4. Morality and *Ordre Public*

4.1. The Concept of Morality and Ordre Public *in the Case Law of the European Patent Office*

One of the most common issues raised in the legal literature relating to Art. 53(a) EPC concerns the categories '*ordre public*' and 'morality' and the relationship between them in this legal provision.[702] In the Guidelines for Examination, these categories are treated as one and are not defined in any way.[703] Meanwhile, the EPO case law provides for different definitions and interpretations of these terms, and in respect of the category 'morality' has even stated that it is not a criterion which should be defined by the patent authorities.[704] In this situation, it is necessary to analyse the concepts of the above-mentioned categories and the relationship between them in the case law of the Office.

As discussed in this study, the first process in the European patent system in which the issue concerning patent granting for an invention on the basis of Art. 53(a) of the Convention was at issue arose when the Harvard Medical School sought to register a patent, the claims of which included the process of creating a genetically modified mouse used for research into cancer treatment.[705] In 1989, the EPO Examining Division rejected the patent application on the basis of Art. 53 (b) EPC.[706] As a result, the applicant lodged an appeal, which was further investigated in the *Onco-mouse/HARVARD* case, but this time also under Art. 53 (a) EPC.[707]

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702 See e.g. Warren-Jones, 'Finding a "Common Morality Codex" for Biotech – A Question of Substance' (n 116) 834; Liddell, 'Immorality and Patents: The Exclusion of Inventions Contrary to Ordre Public and Morality' (n 134) 147; Hellstadius, *A Quest for Clarity: Reconstructing Standards for the Patent Law Morality Exclusion* (n 6) 202-213.

703 Guidelines for Examination, March 2023 (n 63), pt A-III, 8.1. and pt G-II, 4.1.

704 *Euthanasia Compositions/MICHIGAN STATE UNIV* (n 54), para 6.12.

705 European Patent Application No. 85 304 490.7, published as No. 0 169 672.

706 *Harvard/Onco-Mouse* (n 75). See also 'European patents shall not be granted in respect of: [...] (b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof.' (EPC 1973, Art. 53(b)).

707 *Onco-Mouse* (n 80), para III.

During this process, the EPO Board of Appeal pointed out that the manipulation of mammal genes is definitely a problematic issue, especially when the activated oncogenes are injected in order to make the animal in question unusually sensitive to carcinogenic substances and other stimuli, which makes it more likely to develop tumours that inevitably lead to suffering.[708] In addition, according to the Board, there is a risk that, once released, genetically modified animals could cause irreversible damage to the environment.[709] As these aspects were not sufficiently analysed, the EPO Board of Appeal instructed the Examining Division to re-examine the case.[710] In this decision of the EPO Board of Appeal, *ordre public* and morality were treated as one and the same category, without mentioning any peculiarities or differences between them.

A similar approach was later shown in other EPO decisions on the patenting of inventions in the field of biotechnology and in other fields of biomedical sciences. The *Relaxin/HOWARD FLOREY INSTITUTE* case analysed an invention to develop a recombinant human relaxin[711] to alleviate complications associated with labour induction and caesarean section.[712] In this decision, the EPO Board of Appeal assessed the patent claims disputed by the opponents in relation to overall compliance with Art. 53(a) EPC, without any detailed analysis of the concept of morality or *ordre public*.[713] Although there was also no detailed description of the relationship between morality and *ordre public* or the content of each of them, it was concluded that Art. 53(a) of the Convention can be interpreted using Rules 23d and 23e[714] of the EPC Implementing Regulations. Finally, the Board indicated that the content of the EPC provision in question can be interpreted on the basis of Rule 23e(2)[715] of the EPC Implementing Regulations,

708 *Onco-Mouse* (n 80), para 5.
709 ibid.
710 ibid 22.
711 Relaxin is a hormone, secreted by the placenta in the terminal stages of pregnancy, that causes the cervix (neck) of the uterus to dilate and prepares the uterus for the action of oxytocin during labour (Jonathan Law and Elizabeth Martin, 'Relaxin', *Concise Medical Dictionary* (10th edn, 2020) <https://www.oxfordreference.com/display/10.1093/acref/9780198836612.001.0001/acref-9780198836612-e-8694?rskey=I3VMoj&result=10001> accessed 30 May 2023).
712 Sterckx and Cockbain, *Exclusions from Patentability, How Far Has the European Patent Office Eroded Boundaries?* (n 94) 271.
713 *Relaxin/HOWARD FLOREY INSTITUTE* (n 81), paras 4-9.
714 Currently EPC Implementing Regulations, r 28 and r 29.
715 Since 13 December 2007: EPC Implementing Regulations, r 29(2).

which provides a list[716] of inventions which, based on Art. 53(a) EPC, are considered patentable.

In the *Non-invasive localization/LELAND STANFORD* case, when deciding on the patenting of the eukaryotic cell detection process in a live non-human organism, the EPO Board of Appeal applied Rule 28(d)[717] of the EPC Implementing Regulations for the interpretation of Art. 53(a) EPC, as well as the weighing test which was previously used in the *Onco-mouse/HARVARD* case.[718] However, the concept of morality and *ordre public* as well as their relationship were not analysed in this decision.[719]

The European patent for the process of creating a genetically modified mouse[720] in the *Onco-mouse/HARVARD* case discussed above was eventually granted with certain modifications. However, oppositions concerning it were received from 17 subjects[721] and all were substantiated on the basis of Art. 53(a) of the Convention. In this way, a second case, *Transgenic animals/HARVARD*,[722] concerning the patentability of the invention in question was opened before the EPO. During this process, the Board changed its position on the relationship between *ordre public* and morality in analysing the same invention. In this case, unlike in the *Onco-mouse/HARVARD* case, *ordre public* and morality were considered as two separate categories which could together form one ground or separately two different grounds for opposing the patentability of a particular invention invoked in a certain procedure.[723] The aforementioned difference concerning the understanding and relationship between *ordre public* and morality in the *Onco-mouse/HARVARD* and *Transgenic animals/HARVARD* cases can be related to the *Plant cells/PLANT GENETIC SYSTEMS*[724] case, in which they were analysed as two distinct categories, each of them being given a different definition.[725]

716 *Relaxin/HOWARD FLOREY INSTITUTE* (n 81), paras 5-8.
717 Since 1 July 2017: EPC Implementing Regulations, r 28(1)(d).
718 *Non-invasive localization/LELAND STANFORD* (n 81), para 22.
719 ibid paras 13-24.
720 European Patent Application No. 85 304 490.7, published as No. 0 169 672.
721 *Transgenic animals/HARVARD* (n 80), para VI; Sterckx and Cockbain, *Exclusions from Patentability, How Far Has the European Patent Office Eroded Boundaries?* (n 94) 245.
722 *Transgenic animals/HARVARD* (n 80).
723 ibid para 10.2.
724 *Plant cells/PLANT GENETIC SYSTEMS* (n 22).
725 ibid paras 5-6.

In the EPO Board of Appeal decision concerning the *Plant cells/PLANT GENETIC SYSTEMS* case, morality was associated with 'the belief that some behaviour is right and acceptable whereas other behaviour is wrong, this belief being founded on the totality of the accepted norms which are deeply rooted in a particular culture'.[726] In the context of the European patent system, 'the culture in question is the culture inherent in European society and civilisation'.[727] Therefore, based on this provision, inventions that do not conform to this culture should not be patented. In the light of such interpretations, it can be argued that, in the *Plant cells/PLANT GENETIC SYSTEMS* case, the EPO Board of Appeal linked the category 'morality' to ethical rather than legal norms.

Meanwhile, concerning the term '*ordre public*' in the discussed case, the Board stated that this category involves the protection of the physical integrity of society as well as individuals belonging to it and the protection of environment.[728] Therefore, inventions whose exploitation is likely to violate public peace or social order (e.g. by using the invention to attempt a terrorist attack), or which could significantly harm the environment in general, cannot be patented.[729] This definition of *ordre public* allows it to be linked to legal norms.

