full Court should be rejected. In each of its recent decisions, including this case, the Full Court has applied the principles in *NRDC* and *Myriad*, characterising the invention by construing the claim in the light of the specification as a whole and the relevant prior art; and asking whether the invention, as a matter of

substance, not form, was a proper subject of letters patent according to the principles developed for the application of s 6 of the *Statute of Monopolies*.

56. While acknowledging that this Court has eschewed any attempt to place “*the fetters of an exact verbal formula*” on the concept of manner of manufacture, Aristocrat seeks to do just that. Citing *NRDC* at 277, it asserts that the “*true concept*” of manner of manufacture has “*two essential qualities*”, namely an “*artificially created state of affairs*” which has “*economic significance*”: AS [16]. It then seeks to apply this as a necessary and sufficient test: see, eg, AS [20], [87]. As explained in *Myriad*, the language in *NRDC* at 277 does not represent a sufficient or exhaustive statement or definition of the concept of manner of manufacture: see *Myriad* at [20]-[21], [125]-[126], [166]-[167], [272]-[278]. See also *Research Affiliates* at [101]; *RPL* at [116]; *Encompass* at [83]; *Rokt* at [79].
57. Aristocrat seeks to avoid this result by contending, in reliance on a comment by Middleton and Perram JJ (FCJ [62]; CAB 87-88), that this case is “*within the existing boundaries of the concept of manner of manufacture*”, meaning that the so-called “*NRDC criteria*” will “*ordinarily be sufficient*” on the reasoning in *Myriad* at [28]: AS [18], [20]. However, French CJ, Kiefel, Bell and Keane JJ said “*ordinarily be sufficient*”; and their Honours had just emphasised that an “*artificially created state of affairs of economic significance*” is not the statutory test: *Myriad* at [20]-[21]. Gageler and Nettle JJ and Gordon J made similar observations: *Myriad* at [125]-[126], [166]-[167], [272]-[278]. Further, as *Myriad* shows, an invention must be considered as a matter of substance, not form. The invention here is in substance an unpatentable abstract idea. That is not within the existing boundaries of manner of manufacture, but rather firmly outside them.
58. The Full Court in this case and the other recent decisions did not wrongly inquire into novelty and inventive/innovative step by focusing on some claim integers to the exclusion of others: AS [14(a)], [45], [53], [66], [68], [70], [78], [89]. In each case, the Full Court characterised the invention by construing the claim in the light of the specification as a whole and the relevant prior art, considering the invention as a matter of substance, not form. Concepts such as ingenuity in implementation and improvements in computer technology do not reflect any impermissible overlap with other requirements of the Act. Properly understood, they are part of the Court’s assessment of the subject matter of the invention. Nor has the Full Court imposed “*fetters*”, “*contrived constraints*” or a “*rigid formula*”: AS [14(b)], [32], [47]-[48], [53], [79]-[80]. To the contrary, it has continued the broad and flexible approach outlined in *NRDC* and *Myriad* in the context of computer-

implemented inventions. In fact, it was the primary judge’s two-stage inquiry in this case (now propounded by Aristocrat in modified form) which was overly narrow and liable to “*reduce the richness of analysis called for*”: FCJ [25] (CAB 78).

59. Similarly, the Full Court has not wrongly imported concepts from the US and UK cases: AS [14(c)], [35]-[39], [44], [47], [54], [73]. It may be accepted that the statutory context in each jurisdiction is different. But s 18(1A)(a) of the Act, by referring to “*a manner of manufacture within the meaning of section 6 of the Statute of Monopolies*”, has left the development of the principles of patentability to the courts, as recognised in *NRDC* and *Myriad*. In this context, it is legitimate to have regard to the approach in other jurisdictions, notwithstanding legislative differences. The decisions on methods of treatment are an example: see *Apotex* at [243]-[275]. Further, the language used by the Full Court should be understood in the sense described in *Encompass* at [91] (see paragraph 31 above), not as importing “*rules*” from other jurisdictions.
60. Reference to other jurisdictions confirms the need for principles that distinguish between patentable inventions and unpatentable abstractions, and recognise that an unpatentable abstract idea does not change its legal character merely because it is implemented by a computer. In Australia, this is addressed by the principles developed by the Full Court and outlined above. The approach in other jurisdictions, while based on different legislation, produces broadly similar results. The UK and New Zealand are examples.<sup>9</sup> Aristocrat’s approach risks placing Australia out of step with other jurisdictions.
61. Aristocrat’s proposed approach to the assessment of manner of manufacture in this area reflects the primary judge’s two-stage inquiry, but with a modification to the “*second*” question: AS [13], [47], [80], [86]. That approach is flawed for the reasons outlined above. The test cannot be bifurcated. In particular, this favours form over substance, by excluding any consideration of the nature of the implementation of the invention in the computer from the “*initial*” question as to whether the claimed invention is a “*mere scheme*”. This is reinforced by Aristocrat’s assertion that the inquiry can be conducted “*on the face of the specification*”, suggesting the exclusion of the prior art, including the common general knowledge, contrary to *Myriad*: AS [47], [59]. See also, by way of

