

# Computer Implemented Invention (CII) Patents

## Australia

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## Patent Eligible Subject Matter

- “a manner of manufacture within the meaning of section 6 of the Statute of Monopolies”, s. 18 *Patents Act* (Cth)
- *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252 (“NRDC”) “Is this 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?”, NRDC at 269  
“To attempt to place upon the idea the fetters of an exact verbal formula could never have been sound.”, NRDC at 271  
“an artificially created state of affairs” and the significance is economic, NRDC at 277
- A number decisions have held claims to a mere scheme, plan or discovery, or mere abstract ideas or information, are not claims for patentable subject matter

Patent Eligible Subject Mater

## Myriad

- *D'Arcy v Myriad Genetics Inc* [2015] HCA 35
  - "Identification of the subject matter of the claims as a class of chemical compounds is the premise upon which the Full Court's conclusion is based. It is a premise which, with respect, **elevates form over substance** to the detriment of the developmental function entrusted to the Court as explained in NRDC" [88]
  - Exclusion of anything which is not, on the face of the specification, a proper subject of letters patent according to traditional principles and "depends upon the construction of the impugned claims read in the light of the specification as a whole and the relevant prior art" [12]

Patent Eligible Subject Mater

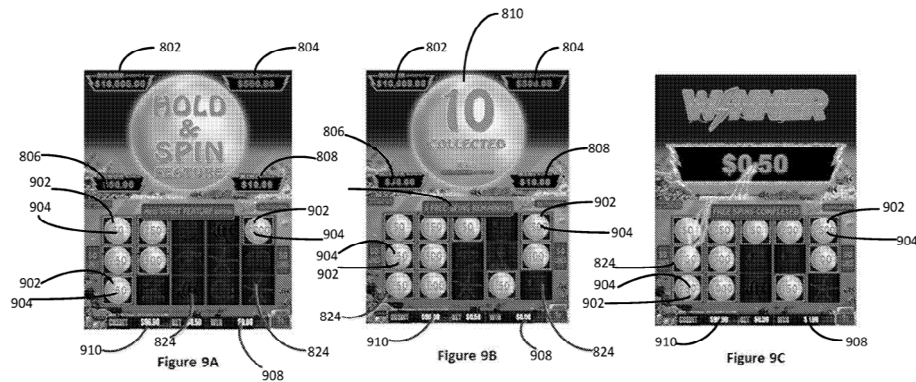
## RPL

- *Commissioner of Patents v RPL Central Pty Ltd* [2015] FCAFC 177
  - No precise guidelines, but consider
    - whether the contribution to the claimed invention is technical in nature.
    - whether the invention solves a "technical" problem within the computer or outside the computer, or whether it results in an improvement in the functioning of the computer, irrespective of the data being processed.
    - Does the claimed method merely require generic computer implementation?
    - Is the computer merely the intermediary, configured to carry out the method using a computer readable medium containing program code for performing the method, but adding nothing to the substance of the idea? [98],[99]
  - "a claimed invention must be examined to ascertain whether it is in substance a scheme or plan or whether it can be broadly described as an improvement in computer technology" [96]

Aristocrat

## Aristocrat

*Aristocrat Technologies Australia Pty Limited v Commissioner of Patents [2020] FCA 778*



Aristocrat

## Aristocrat [2020] FCA 778

- Delegate's & Commissioner's characterisation "the invention is a mere scheme in the form of a set of game rules, or a scheme for making money ... a scheme that has merely been "put into" a computer" [74]
- Need to consider two questions:
  1. "whether the claimed invention is for a mere scheme or business method of the type that is not the proper subject matter of a grant of letters patent."
  2. If yes, then "whether the computer-implemented method is one where invention lay in the computerisation of the method, or whether the language of the claim involves ... "merely plugging an unpatentable scheme into a computer"" [91]
- EGM with a display, credit input mechanism, meters, game play mechanism and game controller and "the invention may be characterised as a machine of a particular construction which implements a gaming function" [98]

Aristocrat

## Aristocrat [2020] FCA 778

- Disagreed with “the approach to the characterisation of the invention taken by the Delegate and the Commissioner, insofar as they first identify the “inventive concept” and then utilise that concept to conclude that the invention is a mere scheme. That rather **puts the cart before the horse**” [99]
- “difficult to see why the development of an implementation of an EGM that utilises the efficiencies of electronics technology would be disqualified from patent eligibility, when the old-fashioned mechanical technology was not” [102] – the ball point pen analogy

Aristocrat

## Aristocrat [2021] FCAFC 202

- Proposed alternative approach:
  - (a) Is the invention claimed a computer-implemented invention?
  - (b) If so, can the invention claimed broadly be described as an advance in computer technology? [26]
- EGM is a specific, highly regulated machine that is a computer [42].
- The substance of the invention is a feature game implemented on the computer which is an EGM [56]
- The use of configurable symbols may constitute advances in gaming technology but they are not advances in computer technology [65]
- Appeal allowed and remitted to the primary judge to determine any technical contribution in all of the claims.