In the context of the definitions given above, the EPO Board of Appeal considered respectively whether the use of the subject-matter claimed in the patent in suit[730] is likely to either (1) seriously harm the environment or (2) contradict the 'conventionally accepted standards of conduct of European culture'.[731] Having individually assessed the invention referred to in the patent claims – (1) processes controlling plant cell activity and the creation of herbicide-resistant plants and (2) herbicide resistant plants and cells – in relation to *ordre public* and morality, the Board stated that the commercial exploitation of the invention in question with regard to Art. 53(a) EPC was patentable.[732]

However, the position of the EPO Board of Appeal on *ordre public* and morality as two separate categories in the *Plant cells/PLANT GENETIC SYSTEMS* case was not confirmed by the further EPO case law. For

726 *Plant cells/PLANT GENETIC SYSTEMS* (n 22) para 6.
727 ibid.
728 ibid para 5.
729 ibid.
730 ibid para 14.
731 ibid paras 14 and 19.
732 ibid paras 17.2 and 19.

example, in the *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* case, when deciding on the compliance with regard to Art. 53(a) of the Convention of an invention comprising the BRCA1 gene sequence and its mutations that may be used to diagnose a predisposition to breast or ovarian cancer,[733] the EPO analysed the commercial exploitation of this invention without separating the categories of *ordre public* and morality from each other.[734] The decision also indicated that, according to Rule 23e(2) of the EPC Implementing Regulations, which was in effect at that time,[735] the subject-matter of the invention described in the patent claims is not among the exceptions to patentability listed in Art. 53(a) EPC.[736]

Nevertheless, in the *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* proceedings, an attempt to divide the arguments into legal and ethical ones, i.e. relating to *ordre public* and morality, is evident. The arguments that the patent applicant did not provide any information about the donors giving their informed and explicit consent for the commercial exploitation of cells and research results, as well as about signing a benefit-sharing agreement,[737] can be considered legal ones. This conclusion can be drawn because, in response to the arguments presented, the Board indicated that the EPC does not contain any provisions requiring the patent applicant to submit the consent form or the benefit-sharing agreement.[738] The definitions of *ordre public* and morality presented in the *Plant cells/PLANT GENETIC SYSTEMS* case allow for a conclusion to be drawn that the discussed arguments of the opponents in *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* can be associated with *ordre public*. However, the EPO Board of Appeal did not choose to do that in this case.

Compliance with morality as mentioned in Art. 53(a) EPC in the *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* case may be related to the

733 *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* (n 22), para VII. The mutations of the BRCA1 gene increase the risk of breast cancer in women by about 60-85 per cent (up to 10 times) and the risk of ovarian cancer by about 40-60 per cent (approximately 30-40 times) compared to the general population (up to 80 years old). If a person has an increased risk of developing an oncological illness, certain characteristics of hereditary tumours, which may influence the nature and outcome of the treatment, should be considered during it. This allows the best course of treatment for each particular patient to be chosen.

734 ibid para 56.

735 Since 13 December 2007: EPC Implementing Regulations, r 29(2).

736 *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* (n 22), para 56.

737 ibid paras 47.

738 ibid paras 48-49.

opponent's arguments regarding the socio-economic consequences of patent granting, which, according to the opponents, are related to ethical issues.[739] However, in this case, the EPO Board of Appeal did not further analyse the issue of compliance with ethics or morality. The Board found that the assessment of the exploitation of the invention itself, rather than the assessment of the exploitation of the patent, fell within the scope of Art. 53(a) EPC[740] and therefore rejected the opponent's arguments regarding the compliance of the exploitation of the patent with the provision in question. The EPO Board of Appeal also stated that the socio-economic implications of the exploitation of a patent cannot be assessed solely in relation to public health, since the consequences of the exploitation of a patent are always the same, i.e. the right to prevent competitors from using a specific invention,[741] and the fact that the national patent law of a Member State obliges them to assess the socio-economic or ethical aspects of patent granting is meaningless, because the regulations of national legal systems are not part of the European patent system.[742]

Therefore, the *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* case did not take into account the interpretations of the content of *ordre public* and morality indicated in Art. 53(a) EPC that were presented in the *Plant cells/PLANT GENETIC SYSTEMS* case. Despite the fact that legal, ethical and socio-economic arguments were presented in the former case, the Board was not inclined to analyse them separately from the perspectives of *ordre public* or morality so as to provide a broader understanding of the content of each category in question.

However, in the *Euthanasia Compositions/MICHIGAN STATE UNIV.* case, where the patent claims encompassed a pharmaceutical composition, i.e. a solution intended to provoke death in lower mammals,[743] the exploitation of this invention, based on the decision in the *Plant cells/PLANT GENETIC SYSTEMS* case, was assessed separately with regard to both categories, i.e. *ordre public* and morality, emphasising that these are two different grounds for opposing the granting of a European patent.[744] The decision stated that mercy killing of animals is a normal part of veterinary

739 *Breast and Ovarian Cancer/UNIVERSITY OF UTAH* (n 22), para 52.
740 ibid para 53.
741 ibid.
742 ibid para 55.
743 *Euthanasia Compositions/MICHIGAN STATE UNIV* (n 54), para II.
744 ibid para 6.9.

practice, which, according to the EPO Board of Appeal, shows that this activity falls under the scope of *ordre public*.[745] The Board also indicated that there was no evidence presented that this type of veterinary practice could in any way disturb *ordre public* or public peace or result in harm to the environment.[746]

Meanwhile, morality, according to the EPO Board of Appeal, is based on ethical norms of behaviour that have become obligatory because of their universal acceptance.[747] In addition, the *Euthanasia Compositions/MICHIGAN STATE UNIV.* case discussed the concept of morality more broadly, indicating that morality is not a criterion which should be defined by patent granting authorities and that in the European culture there is no moral standard based on social, economic or religious principles.[748] However, following the decision in the *Plant cells/PLANT GENETIC SYSTEMS* case, the conclusion was drawn that morality is the basis for including non-legal, ethics-based norms into the legal framework.[749] Furthermore, the Board stated that the exploitation of an invention violates morality only if it is generally regarded as reprehensible by society or at least in commercial practice.[750] Having found none of the discussed violations, the EPO ruled that the patent in question was not in conflict with morality.[751] However, the *Euthanasia Compositions/MICHIGAN STATE UNIV.* case shows that the EPO Board of Appeal, following the decision in the *Plant cells/PLANT GENETIC SYSTEMS* case, applied Art. 53(a) EPC more broadly than in many other decisions, and assessed the exploitation of the invention in terms of both *ordre public* and morality.

In the context of the EPO case law discussed above, it is clear that, with the exception of a number of cases, *ordre public* and morality are not treated as two separate categories in the decisions of the Board. However, in those former few decisions, *ordre public* is perceived as covering the basic legal norms of a particular society, encompassing the security of the public and its members, environmental protection and physical human integrity, whereas morality is associated with other social norms (non-legal, but also very important to a certain society) which recognise proper or

745 *Euthanasia Compositions/MICHIGAN STATE UNIV* (n 54), para 6.10.
746 ibid para 6.11.
747 ibid para 6.12.
748 ibid.
749 ibid.
750 ibid.
751 ibid.

improper behaviour. Nevertheless, these exceptions are few in the EPO case law regarding the patenting of biotechnological inventions in the context of Art. 53(a) EPC. For this reason, in order to improve understanding of the concept of these categories and their relationship, further research into this question from the perspective of the Western legal tradition is needed.

4.2. The Role of Morality in the Western Legal Tradition

R. Dworkin describes the relationship between law and morality as a classical jurisprudential question, the answer to which has not been found for many centuries.[752] This legal philosopher has noted that the law-morality connection is traditionally understood as the relation between two sets of norms, in the context of which the main question is how these two systems of social norms are interconnected.[753] The analysis of this question in the Western legal tradition is aggravated by the legal pluralism[754] manifested in this tradition as one of its main features,[755] and by the differences between the methods of cognition[756] of law as a complex phenomenon, which are determined by the views of the researchers. Also, the fact that '[l]aw is a craft concerned with what *is not* law'[757] complicates its separation from other areas of social reality and allows it to be considered as a complex phenomenon. Therefore, the objective of defining what law is leads to possible answers *ad infinitum*,[758] as reflected by the definitions of law given in the different legal paradigms, which are largely determined by the way law relates to other areas of reality. Consequently, as there is no answer to the

752 Ronald Dworkin, *Justice for Hedgehogs* (Harvard University Press 2011) 400-401. The questions analysed in this subchapter are partially analysed in the article 'The Role of Morality in a Legal System in the Context of the Western Legal Tradition' by the author of this study (Jurgita Randakevičiūtė, 'Moralės vaidmuo teisinėje sistemoje Vakarų teisės tradicijos kontekste' (2016) 101 Teisė 145).

753 Dworkin, *Justice for Hedgehogs* (752) 401.

754 See '3.2. The Concept of the Western Legal Tradition in the 21st Century'.

755 Berman, *Teisė ir revoliucija: vakarų teisės tradicijos formavimasis* (n 41) 26-27.

756 Ernestas Spruogis, 'Teisės aiškinimo probleminiai aspektai' (2006) 8 Jurisprudencija 56, 58.

757 Goldman, *Globalisation and the Western Legal Tradition: Recurring Patterns of Law and Authority* (n 43) 69.

758 ibid 5.

question 'What is law?',[759] a single definite answer to the role of morality in legal systems does not exist either. Despite this uncertain situation, it is agreed in the legal doctrine that it would be difficult to deny the influence of morality on law.[760]

Considering the above, in order to understand the concept of morality and its position from the perspective of the Western legal tradition, it is important to analyse this issue from different standpoints of various legal paradigms: legal positivism, the school of natural law and legal realism. The above-mentioned concepts of law and the works of their respective representatives are used in this study because each one of them emphasises an element important to any legal system in this legal tradition, i.e. the legal form, content or its actual functioning.[761]

4.2.1. The Role of Morality from the Perspective of the Paradigm of Legal Positivism

Although it is usual in the legal literature to analyse legal concepts by starting from the oldest, i.e. the concept of natural law,[762] in this study the paradigm of legal positivism, which is concerned with the legal form, will be discussed first. The use of the term 'positive' in law derives from the Latin word 'positus' and is used to describe works of deliberate human activity, as a contrast to what is not created but rather originates in the natural way of nature.[763] The rise of legal positivism is associated with the revolution in science and technology of the 18th and 19th centuries, which encouraged the

759 Herbert LA Hart, *Teisės samprata* (Pradai 1997) 43; William Twining, *General Jurisprudence* (Cambridge University Press 2012) 65; Vitalij Levičev, 'Teisėtyros metodologinio spektro analizė' (2015) 95 Teisė 100, 101-102.