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<sup>9</sup> UK: *Patents Act 1977* (UK) s 1(2)(c); *Aerotel Ltd v Telco Holdings Ltd* [2007] RPC 7 at [27]-[49]; *Symbian Ltd v Comptroller General of Patents* [2009] RPC 1 at [48]-[59]; *HTC Europe Co Ltd v Apple Inc* [2013] RPC 30 at [44]-[51], [148]-[152]; *Research Affiliates* at [16]-[45]. NZ: *Patents Act 2013* (NZ) s 11 (and examples therein); *Thomson Reuters Enterprise Centre GmbH* [2020] NZIPOPAT 7 at [13]-[22], [37], [41]-[47], [54]-[56].

example, Aristocrat’s criticisms of the decision in *Rokt*, which emphasise form over substance: AS [49]-[52]. Moreover, although Aristocrat does not explicitly state whether it contends that the claimed inventions in each of *Research Affiliates*, *RPL*, *Encompass* and *Rokt* ought to have been found to be patentable, that appears to be the import of its submissions. Ultimately, it does not propound a workable approach.

62. Putting aside those difficulties, Aristocrat accepts that it is necessary to assess whether a computer-implemented invention is a “*mere scheme*” (AS [47], [80]) and contends that “*the criterion for determining the ‘substance’ of a claimed invention is those aspects which give the claimed invention utility in a field of economic endeavour*” (AS [68], [86]).  
 10 Thus it accepts that it may be necessary and legitimate to focus on some “*aspects*” of the invention over others. If *properly applied* to this case, these criteria lead to the conclusion that the claimed invention is not a manner of manufacture. The asserted economic utility of the invention does not reside in the standard hardware and software components recited in the claim which were common to other conventional gaming machines at the priority date (see paragraph 8 above). It resides in the scheme or rules of the game defined by integers 1.7 to 1.12, including the feature game in integers 1.10 to 1.12. That is what is said to “*enhance player enjoyment*” (967 Patent p 1.15; ABFM 7).
63. The earlier decisions dealing with gaming machines cited by Aristocrat pre-dated *Myriad*, *RPL*, *Encompass* and *Rokt*; did not involve any detailed consideration of the principles  
 20 outlined above; and of course, turned on their own facts and the arguments presented: see AS [30]-[31], [69]; PJ [77], [81], [103] (CAB 28-30, 36); FCJ [66]-[86], [121]-124] (CAB 88-94, 106). Similarly, *CCOM*, decided in 1994, should be understood in context, not as laying down any rigid test: *Myriad* at [20]-[21]; *RPL* at [117]; *Encompass* at [84]-[86], [89]-[90]; *Rokt* at [79]. Further, as the Full Court recently observed in *Repipe Pty Ltd v Commissioner of Patents* (2021) 164 IPR 1 at [9], the invention in *CCOM* can broadly be characterised as an improvement in computer technology. In more recent years, a proliferation of patents involving the deployment of conventional computer technology, as exemplified by the recent Full Court decisions, has seen the continued development of the principles in this context. This has been necessary, given the ease  
 30 with which an unpatentable abstract idea can, in the context of computer implementation, “*appear to be dressed in the clothes of invention*”: *Rokt* at [74].
64. Finally, the analogy drawn by Aristocrat and the primary judge with an “*old-fashioned*” mechanical gaming machine implementing the same game is of limited assistance:

AS [84]; PJ [102] (CAB 36); see also AS [27], citing *CCOM* at 291C. It is not possible to compare inventions in the abstract; one needs to have regard to the words of the claim in question and the context in which they appear. A claim to an “*old-fashioned*” gaming machine implementing the same game would need to define, as integers of the claim, the particular mechanical features that would enable the invention to work. If it did, it would likely be a manner of manufacture. If it did not, it may well properly be characterised as an abstract idea or scheme for playing a game, just as is the case here.

