

**IN THE HIGH COURT OF AUSTRALIA  
SYDNEY REGISTRY**

**NO S28 OF 2015**

On Appeal From  
the Full Court of the Federal Court of Australia

**BETWEEN:** **YVONNE D'ARCY**  
Appellant

**AND:** **MYRIAD GENETICS INC**  
First Respondent

**GENETIC TECHNOLOGIES LIMITED**  
Second Respondent

**SUBMISSIONS OF THE ATTORNEY-GENERAL OF THE COMMONWEALTH  
(INTERVENING)**



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Filed on behalf of the Attorney-General of the Commonwealth  
of Australia (Intervening) by:

Australian Government Solicitor  
4 National Circuit, Barton, ACT 2600  
DX 5678 Canberra

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File ref: 15048702  
Liam Boyle / Andrew Buckland  
Telephone: 02 6253 7077 / 02 6253 7024  
Lawyer's E-mail: liam.boyle@ags.gov.au /  
andrew.buckland@ags.gov.au  
Facsimile: 02 6253 7303

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## PART I FORM OF SUBMISSIONS

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

## PART II BASIS OF INTERVENTION

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2. In the event that the Court grants the Institute of Patent and Trade Mark Attorneys of Australia (**Institute**) leave to be heard as *amicus curiae*, the Attorney-General of the Commonwealth (**Commonwealth**) intervenes under s 78A of the *Judiciary Act 1903* (Cth) (**Judiciary Act**).

## PART IV LEGISLATIVE PROVISIONS

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- 10 3. The applicable provisions are s 18(1) of the *Patents Act 1990* (Cth) (**Patents Act**) and the definition of "invention" contained in Sch 1 to that Act.

## PART V ARGUMENT

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### SUMMARY OF THE COMMONWEALTH'S SUBMISSIONS

4. The Commonwealth submits as follows:
  - 4.1. *The basis for the Commonwealth's intervention:* If the Court grants the Institute leave to argue that the Patents Act should be construed to "go to the limits" of the Commonwealth's power under s 51(xviii) of the Constitution to make laws with respect to "patents of inventions" (Institute's submissions (**IS**) [32]), the Commonwealth's right to intervene under s 78A of the Judiciary Act will crystallise. In that event, the Commonwealth intervenes.  
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  - 4.2. *The error in the Institute's argument:* A proper construction of s 18(1) of the Patents Act reveals that there is no basis for the Institute's submission summarised at [4.1] above. There is nothing in the statutory text or context that aligns the scope of s 18(1) of the Patents Act with the outer reach of s 51(xviii). Further, the Institute's argument relies on a radical inversion of orthodox principles of statutory interpretation that should not be accepted.
  - 4.3. *Alternative submission if the Court accepts the Institute's argument:* The Commonwealth urges caution against ruling on a constitutional point not put in issue by the parties. If the Court nonetheless considers it necessary to make findings about the scope of s 51(xviii), the Commonwealth draws the Court's attention to the breadth of the patents power as confirmed by the authorities.  
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5. The Commonwealth makes no submissions on the ultimate question of whether isolated nucleic acid is patentable under the Patents Act.