760 See e.g. Hart, *Teisės samprata* (n 759) 393-394; Hans Kelsen, *Grynoji teisės teorija* (Eugrimas 2002) 87; Gediminas Mesonis ir Kazimieras Meilius, 'Moralės normos konstituciniuose teisiniuose santykiuose' (2002) 3 Jurisprudencija 5, 6.

761 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 24-26 (E Kūris argues that this is a 'simplified view', because, besides the main influential schools of jurisprudence there are many others, for example the historical and psychological schools of law, the law and economics doctrine, integration jurisprudence, etc.).

762 See e.g. Dalia Mikelėnienė and Mikelėnas Valentinas, *Teismo procesas: teisės aiškinimo ir taikymo aspektai* (Justitia 1999) 32-41; Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68); Baublys and others, *Teisės teorijos įvadas* (n 657).

763 Darijus Beinoravičius, 'Teisės samprata kaip metodas' (2013) 75 LOGOS 43, 45.

perception of law 'as a set of certain objective laws subordinate to the same rules as the laws discovered in nature'.[764] In a general sense, the attitude of the paradigm of legal positivism towards law is reflected in J. Bentham's statement that law is the totality of signs expressing the sovereign will of the state, supported by a set of sanctions.[765]

The positivistic view of the relationship between law and values is illustrated by J. Austin, one of the classical positivists, who followed J. Bentham and sought to distinguish law from other social phenomena, especially morality,[766] claiming that '[t]he existence of law is one thing; its merit or demerit is another'.[767] This legal philosopher researched law as a form which exists on its own, independent of its content, and therefore, according to him, law is considered to be law simply because it exists, even if we are not fond of it.[768] According to J. Austin, the content of law and morality may coincide.[769] However, despite this, they are still two distinct categories, and moral rules can be regarded as positive law only when they impose legal duties and also sanctions for disobeying them exist.[770]

The above-mentioned ideas of classical positivism[771] were also developed by H. Kelsen. He acknowledged that, in addition to law, there exist various social norms that regulate human behaviour, one of which is morality.[772] H. Kelsen did not deny that morality could influence the content of law, but at the same time he did not agree that, in order to be regarded as law, a social order must conform to a certain moral standard, i.e. the 'minimal morality'.[773] The idea that law must be moral in nature and that an immoral social order cannot be regarded as a legal order, according to this legal philosopher, 'presupposes an absolute moral order, that is, one that is

764 Vaidotas A Vaičaitis, *Hermeneutinė teisės samprata ir konstitucija* (Justitia 2009) 29.
765 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 27.
766 Howard Davies and David Holdcroft, *Jurisprudence: Texts and Commentary* (Butterworths 1991) 16.
767 John Austin, *Austin: The Province of Jurisprudence Determined* (Wilfrid E Rumble ed, Cambridge University Press 1995) 157.
768 ibid.
769 ibid 138.
770 ibid 120 and 136-137.
771 James Penner and Emmanuel Melissaris, *McCoubrey & White's Textbook on Jurisprudence* (5th edn, OUP 2014) 40-58.
772 Kelsen, *Grynoji teisės teorija* (n 760) 83.
773 ibid 87.

valid at all times and places'.[774] However, in reality, a legal order can only correspond to the moral values of a particular group in society, which may be contrary to the beliefs of other groups that exist in that same society.[775] H. Kelsen also argued that law is constantly changing. Therefore, the legal order that was consistent with certain moral values at a particular time may, after a certain period of time, no longer be compatible with them.[776] Thus, based on this legal philosopher, the two discussed social orders may interact, but, because of the relative nature of the content of morality, it cannot be a criterion for the validity of a legal order.

According to H. L. A. Hart, the separation between legal and non-legal norms depends on the rule of recognition which determines the criteria for what can be considered law.[777] This legal philosopher argued that the validity of a legal system does not essentially depend on its compliance with any moral criteria, even if these criteria actually have an undeniable effect on its development.[778] Although H. L. A. Hart discussed the forms of the relationship between law and morality 'that very few positivist theorists would try to deny',[779] he also argued that the legal system does not have to comply with any particular norms of morality.[780] He stated that 'the failure to recognise unjust norms as being law would immensely simplify the variety of moral problems arising from these norms'[781] and it would not be possible to see the complexity and diversity of all the individually subtle

774 Kelsen, *Grynoji teisės teorija* (n 760) 89-90 (translated from Lithuanian into English by the author of this study).

775 ibid 89.

776 ibid.

777 Hart, *Teisės samprata* (n 759) 180-182. According to H L A Hart, the legal system is comprised of two types of rules: primary rules, which outline obligations and regulate the behaviour of the members of society, and secondary rules, which help in understanding the problems created by the primary rules – inefficiency, uncertainty and their static nature. Secondary rules of recognition compensate for the uncertainty of primary norms, secondary rules of change remedy their static behaviour, and secondary rules of adjudication deal with the inefficiency of the former.

778 ibid 303.

779 ibid 331. The forms of the relationship between law and morality are discussed in: ibid 322-337 (translated from Lithuanian into English by the author of this study).

780 Herbert L A Hart 'Positivism and the Separation of Law and Morals' (1958) 71 Harvard Law Review 593, 626; Hart, *Teisės samprata* (n 759) 303.

781 Hart, *Teisės samprata* (n 759) 336 (translated from Lithuanian into English by the author of this study).

and complex problems.[782] For this reason, he was inclined to consider even immoral legal norms as part of the law.

However, it is difficult for the representatives and supporters of legal positivism to strictly separate themselves from all the requirements related to values. This situation is also reflected in the references to morality in national and international legislation,[783] court decisions[784] and the analysis of the works of legal philosophers who belong to the paradigm of legal positivism.[785] Under discussion is also the *Grundnorm*, i.e. the 'basic norm' proposed by H. Kelsen, which is the basis for the validity of all other legal norms and at the same time of the entire legal system. It is not clear what requirements this norm must conform to and what its content is. Moreover, despite the allegedly strict structure of the positive legal system, this basic norm still faces the typical legal problem of the 'inherent groundlessness of law'.[786] According to H. Kelsen, it is not positive; it is simply presumed.[787] This situation allows for the emergence of ideas that equate the basic

782 Hart, *Teisės samprata* (n 759) 337.

783 See e.g. art 1.81, ch IV; pt II; Book 1 of the Civil Code of the Republic of Lithuania: 'A transaction that is contrary to public order or norms of good morals shall be null and void'; pt 2 of art 3.5, ch I; pt I; Book 3 of the Civil Code of the Republic of Lithuania: 'In exercising their family rights and performing their duties, persons must comply with the laws, respect the rules of their community life as well as the principles of good morality and act in good faith'; pt 2 of art 1.2, ch I; pt I; Book 3 of the Civil Code of the Republic of Lithuania rules that 'No civil rights may be limited, except in the cases established by laws, or on the basis of a court judgment made in accordance with laws, where such limitation is necessary to protect public order, the principles of good morals, likewise the health and life of people, property of persons, their rights and lawful interests' (Civil Code of the Republic of Lithuania (*Lietuvos Respublikos civilinis kodeksas*). *Valstybės žinios (Official Gazette)*, 2000, No. VIII-1864). In addition, Art. 53(a) EPC states that European patents are not granted to inventions the commercial exploitation of which would be against *ordre public* or morality (EPC, Art. 53(a)).

784 According to H L A Hart, judges are obliged to apply not just one important principle of morality when making decisions where the law does not have a clear answer, but to choose from a variety of moral values. In such cases, judges use comparison and balancing, which are typically employed in the cases where justice has to be brought to a situation of competing interests. H L A Hart indicates that this method of decision-making is often referred to as 'moral' (Hart, *Teisės samprata* (n 759) 328). See also Spruogis, 'Teisės aiškinimo probleminiai aspektai' (n 756).

785 Spruogis, 'Teisės aiškinimo probleminiai aspektai' (n 756) 57.

786 Vaičaitis, *Hermeneutinė teisės samprata ir konstitucija* (n 764) 31 (translated from Lithuanian into English by the author of this study).

