CAMBRIDGE UNIVERSITY UK
Robinson College – Faculty of Law

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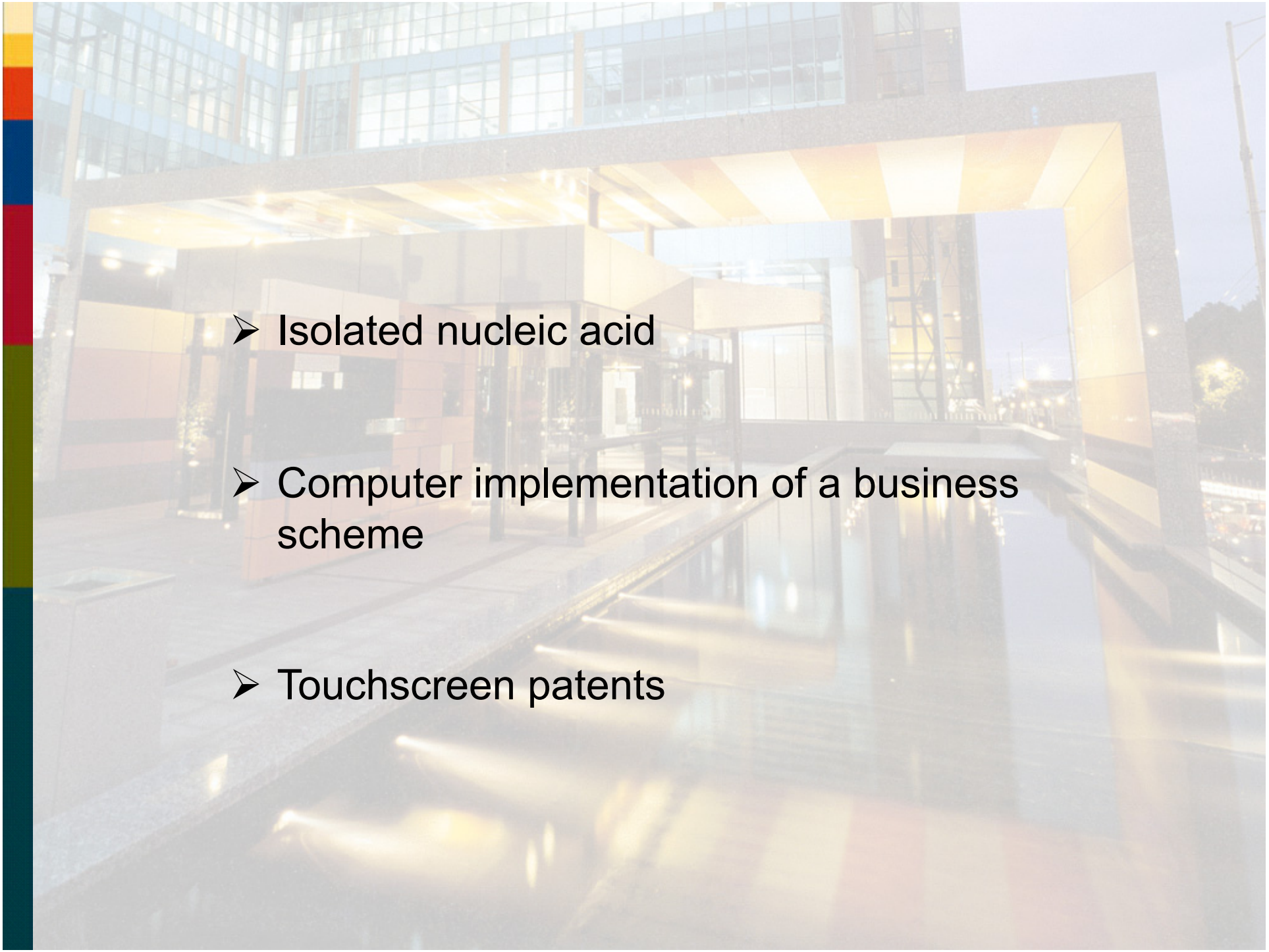
Intellectual Property Law and Policy

8 – 9 April 2015

Patent Session 8C
Patentable Subject Matter

The Hon Justice Annabelle Bennett AO
Judge of the Federal Court of Australia



- Isolated nucleic acid
- Computer implementation of a business scheme
- Touchscreen patents

D'ARCY v MYRIAD GENETICS INC
[2014] FCAFC 15

Claim 1

An isolated nucleic acid coding for a mutant or polymorphic BRCA1 polypeptide, said nucleic acid containing in comparison to the BRCA1 polypeptide encoding sequence set forth in SEQ.ID No:1 one or more mutations or polymorphisms selected from the mutations set forth in Tables 12, 12A and 14, and the polymorphisms set forth in Tables 18 and 19.

