

## **Topic 9**

# **ABS and IP: A case-study on GRs**

Practical Workshop for Indigenous Peoples and Local Communities on  
Intellectual Property and Traditional Knowledge  
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Daphne Zografos Johnsson  
Legal Officer, Traditional Knowledge Division

Suhel al-Janabi,  
Co-Manager, ABS Capacity Development Initiative

Lena Fey  
ABS Capacity Development Initiative

THE ABS  
CAPACITY  
DEVELOPMENT  
INITIATIVE



L'INITIATIVE DE  
RENFORCEMENT  
DES CAPACITES  
POUR L'APA

# ABS and IP: A Case Study on Genetic Resources

**WIPO Practical Workshop for Indigenous Peoples and Local  
Communities on Intellectual Property and Traditional Knowledge**

*Suhel al-Janabi and Lena Fey*

*4 December 2014, Geneva, Switzerland*

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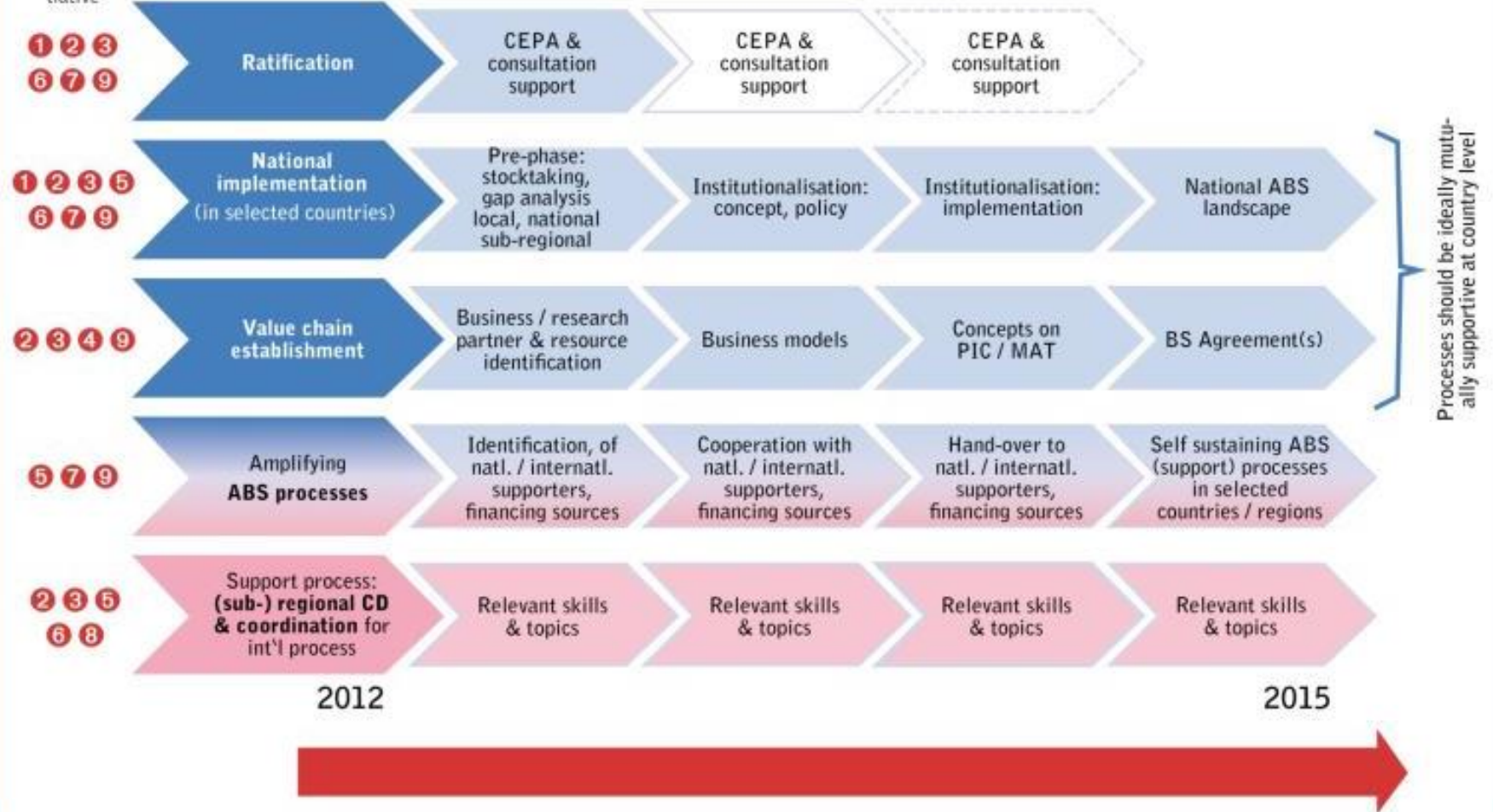