787 Kelsen, *Grynoji teisės teorija* (n 760) 191.

norm to the 'higher' legal order postulated by natural law, which H. Kelsen categorically contradicts in his later works.[788]

H. L. A. Hart's rule of recognition, which helps to decide what is considered right and wrong in a certain society, is also relevant in this context. It defines 'legal sources and the relationships of superiority and subordination that exist among them'.[789] However, despite its importance, this category remains undefined: '[i]n a modern legal system [...] the rule of recognition is correspondingly more complex: the criteria for identifying the law are multiple and commonly include a written constitution, enactment by a legislature, and judicial precedents'.[790] In addition, in the 'Post Scriptum', H. L. A. Hart acknowledges that 'as criteria of legal validity, the rule of recognition may incorporate conformity with moral principles or substantive values'.[791] This approach further complicates the separation of positive law from morality.

The doubts around legal positivism grew significantly during the Second World War. This is illustrated by the change of position of G. Radbruch, who until 1933 was considered to be a proponent of the paradigm of legal positivism.[792] At the end of the war, this legal philosopher argued that the conflict between justice and security should be resolved in such a way that the law established by the legislator would be prioritised, even when its content is incorrect and inapplicable, except in those cases when the opposition between the positive law and justice reaches such an unbearable degree that the legislation, as unjust law, destroys justice.[793] Therefore, in the case of radical injustice, according to G. Radbruch, positive law must give way to justice. Hence, since the middle of the 20th century, at least in the countries of the Western legal tradition, legal criteria postulated in legal positivism are no longer the only ones to be considered when making decisions about the status of a system of social norms as a legal order.

The above-mentioned change, and the fact that it is difficult for legal positivism to remain rigid and to separate itself from criteria related to

788 Herbert L A Hart, 'On the Basic Norm' (1959) 47 California Law Review 107, 109.
789 Hart, *Teisės samprata* (n 759) 409 (translated from Lithuanian into English by the author of this study).
790 ibid 189 (translated from Lithuanian into English by the author of this study).
791 ibid 388 (translated from Lithuanian into English by the author of this study).
792 Baublys and others, *Teisės teorijos įvadas* (n 657) 138.
793 Gustav Radbruch, 'Statutory Lawlessness and Supra-Statutory Law' (2006) 26 Oxford Journal of Legal Studies 1, 7.

values, are reflected in the emergence of soft positivism[794] alongside the discussed hard positivism. The former form of positivism indicates that, although not necessarily, there is a possibility for moral arguments to become a criterion allowing social norms to be attributed to a legal system.[795] This view is also shared by H. L. A. Hart's followers J. Coleman, W. J. Waluchow and M. Kramer, who further developed the ideas of soft positivism and argued that legal systems exist in which the criteria of legal validity include moral principles.[796] Thus, even though there are opponents of the position discussed (J. Raz, A. Marmor, S. Shapiro),[797] the representatives of the paradigm of legal positivism are not able to completely erase the doubts concerning the recognition of certain 'higher' values, including that of morality, and their influence on recognising social norms as legal norms.

Considering the above, it can be concluded that, during its whole period of existence, legal positivism placed a greater or lesser emphasis on the formal features of the Western legal system. Precisely this legal paradigm helps in maintaining one of its characteristics indicated by H. J. Berman: the possibility to analytically separate law from religion, politics, morality and customs.[798] This allows it to be argued that, despite the above-mentioned return to the ideas of the school of natural law in the middle of the 20th century, the legal positivism-based approach to legal system remains important. Nevertheless, in the legal system that belongs to the Western legal tradition, even if the importance of the concept of formally defined social norms is accepted, other non-legal means may sometimes be employed in the interpretation and application of law.[799] Therefore, in order to fully reveal the role of morality in the legal system in the context of the Western legal tradition, it is important to analyse other legal paradigms that belong to this tradition and emphasise other elements of the legal system, i.e. its content and functioning.

794 Spruogis, 'Teisės aiškinimo probleminiai aspektai' (n 756) 57; Matthew H Kramer, *Where Law and Morality Meet* (OUP 2008) 2-3.
795 Kramer, *Where Law and Morality Meet* (n 794) 2.
796 Kenneth Eimar Himma, 'Inclusive Legal Positivism' in Jules Coleman and Scott Shapiro, *The Oxford Handbook of Jurisprudence and Philosophy of Law* (OUP 2002) 125, 125.
797 ibid.
798 Berman, *Teisė ir revoliucija: vakarų teisės tradicijos formavimasis* (n 41) 24.
799 See e.g. Spruogis, 'Teisės aiškinimo probleminiai aspektai' (n 756) 59.

4.2.2. The Role of Morality from the Perspective of the School of Natural Law

The paradigm of natural law indicates that the status of a system of social norms as a legal system does not depend only on whether its norms are determined by a particular procedure, but also on additional factors that arise outside a particular legal system.[800] The origins of this legal concept lie in the works of Greek philosophers.[801] Later, the concept in question was further developed in ancient Roman jurisprudence, where the ideal natural law was called *ius naturale* and was regarded as the basis of the functioning law. Actually, however, the latter was often unable to satisfy the requirements of justice, and therefore it was necessary to turn to natural law, the purpose of which was to correct the imperfections of the legal system in force.[802] This philosophy, born in the era of classical antiquity, had a great influence on Western legal thought, where conflicts between 'what really is' and 'what should be' arise, or as H. J. Berman puts it, a tension between reality and the ideal exists.[803]

The idea of natural law was further developed by the representatives of medieval Christian philosophy, the most prominent of whom were Saint Augustine and Saint Thomas Aquinas. The former lived during a period of important historical change and understood the foundations of the ancient Roman law, but as a Christian he attributed higher power to the order established by God, in which primordial rationality lies, rather than to secular laws.[804] This philosopher emphasised that people must obey the positive laws only insofar as they follow the eternal law, which was understood as created by God and designed to rule righteously and properly manage all affairs.[805] Saint Thomas Aquinas also grouped laws into the categories of right and wrong, and stated that each law created by people has as much legal basis as the extent to which it is derived from the natural law, and if it somehow differs from the latter, it is not a law, but rather a distortion of law.[806] Hence, in contrast to the representatives of

800 Ian McLeod, *Legal Theory* (3rd edn, Palgrave Maccmillan 2005) 19.
801 Baublys and others, *Teisės teorijos įvadas* (n 657) 81-82.
802 Beinoravičius, 'Teisės samprata kaip metodas' (n 763) 44.
803 Berman, *Teisė ir revoliucija: vakarų teisės tradicijos formavimasis* (n 41) 26.
804 Bronislovas Kuzmickas, *Filosofijos istorijos apybraižos* (Mykolas Romeris University 2012) 47-48.
805 Baublys and others, *Teisės teorijos įvadas* (n 657) 85.
806 ibid 102.

legal positivism, according to Saint Augustine and Saint Thomas Aquinas, positive laws must conform to a certain standard of justice that is derived from the will of God.

Later, in the 17th century, H. Grotius, who was still influenced by the ideas of natural law but was already looking through the prism of the dawning positivism,[807] sought to separate law from theology, arguing that natural law is based on rationality rather than on the existence of God.[808] These ideas, as well as those that emerged a little later during the Enlightenment, encouraged the secularisation of law and thus strengthened the central government of the state, at the same time eradicating the religion-based concept of natural law.[809] During the French Revolution, there was a transition from the school of natural law to the school of rationalism, which was based on the dominance of reason and sought to create law on new foundations, eliminating the element of morality.[810] In the second half of the 19th century, these factors contributed to the strengthening of the role of the state in legal ideology and prompted the creation of the paradigm of legal positivism.[811]

However, despite the changes discussed above, 'every time there is a disappointment related to positive law […] [there is a] turn to the more "righteous" natural law'.[812] It was after the wars of the 20th century that the shift to the ideas of natural law occurred.[813] These ideas encouraged 'the pursuit of humanity and justice in positive law, prompted the consolidation and defence of the individual's economic freedom, and exerted enormous influence on constitutionalism and the development of democracy, as well as laid the foundations for more just international law'.[814] Currently, in the Western legal tradition, the secular, reason-based doctrine of natural law is

807 Justinas Žilinskas, '„Teisingo karo" doktrina ir jos atspindžiai mūsų dienomis' (2012) 19 Jurisprudencija 1201, 1206.

808 Brian Z Tamanaha, *General Jurisprudence of Law and Society* (OUP 2001) 21.

809 Beinoravičius, 'Teisės samprata kaip metodas' (n 763) 45.

810 ibid 44-45.

811 ibid 45.

812 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 24. The shift from legal positivism to the paradigm of Natural law, which happened at the end of the Second World War, is discussed in Chapter '4.2.1. The Role of Morality from the Perspective of the Paradigm of Legal Positivism'.

813 Max Lyles, *A Call for Scientific Purity: Axel Hägerström's Critique of Legal Science* (Institutet för Rättshistorisk Forskning 2006) 639.

814 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 24.

considered to be the basis of the concept of natural rights, which was later realised in positivist law in the form of human rights.[815] The Declaration[816] and the European Convention for the Protection of Human Rights and Fundamental Freedoms[817] are examples of legal positivism's return to the ideas of natural law. According to E. Kūris, although the attempt to define the origins of natural law 'ends up in speculations, the validity of which cannot be proven empirically',[818] today it is hard to imagine the refutation of human rights, at least in the countries that belong to the Western legal tradition.

