COMPLIANCE OF CANADA'S UTILITY DOCTRINE WITH INTERNATIONAL MINIMUM STANDARDS OF PATENT PROTECTION

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E. Richard Gold & Michael Short

The Promise of the Patent in Canada and Around the World

30 CANADIAN INTELLECTUAL PROPERTY REVIEW
(forthcoming June 2014)

Section 3(d), Indian Patent Law, 2005

(A) Provisions Under the Patents Act 1970

3.4 The special provisions which pertain to the patentability of pharmaceutical and chemical inventions are contained in s 3 of the Patents Act, the relevant clauses are reproduced below:

3. What are not inventions.—The following are not inventions within the meaning of this Act, –

…

(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation.—For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

Feroz Ali Khader, Chapter 3, *The law of patents : with a special focus on pharmaceuticals in India*, New Delhi: LexisNexis Butterworths Wadhwa Nagpur, 2009

TRIPS (Part II) Article 27: Patentable Subject Matter

1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.[5] Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

[5]For the purposes of this Article, the terms “inventive step” and “capable of industrial application” may be deemed by a Member to be synonymous with the terms “non-obvious” and “useful” respectively.

Jerome H. Reichman & Rochelle Cooper Dreyfus

Harmonization Without Consensus: Critical Reflections on Drafting a Substantive Patent Law Treaty

57 DUKE L. J. 85 (2007)

Part I (TRIPS): GENERAL PROVISIONS AND BASIC PRINCIPLES
Article 1 – Nature and Scope of Obligations

1. Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.

Understanding on rules and procedures governing the settlement of disputes
Annex 2 of the WTO Agreement

Article 19: Panel and Appellate Body Recommendations

1. Where a panel or the Appellate Body concludes that a measure is inconsistent with a covered agreement, it shall recommend that the Member concerned[9] bring the measure into conformity with that agreement.[10] In addition to its recommendations, the panel or Appellate Body may suggest ways in which the Member concerned could implement the recommendations.

2. In accordance with paragraph 2 of Article 3, in their findings and recommendations, the panel and Appellate Body cannot add to or diminish the rights and obligations provided in the covered agreements.

[9] The "Member concerned" is the party to the dispute to which the panel or Appellate Body recommendations are directed.

[10] With respect to recommendations in cases not involving a violation of GATT 1994 or any other covered agreement, see Article 26.

WTO Appellate Body, India—Patent Protection for Pharmaceutical and Agricultural Chemical Products (1997)

WT/DS/50/AB/R at ¶¶ 47-48

See Jerome H. Reichman, *Securing Compliance with the TRIPS Agreement After U.S. v. India*, 4 J. INT'L ECON. L. 588 (1998)

TRIPS (Part I) Article 7 - Objectives

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

TRIPS (Part I) Article 8 – Principles

1. Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.

Doha Declaration on the TRIPS Agreement and Public Health Summary

The Declaration on the TRIPS Agreement and Public Health adopted by Ministers at Doha on 14 November 2001 includes important statements regarding the objectives of the TRIPS Agreement.

Operative paragraph 4 of the Doha Declaration can be understood as directed to elaborating on the meaning of Article 8 of the TRIPS Agreement. It provides:

4. We agree that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. Accordingly, while reiterating our commitment to the TRIPS Agreement, we affirm that the Agreement can and should be interpreted and implemented in a manner supportive of WTO members' right to protect public health and, in particular, to promote access to medicines for all.

In this connection, we reaffirm the right of WTO members to use, to the full, the provisions in the TRIPS Agreement, which provide flexibility for this purpose.

See generally Frederick M. Abbott & Jerome H. Reichman
The Doha Round's Public Health Legacy Under the Amended TRIPS Provisions,
10 J. INT'L ECON. L. 921 (2007)

Max Planck Institute (Munich)
Draft Declaration on Patent Protection—
Regulatory Sovereignty under TRIPS (forthcoming Spring 2014, at 4):

DIFFERENTIATION

Article 27 of the TRIPS Agreement does not prevent States from reasonably differentiating between fields of technology according to

- The characteristics inherent in the technology at issue, and
- The State's public policies pertaining to the sector at issue

Jerome H. Reichman

Intellectual Property in the Twenty-First Century: Will the Developing Countries lead or Follow?

Symposium Issue

46 HOUSTON L. REV. 1115- (2009)