### Response to interveners’ submissions

- 10 65. IPTA and FICPI misstate the effect of the Full Court’s reasons. Inventions in other fields of technology are not excluded merely because they involve the use of computers, and the Commissioner does not propound such an approach. As submitted, Middleton and Perram JJ, in referring to a “*computer-implemented invention*”, evidently had in mind one that involved the implementation of an otherwise unpatentable abstract idea: FCJ [18], [23]-[24], [57] (CAB 75-78, 86). That is the context in which the notion of an improvement in computer technology was raised in each of *Research Affiliates* at [104], *RPL* at [96], *Encompass* at [95] and *Rokt* at [84]. The same applies here.
- 20 66. Such an approach is also consistent with Australia’s international obligations. Art 27(1) of the TRIPS Agreement provides that patents shall be available for “*inventions*” without discrimination as to field of technology. The TRIPS Agreement does not define what constitutes an “*invention*”. However, in giving effect to Art 27(1), Parliament has imposed a requirement that an “*invention*” be a manner of manufacture: s 18(1A)(a). The validity of that requirement is not in dispute. A claimed “*invention*” which is in substance an abstract idea is not, and has never been, a manner of manufacture, and falls outside the operation of Art 27(1). Accordingly, no issue of discrimination arises. The same point may be made in relation to the Australia-US Free Trade Agreement.
- 30 67. The Commissioner does not commend IPTA’s proposed approach. It emphasises the form of the claim and eschews the need to have regard to the substance of the invention, contrary to *Myriad*; apparently, even the invention claimed in *Research Affiliates* (cited with approval in *Myriad* at [145] on this very point) would be patentable: see IPTA’s submissions at [34]-[36]. IPTA’s assertion of a “*deleterious effect*” on the prosecution and grant of patents should be understood in this light. There is nothing deleterious about the refusal of patents which are in substance for abstract ideas. IPTA also cites fresh evidence in support of its proposed submissions, which is impermissible.

68. The end point of FICPI’s argument is that the US position is not an appropriate reference point: FICPI’s submissions at [42]. The Commissioner does not deploy the US position as a “*reference point*”. The uncertainty FICPI asserts has arisen under the Supreme Court’s approach – if indeed that be the case – does not apply here. The above principles are clear. The recent decision in *Repipe* provides an example. Further, Australia is not “*out of step with every other jurisdiction around the world*”: at [43]. As submitted, the above approach produces results broadly consistent with other jurisdictions.
69. Insofar as IPTA and FICPI otherwise echo Aristocrat’s submissions, the Commissioner’s response is set out above. The appeal should be dismissed with costs.

## 10 PART VI ARGUMENT ON NOTICE OF CONTENTION

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70. For the avoidance of doubt, the Commissioner has filed a notice of contention (CAB 135). Ground 1(a) reflects the approach in Part V above. Ground 1(b) is an alternative, which picks up additional matters referred to by Nicholas J: FCJ [141]-[143] (CAB 111-112). The Commissioner’s primary submission is that there is no need to consider these matters. If, as submitted, the invention is in substance an abstract idea, being a scheme or set of rules for playing a game, implemented using conventional computer technology for its well-known and well-understood functions, it is not a manner of manufacture.
71. Aristocrat has not submitted that the patentability of the invention can be sustained on the basis that it involves what Nicholas J referred to as a “*technical contribution*” in the field of gaming technology, or otherwise identified any *patentable* advance in that field. The Courts below made no such finding, and the evidence did not support it. The only “*contribution*” identified, by reference to the substance of the claimed invention, resided in the scheme or rules of the game itself, and was not technical in nature.

## PART VII ESTIMATE OF TIME

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72. The Commissioner estimates that about 3 hours may be required for her oral argument.

Dated: 11 May 2022



**C Dimitriadis SC**  
+61 2 9930 7944  
[cd@nigelbowen.com.au](mailto:cd@nigelbowen.com.au)



**E E Whitby**  
+ 61 2 9930 7968  
[ewhitby@nigelbowen.com.au](mailto:ewhitby@nigelbowen.com.au)

## ANNEXURE

## RELEVANT STATUTORY PROVISIONS

*PATENTS ACT 1990 (CTH) (As at 11 May 2022)***18 Patentable inventions for the purposes of a standard patent**

(1) Subject to subsection (2), an invention is a patentable invention for the purposes of a standard patent if the invention, so far as claimed in any claim:

- 10 (a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and
- (b) when compared with the prior art base as it existed before the priority date of that claim:
- (i) is novel; and
- (ii) involves an inventive step; and
- (c) is useful; and
- (d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.

20 *Patentable inventions for the purposes of an innovation patent*

(1A) Subject to subsections (2) and (3), an invention is a patentable invention for the purposes of an innovation patent if the invention, so far as claimed in any claim:

- (a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and
- (b) when compared with the prior art base as it existed before the priority date of that claim:
- (i) is novel; and
- (ii) involves an innovative step; and
- (c) is useful; and
- 30 (d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.



(2) Human beings, and the biological processes for their generation, are not patentable inventions.

*Certain inventions not patentable inventions for the purposes of an innovation patent*

(3) For the purposes of an innovation patent, plants and animals, and the biological processes for the generation of plants and animals, are not patentable inventions.