The absence of agreement on the origin and content of natural law is one of the factors prompting the representatives of contemporary law to seek alternative criteria of morality that would impose different requirements on legal systems. L. Fuller argued that law must meet certain formal requirements, namely eight principles[819] called the 'internal morality of law',[820] rather than requirements of content. This 'internal morality of law' differs from the classical natural law in that it does not cover all aspects of the moral life of mankind[821] and is neutral in relation to most ethical problems.[822] However, the departure from the above eight principles, according to this legal philosopher, is a violation of the dignity of the person as a responsible subject.[823] Although L. Fuller did not concentrate on the content of law as much as the other representatives of the school of natural law by emphasising specific values that must be reflected in the legal system, according to him, the inability to ensure at least one of the

815 C Fred Alford, *From Aquinas to International Human Rights* (Palgrave Macmillan 2010) 2.
816 Declaration.
817 European Convention on Human Rights.
818 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 24.
819 (1) generality; (2) promulgation (the accessibility of law to the addressee); (3) non-retroactivity (general requirements of retroactive law); (4) intelligibility and clarity; (5) non-contradiction; (6) possibility of compliance; (7) constancy (avoidance of frequent change); (8) congruence (matching of official rules and actions) (Lon L Fuller, *The Morality of Law* (Yale University Press 1964) 46-91).
820 ibid 46.
821 ibid 96.
822 ibid 162.
823 ibid.

aforementioned principles shows that certain orders cannot be regarded as legal in general.[824]

Another representative of the contemporary school of natural law, J. Finnis, did not look for the source of natural law in metaphysics or in human nature, but argued that its origin are irreducible, unquestionable and obvious basic goods that are necessary for human prosperity.[825] The latter legal philosopher did not fully agree with the point of view of the representatives of the classical school of natural law, who claimed that a system cannot be considered a legal system if it does not comply with the aforementioned principles of natural law. J. Finnis stated that even unjust law can still be legally valid, or legally binding in the narrow sense,[826] if it meets certain requirements.[827] Thus, according to him, compliance with a certain higher order is a criterion for assessing the legal system and not a criterion of its status *per se*.

Considering everything discussed above, the change in the role of natural law as a 'higher' law is evident. Numerous ancient and medieval ideas show that natural principles and morality manifest themselves as factors declaring positive law invalid if its content does not meet certain natural law-based standards. Meanwhile, in the modern natural law theories, the morality of law is evaluated in the light of more formal criteria, whereas the 'higher' law acts as a standard for assessing the positive law. However, the incompatibility of the latter with the former does not always invalidate the positive legal system. Despite the clear awareness that a legal system must be characterised by formal features emphasised in the light of the paradigm of legal positivism, the value-based criteria originating in the concept of natural law remain important, even if they do not determine the status of the whole social order as a legal system. This suggests that the role of morality in the Western legal tradition is real and significant.

824 Lon L Fuller, *The Morality of Law* (Yale University Press 1964) 39.

825 Basic goods are the following: (1) life, (2) knowledge, (3) play, (4) aesthetic experience, (5) sociability (friendship), (6) practical reasonableness, (7) 'religion' (John Finnis, *Natural Law and Natural Rights* (OUP 1980) 59, 86-89).

826 ibid 360-361.

827 Requirements: (1) emanates from a legally authorised source; (2) will in fact be enforced by courts and/or other officials, and/or (3) is commonly spoken of as a law like other laws (ibid).

4.2.3. The Role of Morality in the Paradigm of Legal Realism

Defining legal realism is not an easy task, due to the absence of a standard unifying all of the directions of this legal concept.[828] This situation is influenced by the fact that it is not a very systematic legal paradigm, and also holds a sceptical view on generalisations.[829] In the most general sense, this is a direction of legal theory that is not interested in the content or the form of law,[830] but rather in its functions, operation and effects which occur in society.[831] There are two streams of legal realism: (1) American legal realism, which analysed case law, and (2) Scandinavian legal realism, which analysed fundamental legal concepts such as the concept of law, the concept of rights, the concept of the rule of law, etc.[832] According to American legal realism, law is what judges do when settling disputes,[833] whereas the Scandinavian realists claimed that law does not exist at all, and even if it does, its only purpose is factual or social benefit.[834]

According to O. W. Holmes Jr., who is the most prominent representative of American legal realism, when deciding whether certain laws can be applied, it is necessary to discuss such matters as 'the felt necessities of the time, the prevalent moral and political theories, intuitions of public policy, avowed or unconscious, even the prejudices which judges share with their fellow-men'.[835] The American legal realists, much like the legal positivists,

828 Mauro Zamboni, 'Legal Realisms and the Dilemma of the Relationship of Contemporary Law and Politics' <http://www.scandinavianlaw.se/pdf/48-34.pdf> accessed 30 May 2023; Wilfrid E Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (1981) 66 Cornell Law Review 986, 987.

829 Harry W Jones, 'Law and Morality in the Perspective of Legal Realism' (1961) 61 Columbia Law Review 799, 809.

830 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 25.

831 Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (n 828) 1001 citing Yntema, *Jurisprudence on Parade*, 39 MICH. L. Rev. 1154, 1164 (1941).

832 Torben Spaak, 'Naturalism in Scandinavian and American Realism: Similarities and Differences' in Matthias Dahlberg (ed), *Uppsala-Minnesota Colloquium: Law, Culture and Values* (Iustus förlag 2009) 33-83, 34.

833 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 25.

834 Baublys and others, *Teisės teorijos įvadas* (n 657) 185.

835 Oliver W Holmes, *The Common Law* (Belknap Press of Harvard University Press 1963) 5.

sought to separate law and morality from one another,[836] but at the same time acknowledged the influence of morality on the legal system.[837] As a result, according to the American legal realists, a decision of a court can also be based on arguments that arise from what 'should be'.

However, the American legal realists perceive this 'should be' more broadly than the legal positivists. According to the former, a court's decision which is based on arguments arising from the analysis of what 'should be' does not necessarily always exclusively refer to the principles of morality, but also to policy arguments or personal preferences.[838] In view of this, it is to be held that legal realism is not satisfied with only a formal analysis of concepts of legal positivism, but in the decision-making it is concerned with the practical result of legal procedure, rather than only with the internal doctrinal consistency in the positivist legal structure.

According to the Scandinavian realists, law is neither eternal principles nor an obligation imposed by the ruler to behave in a certain way in a particular situation. They argue that the true meaning of law, if it indeed exists, can only be found empirically or scientifically, through observation of the functioning of society.[839] This definition suggests that Scandinavian realism denies the ideas of the aforementioned paradigms, i.e. legal positivism and the school of natural law.[840] A. Hägerström, who was the pioneer of Scandinavian realism, sought to demonstrate that the categories of legal order (rights, duties, transfer of rights and validity) are partly superstitious beliefs, myths, fictions, magic or confusion.[841] He also denied the existence of values and moral norms *per se*, and argued that these categories merely exist in the minds of human beings.[842]

836 Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (n 828) 1006.

837 Oliver W Holmes, 'The Path of Law' <http://moglen.law.columbia.edu/LCS/palaw.pdf> accessed 30 May 2023.

838 Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (n 828) 1010.

839 Baublys and others, *Teisės teorijos įvadas* (n 657) 181.

840 For example, this was done by A Hägerström (see Bjarup J, 'The Philosophy of Scandinavian Realism' (2005) 18 Ratio Juris 1, 6).

841 Herbet L A Hart, 'Scandinavian Realism' (1959) 17 The Cambridge Law Journal 233, 233.

842 Baublys and others, *Teisės teorijos įvadas* (n 657) 181. This position was later supported by the representatives of Critical Legal Studies, who indicated that there is no single objectively appropriate moral position underpinning the legal system (John Eekelaar, 'What is 'critical' family law?' (1989) 105 Law Quarterly Review 244, 244).

A. Hägerström's ideas were continued by K. Olivecrona, who also disagreed with the idea that law originated from the 'higher' order, or that it was ordered by the sovereign. According to him, the binding power of law is nothing more than an idea in the minds of the people,[843] and the content of law and its change are influenced not by morality, but rather by the self-interest of individuals.[844] Much like K. Olivecrona, A. Ross emphasised the psychological nature of law, suggesting that consideration should be given to the way legal norms affect the real behaviour of individuals, rather than just looking at the law as a command of a sovereign.[845] This legal philosopher also argued that law and morality are essentially separate systems of social norms, but there is always the possibility that moral norms will affect legal practice, especially in situations not regulated or insufficiently regulated by law or when the law simply cannot provide an answer.[846]

Hence, despite the difficulties in finding common ground between the ideas of legal realism, both analysed branches agree that 'the roots of law lie in its practice'.[847] Therefore, the issues concerning the form and content of law, emphasised by the schools of legal positivism and natural law, are important to legal realism only insofar as they are related to the actual functioning of law in society. Concerning the role of morality in the legal system, the Scandinavian legal realists deny its impact on the legal system more strictly than the representatives of American legal realism. The latter understand the concept of 'should be' more broadly than the legal positivists and, alongside morality, include arguments arising in other areas of social reality. However, both streams of legal realism agree, at least on a certain level, that internal convictions may be important in interpreting the content of legal norms, which means that morality has a certain role in the legal system in the context of the Western legal tradition.