Aristocrat

## Aristocrat [2022] HCA 29

- Kiefel CJ, Gageler and Keane JJ.
- There is a threshold requirement to be a patentable invention. “The ball point pen would not, now or at the time CCOM was decided, have met the threshold requirement of s 18 that it be an invention because it is not, and was not then, new” [72]
- “it is necessary to characterize Aristocrat’s claimed invention by reference to the terms of the specification having regard to the substance of the claim and in light of the common general knowledge.” “The claimed invention takes its character, as an invention, from those elements of the claim which are not common general knowledge” [73]
- “It is no more than an unpatentable game operated by a wholly conventional computer, using technology which has not been adapted in any way to accommodate the exigencies of the game or in any other way” [76]
- Appeal should be dismissed.

Aristocrat

## Aristocrat [2022] HCA 29

- Gordon, Edelman and Steward JJ.
- Commissioner’s characterization too specific and narrow. “it ignores entirely the interaction between the instructions and those integers concerned with the player interface” [149].
- “the best characterisation ... is an EGM incorporating an interdependent player interface and a game controller which includes feature games and configurable symbols” [149]
- “the implementation of a scheme or idea on a computer to create an artificial digital state of affairs should not be treated any differently from the implementation of a scheme or idea by any other machine to create an artificial physical state of affairs. In both cases, however, the implementation must do more than merely manipulate an abstract idea. ... it must create an artificial state of affairs and a useful result” [153]
- Allow appeal

UbiPark

## **UbiPark v TMA Capital [2023] FCA 885**

- “a communications system, computer program and smartphone configured to determine signal strengths of entry signals and exit signals to control a user’s entry into and exit from a restricted area, in conjunction with the use of authorisation data” [204]
- “claims comprise a series of instructions to be executed by a computer, the invention as claimed does have some “concrete, tangible, physical, or observable effect” (Aristocrat at [25]), namely the opening of the entry barrier and the exit barrier. While this is not explicitly stated in claims 1, 11 and 16, it flows from the references to generating and transferring an entry request and exit request, read in the context of the specification as a whole.” [205]
- “Similarly, and for the same reasons, the invention as claimed constitutes an abstract idea that is “implemented on a computer to produce an artificial state of affairs and a useful result” (Aristocrat at [122]). The artificial state of affairs is the opening of the entry barrier and exit barrier. The useful result is that the user associated with a vehicle is granted entry into, and exit from, a restricted area.” [205]

Hytera

## **Hytera v Motorola[2024] FCAFC 168**

- Accepted the statements of principle that “a computer-implemented invention will be patentable if, in substance, it constitutes an improvement in computer technology rather than a use of that technology” and “the High Court’s decision has no ratio decidendi and stands only for the proposition that the Full Court’s decision stands” [415, 416]
- Digital mobile radios (DMRs) and a method of scanning which could be used in a TDMA system to reduce the time required for completing scan operations. ID information compressed.
- “a method for improving scanning time. That is a manner of manufacture. It is not an abstract idea. The patent discloses and the relevant claims embody a technical means, utilising the structure of data frames by which communications are carried in a digital communications device, by which scanning time can be improved” [417]

Aristocrat

## Aristocrat [2025] FCAFC 131

- The residual claims of 4 patents
- Whilst the primary judge had to follow the approach of the earlier Full Court, it was considered “perverse for the present Full Court to follow” an approach “which has been disapproved of by all judges of the High Court who have considered it” [116]
- “too rigid and narrow an approach to say that the implementation of an idea in a computer, using conventional computer technology for its well-known and well-understood functions, cannot constitute” eligible subject matter [131]
- Better to say is it an abstract idea (i) manipulated on a computer; or (ii) **implemented on a computer to produce an artificial state of affairs and a useful result** [131]
- Following the allowing reasons of the High Court – previous Full Court decisions considered correct. Scheme for assessing competency (*RPL*) v Opening of exit and entry barriers (*UbiPark*) and reducing time for scan operations (*Hytera*)

Aristocrat

## Aristocrat [2026] HCADisp 15

- Special leave to appeal to refused
- “In light of the background to this application, there is insufficient reason to doubt the correctness of the decision of the Full Court.”
- “A grant of special leave to appeal is not in the interests of the administration of justice in circumstances in which that Full Court applied established principles concerning the assessment of manner of manufacture and reached a unanimous and clear conclusion as to characterisation.”

Patent Eligible subject matter

## Summary

- All down to construction – a matter of law and on the face of specification with CGK to only assist – must characterise the invention to determine the “substance”
- Expert evidence discounted – no to inventive concept
- Specification – technical and code details help
- Law allows Examiners wide discretion – but need to follow guidance in Manual which has changed little (introduced benefit of “interdependent physical features”) and is facing heavy scrutiny.
- The broad principles of *NRDC* are intact – the useful arts v the fine arts

## Presenters



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