Fordham IP Conference 2013

Session 8B: Patentable Subject Matter: Are Software and Gene Patents still "Under the Sun"?

A European Perspective

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The NRDC Case (1959) 102 CLR 252 (High Court of Australia)

Dixon CJ Kitto and Windeyer JJ

The inquiry which the definition demands is an inquiry into the scope of the permissible subject matter of letters patent and grants of privilege protected by the section. It is an inquiry not into the meaning of a word so much as into the breadth of the concept which the law has developed by its consideration of the text and purpose of the Statute of Monopolies…The right question is: "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?

EUROPEAN PATENT CONVENTION, ARTICLE 52, paragraph 1:

(1) European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

EUROPEAN PATENT CONVENTION, ARTICLE 52, paragraph 2:

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

EUROPEAN PATENT CONVENTION, ARTICLE 52, paragraph 3:

(3) Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

EUROPEAN PATENT CONVENTION, ARTICLE 53

European patents shall not be granted in respect of:

(a) inventions the commercial exploitation of which would be contrary to "ordre public" or morality; such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof;

(c) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Directive 98/44/EC on the legal protection of biotechnological inventions

Article 5

1. The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

2. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

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Directive 98/44/EC on the legal protection of biotechnological inventions

1. Inventions shall be considered unpatentable where their commercial exploitation would be contrary to ordre public or morality; however, exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

2. On the basis of paragraph 1, the following, in particular, shall be considered unpatentable:

(a) processes for cloning human beings;
(b) processes for modifying the germ line genetic identity of human beings;
(c) uses of human embryos for industrial or commercial purposes;
(d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.