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Correspondence
Nature Biotechnology
345 Park Avenue South
New York, NY 10010-1707, USA
or sent by e-mail to biotech@natureny.com
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Europe ratifies plant patents

To the editor:

Cheryl H. Agris' article (*Nat. Biotechnol.* 17, 197–198, 1999) on "Intellectual property protection for plants," subsection "IP protection in Europe" requires clarification and updating.

Plant or animal varieties are excepted from patentability under Article 53(b) of the European Patent Convention (EPC). This provision was included in the EPC since it was considered more appropriate at the time the EPC was being drawn up to protect plant varieties by a special form of protection under the UPOV Convention. With the advent of plant genetic engineering, inventions were made (typically: a transgenic plant containing a foreign gene X imparting a certain activity to the plant) for which patents were sought because the "plant breeder's rights" under the UPOV Convention are unsuitable for proper protection of this kind of technical development. Several decisions of our boards of appeal dealt with the question as to whether Article 53(b) EPC would allow such protection, and in decision T 356/93 it was held that a claim to a plant encompassing plant varieties was not allowable.

Following this decision, the granting of claims directed to plants (and animals) was stopped at the EPO in order to await a final clarification of the issue. This clarification is now provided by a decision of the Administrative Council of the European Patent Organisation to insert new Rules 23b–e into the Implementing Regulations of the EPC with effect from 1 September 1999.

The new rules have been introduced in order to implement the provisions of the EU Directive 98/44/EC of 6 July 1998 on the Legal Protection of Biotechnological Inventions. According to new Rule 23c(b) EPC, which sets out how Article 53(b) EPC is to be construed, biotechnological inventions shall be patentable if they concern plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety. This means that generic claims to plants or animals may be patentable even though claims to specific plant (or animal) varieties (which are still the subject for plant breeder's rights) are not allowable.

In parallel to this development another case (G 1/98) relating to genetically engineered plants has very recently been decided by our Enlarged Board of Appeal, which renders decisions binding for other boards. The question to be decided in this case was essentially the issue governing the whole debate, namely whether a claim encompassing varieties is compatible with Article 53(b) EPC. The board answered in the affirmative, provided specific varieties are not individually claimed, and thus confirmed that new Rule 23c EPC is in accordance with Article 53(b) EPC.



The new rules hence provide a binding interpretation of the provisions of Article 53(b) EPC, according to which claims to plants and animals in general will be granted provided specific varieties per se are not claimed.

Dr. Siobhan Yeats
Dr. Christian Gugerell
European Patent Office,
D-80298 München,
Germany

Genome Canada update

To the editor:

We are writing in response to a news item that appeared in the October 1999 issue, entitled "Giga speed bioinformatics to power Genome Canada" (*Nat. Biotechnol.* 17, 950, 1999). On behalf of Genome Canada, we would like to correct some significant errors of fact that appeared in this article.

Although we would be pleased if Brian Hoyle's statements regarding budgetary commitments to Genome Canada were true, in fact there have been no pledges by the Canadian Government, the Federal granting councils, the Canada Foundation for Innovation, provincial governments, or industry in direct support of the "Genome Canada" initiative. The numbers cited resemble those that were part of a proposal, now almost a year old, entitled "Genome Canada 1998 Blueprint and Principles," but that proposal, which was never formally ratified, has undergone significant modification and enhancement since its first appearance. In the interim a number of the organizations mentioned above, including the federal government, have recognized the growing importance of genome research to Canada and have allocated some funding to genomics research. Genome Canada's interim board of directors, appointed in

March 1999, is actively working to elicit government, public, and private-sector support for a coordinated Genome Canada research initiative that will establish Canada as a world leader in this burgeoning field of scientific endeavor. We are optimistic that the full Genome Canada vision will be recognized in the next federal budget, expected in early 2000.

To correct other details, the government under Prime Minister Jean Chrétien had not, as the article stated, "...axed the Canadian Genome Analysis and Technology Program...", known as CGAT; rather, its five-year mandate was completed but not renewed. Dr. Tsui was not interviewed for this article, nor was any Genome Canada "official." The interim board and staff of Genome Canada disavow the statements made, and apologize to those individuals and organizations mentioned for any confusion that has ensued.

Arthur Carty,
Ph.D., D.Sc. (HC), FRSC
co-chair, interim board of directors,
Genome Canada,
and president,
National Research Council of Canada
(arthur.carty@nrc.ca)
Lap-Chee Tsui,
OC, Ph.D., FRS, FRSC
co-chair, interim board of directors,
Genome Canada, and geneticist-in-chief,
The Hospital for Sick Children
(lctsui@genet.sickkids.on.ca)

Brian Hoyle replies:

Neither Dr Lap-Chee Tsui nor other Genome Canada officials were available for comment when contacted to discuss the story. The text was based on notes taken at Dr. Tsui's presentation at the BioAtlantech Conference in Fredericton, New Brunswick, and information from Genome Canada's *Blueprint* document. Factual errors relating to funding arrangements for Genome Canada arose for these reasons. I welcome the response from Drs Tsui and Carty, which now sets the record straight.

Next month in Nature Biotechnology:

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