

RECOMMENDATIONS

Recommendation 1

3.156 The Committee recommends that the Government support and expand on the collection of data, research and analysis concerning genetic testing and treatment in Australia, in line with recommendation 19-1 of the 2004 Australia Law Reform Commission report *Genes and ingenuity*.

Recommendation 2

3.157 The Committee recommends that the Government conduct a public consultation and feasibility study regarding establishing a transparency register for patent applications and other measures to track the use of patents dealing with genes and genetic materials.

Recommendation 3

4.137 The Committee recommends that the Senate refer the Patent Amendment (Human Genes and Biological Materials) Bill 2010 to the relevant Senate committee for inquiry and report.

Recommendation 4

5.161 The Committee recommends that the Government provide a combined response addressing the Committee's inquiry into gene patents; the 2004 report on gene patents by the Australian Law Reform Commission; the review of patentable subject matter by the Australian Council on Intellectual Property (ACIP); and the review of Australia's patent system by IP Australia. The Committee recommends that the response be provided not later than mid-2011 or three months after the release of the findings of all reviews.

Recommendation 5

5.162 The Committee recommends that, at an appropriate time following the release of the ACIP review of patentable subject matter and the IP Australia review of the patent system, the Community Affairs References Committee be tasked with inquiring into the Government's response to, and implementation of, the recommendations of those reviews, as well as the recommendations of the Committee's report on gene patents.

Recommendation 6

5.172 The Committee recommends that the *Patents Act 1990* be amended so that the test for obviousness in determining inventive step is that a claimed invention is obvious if it was 'obvious for the skilled person to try a suggested approach, alternative or method with a reasonable expectation of success'.

Recommendation 7

5.173 The Committee recommends that the *Patents Act 1990* be amended to remove the limitation that 'common general knowledge' be confined to that

existing in Australia at the time a patent application is lodged (that is, that 'common general knowledge' anywhere in the world be considered).

Recommendation 8

5.174 The Committee recommends that the *Patents Act 1990* be amended to remove the requirement that 'prior art information' for the purposes of determining inventive step must be that which could reasonably have been expected to be 'ascertained' (that is, that the 'prior art base' against which inventive step is assessed not be restricted to information that a skilled person in the relevant field would have actually looked for and found (ascertained)).

Recommendation 9

5.175 The Committee recommends that the *Patents Act 1990* be amended to introduce descriptive support requirements, including that the whole scope of the claimed invention be enabled and that the description provide sufficient information to allow the skilled addressee to perform the invention without undue experimentation.

Recommendation 10

5.179 The Committee recommends that the *Patents Act 1990* be amended to provide that an invention will satisfy the requirement of 'usefulness' in section 18(1) only in such cases as a patent application discloses a 'specific, substantial and credible' use; the Committee recommends that such amendments incorporate the full set of recommendations on this issue from the Australian Law Reform Commission's 2004 report, *Genes and ingenuity* (Recommendations 6-3 to 6-4).

Recommendation 11

5.185 The Committee recommends that the *Patents Act 1990* be amended to clarify the circumstances in which the Crown use provisions may be employed; and that the Government develop clear policies for the use of the Crown use provisions. The Committee recommends that the Government adopt the Australian Law Reform Commission's recommendations on this issue from its 2004 report, *Genes and ingenuity* (Recommendations 26-1 to 26-3).

Recommendation 12

5.190 The Committee recommends that the Government amend the *Patents Act 1990* to clarify the scope of the 'reasonable requirements of the public' test, taking into account the recommendation of the Australian Law Reform Commission on this issue in its 2004 report, *Genes and ingenuity* (Recommendation 27-1); the Committee recommends that the Government review the operation of the competition based test for the grant of a compulsory licence, with particular reference to its interaction with the *Trade Practices Act 1974*.

Recommendation 13

5.195 The Committee recommends that the *Patents Act 1990* be amended to include a broad research exemption.

Recommendation 14

5.197 The Committee recommends that, to assist courts and patent examiners with the interpretation and application of the *Patents Act 1990*, the Government consider amending the Act to include anti-avoidance provisions.

Recommendation 15

5.198 The Committee recommends that, to assist courts and patent examiners with the interpretation and application of the *Patents Act 1990*, the Government consider amending the Act to include objects provisions.

Recommendation 16

5.202 The Committee recommends that the Government establish a patent audit committee.

