

A tale of two patents

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The Harvard Mouse case and the Pink Panther case are both about cute, furry animals with long tails. They obviously belong in the same column.

The Harvard Mouse case is about a patent claim for a genetically-altered mouse. It raises complex issues about the patentability of higher life forms.

The Pink Panther case is a trade-mark case about the world-renowned pink cartoon character, dealing with the scope of protection available to "famous marks".

So there's a warm-blooded mammal theme here. Let's start with the Pink Panther case.

A small Ontario company called "Pink Panther Beauty Corporation" applied to register PINK PANTHER as a trade-mark for hair care and beauty supplies, on the basis of proposed use. The applicant had nothing to do with United Artists, the movie studio that owns the Peter Sellers movies, the Pink Panther cartoon character and the nifty music. United Artists has its own PINK PANTHER registrations for movie-related services.

United Artists opposed, arguing the registration should not issue because it was confusing with its existing famous PINK PANTHER marks.

The Trade-marks Opposition Board, obviously no Peter Sellers fan, rejected the movie people, and found for Pink Panther Beauty Corp.

United Artists appealed. Mr. Justice MacKay of the Federal Court Trial Division agreed with the movie moguls, and overturned the Opposition Board. Because PINK PANTHER was a famous mark, it should get a wide scope of protection, found MacKay. Even though United Artists didn't sell beauty products or shampoo, there was a likelihood of confusion. The applicant therefore could not register PINK PANTHER, according to the Trial Division.

This weighty issue then went up to the Federal Court of Appeal, who by a 2-1 split vote decided to overturn Justice MacKay in a decision released March 30, and allow the

registration to issue. The majority decision by Justice Linden agreed that United Artists' PINK PANTHER was a famous mark. But the applicant's PINK PANTHER mark, although identical, was not confusing because the applicant sold beauty products, not movies. "There is no likelihood of confusion as to the source of the products. The key factor here is the gaping divergence in the nature of the wares and in the nature of the trade. It is not a fissure but a chasm."

A strongly worded dissent by Justice MacDonald would have rejected the application. "What the Appellant seeks to do is to profit financially from the goodwill associated with the Respondent's trade name.... There are many other feline animals the Appellant could have chosen for its business"

Justice MacDonald was also warned ominously that majority decision "launches trade mark protection down a slippery slope which will result in the protection of famous names only in the very clearest of cases."

The court's learned remarks about "feline animals" bring us to our next topic: can you patent a mouse?

In the Harvard Mouse case, released April 23, Justice Nadon of the Federal Court upheld a decision by the Commissioner of Patents not to allow a patent claim for a "non-human mammal." The case is always called the Harvard Mouse case, even though the scope of the claim is of course broader than mice. (It might even include pink panthers.)

Harvard researchers had applied for a patent claiming an animal modified by genetic engineering to be susceptible to tumors. Mice modified in this way, known as oncomice, are used in cancer research.

The Commissioner had allowed certain claims for the method of modifying the animal (a gene splicing technique), but refused to allow the product claim, that is, a claim for the animal itself, modified in this way.

The issue before the court was whether it is possible to patent a higher life form such as a mammal. It has long been possible to patent lower life forms such as bacteria and yeast. As well, the equivalent claims had been allowed in the US.

Was the claim for the actual animal within the definition of "invention" in Canada's Patent Act?

No, found the court. The problem was the inventors' apparent lack of control over the outcome of the supposed invention. The process involves inserting genetic material into a single egg. The resulting mouse, and its descendents, might or might not have the desired trait, depending on chance and the laws of inheritance.

"In my view," wrote Justice Nadon, "the mouse is not truly reproducible as that term is understood in the Patent Act because too much is left to luck and chance as was the case

in Pioneer Hi-Bred [a well-known 1987 case of the Supreme Court of Canada, where a soy-bean variety was found not patentable] ...The location and even presence and quality of the gene are totally uncontrollable... The variations of the gene are created and controlled completely by the laws of nature and are infinite."

Justice Nadon also noted that the inventor seemed already to have adequate protection, since anyone reproducing the invention would be infringing the method claims in any event.

I spoke to Joy Morrow, of Smart and Biggar, one of the lawyers who represented the applicant Harvard, but she didn't yet know whether her client will appeal.