BEFORE THE
HIGH COURT OF STATE OF MIMOSA
(ORIGINAL JURISDICTION)

(AUGUST 2000, O.P. :- ...../2000)

IN THE MATTER OF **REPLY WITH REGARD TO**	:	The case concerning the grant of Intellectual Property Rights Protection in the State of Mimosa for the designer Plants technology.

DAF **……Applicant**

Versus

FLO **……Respondent**

REPLY TO THE PETITION FIELD INVOKING THE ORIGINAL JURISDICTION OF THE HIGH COURT OF MIMOSA

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STATEMENT OF JURISDICTION

The Respondent humbly submits in the matter of a reply with regard to the petition concerning the grant of Intellectual Property Rights invoking the original jurisdiction of the Honourable High Court of Mimosa.

STATEMENT OF FACTS

Mr. Anther, a national of the island of Pollen and a scientist of the highest repute invents a molecular manipulative technology by which designer plants can be created. He sets up a company Designer -a Flower Limited (herein after referred to as ‘DAF’) and immediately applies for a Patent, both in Pollen as well as other countries through the PCT (Patent Co-operation Treaty) route.

The technology which Mr. Anther, refers to as ‘design - a - flower’ enables a customer to order a desired design on any flower, for examples, a striped, spotted and checked rose or even cartoon characters on tulips etc.

Stigma, a national of “Mimosa” discovers that under the laws of the said country, it takes four years for a patent application to be published and six years on an average for a patent to be granted. The laws of Mimosa do not enable the filing of an infringement action before the patent is granted; however damages can be claimed retrospectively from the date of publishing of the contents of the specifications in the official gazette for opposition purposes Therefore, stigma copies the technology for a period of three and a half years before it is published.

Using a series of designer plants, stigma reverse engineers and announces a rival venture called Floral Mania Ltd. (Herein after referred to as ‘FLO’).

Within a few months, FLO company’s business in the country Mimosa picks up enormously and consequently DAF’ sues ‘FLO’.

QUESTIONS PRESENTED

A. Whether without a patent, a remedy for infringement action of a patent exists.

B. Whether a patent may or may not be granted on ethical and social considerations.

C. Whether the patent in the instant case is really one for biological substance and not for genetic or molecular manipulation technology as under the existing laws of the country patents may be granted for micro or molecular technologies and not for live forms or biological materials.

SUMMARY OF ARGUMENTS

Patent law creates a right for anyone aggrieved by an act of infringement to take to court the alleged infringer and seek a remedy for the infringement. This is a provision supported by the TRIPS agreement as well as by state practise. However, for the remedy of a infringement of a right to he granted, there must, first and foremost resist a right. Since no Patent has been granted in the instant case, it is submitted that no infringement has taken place and therefore no remedy can be claimed.

A patent right is an independent right and like all independent rights, it may he restrict in the interest of public morality and on ethical and social considerations. The subject matter of the present case is one by which designer pants and flowers may be created. Patruting this kind of a process, it is submitted is equivalent to permitting the disturbance of the fragile ecological balance of the Earth. Further, this process has been used to make products that appeal to purient minds. Also, patenting such a process goes against the over-riding institutional goal of science. Therefore, it is submitted that a patent in the instant case, will not be granted on moral, ethical or social grounds.

The patent in the instant case is being sought for a biological process and for biological lice forms. Under the TRIP agreement, a member may exclude these from being patented.

The laws of the state of Mimosa, Therefore do not violate international law by not providing patent protection for such subject-matter. It is submitted, therefore, that in the instant case, a patent cannot be granted.

WRITTEN SUBMISSION

A. WITHOUT A PATENT, A REMEDY FOR INFRINGEMENT ACTION OF A PATENT DOES NOT EXIST.

The right of an aggrieved under patent law to take to the court an alleged infringer is for the infringement of a patent [1], The question of an infringement, however arises only when a patent is granted [2]. When the question is as to the validity of the patent itself; and no patent exists, then it is Submitted that question of an infringement itself does not arise [3]

Under the laws of Mimosa, it takes four years for a patent application to be published and six years on an average for a patent to be granted.

