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Too natural to be patent-eligible

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Tribunal de grande instance de Paris, 3rd chamber, 1st section, 3 July 2014, *Evinerude* v. *Philippe Giraudeau and Aair Lichens*

While the US decisions in *Mayo Collaborative Services* v. *Prometheus Laboratories Inc. and Myriad Genetics* led the USPTO to issue new guidelines to the attention of examiners on the procedure for subject matter eligibility analysis of claims reciting or involving "*interalia*" laws of nature and natural products, the *tribunal de grande instance de Paris,* in a judgment of 3 July 2014, clarifies the exclusion of discoveries from patent-eligible subject matter.

1. Presentation of the judgment

Philippe Giraudeau is the inventor and the applicant of French Patent ? 01 03485, entitled "*Measuring of environmental levels of polychlorinated dibenzodioxins and of polychlorinated dibenzofurans by using lichens as dosing material*", filed on 13 March 2001 and granted on 20 March 2009.

The patent teaches how to measure air pollution, by exposing lichen to ambient air in different places, collecting and analysing these lichens in order to determine their content in polychlorinated dibenzodioxins or polychlorinated dibenzofurans compounds, and comparing the results of the tests performed on lichens located in specific places with an "*average value of atmospheric impregnation*" calculated from measurements performed on lichens taken from a wider geographical area.

The single claim of the patent as granted is drafted as follows:

"This invention consists in using lichens exposed to chlorinated compound-emitting sources and used as transplants or crops to perform quantitative measurements of polychlorinated dibenzodioxins or polychlorinated dibenzofurans compounds, and to assess the impact on the environment".

On 23 January 2010, Philippe Giraudeau assigned his patent to Aair Lichensn whose activity is to detect air pollution; before this assignment, Aair Lichens had already accused its competitor, Evinerude, of implementing the teaching of the aforementioned patent.

Evinerude brought proceedings against Philippe Giraudeau and Aair Lichens for the revocation of the French patent, in September 2010.

The inadmissibility arguments raised by the defendants having been rejected by a previous judgment of 25 April 2013, the *tribunal* ruled, in the 3 July 2014 judgment, on the revocation of the French patent.

Evinerude argued that the invention the subject-matter of Aair Lichens' French patent was not patentable because:

– it covered a discovery;

– the description was insufficient;

– it lacked inventive step.

The *tribunal* revokes the patent on the grounds that it covers a discovery and considers unnecessary to examine the other two grounds for revocation invoked.

To reach this decision, the *tribunal* first examined the object of the patent by citing the single claim (reproduced hereinabove) and by noting that, although the description does mention the different steps of the process to be implemented, these steps are not included in the claim and therefore do not fall within the scope of protection conferred by the patent.

The *tribunal* then assessed the validity of the patent in relation to the exclusion from patent-eligible subject matter of discoveries.

Pursuant to Article L. 611-10 of the French Intellectual Property Code:

"1) Inventions, in all technological fields, which are capable of industrial application, which are new and which involve an inventive step shall be patentable.

2) The following in particular shall not be regarded as inventions within the meaning of the first paragraph of this Article:

a) Discoveries, scientific theories and mathematical methods; …"

The *tribunal* recalls that, while a mere discovery cannot be patented, a practical application (such as the practical application of a law of nature) may be patent-eligible:

"A mere discovery cannot thus be patented. Indeed, the discovery exists before the human intervention whereas the invention is its fruit. So the discovery brings nothing new to the state of the art since the discovery stands at the stage of the pure knowledge.

However, if the subject-matter of a discovery is not patentable, a practical application may result in granting a patent."

In this case, the *tribunal* held that the single claim of the patent covers the principle of using lichens to measure pollution by polychlorinated dibenzodioxins and polychlorinated dibenzofurans and that, since the process steps (alone eligible for protection) were not claimed, the patent covers a discovery and not a patent-eligible process:

"As drafted, the single claim of the patent does not cover the process steps but only the assertion that steps can be performed to assess the impact on the environment, which is not a process

invention."

2. Comments

The reasoning of the *tribunal* must be approved because the patent claim was poorly drafted.

The judgment of 3 July 2014 does not exclude from patent-eligible subject matter any invention involving laws of nature; but the *tribunal* points out that the claim of such a patent must specify all the steps of the process.

