

# Judicially Created Diversity in Patent Law

Norman Siebrasse

Professor of Law

University of New Brunswick, Canada

## Do The USPTO 101 Guidelines Violate International Trade Agreements?



POSTED BY **COURTENAY C. BRINCKERHOFF** ON 9 APRIL 2014

POSTED IN **101; INTERNATIONAL PATENT PRACTICE; MYRIAD; PATENT OFFICE PRACTICE; PROMETHEUS**

One advantage of being a blogger in the relatively small world of patents is that I have gotten to know practitioners in other countries who also have a keen interest in patent law. One such person is Australian Registered Patent Attorney Mark Summerfield, who blogs at Patentology. I enjoyed his article on the new USPTO ...

[Continue reading this entry](#) ▶

## Do Pharmaceutical Compositions Have Patent Subject Matter Eligibility Under The New USPTO Guidelines?



POSTED BY **COURTENAY C. BRINCKERHOFF** ON 10 MARCH 2014

POSTED IN **101; MYRIAD; PERSONALIZED MEDICINE; PROMETHEUS; USPTO PROPOSED RULE CHANGES**

The USPTO's new patent subject matter eligibility guidelines (the "Guidelines") include examples that apply the multi-factored analysis mandated by the Guidelines to compositions that include one or more "natural products" as a component. Do these examples indicate that pharmaceutical compositions with an active ingredient that can be obtained from a natural source no longer can be

# Gunpowder Unpatentable

- Claim: A fountain-style firework comprising:  
(a) a sparking composition, (b) calcium chloride, (c) gunpowder, . . .
- “[T]he claim recites judicial exceptions: . . .  
gunpowder, which is a mixture of naturally occurring saltpeter, sulfur and charcoal.
  - USPTO Subject Matter Guidelines March 2014

# Funk Bros

- Claimed an inoculant “comprising a plurality of selected mutually non-inhibitive strains” of nitrogen-fixing bacteria.
- [O]f course not patentable. For patents cannot issue for the discovery of the phenomena of nature.

# Funk Bros (1948)

- Everything that happens may be deemed ‘the work of nature,’ and any patentable composite exemplifies in its properties ‘the laws of nature.’ Arguments drawn from such terms for ascertaining patentability could fairly be employed to challenge almost every patent.
  - Frankfurter J, concurring in the result

# Shell Oil SCC (1982)

- Discovered known compounds were useful as plant growth regulators
  - Claimed compounds mixed with adjuvants
- Patentable
- A disembodied idea is not *per se* patentable. But it will be patentable if it has a method of practical application.

# Abstract Claims v Subject Matter

- Rule against abstract claims
  - Canada 27(8) No patent shall be granted for any mere scientific principle or abstract theorem.
- Subject matter exclusions
  - No patents for certain subject matter, abstract or not
  - No patents for oncogenic mouse (higher life forms)
    - *Harvard Mouse* SCC (2002)

# Reasons for USSC Anomaly

- *Myriad Genetics* (2013) (DNA)
- *Mayo v Prometheus* (2012) (Personalized medicine)
- *Bilski* (2010) (Business methods)
- *Benson* (1972), *Flook* (1978), (*Diehr* (1981) (Computer-implemented inventions)
- *Funk Bros* (1948) (Properties of bacteria)



# EPC

- Art 52 (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.

# EPC

- (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.

# Implications

- Is specific harmonization desirable?
- If it is, how to decide which rule is optimal?