CIPA

The Chartered Institute of Patent Attorneys

Senate Community Affairs Committee

Inquiry into Gene Patents

Submission by

Chartered Institute of Patent Attorneys (CIPA)

26 November 2009

The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK. It was founded in 1882 and was incorporated by Royal Charter in 1891. It represents virtually all the 1,750 registered patent attorneys in the UK whether they practise in industry or in private practice. Total membership is over 3,000 and includes trainee patent attorneys and other professionals with an interest in intellectual property.

Many of our members' clients currently seek patent or other intellectual property protection in Australia. Many of our members also represent Australian companies or individuals in seeking patent or other intellectual property protection outside Australia, principally in the UK or elsewhere in Europe.

We have been informed that The Community Affairs Committee of the Australian Senate is currently formulating a report based on submissions made during the course of its "inquiry into gene patents". We understand that the inquiry relates to Australian patents covering human and microbial genes, non-coding sequences, proteins, and their derivatives. Many of our members routinely prosecute patent applications concerning such subject matter.

We understand that a submission has been made to the Committee by Cancer Council Australia in which amendment of Section 18 of the Patents Act 1990 is proposed (http://www.aph.gov.au/senate/committee/clac_ctte/gene_patents/submissions/sub50a.pdf). We are concerned that should the proposed changes to what is considered a patentable invention be adopted, the scope of patent protection available in Australia would be significantly limited - not only for gene and/or protein sequences but also for key biotechnological inventions with applications in many fields, including "green technologies". We do not consider this to be in anyone's long-term interests.

Founded 1882 - Royal Charter 1891

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We understand that "human beings, and the biological processes for their generation" are currently excluded from patentability. The proposed amendment is further to exclude from patentability

> "Biological materials, including recombinant materials (including but not limited to their components, parts or derivatives, whether isolated or purified or not and regardless of their state and processes used in their production) which are identical or substantially identical, individually or collectively, to those that exist in nature."

An explanatory passage states that

> "[t]his amendment merely excludes, as a class, a patent monopoly over naturally occurring biological materials regardless of their actual physical state or their method of production. So long as the biological materials are identical or substantially identical to the naturally occurring biological materials they cannot be the subject of a patent monopoly, even if they are recombined. Accordingly, if the individual parts of a recombined and isolated gene are nothing more than a fusion of genetic parts, each of which are identical to their corresponding natural equivalents, then the recombined product is also excluded.

The purpose of the amendment is to stop the patenting of genetic and protein materials that are rudimentary, in the sense that they are identical or substantially identical to their natural counterparts.

In doing so, it will encourage further downstream innovation which utilizes these biological materials in new, inventive and practically useful ways."

We do not agree with this assessment of the impact of the proposed amendment. The wording of the proposed amendment is not only incoherent, but it appears potentially to exclude from patentability many different types of important biotechnological inventions. Much of biotechnology relates to non-obvious combinations of sequences from different sources. The impact of the amendment would be to remove protection from, and therefore incentives for, the practical innovations that the amendment is ostensibly to encourage.

The proposed amendment would also appear to be incompatible with Australia's obligations under the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Furthermore, the proposed amendment would lead to considerable ongoing legal uncertainty as well as divergence from international practice. Terms such as "biological materials", "derivatives" and "substantially identical" are potentially open to widely differing interpretations. This cannot be good for the biotechnology industry in Australia or elsewhere, nor for the members of the public that they serve.

Accordingly we agree with the submission by The Institute of Patent and Trade Mark Attorneys of Australia (http://www.aph.gov.au/senate/committee/clac_ctte/gene_patents/submissions/sub31a.pdf) and urge the Senate Committee not to adopt or recommend the proposal by Cancer Council Australia to amend the Patents Act 1990.

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