

IMPORTANT DECISION REGARDING PATENTABILITY IN CANADA OF LIVING LIFE FORM

Zhen Wong*
LEGER ROBIC RICHARD, L.L.P.
Lawyers, Patent and Trademark Agents
Centre CDP Capital
1001 Square-Victoria – Bloc E – 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel. (514) 987 6242 – Fax (514) 845 7874
www.robic.ca – info@robic.com

Canada's Federal Court of Appeal, in a landmark but split decision rendered on August 3, 2000 (*President and Fellows of Harvard College v. Canada (Commissioner of Patents)*), reported at (2000) F.C.J. 1213), ruled that a transgenic non-human mammal, hereinafter referred to as "oncomouse", fell within the definition of the term "invention" as defined in section 2 of the Canadian *Patent Act* (R.S.C. 1985, c. P-4). In this case, Harvard College had been attempting for more than fifteen years to obtain a patent in Canada on its oncomouse, which had already been patented in the United States and Europe.

In lower jurisdictions, the oncomouse was deemed unpatentable. The Commissioner of Patents restrictively interpreted the term "invention" at Section 2 of the Canadian *Patent Act* to conclude that the terms "manufacture" and "composition of matter" refer respectively to something that is manufactured under the full control of the inventor and to something that is identically reproducible. In his opinion, and in the opinion of the Patent Appeal Board, these criteria were not met in this case.

In order to be deemed patentable, an invention must meet the conditions of patentability which are novelty, utility and inventiveness (or unobviousness). In the case of the oncomouse, both lower jurisdictions had ruled that all three conditions had been met: the oncomouse is novel because it does not exist in nature, useful because of its implication in cancer research and inventive because of the human intervention involved in its production. The issue however was to determine whether the oncomouse fit into the definition of "invention".

© CIPS, 2000.

* Of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the Fall 2000 issue (Vol. 4, No. 4) issue of our Newsletter. Publication 068.031E.

Before the Court of Appeal, the oncomouse was held to be patentable, by a two to one majority. Mr. Justice Rothstein, speaking for the majority, referred to the U.S. majority decision in *Diamond, Commissioner of Patents and Trademarks v. Chakrabarty* (1980), 206 U.S.P.Q. 193, to conclude that there is nothing in the *Patent Act* which prohibits the patentability of higher life forms. Rothstein J. broadly interpreted the expressions "manufacture" and "composition of matter" by relying on *Pioneer Hi-Bred vs Commissioner of Patents* (1989) 1 S.C.R. 1623, which did not prohibit the issuance of a patent on a living life form. In the *Pioneer Hi-Bred* case however, the patent was refused since it was simply a cross-breeding of two plants. In another decision relied on by the majority, *Abitibi (Re Application of Abitibi Co., (1982), 62 C.P.R. (2d) 81 (PAB))*, the Commissioner held that micro-organisms could be the subject of patent applications. Rothstein J. further stated that the term "invention" as read in Canadian patent law did not exclude inventions that use the laws of nature. Therefore, the oncomouse as claimed, could be seen as falling within the definition of the term "invention".

In arriving at his conclusion, Rothstein J. reviewed the previous decisions and found that the Commissioner of Patents erred in rejecting the claims dealing with the oncomouse by including restrictions in the legislative text where no such restrictions existed. As Justice Rothstein stated: "The language of patent law is broad and general and is to be given wide scope because inventions are, necessarily, unanticipated and unforeseeable".

Rothstein J. also found that the Federal Court Trial judge, who heard the appeal from the Patent Appeal Board, erred by applying the following criteria incorrectly: degree of control, reproducibility, separation of the process into phases and making a distinction between higher and lower life forms.

The essential point to be retained from the majority decision is that any invention that results from human intervention, and that is controllable, no matter what the degree is, can be patented as long as it meets the conventional criteria of patentability.

In rendering his dissenting opinion, Mr. Justice Isaac stated that the issue in the present case was not to determine whether the oncomouse constituted patentable subject matter, but rather whether it was appropriate for the Court to review the Commissioner's decision in view of recent administrative law decisions. In his opinion, the Commissioner's decision was reasonable, thus it was not appropriate to review same.

While it is true that the Commissioner has the expertise to decide whether or not to grant a patent, when it comes to determining the actual scope of the

Patent Act by interpreting the definition of "invention", the Courts should not be reluctant to review such decision.

The Federal government has requested leave to appeal this decision to the Supreme Court of Canada. However, it is unknown at this point whether the request for appeal will be granted by Canada's highest Court.

It is submitted that this decision will have an important impact in Canadian law, and may open the door of patentability to areas which were traditionally not held to be patentable, such as software per se or systems which do not necessarily produce physical results, such as methods of doing business.

It is also interesting to note that the majority addressed the implications of the decision for humans. The patent application dealt with claims directed to a non-human mammal. In stating that the decision should not have an impact on humans, Rothstein J. wrote that a patent constitutes a right of property and that ownership concepts cannot be extended to human beings. The *Canadian Charter of Rights and Freedom*, at Section 7, states that each person has the right to freedom. Consequently, the *Patent Act* does not apply to humans. The issue remains however with respect to human organs which could be genetically modified to be "better". Will this decision allow the patentability of such organs? Time will tell.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