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1 . Jon Holyoak and Paul Torremans, Intellectual Property Law p.123 (Butterworths, London 1995). See also Reichrnann, "Legal Hybrids between the patent and copyright Paradigms", 94 Col..L.Rev 22432, 2559 (1994); Peter Pan Manu Featuring Corporation v. Corsets Sithoutte Ltd. [1963] 3 All E.R.402.

2. Robin Jacob and Daniel Alexander, A Guide book to Intellectual Property. p.49 (sweet and Maxwell 4th edn. 1993); Cornish, Intellectual Property p. 159 (sweet and Maxwell 2nd edn. 1 989); F. Scherer, The Economic effects of compulsory patent licensing p. 66 (1977). Notes, "Limiting the Anti Competitive prerogative of patent owners: Predatory standards in patent licensing", 92 Y.I.J. 831, 840 (1983).

3. Supra n.1 at p. 1 1 7 See Generally Bailey & Friediaender, "Market structure and Multi Product Industries " 20 J.Econ. lit. 1024, 1040 (1982); Feist Publications lnc v. Rural Tel.Sow Co; 499 U.S. 340,349 (1991); J.G. Starke, "Protection of Intellectual Property Rights under International trade law," 65 A.L.J.417 (1991).

Moreover, the laws of Mimosa do not enable the filing of an infringement action before the patent is granted. (4)

Patent laws set out the remedies available to the patent owner who has rights against an infringer (5). Article 59 of the TRIPS agreement speaks about the remedies available to a patentee. The article states that:

"Without prejudice to other rights of action (15) open to the right holder and subject to the right of the defendant to seek review by a judicial authority competent authorities shall have the authority to order the destruction or disposal of infringing goods in accordance with the principles setout in Art.46 (7). ..... In countries like United Kingdom [8] , United States [9] Germany [10] , Japan, [11] Netherlands, [12] Australia [13] etc. the remedies granted generally are (1) Permanent Injunction (2) Damages (3) Account of Profits, etc. The remedies available in all these countries show the minimum international standard maintained in granting relief to an infringed patentee.

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4. Refer Statement of Facts, Pg. 2 para 2.

5. Gary M. Ropski, Butterworths patent litigation enforcing a Global Patent Portfolio. P.77 (Butter worths 1995) see also Neil R. Belmore, D Doak Horne, A kelly Gill, Canadian Patent Infringement remedies P.313 (Butterworths 1995); Gary M.Ropski, Remedies in the United States Patent litigation. p.333 (1994).

6. The other rights of action open to the right holder as per the TRIPS agreement are (1) Art.44 of the agreement which speaks about granting of injunction against infringement. (2) Art.45 deals with damages (3) Art.46 deals with other remedies.

7. Art. 46 deals with other remedies. It states that "in order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed.

8. The remedies available to a patentee in the United Kingdom are set out in S.61 of the Patents Act, 1977.

9. Remedies in U.S.A for patent infringement are such that damages are awarded. Most plaintiffs are satisfied with injunctive relief.

10. The statutory basis for the patentee's damage claim is said in See. 1 39 of the German any infringer. Also any Person committing such an act wilfully or negligently shall be liable to compensate the injured party for damage resulting there from.

11 . As relief for the infringement in Japan, a patent owner may expect to recover damages (monetary relies and prevent further infringement (injunctive relies. Under the new rule which was introduced in the patent Act, 1957 the profits an infringer made from the infringement are presumed to be equivalent to the damage a patent owner suffered from infringement at minimum, a reasonable royalty is awarded to the patent owner.

12. Remedies available in the Netherlands is granted by Dutch Courts in both summary proceedings and proceedings on the merits. Injunctions are also granted.

13. In Australia , the Successful patentee in an infringement action is entitled under S. 122 of the Patents Act, 1 990 to an in junction until the patent expires and at the option of the plaintiff, either damages or an account of profits.