## THE BASIS FOR THE COMMONWEALTH'S INTERVENTION

6. The parties appear to agree, correctly, that the question which divides them – namely, the patentability of certain genetic material – can be decided fully and completely on the proper construction of the Patents Act without the need to examine the reach of the grant of power under s 51(xviii) of the Constitution (see First Respondent's submissions (**RS**) [7]; Appellant's Reply (**Reply**) [20]).
7. This contrasts with the situation in *Attorney-General (NSW) v Commonwealth Savings Bank*,<sup>1</sup> which involved (inter alia) the interpretation of s 38(d) of the Judiciary Act. That provision renders the original jurisdiction of the High Court exclusive in suits "by a State, or any person suing on behalf of a State" against "the Commonwealth, or any person being sued on behalf of the Commonwealth". The Court held<sup>2</sup> that s 38(d) undoubtedly reflected the language of ss 75(iii) and (iv) of the Constitution (which respectively grant the High Court original jurisdiction in matters "in which the Commonwealth, or a person suing or being sued on behalf of the Commonwealth" is a party, and in matters between "States"). As such, the interpretation of these constitutional provisions was "essential or relevant" to a determination of the statutory question, and the case involved the interpretation of the Constitution for the purposes of s 40(1) of the Judiciary Act.
8. The parties also appear to agree, correctly, that no issue of the validity of the Patents Act arises in the present appeal (see RS [7]; Reply [20]). Specifically, the Appellant does not contend that, if her construction argument is rejected on the basis that the genetic material presently in issue is patentable under the Patents Act, the Act would fall outside the scope of s 51(xviii). Nor does her argument implicitly depend on such a contention. Rather, it stands or falls on the submission that genetic material is not, for the purposes of s 18(1)(a) of the Patents Act, a "manner of manufacture" as that concept has been expounded in the case law over time (see Appellant's submissions (**AS**) [20]-[21]; see also [46]).
9. In this respect, the present case also differs from *Nelungaloo v Commonwealth*,<sup>3</sup> which concerned the interpretation of two regulations entitling wheat suppliers to compensation. Although no party explicitly pleaded that the case raised a constitutional issue, the Court held<sup>4</sup> that the parties' particular construction arguments necessarily put in issue the provisions' validity under s 51(xxxi). In Kitto J's words, the contention that the interpretation sought by the plaintiff could "possibly be reached by a process of reasoning independent of the Constitution" had "[no] reality about it".<sup>5</sup> The construction of s 51(xxxi) was thus "essential or relevant" to determination of the matter before the Court, and the action was a cause arising under the Constitution or involving its interpretation within (the then) s 40A(1) of the Judiciary Act.

<sup>1</sup> (1986) 160 CLR 315 (*Commonwealth Savings Bank*).

<sup>2</sup> *Ibid* 328.

<sup>3</sup> (1953) 88 CLR 529.

<sup>4</sup> *Ibid* 538, 540-542 (Dixon CJ, Williams and Fullagar JJ agreeing), 547-548 (Kitto J).

<sup>5</sup> *Ibid* 547.

10. Thus, as this appeal is presently constituted between the parties, no matter arises under the Constitution or involving its interpretation, and no right of intervention under s 78A of the Judiciary Act lies in the Commonwealth. Further, applying well-established principles, the Court should not resolve the appeal by deciding a constitutional question in circumstances where this is not necessary to dispose of the matter and the parties disavow the existence of that constitutional issue.<sup>6</sup>
11. However, the Institute seeks to be accorded the status of an amicus in these proceedings to argue, inter alia, that (IS [32]):
- 10           a) the Patents Act should be interpreted so as to authorise the patentability of anything and everything which would fall within the description of “inventions” in s 51(xviii); and
- b) on the proper construction of that constitutional concept, genetic material of the kind presently in issue can be patented.
12. If the Court grants the Institute leave to be heard as amicus and permits it to advance the above arguments, then, for the purposes of s 78A of the Judiciary Act:
- 12.1. these proceedings will “relate to a matter arising under the Constitution or involving its interpretation”, and
- 20           12.2. the Commonwealth’s right to intervene will crystallise.
13. This is because, from that point onwards, the interpretation of s 51(xviii) will, at least according to one intervener putting submissions to the Court, be “essential or relevant” to the question of construction of the Patents Act.<sup>7</sup> In that event, the Commonwealth intervenes in these proceedings as of right, and makes the further submissions set out below.

**THE PATENTS ACT SHOULD NOT BE CONSTRUED SO AS TO HAVE THE FULL REACH OF SECTION 51(XVIII) OF THE CONSTITUTION**

14. The logic of the Institute’s argument appears to be as follows:
- 30           a) the concept of “patents of inventions” within s 51(xviii) is broad enough to cover isolated genetic material (IS [32]);
- b) the Patents Act should be presumed to extend patent protection to all “inventions” within the meaning of s 51(xviii) except where it contains express words of limitation (IS [32]-[34]);
- c) the only express words of limitation are those contained in s 18(2), which provision does not apply to isolated genetic material (IS [34]);

<sup>6</sup> *Chief Executive Officer of Customs v El Hajje* (2005) 224 CLR 159, 171 [28].

<sup>7</sup> *Commonwealth Savings Bank* (1986) 160 CLR 315, 328.

- d) accordingly, leaving aside the carveout in s 18(2), patentable subject matter under the Patents Act should be interpreted to “occup[y] the full permissible landscape” of the patents power (IS [34]).

15. The correctness of step (a) of this argument only arises for decision if the Institute can establish steps (b)-(d). For the following reasons, it cannot do so.