# Outline

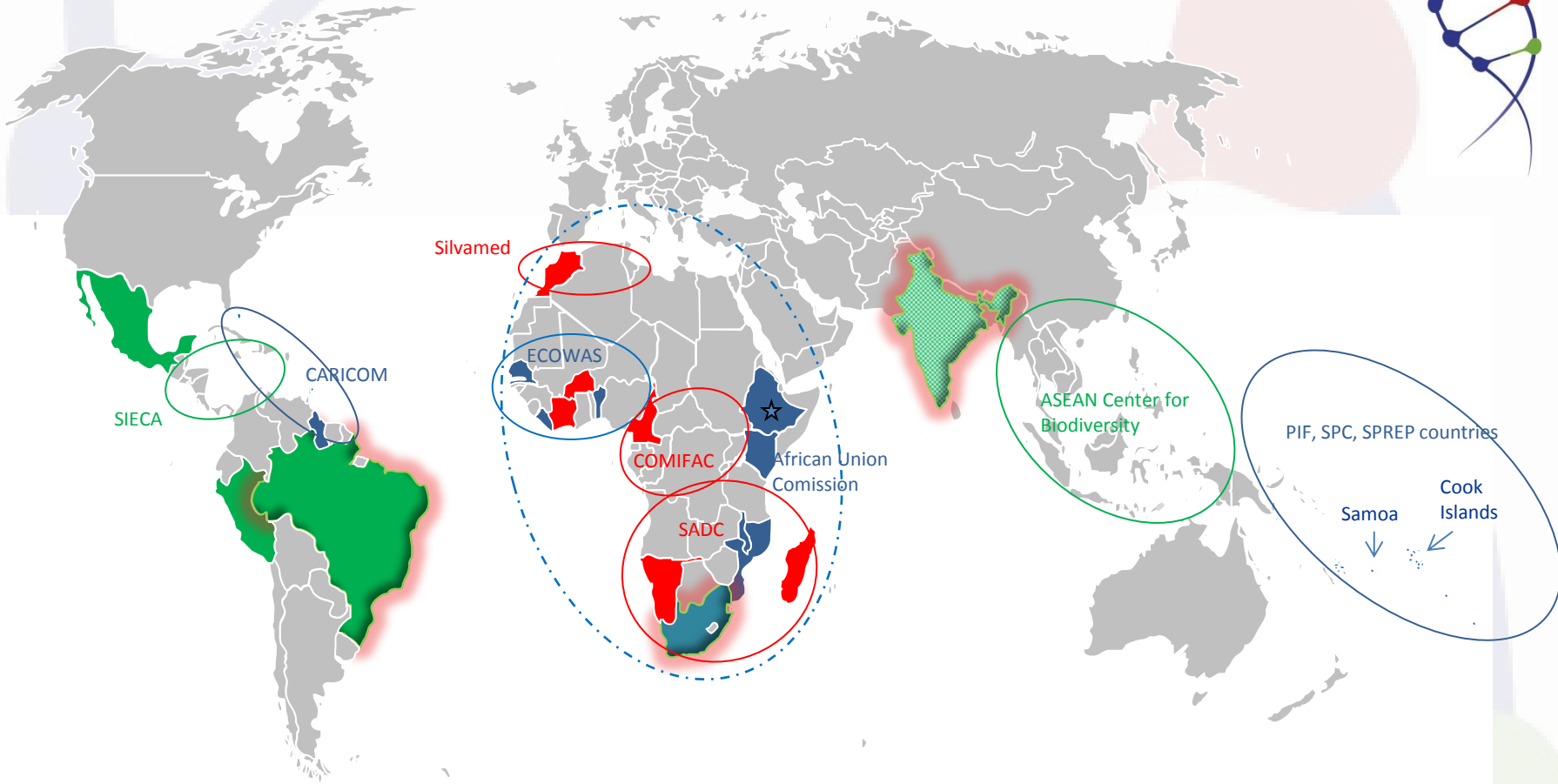
- Introduction
- Key points on ABS
- IP aspects of ABS contracts
- Video of case studies
- Group work on case studies
- Presentations by groups
- Discussion

## Core processes addressed during the current implementation phase for attaining the objectives of the ABS Initiative.

Instruments used by the Initiative



# ABS in German DC / ABS Initiative



## ABS Initiative direct:

Benin	Malawi	<u>Regional Organisations</u>
Cook Islands	Mosambik	AUC, ECOWAS
Guyana	Samoa	CARICOM
Kenia	Senegal	PIF, SPC, SPREP
Liberia	Südafrika	

## ABS Initiative w / bilateral DC

Burkina Faso	<u>Regional Organisations</u>
Côte d'Ivoire	COMIFAC
Cameroon	
Madagascar	<u>Regional rogramme</u>
Morocco	Silvamed
Namibia	

## ABS only in bilateraler DC (out of ACP)

Brasil	<u>Regional Organisations</u>
Mexico	ASEAN, ACB
Peru	SIECA

**PROVIDING  
COUNTRY**

**PIC**

*Competent National  
Authority; (IPLCs)*



**MAT**

*Terms of Use (e.g. Commercial  
or non-commercial; IP; 3<sup>rd</sup> party)  
Benefit-sharing (monetary or  
non-monetary)*



