



NON- PATENTABILITY ON THE BASIS OF 'ORDRE PUBLIC' AND MORALITY

By *Kiran Sharma*

From *Hidayatullah National Law University, Raipur*

Abstract: Inventions which are contrary to public order and morality should not get patented otherwise it might be harmful to national security and could lead to the extinguishing of moral principles of the people. These moral principles and public order vary from country to country, but the question which arises is that these set code of conduct by respective countries need to be followed or the advancement of technology should be seen or it should be weighed upon on by the exercise of balance.

Introduction

States have the right to protect the public interest, and patent law is not an exception to this general principle. Based on a long established tradition in patent law (particularly in the European context), TRIPS allows (but not mandates) two possible exceptions to patentability, based on 'ordre public' and morality. The implementation of these exceptions, which need to be provided for under national law in order to be effective, means that a WTO Member may, in certain cases, refuse to grant a patent when it deems it necessary to protect higher public interests. The term "ordre public", derived from French law, is not an easy term to translate into English, and therefore the original French term is used in TRIPS. It expresses concerns about

matters threatening the social structures which tie a society together, i.e., matters that threaten the structure of civil society as such. "Morality" is "the degree of conformity to moral principles (especially good)". The concept of morality is relative to the values prevailing in a society. Such values are not the same in different cultures and countries, and change over time. Some important decisions relating to patentability may depend upon the judgement about morality. It would be inadmissible that patent office's grant patents to any kind of invention, without any consideration of morality.

There are various theories given by different persons to explain the claim and justification of patent system. Among these various theories "incentive" or the "reward theory" are the most common. To simplify patents are rewards in the form of monopolies granted to persons who has developed new, inventive, and useful products or processes and in return it is expected that such rewards will foster inventors to come up with useful inventions at higher rate. However this is a debatable issue that whether patent system has fostered a higher rate of new useful inventions¹.

In developing countries, patent system is not just only to increase the innovation, but is attuned to take into accounts the concerns of "access" to technology most significantly in the field of pharmaceuticals and public health. Hence it is evident that the patent regime cannot be segregated from other public policies such as moral values and health. Right from start there is conflict between the patent rights on one hand and the public policies, social values and



fundamental rights on the other. The issue is to balance out between these conflicting and competing concerns and to come up with regime that would, while promoting innovation, does not erode important issues¹

Public Order and Morality: The Concept

The exclusions of ‘public order’ or ‘morality’ from patentability vary from country to country as the scope of application of these exclusions largely depends upon local cultures and practices. What is considered as immoral in one country can be considered as normal practice and comes under public order. The terms ‘public order’ or ‘morality’ are full of ambiguity and vary according to the practices of the particular state. Looking into the issue that whether law is a reflection of morality or the same can be divorced from the former, the positivist school of law states that the law should be separated from morality and should be based on logic and reasons. However the school of natural law argues that law reflects the morals and norms of the society and it cannot be based purely on rules of reason and logic. Accordingly the positivist will argue that the patent shall be granted as long as the invention is novel, inventive and useful and morality should have no role to play in the grant of the patent. On the other hand school of natural law will present opposite views that an invention which offends society’s morals should not be granted patents reason being the natural schools fundamentals principle that the law is a reflection of morals of the society and something which offends morality of society cannot be given a legal character¹.

There is no universally accepted notion of ordre public. Member countries have some flexibility to define which situations are covered, depending upon their own social and cultural values. Under the TRIPS agreement also, ordre public is one of the recognised grounds for exceptions from patentability¹.

Article 27.2 of TRIPs states that:

“Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law”.

The words ‘ordre public’ and morality exclusions as provided in Art. 27.2 are not easy to define. According to one interpretation ordre public means “expresses concerns about matters threatening the social structures which tie a society together i.e. matters that threaten the structure of civil society as such” and morality means “degree of conformity of an idea to moral principles”. Both ordre public and morality are reflective of the prevailing principles, socio-cultural and religious values of member countries thus it is not possible to provide objective definition of the same¹.

