



HIGH COURT OF AUSTRALIA

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Details of Filing

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Important Information

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Part I: Suitable for publication

1. This submission is in a form suitable for publication on the internet.

Part II: Outline of oral argument

2. This appeal is concerned with the essence of the threshold requirement, in s 18(1A)(a) of the *Patents Act* (JBA 21), that an invention be a “manner of manufacture” (MM).
3. This requirement concerns patent eligible *subject matter*, **not** issues of *patentability* involving novelty, innovative/inventive step or utility which are dealt with expressly elsewhere in s 18, or the requirements of s 40 (*Ramset* (1998) 194 CLR 171, [33] (JBA 119-120); *CCOM* (1994) 51 FCR 260, 291C (JBA 848); *Lockwood* (2004) 217 CLR 274, [48] (JBA 469-470)).
4. The general principles for determining whether a claimed invention is a MM were identified in *NRDC* (1959) 102 CLR 252, *Apotex* (2013) 253 CLR 284 and *Myriad* (2015) 258 CLR 334.
5. Mere schemes, abstract ideas and intellectual information (“**mere schemes**”) have never been considered a MM, *unless* applied to produce a particular practical and useful result which changes their character from merely intellectual information (*NRDC* 264, 267 (JBA 552, 555); *CCOM* 292C (JBA 849); *Grant* (2006) 154 FCR 62 [14] (JBA 956)).
6. The general principles of MM are universal in their application to all inventions not expressly excluded from patentability by the *Patents Act*. This Court should not sanction an “*anomalous qualification*”, applicable only to “computer-implemented inventions”, which detracts from coherence in the law (*Apotex* [46] (JBA 165-166); *Grant* [23], [29] (JBA 958, 960)). MM is a threshold requirement separate to the “*distinctive requirements of novelty and inventive step*” (*Mirabella* (1995) 183 CLR 655 at 663-5 (JBA 576-578)).
7. This appeal is advanced on three bases.
8. **First**, the primary judge correctly held, on the facts, that the claimed invention is “*a mechanism of a particular construction*”, an EGM, that “*functions in a particular way*” (PJ [95], [98] (CAB 33-35)). The claimed invention, properly characterised as a combination (*Ariosa* (2021) 391 ALR 473 [114], [154] (JBA 745, 753); AR [15]-[20]), is **not** a mere scheme, and is a MM. Therefore, applying established principles (*RPL* (2015) 238 FCR 27, [96] (JBA 908); *Rokt* (2020) 277 FCR 267, [88] (JBA 879); *Ariosa* [160] (JBA 754)), it is unnecessary to enquire into the nature of the “implementation” of the present invention (AS [55]-[58], [85]-[87]; AR [3]-[5]).

9. The “*proposed alternative approach*” (**new test**) of the FFC majority (FCJ [26]-[27] (CAB 78)) should be rejected as inconsistent with *NRDC*, *CCOM*, *Data Access* (1999) 202 CLR 1, *Grant*, *Apotex* and *Myriad* because it:
- a. anomalously excises, from the general principles of patent eligibility, so-called “*computer-implemented inventions*” (AS [23]-[31], [79]-[80]);
 - b. wrongly conflates the assessment under s 18(1A)(a) of the “*boundaries of patentability*” (*Myriad* [18] (JBA 333)) with an assessment under s 18(1A)(b) of whether there has been any *advance over the prior art* (AS [70]); and
 - c. involves an “*exact verbal formula*” of the type which has been repeatedly denounced by this Court and the FFC (AS [83]).
10. The new test of the FFC majority should not be substituted for an assessment of MM based on the fundamental distinction between *mere schemes* and schemes applied to produce a particular, practical and useful result.
11. **Second**, to the extent that the new test finds any support in the decisions of the FFC following *Research Affiliates* (2014) 227 FCR 378 (Cf. Nicholas J in dissent, FCJ [116]-[120] (CAB 104-105)), those decisions have wrongly “*fettered by contrived constraints*” the patent *eligibility* of inventions involving computing technology (Cf. *Grant* [8] (JBA 955); *CCOM* 291C (JBA 848); *Data Access* [20] (JBA 422)).
12. The FFC, starting with *Research Affiliates*, has distorted the assessment of MM for inventions involving computers by applying, as rules, principles derived from EU/UK and US patent law in different legislative contexts (AS [35]-[44]; Cf. *Apotex* [188]-[191] (JBA 204-205); *Calidad* (2020) 94 ALJR 1044, [146], [196]-[198] (JBA 271, 284-285); *CCOM* 288C (JBA 845); *Ariosa* [161], [165] (JBA 755, 756)).
13. The requirement for a “*technical contribution*” in inventions involving computers, endorsed in *Research Affiliates* [36], [45] (JBA 1012, 1014) (and applied by Nicholas J in FCJ [115]-[117] (CAB 104-105)), arose in the UK from Art 52 of the EPC, after the 1977 Act radically changed the law (*IBM* [1980] FSR 564, 566 (JBA 966); *CCOM* 289B-C (JBA 846)). Similarly, the search for “*an improvement in the computer*”, endorsed in *Research Affiliates* [104] (JBA 1027) (and applied by the FFC majority in FCJ [27] (CAB 78)), arose in the US from the wording of §101 of Title 35 of the USC. The FFC then wrongly extended this approach in *Encompass* (2019) 145 IPR 1 and *Rokt* (AS [48]-[52]).

14. The FFC, by importing foreign law concepts into the assessment of MM, has conflated MM, inventive step, and novelty. The FFC in *Research Affiliates* [119] (JBA 1030) asked whether “any part of the **inventive step** lies in the computer implementation”. The FFC in *RPL* [112] (JBA 911-912) sought to identify “where the **inventiveness** or ingenuity is said to lie”. Similarly, the FFC majority assessed what is “inventive (or innovative) about Claim 1” and whether there is an “advance in computer technology” (FCJ [63]-[65] (CAB 88)).
15. This conflation is wrong for the reasons explained in *CCOM* 290F, 291C, 294G-295B (approved in *Data Access* [20] (JBA 422); see *Ramset* [40] (JBA 122-123); AS [21]). It gives rise to the “exclusion” and “overlap” rejected by this Court (AS [17], [42]). The FFC failed to confine questions of “advance[s]” in technology to be determined under ss 18(1)(b) & (1A)(b), subject to the constraints of s 7. That is **not** the role of s 18(1A)(a).
16. **Third**, if this Court rejects the approach of the primary judge of asking whether the claimed invention is a “mere scheme”, this Court should, *first*, endorse the test preferred by Nicholas J, *second*, reject the new test of the FFC majority and, *third*, remit the matter to the primary judge for assessment based on the evidence (along with residual issues).
17. If a “technical contribution” is required for an invention to be a MM (Cf. *NRDC*, *CCOM*, *Grant*, *Apotex* and *Myriad*), a “technical contribution **in the field of the invention**” must suffice (FCJ [118]-[120] (CAB 105)). The application of a scheme to produce “some new and useful effect” (in **any** area of technology) is a MM (*NRDC* 276 (JBA 564); *CCOM* 292C (JBA 849); *Grant* [29] (JBA 960)). This is to be assessed without disaggregating claim integers (*NRDC* 264 (JBA 552); *Minnesota Mining* (1980) 144 CLR 253, 266 (JBA 506); *Ariosa* [155] (JBA 753); AS [64]-[68]; AR [17]-[19]).

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