**Construction of the Patents Act: patentable subject matter under s 18(1) is not coextensive with “inventions” under s 51(xviii) of the Constitution**

*Approaching the question from the statutory perspective*

10 16. The correct starting point for analysing the scope of patentable subject matter under the Patents Act is the statutory text, read in context and with an understanding of the legislative purpose.<sup>8</sup> Legislative history can be an important contextual matter in this regard, particularly where it sheds light on the meaning of statutory language of long-standing provenance.<sup>9</sup> Relevantly for present purposes:

20 16.1. the definition of “invention” in Sch 1 to the Patents Act (“any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies”, including “an alleged invention”) is substantially identical to that contained in s 6 of the *Patents Act 1952* (Cth) (**1952 Act**), s 4 of the *Patents Act 1903* (Cth) (**1903 Act**), and s 46 of the *Patents, Designs and Trade Marks Act 1883* (UK) (**1883 Act**);<sup>10</sup> and

16.2. both that definition and the criterion for patentability within s 18(1)(a) of the Patents Act (that the claimed invention be “a manner of manufacture within the meaning of section 6 of the Statute of Monopolies”) direct attention to the concept of “manner of manufacture” as it has evolved, pursuant to common law processes, since the enactment of a 1623 Imperial statute that itself was seen to be declaratory of the existing law.<sup>11</sup>

17. There is nothing in the statutory text or context that aligns the reach of s 18(1) of the Patents Act with the reach of s 51(xviii).

30 18. Of course, both s 18(1) and s 51(xviii) use the term “invention[s]”. However, “invention” under the Patents Act is defined in Sch 1 to pick up not the breadth of the *constitutional* expression, but the ambit of a body of *common law* principles that have fleshed out and built upon the text and purpose of s 6 of the Statute of Monopolies.<sup>12</sup> Specifically, the question embraced by the

<sup>8</sup> *Project Blue Sky v Australian Broadcasting Authority* (1998) 194 CLR 355, 384 [78].

<sup>9</sup> *Coventry v Charter Pacific Corporation Ltd* (2005) 227 CLR 234, 243 [22], 253 [50]-[51]; *Palgo Holdings Pty Ltd v Gowans* (2005) 221 CLR 249, 254-255 [9]; and see generally *Apotex Pty Ltd v Sanofi-Aventis Pty Ltd* (2013) 304 ALR 1 (*Apotex*).

<sup>10</sup> See *NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd* (1995) 183 CLR 655, 661-662 (*Mirabella*).

<sup>11</sup> See *Apotex* (2013) 304 ALR 1, 5-6 [9]-[10], 9-10 [16]-[19], 53-54 [194]-[197].

<sup>12</sup> *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252, 269 (*NRDC*).

definition of “invention” is whether something is “a proper subject of letters patent according to the principles which have been developed for the application of s 6 of the Statute of Monopolies”.<sup>13</sup> The Sch 1 definition’s inclusion of “alleged inventions” within its scope<sup>14</sup> creates even further distance between the constitutional and statutory language. In these respects, the Patents Act differs starkly from s 10(b) of the *Plant Breeder’s Rights Act 1994* (Cth),<sup>15</sup> which “engage[s] the constitutional head of power as the criterion against which every grant under the legislation is to be measured to determine the efficacy of the grant”.<sup>16</sup> Unlike that statute, the Patents Act contains no indication that the meaning of “inventions” within s 51(xviii) constitutes the “factum” upon which the concept of patentability hinges.

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19. Further, s 18(1) of the Patents Act does not authorise the patenting of all “inventions”, but only a subset of them: inventions that meet the criteria set out in paragraphs (a)-(d) and do not fall within s 18(2). It expounds a composite set of characteristics that an invention must possess in order to be patentable – not only the “manner of manufacture” touchstone in s 18(1)(a), but also novelty (s 18(1)(b)(i)), existence of an inventive step (s 18(1)(b)(ii)), utility (s 18(1)(c)) and absence of secret use before the claim’s priority date (s 18(1)(d)). The process by which patent legislation has been amended over time to separate the touchstones of novelty, inventive step, obviousness and secret use from the threshold “manner of manufacture” inquiry<sup>17</sup> has largely had the effect of codifying the particular common law principles now reflected in ss 18(1)(b)-(d),<sup>18</sup> although some limited residual analysis of “newness” or “inventiveness” at the anterior stage of considering “manner of manufacture” may remain.<sup>19</sup> That legislative development provides further evidence that Australian patent legislation has never fixed on the constitutional meaning of an invention, but instead has incrementally developed its own distinct set of principles governing patentability that reflect the English and Australian common law tradition.<sup>20</sup>

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<sup>13</sup> Ibid.

