World Academy of Science, Engineering and Technology
International Journal of Law and Political Sciences
Vol:10, No:08, 2016

Forum Shopping in Biotechnology Law: Understanding Conflict of Laws in Protecting GMO-Based Inventions as Part of a Patent Portfolio in the Greater China Region

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Abstract : This paper seeks to examine the extent to which 'forum shopping' is available to patent filers seeking protection of GMO (genetically modified organisms)-based inventions in Hong Kong. Under Hong Kong's current re-registration system for standard patents, an inventor must first seek patent protection from one of three Designated Patent Offices (DPO) – those of the People's Republic of China (PRC), the Europe Union (EU) (designating the UK), or the United Kingdom (UK). The 'designated patent' can then be re-registered by the successful patentee in Hong Kong. Interestingly, however, the EU and the PRC do not adopt a harmonized approach toward the patenting of GMOs, and there are discrepancies in their interpretation of the phrase 'animal or plant variety'. In view of these divergences, the ability to effectively manage 'conflict of law' issues is an important priority for multinational biotechnology firms with a patent portfolio in the Greater China region. Generally speaking, both the EU and the PRC exclude 'animal and plant varieties' from the scope of patentable subject matter. However, in the EU, Article 4(2) of the Biotechnology Directive allows a genetically modified plant or animal to be patented if its 'technical feasibility is not limited to a specific variety'. This principle has allowed for certain 'transgenic' mammals, such as the 'Harvard Oncomouse', to be the subject of a successful patent grant in the EU. There is no corresponding provision on 'technical feasibility' in the patent legislation of the PRC. Although the PRC has a sui generis system for protecting plant varieties, its patent legislation allows the patenting of non-biological methods for producing transgenic organisms, not the 'organisms' themselves. This might lead to a situation where an inventor can obtain patent protection in Hong Kong over transgenic life forms through the re-registration of a patent from a more 'biotech-friendly' DPO, even though the subject matter in question might not be patentable per se in the PRC. Through a comparative doctrinal analysis of legislative provisions, cases and court interpretations, this paper argues that differences in the protection afforded to GMOs do not generally prejudice the ability of global MNCs to obtain patent protection in Hong Kong. Corporations which are able to first obtain patents for GMO-based inventions in Europe can generally use their European patent as the basis for re-registration in Hong Kong, even if such protection might not be available in the PRC itself. However, the more restrictive approach to GMO-based patents adopted in the PRC would be more acutely felt by enterprises and inventors based in mainland China. The broader scope of protection offered to GMO-based patents in Europe might not be available in Hong Kong to mainland Chinese patentees under the current re-registration model for standard patents, unless they have the resources to apply for patent protection as well from another (European) DPO as the basis for re-registration.

Keywords : biotechnology, forum shopping, genetically modified organisms (GMOs), greater China region, patent portfolio
Conference Title : ICIPM 2016 : International Conference on Intellectual Property Management
Conference Location : Vancouver, Canada
Conference Dates : August 04-05, 2016