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Current Case

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CURRENT CASE

ANIMAL PATENTS: MAN-MADE LIFE FORMS AS PATENTABLE SUBJECT MATTER, *Ex parte Allen*, 2 U.S.P.Q. 1425 (Bd. Pat. App. & Inter. 1987).

The Patent and Trademark Office Board of Patent Appeals and Interferences in *Ex Parte Allen* (hereinafter *Allen*) ruled that man-made life forms may be statutory subject matter under 35 U.S.C. § 101 and eligible for patent protection.¹ In reaching this decision, an Examiner-in-Chief thoroughly discussed the Supreme Court's interpretation of the scope of 35 U.S.C. § 101 and the applicability of that interpretation to the present case.²

In *Allen*, appellants were the developers of a polyploid³ oyster. The patent examiner in *Allen* allowed claims 1 through 7 and 9 through 11, which were drawn to a method of inducing polyploidy in oysters utilizing hydrostatic pressure. The patent examiner rejected claims 8 and 12 through 14, which were product-by-process claims, dependent on the allowed claims, for producing a species of Pacific oysters, *Crassostrea gigas*. The claims were rejected for obviousness under 35 U.S.C. § 103 in view of an article appearing in the *Aquaculture* journal,⁴ and on the ground that the claimed invention did not fall within the statutory subject matter of 35 U.S.C. § 101.

The Board upheld the patent examiner's Section 101 rejection in view of the prior art. Stanley discloses a method of inducing polyploidy in oysters by treating fertilized eggs with cytochalasin B. Although appellants utilized hydrostatic pressure rather than chemical treatment to induce polyploidy in the oysters, the Board ruled that the patentability of a product did not depend solely on the method of production: "If the product in a product-by-process

1. The language of 35 U.S.C. § 101 is as follows:

§ 101. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. *Diamond v. Chakrabarty*, 447 U.S. 303, 65 L. Ed. 2d 144, 100 S. Ct. 2204 (1980).

3. Polyploid: Having more than twice the normal number of chromosomes. FUNK & WAGNALLS STANDARD DICTIONARY 616 (1st ed. 1980).

4. Stanley, *Growth of American Oysters Increased by Polyploidy Induced by Blocking Meiosis I But Not Meiosis II*, 37 AQUACULTURE, 147-55 (1984).

claim is the same as or obvious from a product of prior art, the claim is unpatentable even though the latter product was made by a different process.”⁵

In support of his 35 U.S.C. § 101 rejection, the patent examiner stated that polyploid oysters are living entities which do not fall within the statutory framework of 35 U.S.C. § 101. In addition, the patent examiner stated that an animal produced by the claimed method would be controlled by laws of nature and would not be a patentable manufacture by man. However the Board noted that the patent examiner presented no evidence that the claimed polyploid oyster occurred naturally without man's intervention. Thus, the examiner was left to rely on his position that certain living entities were not within the terms of 35 U.S.C. § 101 in accordance with *In re Merat*⁶ and *In re Bergy, Coats and Malik*.⁷

The decision in *Merat*, a case involving chicken breeding, did not reach the 35 U.S.C. § 101 rejection made by the patent examiner and the Board in that case. *Merat* was discounted in the present action. The decision in *Bergy*, in finding a claimed microorganism to be within the terms “manufacture” and “composition of matter” of 35 U.S.C. § 101, appeared to draw a distinction between the claimed microorganisms and other living entities. Although the court in *Bergy* went on to determine that microorganisms could be patentable, it made it clear that it was only deciding the case before it and was not deciding whether living entities in general were within the scope of § 101.

Both decisions demonstrate that courts have been slow to demarcate the scope of 35 U.S.C. § 101 with regard to living organisms. An explanation for this hesitancy possibly stems from the confusion created by biological scientists who have a tendency to think of plants and animals as distinct groups, with microorganisms (bacteria, fungi, protozoa, etc.) as a third group having some characteristics of both. An example of the confusion that such a line of thinking has created is evidenced in the majority opinion in *Bergy*, which states that “the nature . . . of microorganisms like the one defined in claim 5 are more akin to inanimate chemical compositions such as reactants, reagents, and catalysts than they are to horses and honeybees or raspberries and roses.”⁸

In contrast, the dissent in *Bergy* points out that:

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5. *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985).
 6. *In re Merat*, 519 F.2d 1390, (C.C.P.A. 1975).
 7. *In re Bergy*, 563 F.2d 1031, 195 U.S.P.Q. 344 (C.C.P.A. 1977).
 8. 195 U.S.P.Q. 350.

Such a distinction is purely gratuitous and clearly erroneous. The nature of organisms, whether microorganisms, plants, or other living things, is fundamentally different from that of inanimate chemical compositions.⁹

The dissent in *Bergy* further argued that Congress established the Plant Patent Act because Congress did not intend 35 U.S.C. § 101 to be extended to living entities and that if living entities were to be protectable by patent it would require similar Congressional action, not interpretation of 35 U.S.C. § 101.

The Board in *Allen* contends that the Supreme Court's decision in *Diamond v. Chakrabarty* resolves any debate on the scope of § 101. In that case the court noted that the use of the expansive terms "manufacture" and "composition of matter" modified by the comprehensive term "any" indicated that Congress "plainly contemplated that the patent laws would be given wide scope." The Supreme Court also noted that the legislative history of § 101 supports a broad construction and concluded from the Committee Reports accompanying the 1952 Act that Congress intended statutory subject matter to "include anything under the sun that is made by man."

The Board in *Allen* went on to state that whether or not the claims are drawn to a living entity is not controlling on the question of whether the claims are drawn to patentable subject matter under § 101. Thus, *Allen* is significant for its clarification of the Patent Office's stance regarding animal patents. As a guide for the future, the Board in *Allen* sees the issue in determining whether claimed subject matter is patentable under § 101 as "simply whether that subject matter is made by man. If the claimed subject matter occurs naturally, it is not patentable subject matter under § 101."¹⁰

Following the decision in this case, the United States Senate on May 28, 1987, voted to bar the Patent Office from expending funds during the fiscal year 1987 for the purpose of granting patents on animals changed through engineering technology.¹¹ Hearings on animal patents have continued, including a House hearing on November 12, 1987. Typically, the Patent Office is behind the times in providing patent protection for new technology, resulting in Congressional action, such as the Semiconductor Chip Protection Act, to fill the gap in protection left open by the Patent Office. With

9. *Id.* at 352.

10. *Ex Parte Allen*, 2 U.S.P.Q. 443 (Bd. Pat. App. & Inter. 1985).

11. The Senate's action came in the form of an amendment to supplemental appropriations legislation (H.R. 1827).

regard to providing protection to living entities, the roles typically assumed by the Patent Office and Congress appear to have reversed. Whether the Patent Office's progressive attitude will continue upon the close of the fiscal year 1987 remains to be seen. Clearly, if everything under the sun that is made by man is patentable, Congressional action will be required to limit the scope of § 101 in the future.

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