<sup>14</sup> Mirroring the language of the definitions of “invention” in s 6 of the 1952 Act and s 4 of the 1903 Act. The inclusion of alleged inventions within this definition “is directed to the inquiry at the stage of examination of an application before the decision as to acceptance”: *Advanced Building Systems Pty Ltd v Ramset Fasteners (Aust) Pty Ltd* (1998) 194 CLR 171, 183 [14] (*Ramset*). The term “alleged invention” qualifies only the word “new” within the first part of the definition of “invention” – ie it extends the definition to manners of manufacture alleged to be new: *NRDC* (1959) 102 CLR 252, 261-262.

<sup>15</sup> That section provides that nothing in the statute requires or permits the granting of plant breeder’s rights in a plant variety unless “the breeding of the plant variety constitutes an invention for the purposes of paragraph 51(xviii) of the Constitution”.

<sup>16</sup> *Grain Pool of WA v Commonwealth* (2000) 202 CLR 479, 490 [8] (*Grain Pool*).

<sup>17</sup> This separation process was initially reflected in amendments to the grounds for opposition and revocation. For example, s 56(e) of the 1903 Act departed from the 1883 Act by expressly establishing that a separate ground of opposition to the grant of a patent was that the claimed invention was “not novel”. In turn, s 59(1)(g) of the 1952 Act added as a further ground of opposition that the claimed invention was obvious and did not involve an inventive step.

<sup>18</sup> See *Ramset* (1998) 194 CLR 171, 189-193 [32]-[40].

<sup>19</sup> See *ibid* 192-193 [40], 200 [55]; *Mirabella* (1995) 183 CLR 655, 663-664.

<sup>20</sup> For a history of the long and fluid development of these principles in Anglo-Australian law, see J Pila, ‘Inherent Patentability in Anglo-Australian Law: A History’ (2003) 14 *Australian Intellectual Property Journal* 109. Since 1793, the US has followed essentially the same process of establishing and incrementally amending a broad statutory framework that left it to the courts to identify the more precise conditions of patentability over time as new alleged inventions emerged: see *Graham v John Deere Company of Kansas City*, 383 US 1, 7-10 (1966) (*Graham*).

20. Similar difficulties attend the argument that the criterion for patentability in s 18(1)(a) is coextensive with the meaning of “inventions” under s 51(xviii) of the Constitution.<sup>21</sup> Again, the “manner of manufacture” enquiry adopted within s 18(1)(a) is tied to an iterative common law development of the notion of patentable subject matter. Whilst it is true that that notion is broad and flexible, there is no reason for assuming that it covers identical terrain to s 51(xviii) of the Constitution.
21. Certainly, this does not follow simply from the absence of express qualifications on the scope of s 18(1), aside from s 18(2) (cf IS [34]). As this Court acknowledged in *Apotex*,<sup>22</sup> Parliament adopted the approach in s 18(1) of the Patents Act of continuing to draw on “manner of manufacture” as the touchstone of patentability to avoid an “inflexible codified definition”<sup>23</sup> with express inclusions and exclusions, which the Industrial Property Advisory Committee (IPAC) had opined would prove a “very slow, blunt and inefficient instrument” for implementing economic policy objectives.<sup>24</sup> Thus, the Patents Act was enacted on the basis that whether something was patentable or not would be determined according to the framework established by the existing and developing body of case law, in the light of new circumstances as they arose. The statute does not provide that everything not excluded is patentable under s 18(1).<sup>25</sup> Nor does it reflect the (only slightly narrower) position that anything not excluded is patentable if it falls within the ambit of s 51(xviii) of the Constitution. In French CJ’s words, “legislative silence in this field is an unsure guide to the development of principle”.<sup>26</sup>

*Approaching the question from the constitutional perspective*

22. The absence of any necessary equivalence between “inventions” in s 51(xviii) and patentable subject matter under s 18(1) of the Patents Act is equally clear if one approaches the issue from the perspective of constitutional power. There is no reason to assume that the scope of “inventions” that may be regulated under s 51(xviii) is confined to those things falling within the principles that have been developed for the application of s 6 of the Statute of Monopolies. *Grain Pool* does not support this proposition. The touchstone of constitutional power endorsed by the Court in that case was a broader one – namely, the regulation of intellectual property rights in respect of “products of intellectual effort”.<sup>27</sup> Even

<sup>21</sup> See para 2 of the Institute’s s 78B notice.