**Permit**



Notified to ABS Clearing-House



**International Certificate of Compliance**



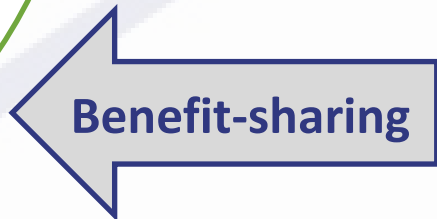
**USING  
COUNTRY**

Utilization of GRs

**Checkpoints:**

*Research publishing houses  
Research institutions subject to  
public funding  
Patent examination offices  
Authorities providing regulatory or  
marketing approval of products*

Provide information on  
PIC, MAT, source of  
GRs/aTK, use of GRs/aTK



**Interplay of providing and using  
country re legal utilization of GR**

# Definition of research and development under the NP



## Objective

“... the fair and equitable sharing of the benefits arising from the *utilization* of genetic resources, including by *appropriate access* to genetic resources and by *appropriate transfer of relevant technologies*, taking into account all *rights over those resources* and to *technologies*, and by *appropriate funding*, thereby contributing to the *conservation of biological diversity* and the sustainable use of its components”



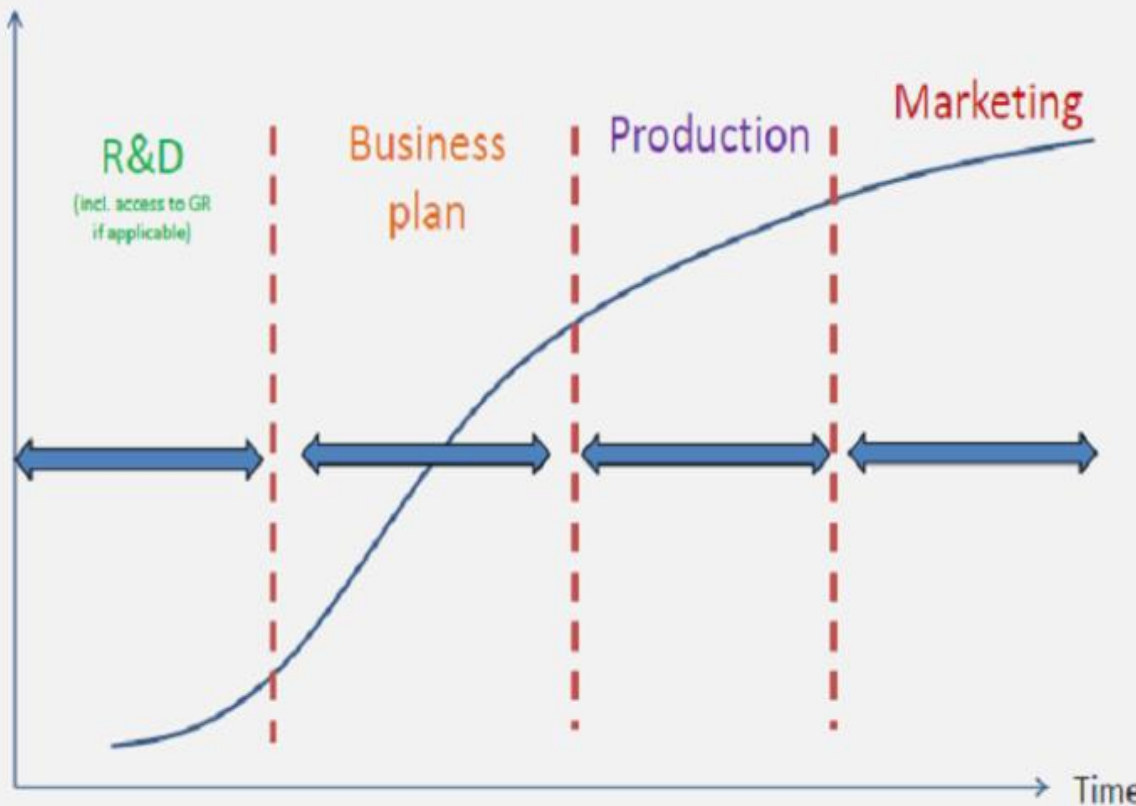
## Art. 2:

“Utilization of genetic resources” means to conduct research and development on the genetic and/or biochemical composition of genetic resources, including through the application of biotechnology as defined in Article 2 of the Convention.