However the law also states that only a granted patent can be infringed [14] Moreover to qualify for patent protection, an invention must fall within patentable subject matter. [15] It is submitted that the technology in the instant case is one where a patent may or may not be granted [16]

However , the laws of the country also states that damages can be claimed retrospectively from the date of publishing of the contents of the specifications in the official gazette for opposition purposes [17], Assuming Arguendo that the technology is of such kind that patent will be granted, then as per the laws of the country, the petitioner has the right to claim damages retrospectively. [18]

In the instant case, though Mr. Anther has applied for a patent in Mimosa through the PCT route, it has not been granted yet, based on the laws of Mimosa. There fore, it is submitted that as no patent has been granted, there exists no infringement. In the light of the above said arguments, it is submitted that without a patent , a remedy for the infringement action of a patent is futile.

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14. See Andrew Christie & Stephen Gare, Blackstone's Statutes on Intellectual Property (2nd edn. 1995),

15. See Rebeeca S. Eisen berg, 11 Proprietary Rights and the Norms of Science in Biotechnology Research " 97 Y.L.J 177 (1987).

16. Refer statement of Facts pg. 3

17. Refer Statement of Facts.

18. Ibid. Emphasis supplied.

B. A PATENT MAY OR MAY NOT BE GRANTED ON ETHICAL AND SOCIAL CONSIDERATIONS

An independent right would definitely need an *ordre public* provision to protect society from the misuse of the independent right by putting it to use for undesirable or dangerous purposes("). The principle implication of a patent is that it is deemed to be an item of personal property and subject to what follows, can be dealt with by its owner just like any other item of personal property [(21)]. It is therefore, an independent right and the requirement of an ordre public provision for this right has been recognized in Art. 27 paragraph 2 of the TRIPS agreements which states that "a member may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality....."

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19. Jon Holyoak and Paul Torre mans , Intellectual Property Law p.77 (Butterworths. 1995); See also Nott, "Patent protection for plants and animals", 3 EIPR 79 (1992); Jones, "Biotechnological patents in Europe - update on the Draft Directive" 12 EIPR 455 (1992).

20. Dennis Campbell and Susan Cotter, International Intellectual Property Law - New Developments p.107. (John Wiley & Sons. Inc . 1995). See also Jay David Schainheiz, "The validity of Patents after market Testing : A new and improved experimental use Doctrine ?" 85 col. L.Rev. 371 (1985); D.Chisum, Patents. A Treatise on the Law of Potentiality. validity and Infringement (1984).

It is therefore submitted that a patent may not be granted in respect of inventions which might encourage immoral behaviour or be a threat to public-order. This principles has been reiterated by several nations in their national legislations[21].

The subject matter for patentability in the instant case is a process by which designer plants can be created.[22] The process has been used to enable Customers to order desired designs on flowers. This has led to the whole concept of flower arrangement taking on a new meaning altogether resulting in the once cherished natural flowers now being ignored [23]. it is submitted, therefore, that the processes for which the patent is sought for in the instant case, has the potential to manipulate nature [24] and thereby disturb the fragile ecological balance of nature [25]. It may, therefore be prevented from being patented on ethical and social considerations.

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21. Section 1(3) of the 1977 Act states that A patent shall not be granted - (a) for an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti social behaviour. Article 53 of the convention on the grant of European Patents, 1973 (EPC) speaks about the exclusion from patentability inventions the publication or exploitation of which would be contrary to order publique or morality...

    Patent Act no 57/1978 of South Africa also has a clause which speaks about exclusion from patentability It states Any thing contrary to well-established natural laws and anything expected to encourage offensive or immoral behaviour.

22. Refer statement of facts.

23. Refer statement of facts.

24. See. International Encyclopedia for the Social Sciences Vol. 9 [The MacMillan Co.& the Free press New York - MacMillian Publishers London 1972);

25. See, Illustrative Science and Invention Encyclopedia Vol. 6 (H.S. STUTT Man Co; Inc. Publishers 1977); Encyclopedia Britannica Vol. 13 (15th edn. 1974)

Further, using a series of designer plants, the Respondent has been able to produce products that appeal to prurient minds which has helped the Respondent to Popularise his business in the country of Mimosa enormously[26]. Setting aside considerations as to the legality of such an act, it is submitted, that this is a clear indication that the subject matter of the patent, in the instant case is capable of being detrimental to public morality [27]. Therefore, a patent may again be prevented bearing in mind moral and social considerations. It is also submitted that any method of Patent exploitation not socially efficient is beyond the legitimate scope of a patent for reasons of morality and public order.