<sup>22</sup> (2013) 304 ALR 1, 9 [16], 52-53 [191]-[192].

<sup>23</sup> Explanatory Memorandum for the Patents Bill 1990, [31].

<sup>24</sup> Industrial Property Advisory Committee, *Patents, Innovation and Competition in Australia* (1984), 40 (1984 Report).

<sup>25</sup> See *Apotex* (2013) 304 ALR 1, 58 [220].

<sup>26</sup> *Ibid* 10 [19], 22 [49]. The different approach taken by Crennan and Kiefel JJ (at 64 [241] and 71 [279]) in *Apotex* does not detract from this broader proposition. Their Honours’ point was a narrower one. As one factor underpinning their conclusion that a method of medical treatment was patentable under the Patents Act, their Honours stated that, in a context where Parliament had deliberately declined to exclude methods of treatment of humans from patentability under the 1990 Act and the “manner of manufacture” principles had been developed broadly since *NRDC*, “courts should hesitate to introduce the exclusion” (at 64 [241]).

<sup>27</sup> *Grain Pool* (2000) 202 CLR 479, 493 [17] (describing this concept as a “variable” rather than a “fixed constitutional criterion”), 501 [42], 527 [122]. See also *Nintendo Co Ltd v Centronics Systems Pty Ltd* (1994) 181 CLR 134, 160 (*Nintendo*).

if there was some degree of congruence between the constitutional and statutory concepts of “inventions”, the meaning of that term still would not mark the outer boundaries of the reach of s 51(xviii). This is because s 51(xviii) confers power to make laws *with respect to* patents of inventions. The requirement that a law be sufficiently connected with that power does not reduce simply to an analysis of the meaning of “inventions” under s 51(xviii). Rather, the “sufficient connection” standard affords Parliament a large law-making ambit, including to resolve “cross-currents and uncertainties” in the existing law and to determine that there be “fresh rights in the nature of” patents of inventions.<sup>28</sup> In this respect, too, the constitutional power plainly extends beyond the common law principles governing patentability.

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23. Further, various features of the development of the “manner of manufacture” test demonstrate the inaptness of equating the scope of constitutional power with the reach of common law doctrine from time to time. For example, s 6 of the Statute of Monopolies provided for the grant of patents in respect of manners of new manufacture that were not “generally inconvenient”. Various judges have suggested that this language leaves open an exception to patentability for inventions that the court considers should be denied patent protection on public policy grounds.<sup>29</sup> To the extent that such an exception subsists under the Patents Act,<sup>30</sup> it would be surprising if the very *power* granted to Parliament under s 51(xviii) of the Constitution to create and regulate rights “in the nature of ... patents of inventions”<sup>31</sup> were subject to the same fetter.

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24. An important consequence of the above analysis is that, contrary to the logic of the Institute’s argument, s 51(xviii) does not require Parliament to define patentable inventions by reference to the touchstone of s 6 of the Statute of Monopolies, even though this has been its preferred choice since the 1903 Act. The patents power does not preclude Parliament from defining the subject matter of grants of monopolies over inventions in a manner which varies the common law principles currently picked up by s 18(1)(a) and the definition of “invention” in the Patents Act, whether by expanding or contracting those principles. Nor would it prevent Parliament from doing away with the “manner of manufacture” touchstone altogether in favour of an alternative drafting device – a proposal that IPAC considered but ultimately rejected in the 1984 Report.<sup>32</sup>

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#### The Institute inverts the correct approach to statutory interpretation

25. In the absence of any textual indication that the scope of the Patents Act is coextensive with the reach of s 51(xviii), the Institute’s argument necessarily

<sup>28</sup> *Grain Pool* (2000) 202 CLR 479, 501 [41].