[T]he view which we think is correct in the present case is that the method the subject of the relevant claims has at its end result an artificial effect falling squarely within the true concept of what must be produced by a process if it is to be held patentable.

… the distinction between discovery and invention is not precise enough to be other than misleading in this area of discussion. There may indeed be a discovery without invention – either because the discovery is some piece of abstract information without any suggestion of a practical application of it to a useful end, or because its application lies outside the realm of ‘manufacture’.

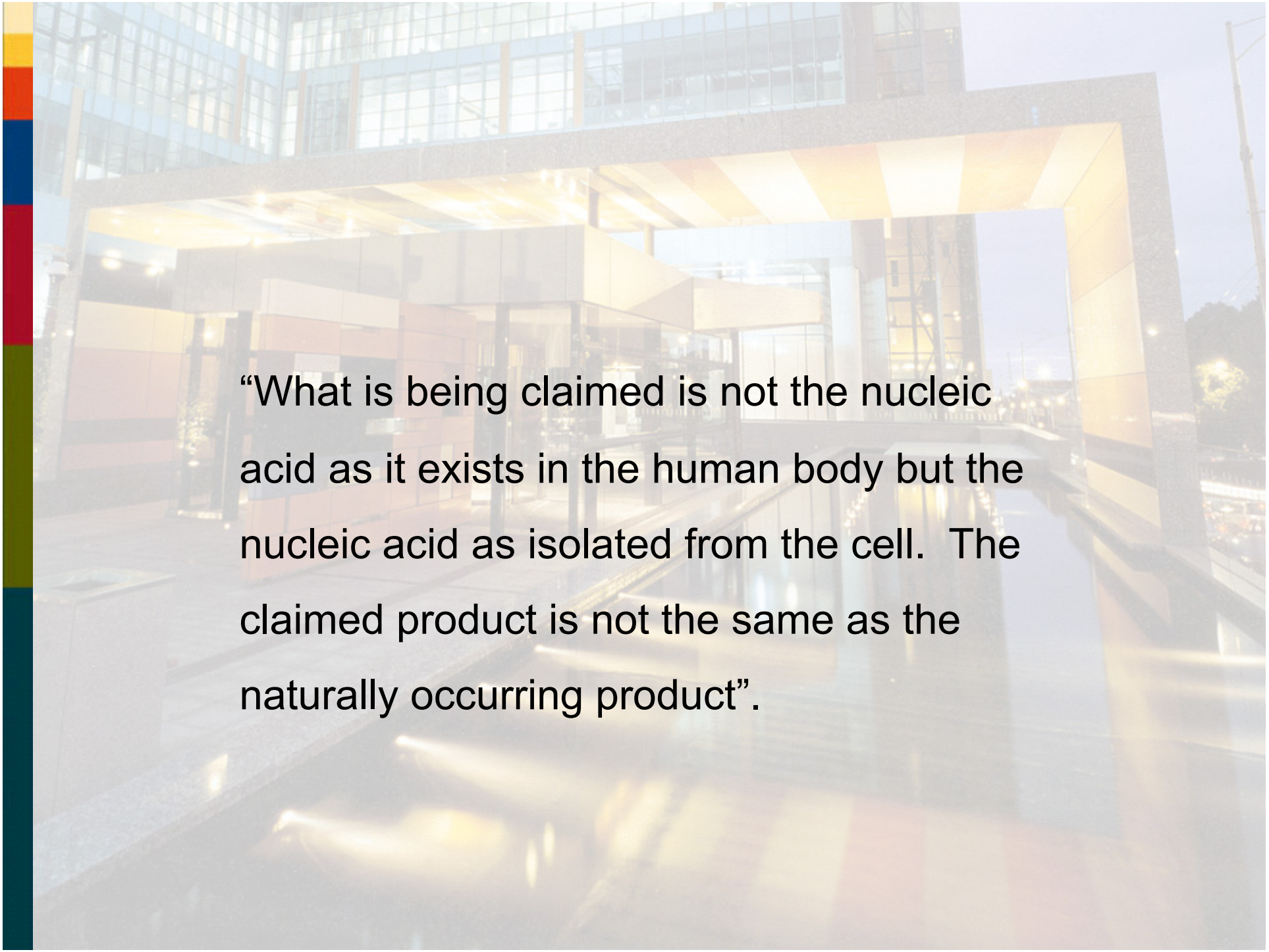
… it confuses the issue to use such terms as “the work of nature” and the “laws of nature”. It is not decisive or helpful to point out that the suggestion is that nature, in its newly ascertained aspect, be allowed to work in its own way. Expressions such as the “work of nature” or the “laws of nature” could fairly be employed to challenge almost any patent.