This is because granting property rights in research discoveries is antithetical to the norms of science as it is contrary to scientific norms to claim exclusive rights in research discoveries [28].

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26. Refer Statement of facts

27. Morality is defined as the degree of conformity of an idea, Practice etc. to moral principles; points of ethics, right rnoral conduct. See Illustrated Oxford Dictionary P 528 (Oxford University Press 1998); See also Black's Law Dictionary p. 629 (5th edn. 1995); Bouviers Law Dictionary p. 541 (3rd revision 1914).

28. See fox, "Patents engineering on Research Freedom"; 224 SCIENCE 1080 (1984); Kitch " The nature and function of the Patent System", 20 J.L. & Econ. 265, 278 (1977)

It is a commonly held conception that the overriding institutional goal of science is "the existence of certified knowledge" [29] Patent Protection therefore has been denied to theoretical or abstract discoveries, laws of nature, principles of nature etc. [30]. Based on the above facts and arguments, it is submitted that patent in the instant case may not be granted under the existing laws of the country.

C. THE PATENT IN THE INSTANT CASE IS REALLY ONE FOR BIOLOGICAL SUBSTANCE AND UNDER THE EXISTING LAWS OF THE COUNTRY, PATENTS MAY BE GRANTED FOR MICRO OR MOLECULAR TECHNOLOGIES AND NOT FOR LIVE FORMS OR BIOLOGICAL MATERIALS.

Biological substances [31] or materials have been defined as substances or materials of or relating to biology or living organisms.

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29. See Generally Note , "Microorganism and the Patent Office To Deposit or not the Deposit, that is the question", 52 FORDHAM L. Rev. 592 (1984); Hevy & Wendt, "Microbiology and a Standard Format for infrared Absorption spectra in Antibiotic Patent Application", 37 J. PAT. OFF. Soc'y 855, 859 (1995); Meyer, " Problems and Issues in Depositing Microorganism for Patent purposes", 65 J. PAT, OFF. Soc'y 455 1983).

30. See Chisum, "Sources of prior Art in Patent Law," 52 WASH L. Rev 1 (1976); Gordon, " Fair use as Market Failure : A Structural and Economic Analysis of the Betamax Case and its Predecessors", 82 Col.L. Rev. 1600 (1982); Turner, " The Patent system and competitive policy" 44 N.Y. U.L. Rev 449,. 455 (1969); Hant man, "Experimental use as an exception to patent Infringement", 67 J. PAT. Off Soc'y 617 (1985).

31. See. Random House Dictionary of English Language (The unabridged edition 1966), See also Haisbury's Laws of England (4th edn. reprinted 1997).

When a biological process is explored for Industrial and other purposes it is deemed to come within the ambit of biotechnology [32].

Under the TRIPS agreement plants, animals and processes which are essentially biological and meant for the production of plants or animals may be excluded from patentability by members [33]. The existing laws of the state of Mimosa are therefore on conformity with the provisions of international law [34].

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32. See D. Hartridge and A. Subramaniam, "Intellectual Property Rights - The issues in GATT", 22 Vand . J of Trans. Law 898 (1989): J.H. Reichman,, "Intellectual Property in international trade : opportunities and risks of GATT connection", 22 Vand. J of Trans. Law 829,860 (1989); R. Rozek and Rapp,, "Benefits and costs of intellectual property protection in developing countries", 24 line of world Trade 75 (1990); A.V. Deard off, "Should Patent protection be extended to all developing countries?" 13 World Economy 501 (1990), C. Correa, "The pharmaceutical industry and biotechnology: Opportunities and constraints for developing countries", 16 World Competition 43 (1981).

33. See generally. A Yusuf and A. Man 'cayoven Hase, "Intellectual property protection and International Trade exhaustion of rights revisited", 16 World Competition 130 (1992); P. Tanden, : "Optimal Patents with compulsory Licensing", 90 Journal of Political economy 484 (1982).

