



HIGH COURT OF AUSTRALIA

17 August 2022

ARISTOCRAT TECHNOLOGIES AUSTRALIA PTY LTD v COMMISSIONER OF PATENTS
[2022] HCA 29

Today, the High Court dismissed an appeal from a decision of the Full Court of the Federal Court of Australia. The appeal concerned whether the appellant's patent claim for a system and method for providing a feature game to be played on an electronic gaming machine ("EGM") was a "manner of manufacture" within the meaning of s 18(1A)(a) of the *Patents Act 1990* (Cth).

The appellant manufactures EGMs. It owned four innovation patents concerning various embodiments of an EGM. The specification of one patent, which was sufficiently similar to the others for the purpose of analysis, described the claimed invention as the combination of a player interface, being the physical features of an ordinary EGM, and a game controller, being the computerised components that interacted with the player interface to implement a base game and a feature game. Both the player interface and game controller contained elements that were part of the common general knowledge. The specification also described the triggering of a feature game from the base game using configurable symbols; those elements, which were part of the game controller, were not part of the common general knowledge. Following examination by the respondent, each patent was revoked on the ground that none of the claims in any of the innovation patents was a manner of manufacture.

The appellant successfully appealed the revocation to the Federal Court of Australia. The primary judge found that the claimed invention was not a mere scheme and was therefore patentable subject matter. The Full Court allowed an appeal, with a majority of that Court holding that while the claimed invention was computer-implemented, it was not an advance in computer technology and therefore not patentable subject matter.

The High Court unanimously held that s 18 of the *Patents Act* imposes a threshold requirement that there be an invention and that the only question in assessing whether a manner of manufacture exists under s 18(1) or (1A) is whether there is a manner of manufacture within s 6 of the *Statute of Monopolies*. The Court divided on the proper characterisation of the appellant's invention. Three Justices would have dismissed the appeal, characterising the invention, in light of the specification as a whole and the common general knowledge, as nothing other than a claim for a new system or method of gaming. The only thing differentiating it from the common general knowledge was the unpatentable idea of the feature game. Three Justices would have allowed the appeal, characterising the invention as an EGM incorporating an interdependent player interface and a game controller which included feature games and configurable symbols. That operation involved an artificial state of affairs and a useful result amounting to a manner of manufacture.

Where the High Court is equally divided in opinion, s 23(2)(a) of the *Judiciary Act 1903* (Cth) requires that the decision appealed from shall be affirmed. Accordingly, the High Court ordered that the appeal be dismissed with costs.

- *This statement is not intended to be a substitute for the reasons of the High Court or to be used in any later consideration of the Court's reasons.*