# « Generic » product development cycle

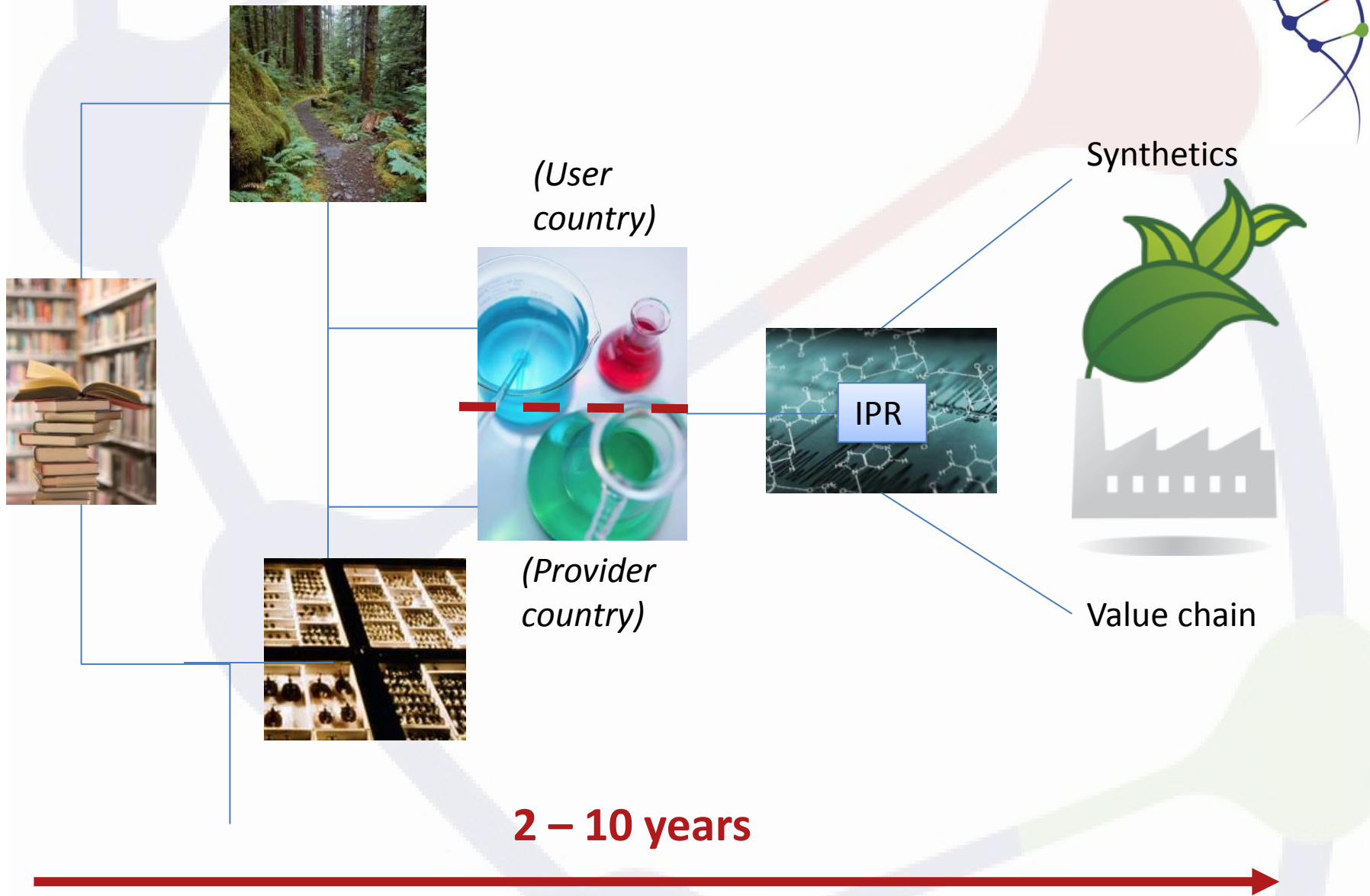


Investments in the product development process





# R&D Process





# Biodiversity = Diversity of ...

Ecosystems

