

FICPI WORLD CONGRESS

BREAKOUT 4.2
§.101. IS THERE A COORDINATED MOVE
IN B+ AND ELSEWHERE?



BREAKOUT 4.2

§.101. IS THERE A COORDINATED MOVE IN B+ AND ELSEWHERE?

Article 27 of TRIPS states that “*patents shall be available and patent rights enjoyable without discrimination as to ... the field of technology...*”.

While all contracting parties are bound by the TRIPS Agreement, each nation, through its own statutory requirements and jurisprudence, sets limits on what it considers to be patent-eligible subject matter. Harmonising the scope of patent-eligible subject matter amongst the contracting parties will provide greater legal certainty, promote high quality patents, provide consistent results in multiple jurisdictions and should ultimately promote innovation and competition.

But what if harmonising does discriminate as to the field of technology?



BREAKOUT 4.2

§.101. IS THERE A COORDINATED MOVE IN B+ AND ELSEWHERE?

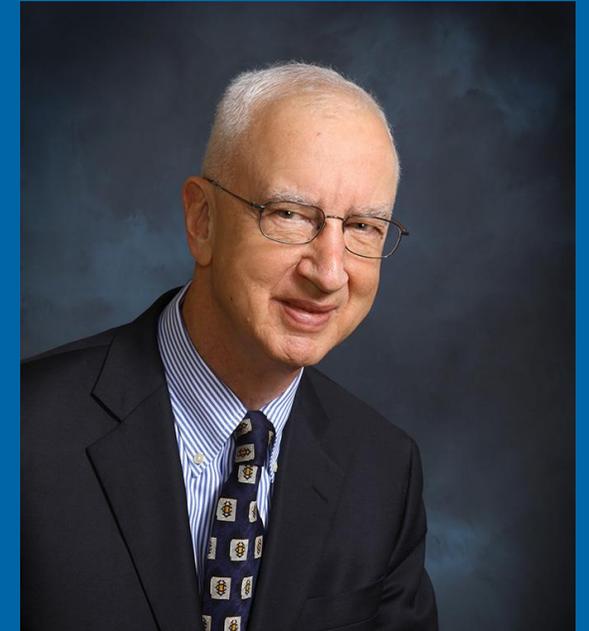
Dr. Daniel Alge



Dr. Sharon Crane



Judge Paul R. Michel (ret.)



BREAKOUT 4.2 – US & EUROPE

- Closer alignment than ever before?
- Alice’s “something more” perhaps equates to EP technical effect
- EP bar on methods of treatment
- UK Aerotel decision
 - Construe claim
 - Identify contribution
 - Excluded subject matter of EPC?
 - Contribution technical in nature?



BREAKOUT 4.2 – AUSTRALIA 1

- Aerotel in Australia?
- Myriad 2015 – isolated DNA not patentable
 - Significant new application or extension of traditional concept of what constitutes a manner of manufacture (NRDC)
 - Follows US Myriad
- Research Affiliates 2014 & RPL Central 2015
 - Computer implemented inventions (CII)
 - Technological innovation patentable, business innovation not
 - *Aerotel obiter dicta*: technical contribution test useful in assessing CII patentability?



BREAKOUT 4.2 – AUSTRALIA 2

- Adapted Aerotel test applied by IP Australia to all inventions
 - Construe claim
 - Identify substance or contribution of claim
 - Ask whether substance of claim lies within established principles of what does not constitute a patentable invention (schemes, etc)
 - If not, consider whether substance otherwise lies outside of existing concepts of a patentable invention so as to be treated as a new class of subject matter
- No reference to technical contribution



BREAKOUT 4.2 – AUSTRALIA 3

- Object clause to be added to Patents Act
 - patent system in Australia required to enhance wellbeing of society by promoting economic wellbeing through
 - technological innovation
 - Transfer of technology
 - In so doing, the patent system should balance over time the interests of producers, owners, and users of technology, and the public
- How will object clause in Act affect considerations of patentability?



BREAKOUT 4.2 – AUSTRALIA 4

- Summary
 - considerable alignment of patent eligibility laws and jurisprudence with
 - US and UK
 - possibly also Europe more generally with proposed new object clause in Act
 - Additionally, outside scope of session, in amendments that introduce object clause, proposals to closely align inventive step laws with those in Europe.
- Thank you





FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN