

The Role of Intellectual Property in ABS Projects and BioTrade Enterprises

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Relationship to BioTrade

- Misappropriation of genetic resources and associated traditional knowledge undermines basic BioTrade principles, which acknowledge the contribution of local content, fair and equitable sharing of benefits and respect for rights
- IP tools can also provide ways and means for local communities to derive value from their intangible know-how

Presentation Outline

1. Patentability Criteria and Disclosure
2. Geographical Indications & Collective Trademarks

Patent Application No. WO2006068786

Stephania rotunda: bình vôi (in Vietnamese)

“A method of ameliorating, reducing or treating progressive degradation of a dermal-epidermal junction and/or degradation of a cell-cell cohesion in skin.”

Claims several Asian plants that may be used to create skin care products of the invention including *Stephania rotunda*.

(Avon, 2006 – Application)

TRIPS Requirements (Article 27)

- Requires Members of WTO to grant patents for all fields of technology, including pharmaceuticals
- Novelty, inventive step, industrial application
- 20 year term from the date of filing
- Patent offices will examine application to see if invention meets patentability criteria

What Is Disclosure?

- Disclosure: a key part of the social contract underlying the patent system; time-limited exclusive rights granted in exchange for making public the technology
- Article 29(1), TRIPS: establishes minimum standard for disclosure in patent law. Two concepts:
 - 'sufficiently clear and complete' information for the invention to be carried out by a person skilled in the art
 - best mode for carrying out the invention
- When applying for a patent over an invention, applicants must include (1) a complete description of the invention and (2) how to work it

Disclosure and Prior Art

Disclosure reveals *prior art* - allows for a better assessment of whether the patentability criteria has been met.

Despite variations in countries, the relationship between prior art and disclosure can generally be described as follows:

Novelty: prior disclosures of the invention to the public anywhere in the world can result in rejection of the application on grounds that the invention is not new

Inventive Step: the extent to which an invention embodies in the application is obvious to a person who is skilled in the art who has knowledge of the prior art.

Disclosure and ABS (1)

Nagoya Protocol sets out the rules and mechanisms for ABS. Implications of NP ratification - an obligation to establish a national regime

- Regulation of access to genetic resources and associated TK based on PIC, MAT and benefit sharing
- Designation of national 'checkpoint' and publication of a certificate of compliance
- Since IP absent in NP, need to examine how national IP law can be shaped to further goals of CBD/ABS
- Slow progress on ABS legislation - existing IP law and mechanisms can offer useful options to prevent misappropriation

Disclosure and ABS (2)

IP system can generate incentives for access, utilization and misappropriation of genetic resources and TK

Disclosure of origin requirement

- builds on the interface between IP and ABS systems
- means to ensure that IP system supports ABS objectives by preventing misappropriation of genetic resources and TK

Disclosure of Origin builds on the basic obligation to disclose information in a patent application, as per Article 29, TRIPS

Vietnamese Practice

Ministry of Science and Technology Circular 01/2007

Application for patents relating to genetic resources and/or traditional knowledge should include documents illustrating the origin of the concerned genetic resources and/or traditional knowledge. In case where the inventor or applicant is unable to determine the origin, he/she should make a declaration about that.

Disclosure and its Limitations

2 Key Limitations

- Can only cover a handful of ABS cases - i.e., those that involve patenting
- Will not prevent biopiracy in countries without a disclosure of origin requirement → patents can still be obtained in certain jurisdictions

BUT, requirement can still be useful because

- Critical mass of countries adopting disclosure requirements
- Expanding prior art and accessibility of patent applications worldwide through ICT
- Permits assessment of patent applications using genetic resources and TK that pre-date the CBD and the NP
- Utility of databases and sharing of information (India, Peru)
- Work continues at WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore – text on patents includes options for disclosure of origin; disclosure proposal also tabled at WTO TRIPS Council

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1. Patentability Criteria and Disclosure
2. Geographical Indications & Collective Trademarks

Geographical Indications: a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place. In addition, the qualities, characteristics or reputation of the product should be essentially due to the place of origin.

Collective Trademarks: signs which distinguish the geographical origin, material, mode of manufacture or other common characteristics of goods or services of different enterprises using the collective mark. The owner may be either an association of which those enterprises are members or any other entity, including a public institution or a cooperative.

(Source: WIPO)





What TRIPS Says About GIs

Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin (Article 22).

Geographical indications have to be protected in order to avoid misleading the public and to prevent unfair competition (Article 22).

State of Play at International Level (1)

- Negotiations on both issues taking place as part of the Doha Development Round talks.
- Original deadline for resolving these issues was 2003. Agreement elusive – text to establish a multilateral register remains bracketed; little movement since 2011.
- Appears as a standard item at TRIPS Council meetings.
- Key issue appears to be what the legal effect will be of registration. Does it create some sort of presumption?

State of Play at International Level (2)

- Negotiations are not self contained. Give and take on larger package of agreements under the Doha round, including, for example, enhanced disclosure requirements.
- Where countries stand - GI issues do not break down easily into North-South divide.
- Forum shopping – WIPO, WTO, regional and bilateral agreements
- Developing countries that stand to benefit from GIs are moving ahead on establishing GIs in any event

Questions and answers



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