As we can see there is no specified definition of public order and morality and there can’t be one because it is such a thing which is wide open to the perception of people of country and it totally depends



upon on the nature of a country, order and moralities are such a thing which vary from country to country as each countries need, demands, culture, perspective is different and so the people is different. One thing might be moral in one country and immoral in another so there can't be any defined meaning of this subject matter.

Even though we specify the meaning of public order and morality for all but we can understand the meaning of same as the basic understanding of these term will be same for all. And what I understood from public order is anything which is concerning the public as a whole, normal standards and operations of society. Morality could be understood as a system of moral conduct, anything which people follows and they have belief in. Anything in contravention of which might hurt the sentiments of the people. That's why they have categorised the ideas in good and bad conduct.

Where some standards, conduct, principles, order has already been set by the people of any society and they are following it without any logic or reason or their might be a valid reason for such action but a thing need not only be against the law for raising an issue, even when it affects the beliefs, sentiments and already set principles of the people that could also raise a problem be it in any area of subject.

Patent law also deal with such issue, where a patent is given on any kind of invention where it fulfils the criteria of novelty, non-obviousness and industrial application but it could also be stopped from being patent even after fulfilling such required conditions where it contravenes the public order and morality. No invention could be as

important if it affects the already set standards and mode of conduct of the people. Not only national law, it is recognised by international law as well. As we have already seen above that it has been included in TRIPs as well that inventions will not get patent exploitation of which is necessary to protect ordre public or morality.

Practice at the European Patent Office

The EPC does not provide definition of 'ordre public' or morality. The board of Appeal has indicated that they are to be construed narrowly. 'Order public' should be taken to mean the protection of public security and the physical integrity of individuals as part of society. The concept encompasses the protection of the environment. As for morality, the board said that in the context of Art. 53(a) morality is founded on the totality of the accepted norms which are deeply rooted in European society and civilization. Neither 'order public' nor morality is susceptible of being determined by surveys or opinion polls¹.

The Paris convention provided that the patentability of an invention must not be affected by the fact that a particular patented product (or product must be obtained by the process) is subject to restrictions or limitations resulting from domestic law¹. Both the Paris convention and TRIPS agreement only prohibit excluding patentability on the grounds that a particular invention is contrary to domestic law; so where something contravenes international law it may be non-patentable on the ground of order public and morality¹.



The words *ordre public* are intended to convey the fact that an invention contrary to national law would not necessarily be contrary to *ordre public*. To be excluded the invention must offend a fundamental principle of society. The concept of morality was purposively not left to contracting states; rather a centralised view was to be taken by the EPO; although it was acknowledged that this would lead to a concept at variance with that adopted in contracting states¹.

A European patent application cannot contain matter which is contrary to *ordre public* and where it does this need not be published so as to ensure that the *ordre public* exclusion is not illusory.

The EPC provides at art 53(a) that¹:

“Inventions the commercial exploitation of which would be contrary to “ordre public” or morality such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the contracting states.”

The meaning of morality was first considered in EU in the 1989 *Onco-mouse decision*¹ in that case, the question of patentability of mice had come up for consideration that had been genetically modified so that they develop cancer; a result that the applicants hoped would be useful in cancer research for humans. After its initial rejection, the Board of Appeal expressed the view that careful weighing up of the suffering of animals and possible risks to the environment should be weighed against the invention useful to mankind. Applying this utilitarian balancing act, on remission of the case, the Examining

division held that the subject matter could be patented¹. In US it was earlier granted patent.

Developments in technology have associated risks. Genomes are discovered by research into disease. Patent for such inventions can raise legal, ethical and moral issues. The issue of patenting of genomes has become highly controversial in the context of application for patenting human genomes.

This exception is not related to whether the Patenting of the invention is contrary to *ordre public* or morality, what is important is its exploitation. *In plant genetic systems, glutamine synthetase inhibitors*¹ the invention related to the genetic engineering of plants and seeds in order to make them herbicide resistant. The opponents argued that the invention was not patentable by reason of article 53(a) EPC. It is generally accepted that the concept of *ordre public* encompasses also the protection of the environment.