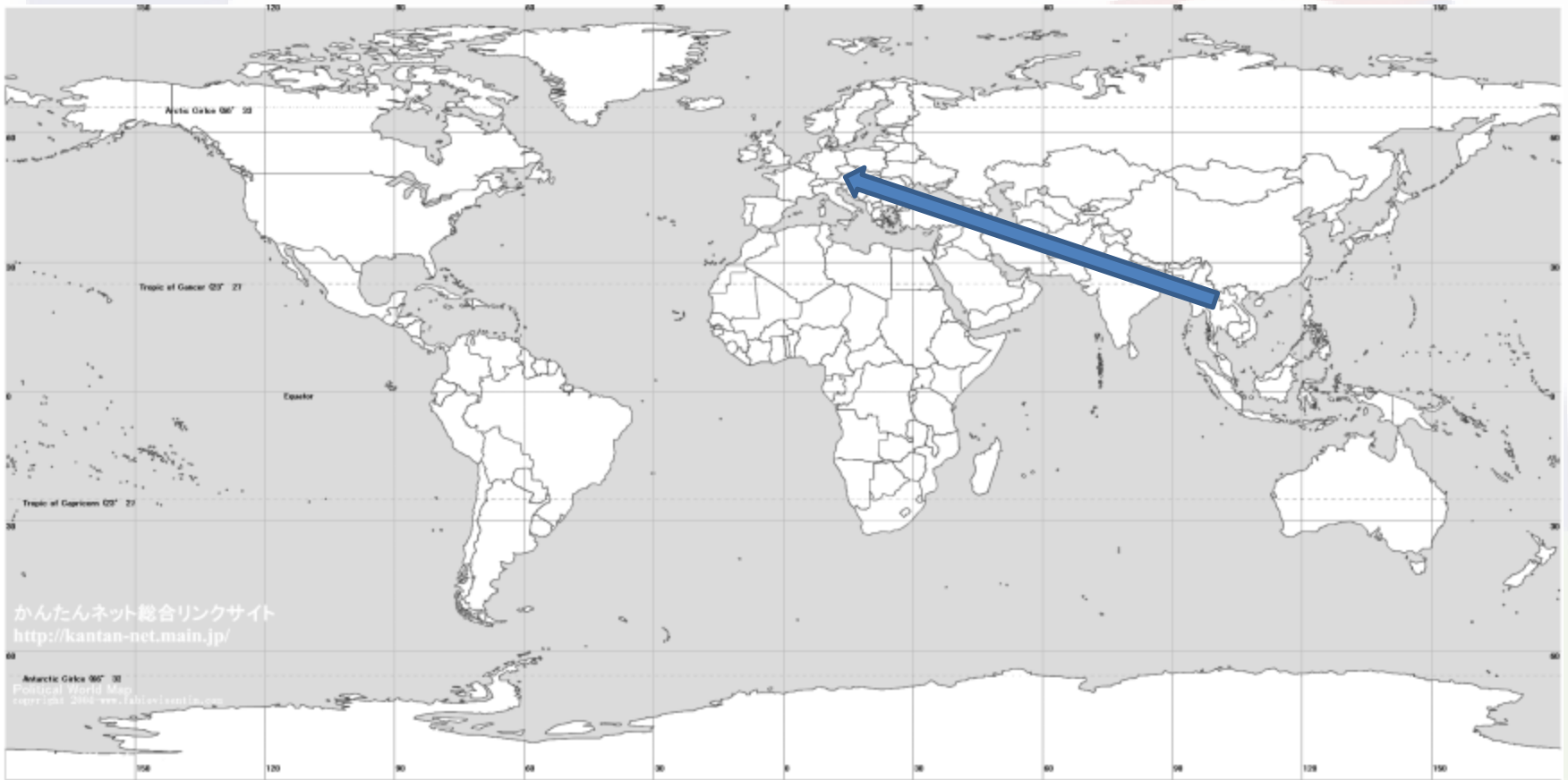
Species

Genes



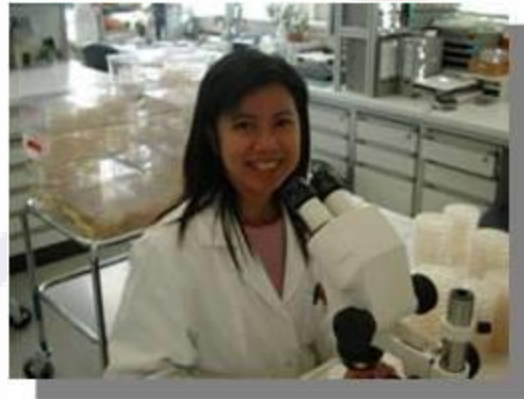


# Artemisia



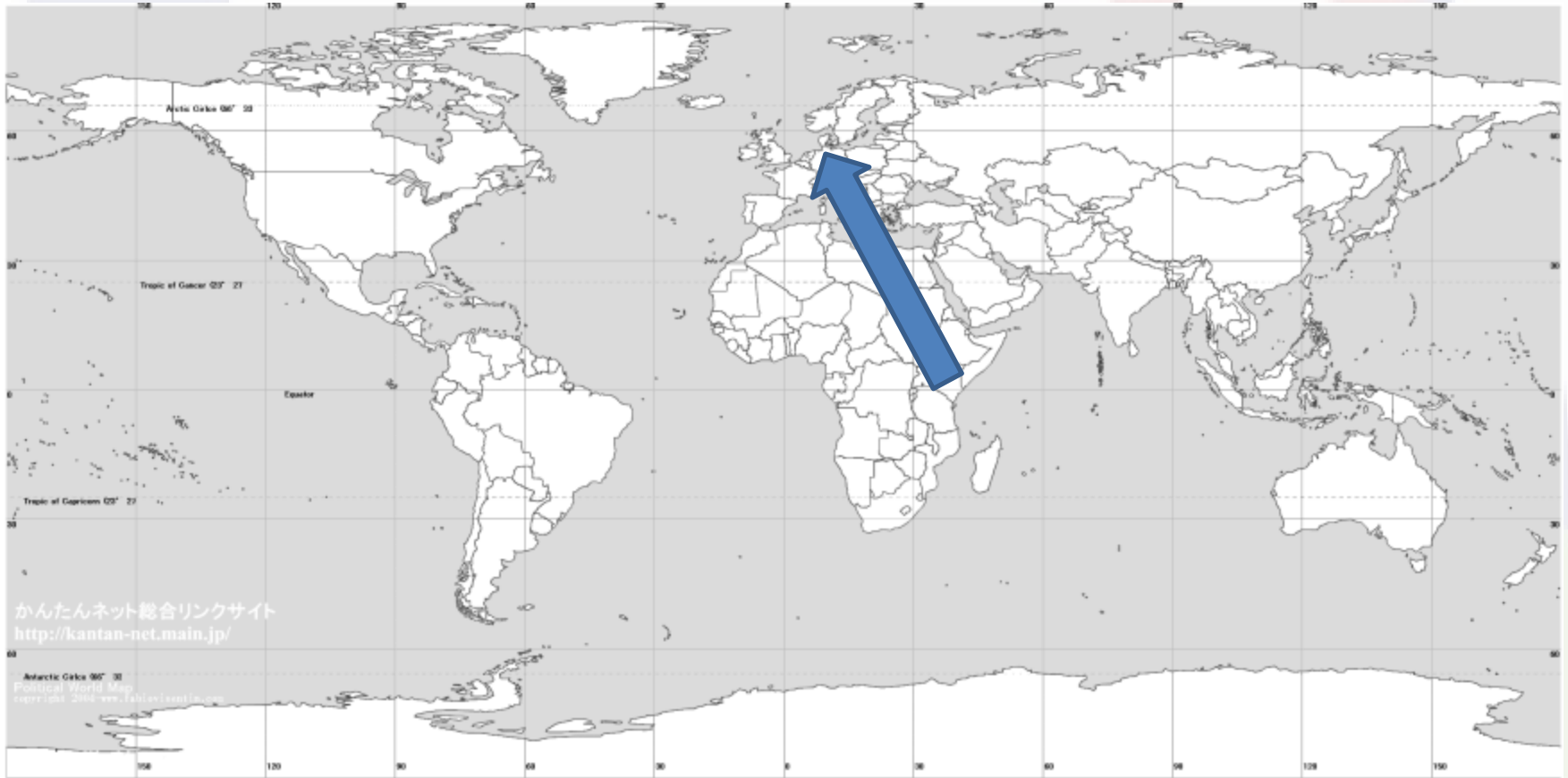


# Artemisia



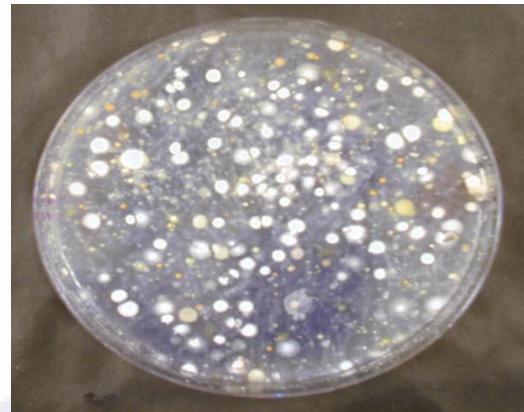


