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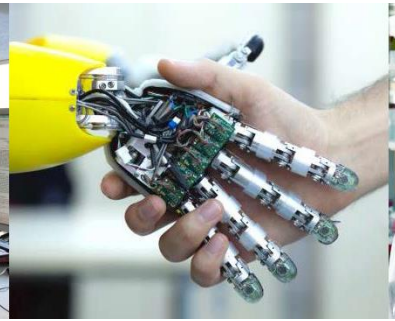
8c. Harmonisation of Patentable Subject-Matter

US Bar-EPO Liaison Council

Washington, DC, 24 September 2019





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Patentable subject-matter: evolution

USA, early 2000s

- § 101: List of eligible subject-matter is exemplary, not restrictive
- Chakrabarty (1980): statutory subject matter included "anything under the sun that is made by man", including a man-made living organism
- State Street Bank (1998): patentability of business methods in the US

  − Much more liberal than European practice at the time

- .. but then, US Supreme Court decisions in *Bilski* (2008), *Mayo* (2012), *Myriad (2013), Alice* (2014)...

Patentable subject-matter: evolution (2)

Europe

- Art. 52 and 53 EPC: patentable: "*any inventions, in all fields of technology, provided that they... are susceptible of industrial application*
- Art. 52(2) and (3) EPC define what is not an invention
  - list of exclusions in Art. 52(2) EPC to be construed narrowly
- Art. 53 EPC defines non-patentable inventions

- Perceptions:
  - In early 2000's, considered overly restrictive
  - Now, European practice is arguably considered more liberal, predictable and consistent than US practice...

Patentable subject-matter and harmonisation: SPLT I

- Patentable subject-matter was included in the draft Substantive Patent Law Treaty of 1991 ("SPLT" I) (Art. 10; 2 Alternatives: hint at difficulties…)
- *Alternative A*: List of allowed exceptions:

  (i) use contrary to public order, law or morality or injurious to public health;

  (ii) plant or animal varieties or essentially biological processes for production of plants or animals;

  (iii) discoveries and materials or substances already existing in nature;

  (iv) methods of medical treatment for humans or animals;

  (v) nuclear and fissionable material.
- *Alternative B*: *Patent protection shall be available for inventions, whether they concern products or processes, in all fields of technology.*

Patentable subject-matter : SPLT II

- Taken up again in the WIPO/SCP in the SPLT II in Nov. 2001 (SCP/6/2)

- Article 12 (1) *[Subject-matter Eligible for Protection*] (a) A claimed invention shall fall within the scope of subject matter eligible for protection. Subject-matter eligible for protection shall include products and processes [, in all fields of technology,] which can be made and used in any field of activity.

- (b) Notwithstanding subparagraph (a), the following shall not be considered as subject matter eligible for protection:
  - (i) mere discoveries;
  - (ii) abstract ideas as such;
  - (iii) scientific and mathematical theories and laws of nature as such;
  - (iv) purely aesthetic creations.

Outcome of the discussions in the SCP

- May 2002: Session of the WIPO Standing Committee on Patents:
  - US wanted a broad definition aligned on USPTO practice at the time
  - Some EU delegations shepherding legislation transposing the EU Biotech Directive into national law encountered political problems in their respective Parliaments and resisted inclusion

- Issue “reserved” in draft of SCP/8/2 (Nov. 2002), first issue to disappear, prior to paring down of norms into a “Reduced Package” to be considered by the Trilateral Offices and then Group B+

Arguments

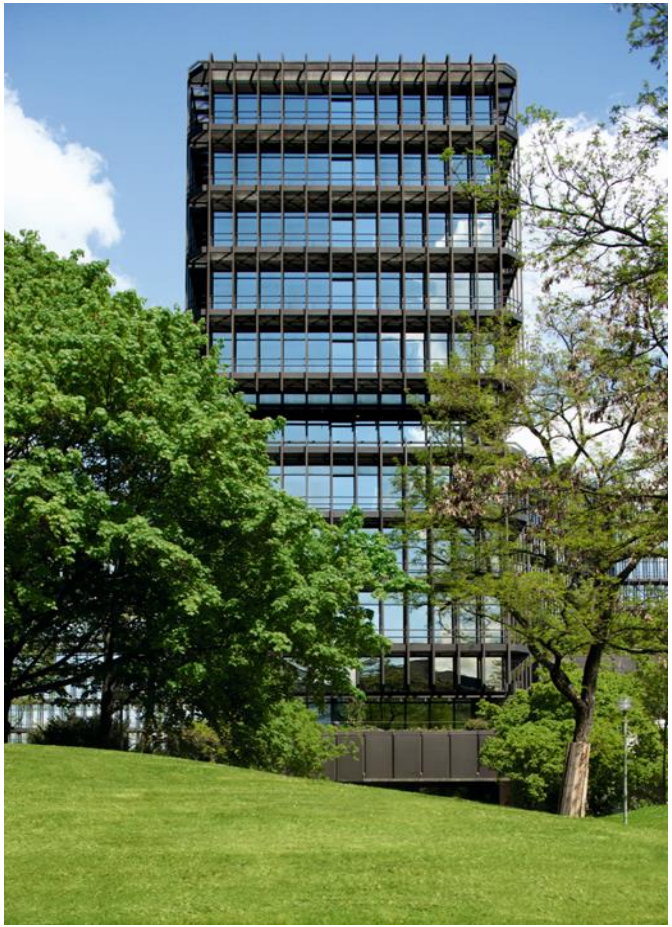
- Recent events in the US show that state of the law in this regard can fluctuate according to Court decisions quite radically, without the statute actually being modified
- Highest courts deciding on these issues are not specialised (SCOTUS, CJEU, etc.)
- Societal sensitivities in this area may change over time
- This is an area in which flexibility to adjust norms to societal sensitivities is essential: failing to do so risks bringing whole patent system into disrepute
  - See lobby groups in Europe against patents on life, seeds, beer, plants, CIIs, etc...

Conclusion

- Rules governing patentable subject-matter, going beyond the basic principles of non-discrimination found within Art. 27.1 TRIPs should be kept out of Treaties

- Societies need to retain the flexibilities to be able to adjust their patent systems to the evolution of the times and the perceptions of society

- Because higher courts may be unpredictable, it is better to have an internal fix if there are problems, than have additional issues going to failure to comply with international obligations



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Thank you for your attention!

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