Australia's highest court considers computer-implemented invention - *Aristocrat Technologies Pty Ltd v Commissioner of Patents* [2022] HCA 29

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In *Aristocrat Technologies Pty Ltd v Commissioner of Patents* [2022] HCA 29 (***Aristocrat HCA***), six members of the High Court delivered two judgments. Kiefel CJ, Keane J and Gageler J concluded that the claims to an electronic gaming machine were not to a manner of manufacture and that the appeal should be dismissed. Gordon, Edelman and Steward JJ concluded that the claims were to a manner of manufacture and that the appeal should be allowed.

What is the effect of Aristocrat HCA?

Section 23(2)(a) of the Judiciary Act 1903 (Cth) has the effect that Aristocrat's appeal was dismissed. However, case law indicates that the seriously considered dicta of three members of a six-judge bench need not be followed, because it is not the majority of the High Court.

So then, what was the reasoning in each judgement in Aristocrat HCA; what can practitioners take away from the decision; and what should practitioners do in cases which involve the patentability of computer implemented inventions?

The judgment of Kiefel CJ, Gageler and Keane JJ said that "*the issue is whether the implementation of what is otherwise an unpatentable idea or plan or game involves some adaptation to or alteration of or addition to technology otherwise well known in the common general knowledge, to accommodate the exigencies of the new idea or plan or game.". Their Honours said that "a new idea implemented using old technology is simply not patentable subject matter*."

Their Honours concluded that the claim in Aristocrat's innovation did not disclose any technical contribution to either computer or gaming technology outside common general knowledge: at best it disclosed a new game, which is not patentable subject matter.

Gordon, Edelman and Steward JJ stated "*In the 21st century, a law such as s 18(1A) of the Patents Act that is designed to encourage invention and innovation should not lead to a different conclusion where physical cogs, reels and motors are replaced by complex software and hardware that generate digital images*". However, they said that it is not enough that the scheme involves the use of a machine to manipulate abstract ideas. Where the manner of manufacture relies upon some change in state or information in a machine, then that change must produce an artificial state of affairs or a useful result. Their Honours concluded that the claim was patentable.

What should practitioners do?

It seems almost inevitable that the question of manner of manufacture in the context of computer implemented inventions will return to the High Court sooner rather than later.

Pending that result, and in the absence of a binding judgment or legislative change, we consider it likely that courts will continue to apply the earlier Full Court authority. It would be open to any litigant to argue that a claim to a computer implemented invention is patentable because it is implemented on a computer to produce an artificial state of affairs and a useful result, and for the matter to return to the High Court.

That is, patent applicants could prosecute claims on the basis that the Gordon, Edelman and Steward JJ judgment is correct, but they would need to do so on the understanding that the matter would likely need resolution by the High Court.

Note: this is a copy of an abridged article that appears in full at https://emmersonchambers.com/news/intellectual-property-law-update-what-to-do-with

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