# Microorganisms & Enzymes





# Microorganisms & Enzymes

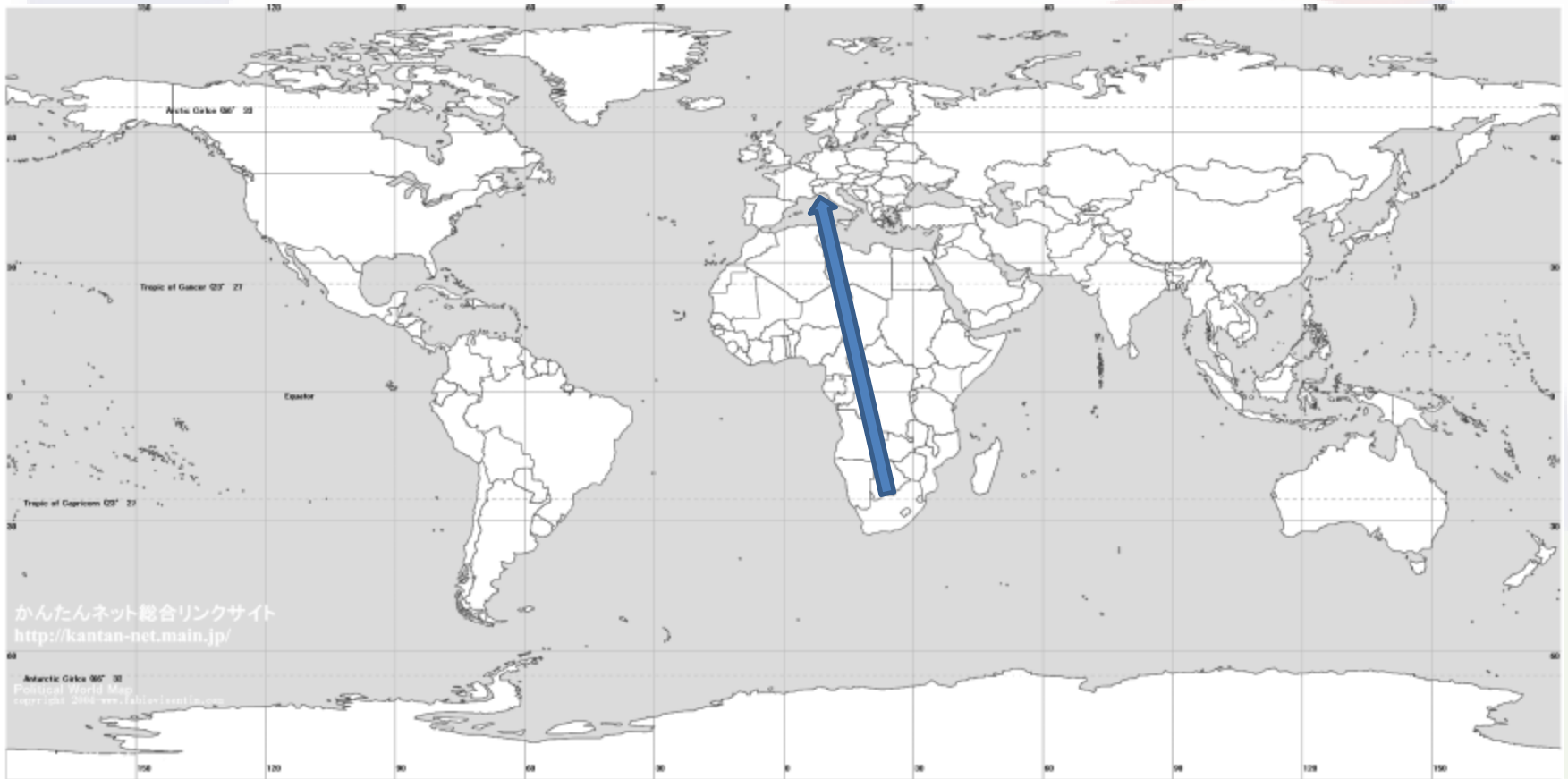


**BIOETHANOL**

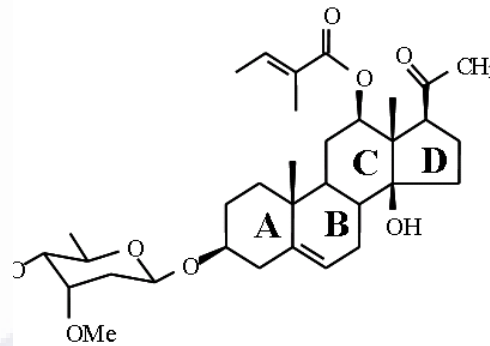




# Hoodia Gordonii



# Hoodia Gordonii

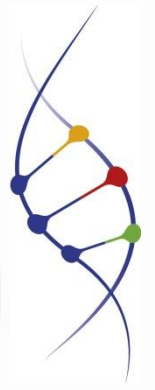