<sup>29</sup> See *Joos v Commissioner of Patents* (1972) 126 CLR 611, 623; *Rescare Ltd v Anaesthetic Supplies* (1992) 111 ALR 205, 237 (*Rescare FC*); *Anaesthetic Supplies v Rescare* (1994) 50 FCR 1, 19, 32-33, 37 (*Rescare FFC*).

<sup>30</sup> See *Apotex* (2013) 304 ALR 1, 22-23 [50], 72 [282]; cf *Rescare FC* (1992) 111 ALR 205, 237-238; *Rescare FFC* (1994) 50 FCR 1, 45; *Bristol-Myers v FH Faulding* (2000) 97 FCR 524, 569 [142].

<sup>31</sup> *Grain Pool* (2000) 202 CLR 479, 501 [41].

<sup>32</sup> See para [21] above. UK legislation has reflected this alternative approach since 1977: see *Patents Act* 1977 (UK).



relies upon a radical interpretative principle: that courts should presume Parliament intends to legislate to the limits of its constitutional power unless there is a clear indication to the contrary. There are a number of compelling reasons why the Court should not take this approach in construing the Patents Act.

- 10 26. First, it is inconsistent with the notion that courts should arrive at the preferred construction of a statute “by the application of rules of interpretation accepted by all arms of government in the system of representative democracy”.<sup>33</sup> The Institute’s purported principle is certainly not an accepted interpretative rule. Rather, the Institute asks the Court to assess the meaning of statutory text enacted decades ago (and reflective of language dating from pre-Federation English statutes) against the backdrop of a novel inversion of existing canons of construction.
- 20 27. Secondly, the Institute’s approach misunderstands the differences between the Constitution and ordinary legislation, and, in so doing, constricts legislative choice. The Constitution is a “mechanism under which laws are to be made, and not a mere Act which declares what the law is to be”.<sup>34</sup> It is a foundational charter intended to endure over time in a manner that adjusts to society’s changing needs. Formal amendment of the document pursuant to s 128 is difficult. Thus, a broad approach to constitutional interpretation – and particularly to the interpretation of the heads of Commonwealth legislative power – is necessary to facilitate effective governance by the political branches.
- 30 28. Conversely, a statute is the expression of Parliament’s response to a particular mischief it sees, intended to govern behaviour at a day-to-day level and amenable to amendment or repeal whenever the legislature considers that the mischief and the law no longer align. Sometimes, Parliament will seek to regulate all matters falling within a particular head of power under s 51. More often, it will not. To suggest that federal legislation should, without more, be interpreted to “go to the limits” of constitutional power is to ignore the broad choices that the Constitution leaves the Parliament to govern as it sees fit within its field of constitutional competence.
- 40 29. Thirdly, and of real practical concern, acceptance of the Institute’s argument in the present proceedings would have the effect of “constitutionalising” many patent cases. In any matter where an issue arises as to whether the subject matter of a given patent is patentable, the court would first have to decide upon the reach of the concept of “patents of inventions” within s 51(xviii) before it could answer the statutory question before it.<sup>35</sup> That has never been the practice in patent litigation in Australia under the 1903 Act, the 1952 Act or the Patents Act, and it is not required by any of those Acts. Courts at all levels in the judicial hierarchy should not be put to the exercise commended by the Institute in these circumstances.

<sup>33</sup> *Zheng v Cai* (2009) 239 CLR 446, 455-456 [28].

<sup>34</sup> *Attorney-General (NSW) v Brewery Employees Union of NSW* (1908) 6 CLR 469, 612.

<sup>35</sup> Compare the observations of Barwick CJ in *R v Federal Court of Australia; Ex parte WA National Football League* (1979) 143 CLR 190, 199, quoted in *Grain Pool* (2000) 202 CLR 479, 490-491 [9].

30. Finally, to the extent that the Institute seeks to bolster its radical interpretative approach by reference to US authorities (see IS [26]), those authorities in fact support the Commonwealth's position. In *Diamond v Chakrabarty*,<sup>36</sup> cited by the Institute, the US Supreme Court referenced the terms of the grant of constitutional power<sup>37</sup> by way of background.<sup>38</sup> However, it then engaged in a wholly conventional exercise of statutory construction to determine whether the alleged invention was patentable, commencing with the statutory text and having regard to legislative history.<sup>39</sup> The same approach is evident from other relevant cases, such as *Graham*,<sup>40</sup> *Bilski v Kappos*<sup>41</sup> and, indeed, *Association for Molecular Pathology v Myriad*<sup>42</sup> – which contains no reference to constitutional power at all.<sup>43</sup> Even where the judges in these authorities observe that Art I § 8 cl 8 of the US Constitution sets a standard which Congress cannot overreach, they confirm that the question for the Court is the proper construction of the statutory scheme in force from time to time within the limits of the constitutional grant.<sup>44</sup> They do not assume that the statutory scheme has the full reach of constitutional power and then look for an express statutory exception to patentability.