The reason [Novelty] is manifest, because much further information, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the use of mankind. **It is the difference between the ore and the refined and pure metal which is extracted from it…** The prior knowledge of an invention to avoid a patent must be knowledge equal to that required to be given by a specification, namely, such knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use.

[emphasis added] **(Hill v Evans)**

… ‘if a process which does not produce a new substance but nevertheless results in “a new and useful effect”’, so that the new result is ‘an artificially created state of affairs providing economic utility, it may be considered a “manner of new manufacture”’ within s 6 of the Statute of Monopolies

… Patent monopolies are as much an appropriate reward for research into hitherto unknown therapeutic uses of (known) compounds, which uses benefit mankind, as they are for research directed to novel substances or compounds for therapeutic use in humans. It is not possible to erect a distinction between such research based on public policy considerations.


“What is being claimed is not the nucleic acid as it exists in the human body but the nucleic acid as isolated from the cell. The claimed product is not the same as the naturally occurring product”.

RESEARCH AFFILIATES LLV
v
COMMISSIONER OF PATENTS

Claim 1

A computer-implemented method for generating an index, the method including steps of:

(a) accessing data relating to a plurality of assets;

(b) processing the data thereby to identify a selection of the assets for inclusion in the index based on an objective measure of scale other than share price, market capitalization and any combination thereof;

(c) accessing a weighting function configured to weight the selected assets;

(d) applying the weighting function, thereby to assign to each of the selected assets a respective weighting, wherein the weighting:

i. is based on an objective measure of scale other than share price, market capitalization and any combination thereof; and

ii. is not based on market capitalization weighting, equal weighting, share price weighting and any combination thereof;

thereby to generate the index.

Although the summary of the invention and the exemplary embodiments do make reference to computers, it is to be noted that what is missing from the title of the invention, the described field of the invention and the detailed description of the invention is any reference to a computer, even though the claims limit the method of the invention to one that is computer-implemented.

Description of exemplary embodiment:

“an analyst **may** use a computer system to generate an index”.

The only claims to a computer system, rather than to a method, are claim 26, being to a computer system configured to perform a method according to any of claims 1 to 25, and claim 28 which is to a computer system including the means for carrying out the steps of the method.

Court considered:

UK

- IBM
- Symbiom
- Aerotel
- HTC

US

- Bilski
- Alice Corporation

Turning to the present appeal, the relevant inquiry is not into the form of the words to determine whether what is claimed is properly the subject of a patent. If a process is to be patentable, it must offer some advantage which is material, in the sense that the process belongs to a useful art. The characterisation of patentability by reference only to the description in *NRDC* of a product which consists of an artificially created state of affairs of economic significance was part of the High Court's reasoning but did not represent a sufficient or exhaustive statement of the circumstances in which a claimed invention is patentable.

The determination whether the claimed invention is truly *"an artificially created state of affairs"* in satisfaction of *NRDC* is made not by some mechanistic application of the criterion of artificiality or physical effect, but by an understanding of the claimed invention itself. The invention is to be understood as a matter of substance and not merely as a matter of form.

The invention set out in the specification is directed to the index itself. The method of the invention is not one that has any artificial or patentable effect other than the implementation of a scheme, which happens to use a computer to effect that implementation…

In the context of the claim, the significance lies in the content of the data rather than any specific effect generated by the computer.

APPLE v SAMSUNG

- Touchscreen Patents