843 Davies and Holdcroft, *Jurisprudence: Texts and Commentary* (n 766) 427.
844 Gregory S Alexander, 'Comparing the Two Legal Realisms-American and Scandinavian' (2002) 50 The American Journal of Comparative Law 131, 159.
845 Baublys and others, *Teisės teorijos įvadas* (n 657) 184.
846 Cornelis V Maris, *Critique of the Empiricist Explanation of Morality* (Kluwer-Deventer 1981) 210.
847 Baublys and others, *Teisės teorijos įvadas* (n 657) 185.

4.2.4. The Role of Morality in the Western Legal Tradition and its Significance for the European Patent System

The legal paradigms discussed above present different views on the role of morality in the legal system that belongs to the Western legal tradition. This situation is considered to be an important element of the constant debate taking place in this legal tradition concerning law and its continuous and interrupted relationship with other areas of social reality.[848]

Legal positivism, which emphasises the formal concept of law, states that morality does not play any role in the positivist legal system, even if it affects the development of the positive legal norms. According to H. Kelsen, moral norms can only be transformed into positive legal norms if the law itself delegates 'certain metalegal norms, such as morality or justice'.[849] This legal philosopher argued that only those moral norms that have already undergone a certain formal procedure of becoming a part of the positive legal system – after which they are understood to be no longer moral but rather legal norms – can be considered as part of the legal system. Therefore, according to this legal paradigm, morality norms influence the content of legal norms before they become a part of the positive law, but after a legal system or a legal norm is formed on the basis of morality norms, morality loses any role it had in the legal system because morality becomes a legal norm. This means that in legal positivism, the role of morality as a category of ethics does not exist in the context of the Western legal tradition.

In the light of the discussed approach of legal positivism, it can be concluded that morality as a category of ethics[850] does not exist when applying and interpreting Art. 53(a) EPC. In the provision in question, morality has already been transformed into a norm of positive law and has become a part of the positivist European patent system. Therefore, in accordance with Art. 53(a) of the Convention, a decision concerning the patentability of a particular invention should not result from the arguments outside this legal framework, including morality.

However, in order to apply the said provision, it is necessary to interpret the content of the term 'morality', which inevitably leads to analysis of the

848 William Twining, *Globalisation and Legal Theory* (Cambridge University Press 2000) 244.

849 Kelsen, *Grynoji teisės teorija* (n 760) 280-281 (translated from Lithuanian into English by the author of this study).

850 According to ibid 83.

concept of the category in question. In this case, according to H. Kelsen, the legal norms are interpreted in two possible ways: (1) by the law enforcement body; or (2) by the private individual and, especially, by legal science.[851] During the processes of interpretation by a law enforcement body, 'the applicable law is merely a framework in which there are several different possible options'.[852] Therefore, H. Kelsen disagrees with the traditional approach in jurisprudence which states that 'a law applicable in a certain case can only provide *one* correct solution'.[853] Similarly, in the case of interpretation in legal science, which involves a purely cognitive identification of the meaning of legal norms,[854] it is possible to 'reveal all possible meanings of a legal norm and not more'.[855] Therefore, according to H. Kelsen, in every case of interpretation, there are several possible answers to questions concerning exactly what may happen when evaluating commercial exploitation of an invention with regard to Art. 53(a) EPC.

The above considerations show that, when a norm becomes part of the legal system, as in the case of Art. 53(a) of the Convention, a representative of legal positivism, even if he/she denies the role of morality as a category of ethics in the legal system, is forced to analyse the meaning of the category 'morality' as a part of the positivist legal system. In this case, the said category, even when it is included in the EPC and is a part of the positive law,[856] remains rather abstract in terms of its content. In such situations, it may not be sufficient to merely consider what is written, or to analyse the system of positive legal norms and their interrelationships, but it may also be necessary to make an assessment based on certain values. This means that, even from the perspective of positive law, in interpreting and applying Art. 53(a) EPC, it may be necessary to rely on moral norms prevailing in a society or even personal values, in addition to the norms existing in the positivist legal system.

According to the ideas of H. Kelsen, such a solution, despite the fact that it is based on moral convictions, is, if it falls within the framework of the positivist legal system, considered a legal act[857] which is in line with the existing positive law. Thus, even when seeking to eliminate morality from

851 Kelsen, *Grynoji teisės teorija* (n 760) 277.
852 ibid 279 (translated from Lithuanian into English by the author of this study).
853 ibid (translated from Lithuanian into English by the author of this study).
854 ibid 281.
855 ibid 282 (translated from Lithuanian into English by the author of this study).
856 Being in the 'framework' of positivist law (ibid 279).
857 ibid.

the legal system and deny its role in it, in the case of interpretation of abstract legal norms, as in Art. 53(a) EPC, the legal positivists are still forced to employ subjective personal or socially accepted and widespread values. Therefore, in the analysis of such norms as Art. 53(a) of the Convention, the role of morality in the legal system is difficult to deny.

Representatives of the school of natural law acknowledge that, along with the positivist legal system created by human beings, there also exists a certain 'higher' order to which the content of the former must correspond. Therefore, particular value-based standards, including morality, can be the criteria both for assessing a legal system and acknowledging it as legal.[858] Despite the absolutely identical positivist law,[859] the fact that the effect of values is extremely evident in the case of controversial legal issues shows that morality, even if it is relative, can play an important role in the legal system in the context of the Western legal tradition.

According to the paradigm of natural law, when employing the criteria of value, a direct reference to morality as provided in Art. 53(a) EPC is not necessary for the interpretation of the positive legal norms. However, such reference allows an analysis that focuses on value beliefs and does not hide behind legal arguments that are usually used with the intention of providing the legal system with more predictability and stability. Hence, in the case of the interpretation and application of Art. 53(a) of the Convention, it becomes possible to openly discuss morality as a criterion for making decisions.

Nevertheless, in this case, the difficulties coming from the concept of natural law are evident: differently than in legal positivism, even in the case of consistent argumentation leading to a rational solution from one perspective of a certain value position, that solution may be considered completely incorrect from the point of view of another. This difficult situation is caused by the fact that it is impossible to define universally acceptable standards of value applied in all cases, especially in a legal system that belongs to the Western legal tradition, which is characterised by pluralism.[860] Hence, even if the role of morality in the legal system is recognised, it is difficult to define it.

858 See e.g. Fuller, *The Morality of Law* (n 819) 39; Finnis, *Natural Law and Natural Rights* (n 825) 360-361.

859 Levičev, 'Teisėtyros metodologinio spektro analizė' (n 759) 101-102.

860 Berman, *Teisė ir revoliucija: vakarų teisės tradicijos formavimasis* (n 41) 26.

Often, from the point of view of the modern Western legal tradition, human rights are considered to be the expression of natural law in a positive legal system.[861] For this reason, from the perspective of both legal positivism and the school of natural law, particular attention is paid to the interpretation of Art. 53(a) EPC in order to ensure the physical and spiritual well-being of the human being. From the position of legal positivism, this development of thought in the Western legal tradition encourages the creation of positivist legal norms that would reflect the attention to human interests. It can even be connected to the discussed forms of the relationship between morality and law mentioned by H. L. A. Hart which appear when law overlaps with certain moral beliefs that the positivist legal system must match.[862] On the other hand, human rights, embodying the contemporary ideas of natural law, promote the assessment of the positive law precisely from the point of view of their protection. Considering the above, the criteria related to the protection of human interests influence the analysis of Art. 53(a) EPC, both with the help of the positive legal norms embodying specific standards for the protection of human rights – or containing such categories as 'morality' – and from the perspective of natural law, where the positivist legal norms are evaluated.

American and Scandinavian legal realism, both of which emphasise the actual functioning of law, acknowledge the separation of law from morality, much like the paradigm of legal positivism. However, American legal realism indicates that morality can nonetheless affect the legal system,[863] and that the idea of 'should be', which the discussed branch associates with policy or personal choice, can influence legal decisions.[864] Although policy or personal choice cannot be fully equated with morality, it can be agreed that the approach of American legal realism to the role of morality or other arguments that are outside the legal framework is more in line

861 Kūris, 'Grynoji teisės teorija, teisės sistema ir vertybės: normatyvizmo paradigmos iššūkis' (n 68) 24; Goldman, *Globalisation and the Western Legal Tradition: Recurring Patterns of Law and Authority* (n 43) 227; Kai Man Kwan, 'Reflections on Contemporary Natural Law Theories and Their Relevance' [2012] CGST Journal 197, 203 citing Jacques Maritain, *The Rights of Man and Natural Law* (London: Geoffrey, 1944).