In the board's judgement, none of the claims of the patent on suit refer to the subject matter which related to a misuse or destruction use of plant biotechnological techniques because they concern activities and products, which cannot be considered to be wrong as such in the light of conventionally accepted standards of conduct of European culture. Alleged environmental consequences due to these activities will have to be considered against the background of the *ordre public* issue¹. On this basis it was concluded that where the exploitation of the invention was likely to prejudice the environment, the invention would be excluded from patentability under article 53(a). The board at the same time



rejected that a balancing exercise was not the only way of patentability, while holding that although the morality provision is to be construed, it should not be disregarded. This is the case even it is difficult to judge, whether the claimed subject matter is contrary to ordre public or morality.¹

The fact that exploiting an invention is unlawful in a contracting state is immaterial to determining whether it is contrary to morality or ordre public. The exclusion should be narrowly construed and should reflect the current views of society in relation to morality and technology. The threshold has even been expressed for morality as something which is universally regarded as outrageous. Such views, however, cannot be obtained from opinion polls or the like as they do not reflect the right standard¹.

The rule under the Patent Act 1977 is that a patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality. The exception is restricted to the exploitation of the invention and no longer includes publication, but it is reasonable to the invention and no longer includes publication of an immoral invention would lead someone to exploit it¹.

The ethical status of biotechnology inventions was addressed by EU biotechnology directive [also to conform to TRIPS agreement article 27(2)]. Article 6(1) of directive, taking a middle ground affirms the relevance of ethical considerations in so far as it provides that inventions shall be unpatentable where their commercial

exploitation would be contrary to order or morality. It however adds that exploitation shall not be considered to be contrary to morality because it is prohibited by law or regulation¹.

Article 6(2) of the above directive however gives specific examples of types of inventions not patentable. The excluded inventions are:

- Process for cloning human beings
- Process for modifying the germ line genetic identity of human beings
- Use of human embryos for industrial or commercial purposes
- Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial benefit to man or animal and also animals resulting from such processes.

The biotechnology directive has been incorporated into the EPC and it applies to all patents and for this purpose the directive and its recitals can be used for the interpretation of the convention. Where an invention offends art 6(2) of the directive as incorporated into the convention, it is automatically contrary to art 53(a). The list in art 6(2) is only exemplary, rather than exhaustive, therefore where a biotechnological invention is not that list it is necessary to go on and consider art 53(a) substantially¹.

*R. v. Leland Stanford/modified animal*¹ the patent for an immune-compromised chimeric mouse was upheld and the EPO ruled that the controversial nature of the technology did not act as a bar to patenting.



In the opposition proceedings, the patent was amended to exclude human or animal embryonic cells. The case involved an immune compromised mouse that had been implanted with human tissue. The production technique involved the use of cells and tissues from aborted fetuses or children below the age of three years to create an animal- human chimera. The claim extended to any “chimeric non human mammalian host” comprising certain stated elements. The case was fought on issues of novelty, inventive step, sufficiency of disclosure and ordre public and morality.

On the issue of ordre public and morality, the opposition division carried out the balancing test and noted that the claimed invention provided the only animal model for HIV- 1 infection and could be used to test potential anti-AIDS therapies before human trials were undertaken. Other benefits included the promise of a supply of human cells and organs of transplant in the future. The opposition division dismissed the hypothetical potential risks associated with the invention. In order for risks to be taken into account, they had to be conclusively documented hazards and not just possibilities. Further the opposition division noted that “as long as claimed invention has a legitimate use, it cannot be the role of the EPO to act a moral censor and invite the provisions of morality”¹

The Indian Position

An invention should not be excluded as being not patentable merely because a technology is dangerous. There is a general perception that new technologies will involve new risks. In determining the merit of new technology there must be a careful

weighing up of the risks vis-a-vis positive aspects. The issue of morality will come into play in cases of new technology involving higher life forms where not only should the risk be considered, but also the possible harm which is done to such higher life forms. As section 3 excludes a number of inventions as being not patentable, the question of morality has to be determined for each invention before the grant. The invention has to be examined, and the possible detrimental effects and risks have to be weighed and balanced against the merits and advantages promised¹.

