

Background information on the "Edinburgh" patent

European Patent Office press kit, July 2002

The "Edinburgh" patent

This is the name commonly given to European patent No. 0695351, owned by the University of Edinburgh. The corresponding patent application was filed with the European Patent Office (EPO) in April 1994, which granted the patent, after examination, in December 1999. The patent concerns a method of genetically modifying animal stem cells so as to give them a survival advantage over unwanted differentiated cells. Biotechnology researchers face the problem that stem cells may grow more slowly than other cells and thus be crowded out. The method described in the Edinburgh patent solves this problem by making it easier to culture and isolate desired stem cells.

The controversy behind the patent

The EPO examined the application and granted the patent but, by an oversight, failed to insist on limiting the term "animal", which can be interpreted as extending to humans. Initial protests against the granting of the "Edinburgh" patent were voiced in February 2000 and first oppositions were filed in March 2000. The opponents have strong ethical objections against the invention, as it also involves human stem cells, in particular human embryonic stem cells and the modification thereof. In addition, some parties hold that the patent refers to human cloning and the creation of transgenic animals, including humans.

The opposition procedure

According to the European Patent Convention, any third party may oppose any European patent, within a period of nine months after its grant, and argue that the grant was unjustified. This is a standard procedure which is initiated against approximately 6% of the patents the EPO grants each year.

In the Edinburgh case, oppositions were formally lodged by 14 parties, including the governments of Germany, the Netherlands and Italy. The result of the opposition proceedings may be expected at the end of the hearing beginning on 22 July 2002.

Amendment of the patent

Immediately after oppositions were filed, the University of Edinburgh stated that it had never intended the scope of the patent to extend to the creation of transgenic humans, and has since proposed a corresponding limitation of the patent. The limitation does not concern the separate issue of patenting human stem cells, in particular human embryonic stem cells and the modification thereof.

The outcome of the opposition hearing

Generally speaking, an opposition procedure against the grant of a patent can have one of three outcomes: the patent may be upheld, maintained in an amended form or revoked in its entirety. The outcome in the Edinburgh case may be expected to be announced after all of the parties attending the hearing have presented their arguments. This may take up to five days. The written decision of the Opposition Division, with a full account of the facts and arguments, will follow some months later.

Possible next steps

Decisions of Opposition Divisions may be challenged in a second-instance procedure before a Board of Appeal of the EPO. If a Board of Appeal decides to maintain a European patent, it is still possible to initiate revocation proceedings before national courts.

For further information, please see:

EPO website

www.european-patent-office.org

EPO information brochures

www.european-patent-office.org/epo/pubs/brochure/general/e/brochures_e.htm