It must be recognised that the claim of the patent at issue was worded very broadly, without specifying that quantitative measurements of pollutants must be performed on lichens, and without specifying how to correlate the measured pollutant concentrations in lichens with the existence of pollution; it is the broad wording of the claim that led the *tribunal* to hold that the patent covers not a patent-eligible process but a mere discovery.

The wording of the judgment suggests quite clearly that the claim could have been considered patent-eligible (without prejudice to the inventive step which was also challenged) if it had contained all the steps of the process described in the patent.

The judgment of the *tribunal de grande instance de Paris* must be compared to the decision of the US Supreme Court of 20 March 2012, in *Mayo Collaborative Services* v. *Prometheus Laboratories Inc*., which held that a process claim must add "*significantly more*" to the mere description of the laws of nature in order "*to transform an unpatentable law of nature into a patent-eligible application of such law*".

The decision of the Supreme Court has been criticised notably because, while the claims did recite steps adding to the mere application of the laws of nature, the Supreme Court disregarded them on the grounds that these additions were not novel and inventive, thus combining the assessment of the patent eligible requirements to that of novelty and inventive step.

The *tribunal de grande instance de Paris* has not followed this path and assessed the patent eligibility requirement in isolation.

The teaching of the judgment is quite close to the USPTO guidelines recently issued, requiring that claims recite steps in addition to the laws of nature "*to narrow the scope of the claim so that others are not substantially foreclosed from using the laws of nature*".

The judgment of 3 July 2014 of the *tribunal de grande instance de Paris* therefore revokes the claim covering the use of a natural product and involving laws of nature on the grounds that it constitutes a non-patent-eligible discovery, as it failed to cover a specific application, but without questioning excessively the patent-eligibility of products and laws of nature.

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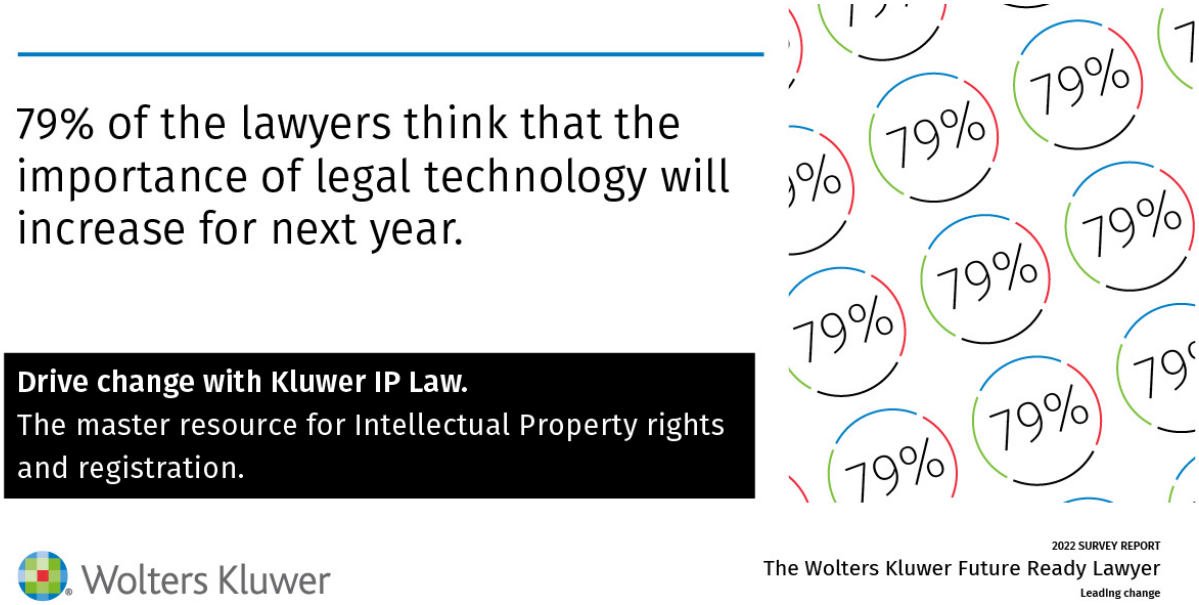

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