Patent eligibility means the subject matter that is open to patenting. Patents are granted to inventions that satisfy the statutory requirements of novelty, inventive step and industrial application. The Indian patents act corresponds to the negative method of excluding the categories of invention that are not patent eligible. The Indian Patent Act, 1970 contains a non exhaustive list of things which shall not be regarded as inventions¹.

Section 3(b) states that:

“an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment”.

For better understanding some of the example could be an apparatus for injecting opium into human body for faster absorption would not be patentable as it would affect human health. Furthermore, a machine for



polluting air would not be patentable as it would be prejudicial to the environment. Moreover, a camera that can capture naked pictures of dressed persons might also not be patentable because it would be contrary to public order and morality¹.

This section has not been invoked by the patent office too often, except in the cases pertaining to public health concerns, however, one of the recently decided applications i.e., Application no. 1375/DELNP/2009 was refused by the patent office on the basis of section 3(b) catches an obvious attention. The invention was related to a method and device for controlling the position of numbering wheels of a numbering device as used in printing presses for carrying out numbering of printed documents, especially banknotes and the like securities. According to the Applicant, a particularity of this numbering device resides in that each numbering wheel of the numbering device is driven into rotation by its own independent driving mechanism and can be set to any desired position independently from the other numbering wheels.

The application had independent claims on the device and the corresponding method respectively. Subsequently, the examination report/s raised objection under section 3(b) and the novelty and inventive step of the invention in view of few patent prior arts. The Controller majorly refused to allow the patent for grant in view of the restriction posed by section 3(b).

The Controller observed that the invention used in printing presses for carrying out numbering of printed documents, especially bank notes and the like securities could be

contrary to public order or morality as per section 3(b). It seems that the Controller has taken a narrow view by dismissing the said application on the basis of section 3 (b).

It is noticeable that the same patent is granted in Europe, Japan and China. On the face of it, the grant of patent would not imply that the Applicant will make use of the said invention for wrongful purposes such as printing currency, bank securities without authorization. In any case such use would attract penalties under the Indian Penal code and thereby granting patent may have its own consequences. Nevertheless, it would be difficult to see advancement in technology if the protection scheme falls short of taking care of the technology in such sensitive areas¹.

In India, for biotechnology inventions, which describe biological material in the specification, the law provides for deposit of such biological materials at a recognized depository. The manual of patent practice and procedure requires the invention to be described completely in the specification to enable a person skilled in the art to be able to carry out the invention by reading the specification. However, there are no cases in India that talk about differing written description or enablement standards for biotechnology inventions. The Draft Manual of Patent Procedure, 2010 provides that Any biological material and method of making the same which is capable of causing serious prejudice to human, animal or plant lives or health or to the environment including the use of those that would be contrary to public order and morality are not patentable. It further provides that the processes for



cloning human beings or animals, processes for modifying the germ line, genetic identity of human beings or animals, uses of human or animal embryos for any purpose are not patentable as they are against public order and morality. The Indian Patent Law has strong prohibitions against patenting of biotechnology inventions based on morality and public order¹.

Conclusion

Public order, in simple sense can be understood as social structure of society or protection of public security and morality as we all know are moral principles or accepted norms by the people. TRIPS art 27.2, EPC art 53(a) and sec 3(b) of Indian patent Act all have the same concept which states that any invention, commercial exploitation of which is in contravention of public order and morality is not patentable. Paris convention also states that any invention should not affect the laws of any nation. European Appeal Board even said that balancing exercise cannot be the way of patentability where it is prejudice to environment or conduct of European culture.

Any product or process which could be commercially exploited and is against public order and morality should not get patented as it is against the will of the people and might harm the feelings, beliefs and sentiments of the people. Such as patent for machine which could counterfeit the currency or any such goggles which could see a person naked. These things should straight away be rejected. But now the question arises whether such things which is beneficial to the nation but against the public order and morality should get

patented or not, as what have discussed as balancing out exercise.

In my opinion even though the invention is advancement of technology but it should always be weighed on the machine of public order and morality as nothing is as important as the moral principles of the people and set standards of the society.