862 Hart, *Teisės samprata* (n 759) 322-337.

863 Holmes, 'The Path of Law' (n 837).

864 Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (n 828) 1010 citing HLA Hart, The Concept of Law (1961), at 200-201.

with the concept of natural law than with the position of legal positivism.[865] However, unlike the school of natural law, representatives of legal realism indicated that the factors influencing legal decision-making are not only morality, but also psychological, political, economic, business or social criteria.[866] This means that in the paradigm of legal realism, the decision-making process of the courts is not only perceived as a formal process limited by the norms of positive law, but also as an activity in which it is necessary to consider what 'should be' in the context of morality as well as other fields of social reality.

Considering the above, it can be concluded that legal realism reveals how difficult the interpretation of Art. 53(a) EPC is. In the case of the interpretation of the aforementioned provision, this direction of legal realism would draw attention not only to the normative, i.e. legal and moral, aspects, but also to the arguments and objectives related to economic benefits or even progress in a certain scientific field. Although the norms of soft law, the Guidelines for Examination, state that the economic effects of granting or rejecting patents are not examined,[867] in reality, these aspects are crucial for patent systems. Economic arguments, in particular, are considered to be one of the key reasons for the creation of the patent system.[868] Hence, it can be understood that, in the interpretation of Art. 53(a) of the Convention from the perspective of legal realism, the meaning attributed to the category 'morality' may be determined by specific economic intentions. Therefore, from the point of view of legal realism, the role of morality, as well as of the arguments emerging from other areas of social reality, in interpreting this provision of European patent law cannot be denied.

In the light of the above, it can be held that a legal system in the context of the Western legal tradition is influenced by the totality of the paradigms emphasising the form, content and actual functioning of legal systems.

865 Jones, 'Law and Morality in the Perspective of Legal Realism' (n 829) 809.

866 Rumble, 'Legal Positivism of John Austin and the Realist Movement in American Jurisprudence' (n 828) 997 citing W. O. DOUGLAS, Education for the Law, in DEMOCRACY AND FINANCE: THE ADDRESSES AND PUBLIC STATEMENTS OF WILLIAM O. DOUGLAS AS MEMBER AND CHAIRMAN OF THE SECURITIES AND EXCHANGE COMMISSION 279 (J. Allen ed. 1969).

867 Guidelines for Examination, March 2023 (n 63), pt G-II, 4.1.3. However, there is unanimous agreement on the importance of the economic function of patents in patent law theory (see e.g. Hall and Harhoff, 'Recent Research on the Economics of Patents' (n 56)).

868 Hall and Harhoff, 'Recent Research on the Economics of Patents' (n 56).

These paradigms discussed above, which have interchanged between themselves[869] and opposed each other,[870] are important for understanding every modern legal system in the Western legal tradition. A significant part of this legal tradition is the relationship between a legal system and other areas of social reality, such as morality, as is the case with Art. 53(a) EPC. Each of these legal paradigms distinguishes an important dimension of the legal system belonging to the pluralist Western legal tradition and indicates that there is nothing in the said tradition in an absolutely pure form.

The analysis of the above-mentioned legal paradigms reveals a significant and actual role of morality in the legal system in the context of the Western legal tradition. Consequently, this means that in the modern legal system, values outside its framework are also important; however, their role depends on the perspective of each of these paradigms. On the one hand, especially from the practical point of view, this leads to a paradoxical situation where there are contradictory positions in the same legal tradition concerning the role of morality in the legal system. On the other hand, the differences in the legal paradigms make it possible to analyse the place of morality broadly by taking into consideration its various dimensions. Thus, in order to determine the role of morality in Art. 53(a) of the Convention, which belongs to the Western legal tradition, the positions of all the legal paradigms analysed in this study must be taken into account and perceived as equally important parts.

4.3. The Role of Ordre Public *in the Western Legal Tradition*

For a long time, countries had the freedom to refuse patents for inventions of certain technologies, such as chemistry or pharmaceuticals, and this was regarded as one of the most significant intellectual property rights-related barriers to trade.[871] However, following the adoption of the TRIPS Agree-

869 Berman, 'The Western legal tradition: The interaction of revolutionary innovation and evolutionary growth' (n 639) 43.

870 Tamanaha, *General Jurisprudence of Law and Society* (n 808) 8. Discusses legal positivism, the concept of Natural law and the historical school of law. It must be noted that Yntema linked legal realism to the historical school of law (Hessel E Yntema, 'Mr. Justice Holmes' View of Legal Science' (1931) 40 The Yale Law Review 696).

871 Pires de Carvalho, *The TRIPS Regime of Patent Rights* (n 29) 245.

ment, this discriminatory regime was abolished,[872] as the TRIPS Agreement obliged the contracting parties to issue patents for all patentable inventions, regardless of their technological field.[873] At the same time, this new regulation made it possible for the contracting parties to impose limited exceptions to patentability, one of which is the *ordre public*- and morality-based Article 27(2).[874]

The aforementioned exception in the TRIPS Agreement indicates that the members of the World Trade Organization (the 'WTO') 'may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law'.[875] According to the legal doctrine, this Art. 27(2) of the TRIPS Agreement means that inventions may be considered non-patentable 'based on a risk that their commercial exploitation within their territory could endanger *ordre public* or morality within the territory of the WTO Members concerned'.[876]

The terms '*ordre public*' and 'morality' for the discussed provision of the TRIPS Agreement were 'borrowed' from Art. 53(a) EPC on the recommendation of the European Community.[877] In Art. 53(a) EPC, not only is '*ordre public*' identified as one of the grounds for exceptions to patentability, but it is also stated that the EPO can interpret this category autonomously and does not need to take into account the national legal systems of the EPOrg Member States.[878] Legal doctrine states that *ordre public* as referred to in Art. 53(a) of the Convention is composed of 'ethically based constitutional or other rules, usually backed up by penal provisions, that reflect basic rules prevailing in society and trade'.[879]

872 Pires de Carvalho, *The TRIPS Regime of Patent Rights* (n 29) 245.
873 TRIPS Agreement, Art. 27(1).
874 Pires de Carvalho, *The TRIPS Regime of Patent Rights* (n 29) 247.
875 TRIPS Agreement, Art 27(2).
876 Gervais, *The TRIPS Agreement, Drafting History and Analysis* (n 37) 341.
877 Pires de Carvalho, *The TRIPS Regime of Patent Rights* (n 29) 297.
878 The second part of the sentence in Art. 53(a) indicates that 'such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States.' (EPC, Art. 53 (a)).
879 Singer and Stauder, *The European Patent Convention. A Commentary* (n 125) 88.

According to D. Gervais, the negotiations concerning Part 5 of the TRIPS Agreement,[880] containing Art. 27(2) on patents, were the most difficult, because a consensus had to be reached concerning both the problems that exist in the Northern hemisphere and the disagreements between the South and the North.[881] Despite the fact that the mentioned author regards the result of these negotiations as positive in terms of extensiveness concerning Part 5 and describes it as 'impressive',[882] there exist different opinions in the legal literature, some of which indicate that the TRIPS Agreement more reflects an approach that is favourable for developed countries, which are most often Western.[883]

The purpose of this study is not to analyse in detail the question of which countries or interest groups were most favoured in negotiating the TRIPS Agreement. However, the fact that the industrialised Western states proposed the inclusion of intellectual property in the Uruguay Round of the General Agreement on Tariffs and Trade, which led to the establishment of the WTO and the adoption of the TRIPS Agreement,[884] allows the con-

880 TRIPS Agreement, Chapter 5: Patents.

881 Gervais, *The TRIPS Agreement, Drafting History and Analysis* (n 37) 336.

882 ibid 336-337. According to publicly available data of the World Intellectual Property Organization, 164 countries have signed the TRIPS Agreement to date (World Intellectual Property Organization, IP Treaties Collection, IP-related Multilateral Treaties, Contracting Parties/Signatories, Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) <http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22> accessed 30 May 2023).

883 See e.g. Gana, 'Prospects For Developing Countries Under the TRIPs Agreement' (n 49) 746-757; L Danielle Tully, 'Prospects For Progress: The TRIPS Agreement and Developing Countries After the DOHA Conference' (2003) 26 Boston College International and Comparative Law Review 129, 134; Daniel J Gervais, 'Intellectual Property, Trade & Development: The State of Play' (2005) 74 Fordham Law Review 505, 508-509 citing Daniel Gervais, The TRIPS Agreement: Drafting History and Analysis (2d ed. 2003); Annette Kur, 'International Norm-Making in the Field of Intellectual Property: A Shift Towards Maximum Rules?' (2009) 1 WIPO Journal: Analysis And Debate Of Intellectual Property Issues 27, 28; Marianne Levin, 'The pendum keeps swinging – present discussions on and around the TRIPS Agreement' in Annette Kur (ed), *Intellectual Property Rights in a Fair World Trade System* (Edward Elgar Publishing 2011) 3-60, 15-16.