(4) Subsection (3) does not apply if the invention is a microbiological process or a product of such a process.

[Note: see also sections 7 and 9.]

**STATUTE OF MONOPOLIES 1623 (UK) (As at 11 May 2022)**

10 **VI Proviso for future Patents for 14 Years or less, for new Inventions.**

Provided alsoe That any Declaracion before mencioned shall not extend to any tres Patents and Graunt of Privilege for the tearme of fowerteene yeares or under, hereafter to be made of the sole working or makinge of any manner of new Manufactures within this Realme, to the true and first Inventor and Inventors of such Manufactures, which others at the tyme of makinge such tres Patents and Graunts shall not use, soe as alsoe they be not contrary to the Lawe nor mischievous to the State, by raisinge prices of Commodities at home, or hurt of Trade, or generallie inconvenient; the said fourteene yeares to be from the date of the first tres Patents or Grant of such priviledge hereafter to be made, but that the same shall be of such force as they should be if this Act had never byn made, and of none other.

20 **PATENTS ACT 1977 (UK) (As at 11 May 2022)**

**1 Patentable inventions.**

(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application;
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) below;

and references in this Act to a patentable invention shall be construed accordingly.

30 (2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—

- (a) a discovery, scientific theory or mathematical method;

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;

(d) the presentation of information; but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

(3) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality.

10 (4) For the purposes of subsection (3) above exploitation shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it.

(5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

### ***PATENTS ACT 2013 (NZ) (As at 11 May 2022)***

#### **11 Computer programs**

20 (1) A computer program is not an invention and not a manner of manufacture for the purposes of this Act.

(2) Subsection (1) prevents anything from being an invention or a manner of manufacture for the purposes of this Act only to the extent that a claim in a patent or an application relates to a computer program as such.

(3) A claim in a patent or an application relates to a computer program as such if the actual contribution made by the alleged invention lies solely in it being a computer program.

#### **Examples**

##### *A process that may be an invention*

30 A claim in an application provides for a better method of washing clothes when using an existing washing machine. That method is implemented through a computer program on a computer chip that is inserted into the washing machine. The computer program controls the operation of the washing machine. The washing machine is not materially altered in any way to perform the invention.

The Commissioner considers that the actual contribution is a new and improved way of operating a washing machine that gets clothes cleaner and uses less electricity.

While the only thing that is different about the washing machine is the computer program, the actual contribution lies in the way in which the washing machine works (rather than in the computer program per se). The computer program is only the way in which that new method, with its resulting contribution, is implemented.

The actual contribution does not lie solely in it being a computer program. Accordingly, the claim involves an invention that may be patented (namely, the washing machine when using the new method of washing clothes).

*A process that is not an invention*

10 An inventor has developed a process for automatically completing the legal documents necessary to register an entity.

The claimed process involves a computer asking questions of a user. The answers are stored in a database and the information is processed using a computer program to produce the required legal documents, which are then sent to the user.

The hardware used is conventional. The only novel aspect is the computer program.

The Commissioner considers that the actual contribution of the claim lies solely in it being a computer program. The mere execution of a method within a computer does not allow the method to be patented. Accordingly, the process is not an invention for the purposes of the Act.

20 (4) The Commissioner or the court (as the case may be) must, in identifying the actual contribution made by the alleged invention, consider the following:

(a) the substance of the claim (rather than its form and the contribution alleged by the applicant) and the actual contribution it makes:

(b) what problem or other issue is to be solved or addressed:

(c) how the relevant product or process solves or addresses the problem or other issue:

(d) the advantages or benefits of solving or addressing the problem or other issue in that manner:

(e) any other matters the Commissioner or the court thinks relevant.

30 (5) To avoid doubt, a patent must not be granted for anything that is not an invention and not a manner of manufacture under this section.

***ANNEX 1C OF THE MARRAKESH AGREEMENT ESTABLISHING THE WORLD  
TRADE ORGANIZATION, SIGNED IN MARRAKESH, MOROCCO ON 15 APRIL 1994  
AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY  
RIGHTS***

**Art 27 Patentable Subject Matter**

10 1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.<sup>5</sup> Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

(footnotes omitted)

***AUSTRALIA-UNITED STATES FREE TRADE AGREEMENT MADE AT  
WASHINGTON ON 18 MAY 2004***

**Art 17.9 Patents**

20 1. Each Party shall make patents available for any invention, whether a product or process, in all fields of technology, provided that the invention is new, involves an inventive step, and is capable of industrial application. The Parties confirm that patents shall be available for any new uses or methods of using a known product. For the purposes of this Article, a Party may treat the terms “inventive step” and “capable of industrial application” as synonymous with the terms “non-obvious” and “useful”, respectively.

(footnotes omitted)