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Stem cell patent partially revoked

In a recent decision (3Ni-42/04) the German Federal Patent Court has revoked the German patent DE 19756864 relating to neuronal precursor cells derived from embryonic stem (ES) cells insofar as it concerns cells that descend from ES cells prepared from human embryos.

The Court has based its decision on § 2(2) No 3 of the German Patent Act (GPA), according to which patents shall not be granted in respect of inventions concerning the use of human embryos for industrial or commercial purposes. Remarkably, the claims of the disputed patent are not directed to such a use. However, in the hearing, the Court stated that, to obtain the ES cells, the destruction of human embryos would be inevitable, and this would contravene the above regulation as well.

The written decision is not yet available, but it will be of interest to see how the Court will argue for its position. The amended patent still encompasses cells derived from human ES cells which are not prepared from human embryos but from different sources such as human embryonic germ cells. Furthermore, it is also of note that the Court has retroactively applied the exemption of § 2 GPA that only entered into force in 2005, while the disputed patent was filed in 1997.

The decision will be open to an appeal to the German Federal Supreme Court (BGH) and the patentee has already announced that he will take legal action.

The Enlarged Board of Appeal of the European Patent Office is charged with the same question that has now been answered in a national German lawsuit.

In pending case G 2/06, a referral has been addressed to the Enlarged Board asking whether “Rule 23d(c) EPC (the European correspondent to § 2(2) No 3 GPA) forbids the patenting of claims directed to products (here: human embryonic stem cell cultures) which – as described in the application – at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos

from which said products are derived”.

The Enlarged Board will have to clarify *inter alia* whether the corresponding regulations of the EPC have to be interpreted narrowly or not. In the case G 1/98, which concerned the scope of the exclusion of plant varieties from patentability under Article 53(b) EPC, the Enlarged Board arrived at a narrow construction by finding that this article does allow claims covering plant varieties, unless a specific variety is not mentioned in the claim.

It will also be interesting to see whether, on appeal, the BGH will stay the national proceedings until issuance of the decision of the Enlarged Board and whether it will deviate from that decision or not.