

6 November 2015

PCG Secretariat
IP Australia

By email only: mdb-patents-consultation-group@ipaaustralia.gov.au

Public Consultation: Proposed examination practice following the High Court decision in *D'Arcy v Myriad Genetics Inc*

IPTA refers to the IP Australia's request for consultation in relation to the proposed examination practice following the High Court decision in *D'Arcy v Myriad Genetics Inc*.

About IPTA

The Institute of Patent and Trade Mark Attorneys of Australia (IPTA) is a voluntary organisation representing registered patent attorneys, registered trade mark attorneys and student members in the process of qualifying for registration as a patent or trade mark attorney in Australia. The membership of IPTA includes over 87% of registered patent attorneys located in Australia and it is believed that its members make up more than 90% of registered patent attorneys in active practice in Australia. The membership of IPTA includes registered patent attorneys in private practice as well as patent attorneys working in industry and others that practice as barristers. IPTA members represent large local and foreign corporations, SME's, Universities, Research Institutes and individual inventors.

IPTA's position

IPTA is supportive of IP Australia's rapid response to the decision and its adoption of relatively clear examination guidelines.

There are some issues with the guidelines that we believe need to be addressed in order for them to further clarified and internally consistent. These are:

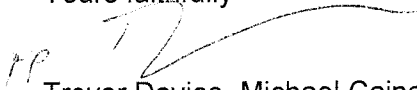
- Clarification should be made as to what are 'functional fragments' in the exclusions
- Clarification should be made regarding cDNA ie only cDNA related to excluded nucleic acid classes should it self be excluded

More generally, IPTA agree with IP Australia that the High Court in considering claims 1 to 3 of AU686004 decided that the substance of the invention was the information embodied in the nucleotides of the molecule. IPTA consider that it may not always be the case that a claim to a nucleotide sequence is only directed to information and that, as this concept is further explored, there will conceivably be a basis for identifying claims to naturally occurring nucleotide sequences that are patentable. We are therefore of the view that the Commissioner's position that certain classes of claim are not patent eligible should be regarded as guidelines only.

Assistance from IPTA

IPTA will be pleased to further assist and support IP Australia in relation to the consequences of the decision including assisting with any submissions or proposals for legislative change that may be contemplated.

Yours faithfully

A handwritten signature in black ink, appearing to be 'Trevor Davies, Michael Caine and Damian Slizys', with a long, sweeping horizontal line extending to the right.

Trevor Davies, Michael Caine and Damian Slizys
On behalf of IPTA Council