#### ALTERNATIVE SUBMISSIONS IF SECTION 51(XVIII) IS RELEVANT

31. If the position by the time of the hearing remains that no party seeks to argue that the patentability of isolated nucleic acid falls outside the power in s 51(xviii), it is difficult to see why the Court should embark upon such an enquiry within the confines of this matter.
32. However, if the Court ultimately considers it necessary to make findings about the scope of s 51(xviii), the Commonwealth draws the Court's attention to the ample breadth of the patents power as affirmed in the relevant authorities. In *Grain Pool*,<sup>45</sup> the Court held that the scope of the patents power should not be confined to the types of inventions in existence at 1900. Rather, the term

<sup>36</sup> 447 US 303 (1980).

<sup>37</sup> Art I § 8 cl 8 of the US Constitution authorises the Congress to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

<sup>38</sup> 447 US 303, 307 (1980).

<sup>39</sup> *Ibid* 307-310. The relevant provision governing patentable subject matter in the US is 35 USC § 101, which largely mirrors language dating back to the Patent Act of 1793. Since 1952, § 101 has provided: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

<sup>40</sup> 383 US 1 (1966).

<sup>41</sup> 561 US 593 (2010). Although the concurring judgment of Stevens J weaves in a close analysis of all aspects of patent history – the English background, the purpose of the constitutional grant, US patent practice and authorities, and US legislative history – his Honour's reasoning starts (at 621) and ultimately ends (at 657) with the statutory text. Stevens J does not imbue the statute with all the breadth of the constitutional power.

<sup>42</sup> 133 S Ct 2107 (2013).

<sup>43</sup> For the same interpretative approach in the Canadian context, see *Harvard College v Canada (Commissioner of Patents)* [2002] 4 SCR 45, 60 [6], 63 [10], 121-122 [153]-[154].

<sup>44</sup> See *Graham*, 383 US 1, 3-7 (1966).

<sup>45</sup> (2000) 202 CLR 479, 495-496 [23].

“patents of inventions” within s 51(xviii) reflects a “dynamism”<sup>46</sup> that would permit the Parliament to respond to developments in technology.<sup>47</sup> Similar to the position with respect to s 51(v), there is therefore “inherent scope for expansion” of the application of the patents power.<sup>48</sup> The Court endorsed its earlier statement from *Nintendo* that the “essence” of the grant of power in s 51(xviii) is that it<sup>49</sup>

authorises the making of laws which create, confer, and provide for the enforcement of intellectual property rights in original compositions, inventions, designs, trade marks and other products of intellectual effort.

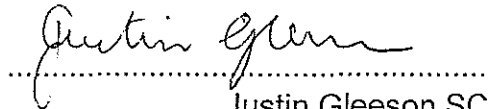
10 33. The Court should not depart from the broad approach taken in these authorities. They are not the subject of any challenge in this case.

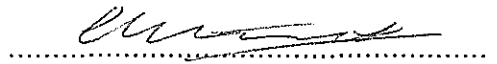
**PART VI ESTIMATED HOURS**

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It is estimated that 15 minutes will be required for the presentation of the Commonwealth’s oral argument.

Dated: 26 May 2015

20   
Justin Gleeson SC  
Solicitor-General of the Commonwealth  
Telephone: 02 6141 4145  
Facsimile: 02 6141 4149  
Email: justin.gleeson@ag.gov.au

  
Celia Winnett  
Telephone: 02 6141 4118  
Facsimile: 02 6141 4149  
Email: celia.winnett@ag.gov.au

30 Counsel for the Attorney-General of the Commonwealth (Intervening)

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<sup>46</sup> Ibid 495-496 [23].

<sup>47</sup> Ibid 493 [18].

<sup>48</sup> Ibid.

<sup>49</sup> Ibid 493 [17], quoting from *Nintendo* (1994) 181 CLR 134, 160.