

Still absolute compound protection for DNA?

According to subsection 4 of new §1(a) of the German Patent Act (GPA) implementing EU Directive 98/44/EC, a claim to a naturally occurring DNA sequence must recite the use of the DNA. There appears to be a general understanding in the patent community that this proviso establishes purpose-limited protection for DNA sequences. There is no doubt that this notion finds support among members of the legislative bodies, whose statements on the subject show a clear inclination to exempt gene sequences from absolute compound protection.

However, such a dogma of purpose-limited protection for DNA sequences might be open to challenge for the following reasons.

Sections 1 and 1(a) GPA only relate to patentability requirements. However, the scope of protection conferred by a patent is regulated by § 14 GPA, which is identical to Article 69 EPC. Thus, the scope of a patent is determined by the claims, while the description and drawings are used to interpret the claims.

The Federal Supreme Court's decision "Antivirumittel", which has often been cited in support of construing §1(a) GPA as purpose-limiting, is not pertinent because it relates to a situation where the compound as such was already prior art. Rather, it is well-established case law in Germany that the scope of a claim to a compound which reads "Compound X for use in ..." is not limited to this specific purpose if the compound itself is novel and inventive and if the indicated use does not imply certain limitations for the compound. This applies even where there is no legal provision obliging the applicant to include the use in the claim.

It is not apparent why the courts should abandon this approach, especially considering that the incorporation of the use of a DNA sequence is not at the discretion of applicants in view of the new §1(a) GPA. Moreover, the preamble to the German act implementing the EU Directive explicitly recites that the general principle of patent law providing absolute compound protection should not be relinquished.

We therefore take the view that §1(a) GPA sets a new patentability requirement for DNA sequences, but that claims to such sequences still provide absolute compound protection. However, if German courts were ever to come to a different conclusion, this might also affect the German national parts of European patents, since according to Article 69 EPC the description shall be used for interpretation of the claims and according to Rule 23e(3) EPC the industrial application of a sequence, that is its use, must be disclosed in the patent application.