Mouse case may signal shift to US Law

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Edward Hore
Hazzard & Hore
141 Adelaide Street West, Suite 1002
Toronto, ON M5H 3L5
(416) 868-1340
edhore@ hazzardandhore.com

Who wouldn't want to read a newspaper story about mutant mice? So it's probably not surprising the mainstream press devoted such a lot of attention to the Harvard Mouse case.

It's a very interesting case, but not always for the reasons that seemed to interest the media. Patented super- mice are not about to take over the earth. Nor will the case lead to patented, genetically-modified zombie-like humans.

I won't bore you with another dry recitation of the facts (well, maybe a short one). In early August, the Federal Court of Appeal, in a majority decision by Mr. Justice Marshal Rothstein, ruled that a genetically-modified non-human animal, more specifically an "oncomouse," was patentable.

The ruling overturned the lower court which had upheld the Commissioner of Patents' refusal to allow a patent on claims to the animal itself, although the Commissioner had allowed claims to the method of performing the genetic modification.

In dissent, Justice Julius Isaac would have dismissed the decision for reasons turning on the standard of review. He said the court should defer to the expertise of the Commissioner of Patents, whose decision that the mouse was not patentable had not been shown to be unreasonable, in his view. Isaac supported the Commissioner's cautious approach to patenting new life forms because the question had "serious moral and ethical implications", although he wasn't specific about what they were.

The issue, on one level, is in fact a fairly technical one, of interest mainly to highly specialized patent agents dealing with genetics: how must patent claims dealing with genetic techniques be worded? Patent claims on higher life forms such as mice are old news elsewhere in the world. So the practical issue was really whether Canadian patent applications must be worded differently from those filed in other countries, claiming only a method of modifying the animal, as opposed to the genetically-modified animal itself. Whether such a difference in wording would make any real difference in an infringement action was sufficiently debatable that Rothstein felt obliged to say in the decision that the issue might have some practical effect in some cases.

The Patent Act defines "invention" to be "any new and useful art, process, machine or composition of matter." The issue was whether an animal is a composition of matter. Since animals are composed of matter, Justice Rothstein found there was no reason a mouse, modified by human ingenuity, couldn't be patented.

Does this imply humans could be patented? Rothstein briefly addressed this: "The answer is clearly that the Patent Act cannot be extended to human beings. Patenting is a form of ownership of property. Ownership concepts cannot be extended to human beings."

I found two things interesting about the case. First, the amount of press attention it got was interesting in itself. The National Post, for example, devoted not just a story, but an entire double page spread to the decision. CBC radio covered it at length.

In part, this may be a reflection of public curiosity and uneasiness about genetic engineering. But it also seems to be symptomatic of a big growth in public interest in intellectual property issues generally. Only five years ago, it seems to me, intellectual property cases were rarely or never covered in the mainstream press. That has changed. The Harvard Mouse case is merely the biggest recent example in Canada.

Suddenly, almost every day, the newspapers have a story about a domain name dispute or a copyright issue (Napster etc.) The same week the Mouse case came out, for example, a US court ruled that one of Lilly's Prozac patents was invalid, and made front page headlines around the world.

In a world where information and ideas are ever more widely available and accessible, people are becoming more aware that having the exclusive legal right to sell something under an intellectual property law can be the biggest market advantage there is.

The other interesting thing about the Mouse case is that the court relied heavily on US law, to a greater extent than in any important patent case I can recall. Justice Rothstein noted that the definition of "invention" in the US patent statute and Canada's Patent Act are similar, and cited extensively from the leading US case on the patentability of life forms, Chakrabarty. He strongly disagreed with the Commissioner's view that US case law had little weight in Canada.

This could have important implications. There are a number of key issues about patentable subject matter on the horizon in Canada. The question boils down to: should our law follow the US, or not?

For example, it has recently become clear in the US (but not yet in Canada) that business methods are patentable. That is, new and useful business methods are "inventions." In the US, a mutual fund company, for example, can now patent a method of tracking the value of its funds, and sue its competitors if they use a similar method. As a result, the US is seeing a huge expansion in the nature of patents that can be granted, and the type of businesses that are seeking them. Patents are becoming a key concern in sectors of the economy where they never mattered before.

If the Mouse case means that US jurisprudence on patentable subject matter should be considered persuasive authority in Canada, then some big changes are coming.