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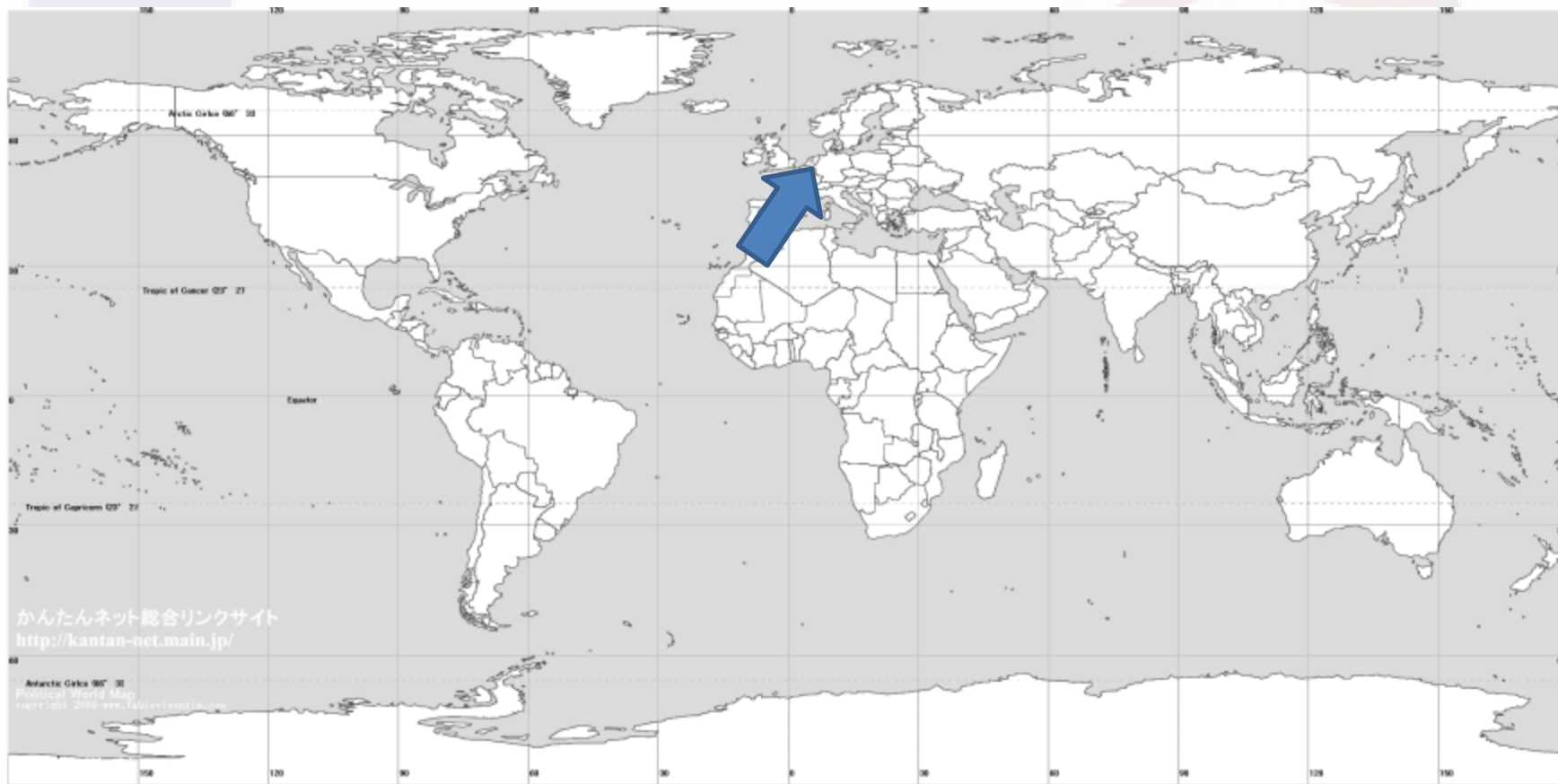
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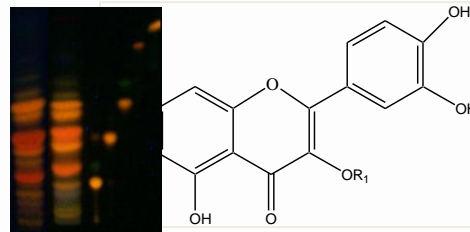