34. See Generally, Ian Browlie, Principles of International Law (4th edn. 1990); J.G. Starke, Introduction of International Law Shaw Malcon, International Law (10th edn. 1989); (4th edn. 1997); Martin Dixon, Text book on International Law (1990); Rebeeca M.M, Wallace, International law (2nd edn. 1995)

A biotechnological invention must be patented only if it is a non-biological or microbiological process [35] . Similarly, a patent must be granted to a plant or animal only if it is a micro-organism. The patent in the instant case is being sought for a molecular manipulative and hence it is not a microbiological process [36]. It is a process relating to biology or living organisms as it is a process by which designer plants can be created. It is submitted that such a process cannot be a non-biological process, A patent, therefore will not be granted for this process in the state of Mimosa as the laws of the country do not permit the patenting of biological material [37].

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35. Art. 27 (3) (b) of the TRIPS agreement. See also Sang - Gon kim, Kong-Kyun Ro and Pyung-II yu, "Intellectual Property protection policy and technological capability", 21 Science and Public Policy, Journal of International Science Policy Foundation 121 1994)

36. Refer statement of Facts.

37. Rebecca S. Eisenberg " Proprietary Rights and the norms of science in Biotechnology Research", 97 Y.L.J 177, 181 (1987) Gorbstein, "Biotechnology and open University science' 10 Sci. Tech & Hum. Valves 55 1985) Note patent and Trade secret protections in University Industry Research Relationships in Biotechnology", 24 Harv. J. on Legis 191, 201 (1987)

The petitioner, in the instant case has used the biological process design production of flowers with desired design, Industrial application is one of the main requirements that have to be satisfied for a patent to be granted for a subject matter [38] . In the instant case, this requirement has been satisfied by applying the process for production of live forms. Hence, it is submitted that a patent in the instant case cannot be granted [39].

Further plant varieties may be protectable either by patents, a sui *generis* system or by any combination of the two. However, intellectual property protection in the area of living matter is still in its early years of development This [40] is reflected in Art. 27.3 (b) of the TRIPS agreement and in he different choices for such protection in various national legislations [41]. It is therefore submitted that a patent in the instant case cannot be claimed as a matter of right, for the protection of the new plant varieties that may be created using the process for which the patent is sought.

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38. See Markle & Robin, 'Bio technology and the Social Reconstruction of Molecular Biology", 10 Sci. Tech & Hum. Valves 70 (1985), B. Bugbee, Genesis of American Patent and Copyright Law P.57 (1967)., W. Hamilton, Patents and Free Enterprise P. 154 194 Dobkin, "Patents Policy is Government Research and Development contracts", 53 Va. 1. Rev.. 564, 591 (1967)

39. Biggart, Potentiality. Disclosure Requirements. Claiming and infringement of Micro organism-Related Inventions in genetically Engineered Micro organisms & Cells. The law & the Business (1987); Chisum, 'The patentability of Algorithms", 47 U.P. T.T. L. Rev. 959 (1986).

40. Article 27:3 (b) of the TRIPS agreement calls for a review four years after the date of entry into force of the Agreement. The review will thus take place one year before the end of the five year transitional period of the Agreement on TRIPS for developing Countries. See also R. Saliwanclik, Legal Protection for Micro Biological and Genetic Engineering Invention P. 9 (1982).

41. See generally the legislation of United States and European Countries. See also Mousica Y. Youn, “Neither Intellectual or Property”. 107 Y.L.J. 1162 (1997); Sobel, Preserving Trade Secret Protection, in Practising Law Institutes, Patent, Copyright, Trademarks & Literary Property course Handbook series No: 224, Protecting Trade Secrets p. 567 (1986)

‘CONCLUSION AND PRAYER’

In the light of the above said grounds and other grounds to be urged at the time of argument, the Respondent most humbly prays that this Honourable Court may adjudge and declare that:

(A) Without a patent, there is no remedy and the action fails;

(B) A patent may or may not be granted on ethical and social consideration.

(C) The Patent is really one for a biological substances and not for genetic or molecular manipulative technology and that under the existing laws of the country, patents cannot be granted on live forms or biological materials although they can be granted for micro or molecular technologies.