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Can the same thing be a discovery in Spain and an invention in England?

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One of the drawbacks of a fragmented patent litigation system in Europe is the existence of contradictory judgments on exactly the same question from Courts of different European countries.

The most recent example of this anomaly can be found in the different conclusions reached by a Spanish Court and, a few weeks later, by an English Court, on whether the method of detecting the presence of a paternally inherited nucleic acid sequence of foetal origin which is not possessed by the pregnant female, in a maternal serum or plasma sample, invented by Dr. Lo, was a "discovery" or an "invention." To put the debate in context, the main claims of this patent are set out below:

"*1. A detection method performed on a maternal serum or plasma sample from a pregnant female, which method comprises detecting the presence of a nucleic acid of foetal origin in the sample, wherein said nucleic acid is a paternally inherited sequence which is not possessed by said pregnant female.*

4. A method according to any one of claims 1 to 3, wherein said detecting comprises amplifying said nucleic acid.

5. A method according to claim 4, wherein said amplification is by the polymerase chain reaction.

7. A method according to any one of the preceding claims, wherein the presence of a foetal nucleic acid sequence from the Y chromosome is detected.

8. A method according to claim 7, for determining the sex of the foetus."

In a Ruling of 12 September 2017, Commercial Court Number 5 of Barcelona rejected an application for a preliminary injunction on the grounds that this claim would allegedly protect a mere discovery. In particular, the Court concluded that:

"8.6 However, this doctrine [meaning the EPO case law] *is not applicable to our case, because the procedure in Claim 1 does not contain any additional technical characteristics, any technical teachings that go beyond the discovery that constitutes its subject. The method in the Claim begins with a natural fact (cffADN taken from a sample of maternal plasma or serum) and concludes with a natural phenomenon (cffADN inherited paternally). And the rest of claims 2 to 19, which are dependent, add a series of methods of detection or diagnostics that are already known, routine and conventional. And, most importantly: ES '700 (EP '963) does not claim uses or applications of*

cffADN, it simply claims methods to detect the discovery, in an attempt to monopolise the same. "

Only two months later, the High Court of Justice (Patents Court) of England and Wales delivered a judgment on 21 November 2017 where it reached the opposite conclusion. In particular, the Judge held that:

"*189. I do not accept that, properly construed, claim 1 is a claim to a discovery as such. The claims are not directed to information about the natural world, but rather to a practical process, namely a "detection method" which uses information about the natural world. Claim 1 is directed to the detection of foetal DNA in a sample of plasma or serum. Such samples do not exist in the natural world and must be artificially created. The claimed method of detection is also an artificial process which does not exist in the natural world. The claim is to a practical process of implementing a discovery, for practical applications. The actual contribution, as a matter of substance, does not fall solely within the excluded subject matter and is technical in nature."*

For the benefit of legal certainty in Europe, hopefully Spanish and English Courts will end up on the same page on this point when the respective cases reach higher instances.

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