

ORIGINAL

Form 122
Rule 36.01(1)(b); 36.01(1)(c)

Notice of appeal

NSD 359 / 2013

No. ~~1234567~~

Federal Court of Australia
District Registry: New South Wales
Division: General

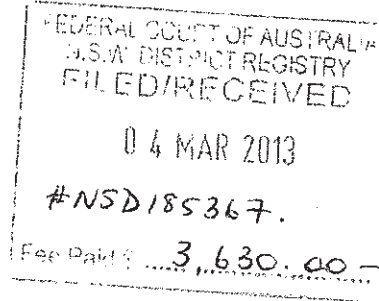
On appeal from the Federal Court

Yvonne D'Arcy

Appellant

Myriad Genetics Inc and another named in the schedule

Respondents



To the Respondent

The Appellant appeals from the judgment as set out in this notice of appeal.

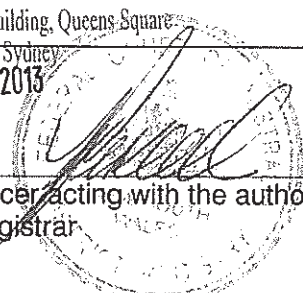
1. The papers in the appeal will be settled and prepared in accordance with the Federal Court Rules Division 36.5.
2. The Court will make orders for the conduct of the proceeding, at the time and place stated below. If you or your lawyer do not attend, then the Court may make orders in your absence. You must file a notice of address for service (Form 10) in the Registry before attending Court or taking any other steps in the proceeding.

Time and date for hearing: 17 April 2013 at 9.30am

Federal Court of Australia
Place: Law Courts Building, Queens Square
Sydney

Date: 04 MAR 2013

Signed by an officer acting with the authority
of the District Registrar

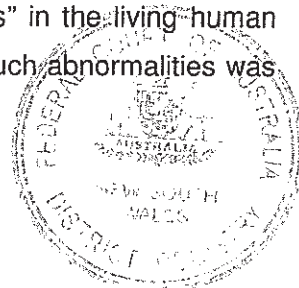


Filed on behalf of (name & role of party)	Yvonne D'Arcy, Appellant	
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The Appellant appeals from the whole of the judgment of the Federal Court given on 15 February 2013 at Sydney.

Grounds of appeal

1. The primary Judge erred in holding that each of Claims 1, 2 and 3 of Australian Patent No. 686004 was a claim to a manner of manufacture within the meaning of section 6 of the Statute of Monopolies and, thus, a patentable invention within the meaning of s18(1)(a) of the *Patents Act* 1990.
2. The primary Judge erred in holding that, because the isolated nucleic acid claimed was the product of human intervention, the inventions claimed involved the creation of an “artificial state of affairs” and, in consequence, patentable subject-matter (at [107]-[108]), even if the relevant properties had not changed [104].
3. The primary Judge erred in failing to hold that the claims were limited by the result of coding for the mutant or polymorphic BRCA1 polypeptides and that, in that respect, the nucleic acids claimed were the same as those in the naturally occurring cells; that is, they did not represent an “artificial state of affairs”.
4. Having (correctly) assumed that isolated nucleic acid within the claims has the same (relevant) physical composition and structure as that found in the naturally occurring nucleic acid in the human body, the primary Judge erred in holding that such isolated nucleic acid constituted an artificial state of affairs such as to constitute patentable subject matter [106] and in failing to hold that the claimed nucleic acid was the mere discovery of a non patentable product of nature.
5. The primary Judge erred in failing to hold that the claimed isolated nucleic acid did not have as its end result an artificial effect, or discernible or observable result, falling within what must be produced by a process, such as to satisfy the requirements of the High Court decision in *NRDC*.
6. The primary Judge erred in failing to give any or any sufficient consideration to the (undisputed) fact that the primary rationale for the isolation of the claimed nucleic acid was to examine for and identify “**in vivo** mutations and polymorphisms” in the living human body and in failing to hold that the isolation and detection of any such abnormalities was the mere discovery of non patentable phenomena of nature.



7. The primary Judge erred in holding that the fact of human intervention, *per se*, in the process of isolation was relevant to the question of whether the claimed isolated nucleic acid constituted patentable subject matter [108].
8. The primary Judge erred in taking into account facts the subject of the reasons in *American Cyanamid Company v Upjohn Company (Dann's Patent)* [1971] RPC 425 when neither the complete specification of the patent in suit nor the evidence in the proceedings either asserted or described any expenditure of skill and effort in the isolation of the nucleotide sequences claimed [109].
9. The primary Judge erred in having regard to "recent amendments and their history", (including Bills not passed and reports and recommendations) in construing s18(1)(a) as enacted in the *Patents Act* 1990 [111]-[123].
10. The primary Judge erred in treating as relevant "the Australian Patent Office's long standing practice, reflected in decisions of the Australian Patent Offices since the enactment of the *Patents Act* 1990" [113-114].
11. The primary Judge erred ordering that the appellant pay the respondents' costs.

Orders sought

12. The appeal be allowed with costs.
13. The order of the primary Judge made on 15 February 2013 be set aside and in lieu thereof the following orders be made:
 - (a) A declaration that each of claims 1, 2 and 3 of patent 686004 does not claim an invention or a patentable invention within the meaning of the Act as such claims do not constitute a manner of new manufacture within the meaning of s6 of the *Statute of Monopolies* or a manner of manufacture within the meaning of s18(1)(a) of the Act;
 - (b) An order revoking patent 686004 so far as it relates to claims 1, 2 and 3; and
 - (c) An order for costs.

Appellant's address

The Appellant's address for service is:



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Sydney NSW 2000

Email: rgilsenan@mauriceblackburn.com.au

The Appellant's address is:

c/- Level 20
201 Elizabeth Street
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Service on the Respondent

It is intended to serve this application on all Respondents.

Date: 4 March 2013



Signed by Rebecca Gilsonan
Lawyer for the Appellant



Schedule

No. 643 of 2010

Federal Court of Australia
District Registry: New South Wales
Division: General

Respondents

Genetic Technologies Limited
(ABN 17 009 212 328)

Date: 4 March 2013

