New Zealand Institute of Patent Attorneys Inc
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31 August 2018

The Commissioner of Patents
PO Box 200
Woden ACT 2606

Attention: Paul Gardner and Brett Massey

Re: Exposure draft of the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Bill 2018 and Explanatory Memorandum to the Amendment Bill

Dear Paul and Brett

These submissions have been prepared by the New Zealand Institute of Patent Attorneys Inc. (NZIPA).

The NZIPA was established in 1912. It is an incorporated body representing most Patent Attorneys registered under the New Zealand Patents Act, and who are resident and practising in New Zealand.

The submissions are made in response to the Exposure drafts of the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Bill 2018 and Explanatory Memorandum to the Amendment Bill. The submissions respond only to the questions raised by IP Australia regarding proposed amendments to the legislation.

Consultation questions Schedule 1, Part 1 – Inventive step

In response to the proposal to amend subparagraph 7(2) (definition of inventive step) to use the terminology 'in comparison with' the prior art base instead of the previously proposed 'having regard to' the prior art base, we submit that the amendment is premature and should not be made at this time. The test for inventive step has only recently been changed when the Raising the Bar legislation came into force. Only a small amount of case law has issued since that change, so we believe that it is too early to identify the full effect of the new test. We submit that it would be better to wait until the case law has developed further before making changes to the inventive step requirements set out in the Act. By taking this approach, it would be possible to identify whether the current legislation meets its objectives or whether issues arise from it. If issues are identified then we believe that it would be appropriate to change the legislation in response to those issues at that time.

Schedule 1, Part 2 – Object of the Act

NZIPA believes that it is not necessary to include an objects clause within the Patents Act 1990. However, if such a clause is to included, we submit that the word "technological" to qualify the word "innovation" is both undesirable and unnecessary. The meaning of the word "technological" is unclear. We believe that the word "technological" suggests that the object of the Act is to protect only inventions of a technical nature or of an electronic nature. It raises questions about whether a simple, but inventive mechanical solution should be protected by the Act. It also raises questions about whether some inventions in the field of life sciences should be protected by the Act because these inventions might not naturally be thought of as "*technological* innovations". Furthermore, it raises a question about whether methods and processes that do not involve "technological" equipment would be patentable.

We are concerned that patentability requirements may be interpreted in light of the Object of the Act and therefore it may be possible that otherwise legitimate inventions are excluded from patentability if those inventions are not considered to be "technological".

We are also concerned that during a dispute between parties about the validity of a patent, much argument could be made about whether the invention of the patent is a "technological" innovation. This is likely to create increased costs for parties in a dispute.

We do not believe it necessary to use the word "technological". We believe that it is sufficient to simply state that "The object of this Act is to provide a patent system in Australia that promotes economic wellbeing through innovation and the transfer and dissemination of technology…." NZIPA therefore submits that the word "technological" should be deleted.

Schedule 4 – Compulsory licenses

Regarding the proposed amendments to paragraph 133(5)(b), we submit that the factors listed are also relevant to a dependent patent licence.

We believe that it would be appropriate to allow a cross licence to be revoked under subsection 133(6).

We do not foresee any consequences which we have not already been considered.

Yours faithfully
Catalyst Intellectual Property

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