884 Annette Kur, 'International Norm-Making in the Field of Intellectual Property: A Shift Towards Maximum Rules' (International Conference on Innovation and Communication Law 2009) <http://www.ip.mpg.de/fileadmin/ipmpg/content/personen/annette_kur/madrid_08032.pdf> accessed 30 May 2023. Some sources highlight the role of the U.S. in pursuit of higher standards for the protection of intellectual property (e.g. Josef Drexl, 'The Concept of Trade-Relatedness of Intellectual Property Rights in Times of Post-TRIPS Bilateralism' in Hanns Ullrich

clusion that the latter agreement, including its Art. 27(2), to a high degree reflects the interests of the Western countries. In addition, as mentioned above, the term '*ordre public*' was itself proposed by the European Community on the basis of Art. 53(a) EPC,[885] which in this research is regarded as part of the Western legal tradition. Therefore, the analysis of Art. 27(2) of the TRIPS Agreement, as well as of the legal norms and the doctrine related to it, can be beneficial in understanding the concept '*ordre public*' and its significance in the Western legal tradition. The definition of this concept as provided in the scholarly literature is difficult to translate into English,[886] and thus it is even regarded as not having an English equivalent.[887]

The choice of the category '*ordre public*' shows that, from the very moment of the drafting of the Convention, the European patent system seeks to ensure that this term is perceived in the same way, even from the perspective of those legal systems whose national legal norms could define this category differently. This also confirms the EPO's objective to ensure the unity of the European patent system and its autonomy from the influence of national legal systems in construing the content of *ordre public*.

In the countries of civil law tradition, *ordre public* refers to imperative or *jus cogens*[888] legal provisions that cannot be changed by contract or restricted in any other way.[889] This particular concept of *ordre public* exists in the French legal system.[890] In the German translation of the EPC, the term '*öffentliche Ordnung*' is used. It exists in the German legal system, which is a part of the civil law tradition, and it can also be synonymous with the category '*ordre public*'.[891] Meanwhile, in the English legal system,

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and others, *TRIPS plus 20. MPI Studies on Intellectual Property and Competition Law* (Springer Verlag 2016) 53-83, 60-61).

885 Pires de Carvalho, *The TRIPS Regime of Patent Rights* (n 29) 297.

886 UNCTAD-ICTSD, *Resource Book on TRIPS and Development* (Cambridge University Press 2005) 375.

887 Warren-Jones, 'Finding a "Common Morality Codex" for Biotech – A Question of Substance' (n 116) 641 citing Armitage & Davis, "Patents and Morality in Perspective" (Common Law Institute of Intellectual Property, London 1994), at 24.

888 In the legal doctrine, *jus cogens* is defined as 'the body of those general rules of law whose non-observance may affect the very essence of the legal system to which they belong to such an extent that the subject of law may not, under pain of absolute nullity, depart from them in virtue of particular agreements' (Ian Sinclair, *The Vienna Convention on the Law of Treaties* (Manchester University Press 1984) 203).

889 Michael Forde, 'The "Ordre Public" Exception and Adjudicative Jurisdiction Conventions' (1980) 29 The International and Comparative Law Quarterly 259, 259.

890 ibid.

891 Sinclair, *The Vienna Convention on the Law of Treaties* (n 888) 203.

which belongs to the common law tradition, this category is considered to be closest to the term 'public policy',[892] indicating that courts may refrain from following certain contracts if these 'contravene fundamental moral principles (*bonnes moeurs*, or *gute sitten*), or which would offend against some other overriding public interest'.[893]

Although the legal literature indicates that there is no consensus on the definition of the term '*ordre public*',[894] the aim of providing certain generalisations concerning it exists. For example, it is argued that there are two approaches to the category of '*ordre public*'.[895] One of them is broader and identifies this term as 'public order' or 'public policy', both of which include a particularly wide range of aspects.[896] This concept is associated with the common law system, for example the English system, and, despite being rather broad, it is considered to be less prone to change.[897]

Another, narrower understanding of this term indicates that *ordre public* includes 'fundaments from which one cannot derogate without endangering the institutions in a given society'[898] or that the term in question 'expresses concerns about matters threatening the social structures which tie a society together, i.e., matters that threaten the structure of civil society as such'[899]. In Art. 27(2) of the TRIPS Agreement, it is specified that *ordre public* may be associated with the protection of human, animal or plant life and health, as well as the prevention of serious damage to the environment.[900] Also, legal doctrine states that *ordre public* includes 'only the "major principles of the legal order",[901] for example, the inviolability of human dignity and the right to life, physical integrity and personal freedom'.[902]

The legal literature explains that, when drafting the TRIPS Agreement, the term '*ordre public*', proposed by the European Community, was chosen

892 Gervais, *The TRIPS Agreement, Drafting History and Analysis* (n 37) 343.
893 Forde, 'The "Ordre Public" Exception and Adjudicative Jurisdiction Conventions' (n 889) 259.
894 Hellstadius, *A Quest for Clarity: Reconstructing Standards for the Patent Law Morality Exclusion* (n 6) 161.
895 ibid 162.
896 ibid.
897 Sinclair, *The Vienna Convention on the Law of Treaties* (n 888) 204.
898 Gervais, *The TRIPS Agreement, Drafting History and Analysis* (n 37) 343.
899 UNCTAD-ICTSD, *Resource Book on TRIPS and Development* (n 886) 375.
900 TRIPS Agreement, Art. 27(2).
901 Straus, '*Ordre public* and morality issues in patent eligibility' (n 56) 22.
902 ibid.

instead of 'public order' or 'public policy', specifically because it has a more precise and narrower meaning.[903] Although this concept is regarded as being narrower, it is also considered to have more potential for change and development according to political, social and economic circumstances,[904] and is therefore reasonably considered to be evolutionary.[905]

Considering the above, it is possible to conclude that the category '*ordre public*' is associated with the legal norms and principles that are of fundamental importance to the existence and proper functioning of a particular society, its members and the surrounding environment. Attention to the human being and the protection of his/her essential interests, which is an important characteristic of every legal system that is a part of the modern Western legal tradition, falls within the scope of *ordre public* and takes an important place. Despite the fact that *ordre public* is first and foremost equated with the legal aspects of reality, it is able to evolve and adapt to changing circumstances of the environment. Consequently, its content can be shaped not only by the established legal rules and principles, but also by non-legal arguments. This reveals another feature of the Western legal tradition, i.e. the relative autonomy of law with regard to other areas of reality, and allows the conclusion that *ordre public*, which is primarily identified as legal norms and principles, may coincide with certain moral norms that are common in a society. In such cases, *ordre public* can be difficult to distinguish from morality in the legal systems of the Western legal tradition, as illustrated by the case law of the EPO Divisions with regard to interpreting and applying Art. 53(a) EPC.

4.4. Preliminary Conclusion

In the majority of EPO case law, morality and *ordre public* are treated as a single ground for opposing the grant of a patent on the basis of Art. 53(a) EPC. There are only a few decisions of the Office in which

903 Dan Leskien and Michael Flitner, *Intellectual Property Rights and Plant Genetic Resources: Options for a Sui Generis System* (International Plant Genetic Resources Institute 1997) 16; Straus, '*Ordre public* and morality issues in patent eligibility' (n 56) 22; Hellstadius, *A Quest for Clarity: Reconstructing Standards for the Patent Law Morality Exclusion* (n 6) 161 citing Correa, Carlos M, Trade Related Aspects of Intellectual Property Rights, A Commentary on the TRIPS Agreement, Oxford University Press 2007.

904 Sinclair, *The Vienna Convention on the Law of Treaties* (n 888) 204.

905 Gervais, *The TRIPS Agreement, Drafting History and Analysis* (n 37) 343.

these categories are distinguished, associating morality with non-legal behavioural standards recognised in a specific society and identifying *ordre public* with legal norms that are fundamental for the existence and proper functioning of a certain society.

Legal positivism and legal realism perceive morality as norms of conduct recognised by a society, or even subjective internal beliefs of an individual, that influence the creation, interpretation and application of legal norms. From the point of view of natural law, morality, regardless of its relative nature, can be identified with law or can be the basis for its evaluation. However, even in the legal paradigms that seek to strictly separate morality from law, there are situations where it is difficult to do so; thus, these two categories may overlap. At the same time, *ordre public* in the Western legal tradition is identified as legal norms and principles that are fundamental to the existence and proper functioning of a particular society and its members as well as the surrounding environment, but which, due to its ability to evolve and adapt to changing conditions by accepting arguments of a non-legal nature, may in some cases coincide with the moral standards.

In the Western legal tradition and in the EPO case law, it is difficult to distinguish morality and *ordre public* from each other. They can be treated as a single category, or they can be treated separately by identifying *ordre public* with legal norms and principles, and morality with non-legal standards of conduct. These difficulties regarding the separation of these analysed categories, both from the position of the Western legal tradition and from the perspective of the European patent system, reveal one of the main features of the Western legal tradition, i.e. the relative autonomy of law from other areas of social reality.