# Argan





# Argan



Polyphenoles



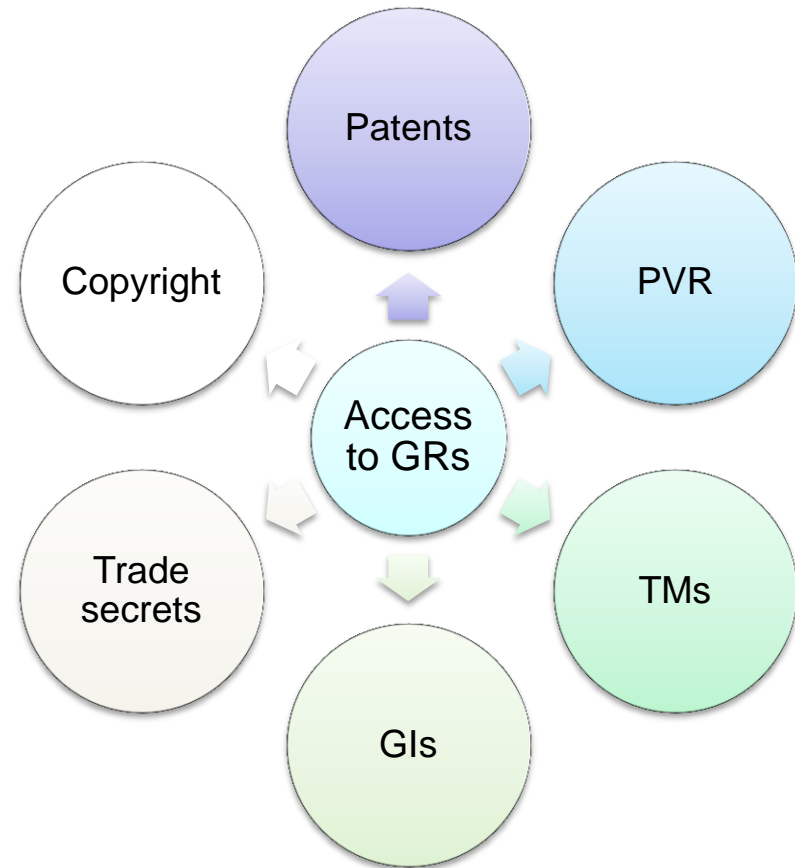
# IP aspects of ABS contracts

# IP issues associated with GRs → Proposed responses/solutions

- prevention of erroneously granted patents
- ensuring and tracking compliance with ABS systems
- databases/information systems, information exchange, patent examination guidelines
- mandatory disclosure requirement, i.e. to make it mandatory for patent applications to show the source of origin of GRs, as well as evidence of PIC and a benefit-sharing agreement
- and/or managing patent/IP rights through contract (IP clauses in mutually-agreed terms)

# IP aspects of ABS

- Negotiating and granting access to GRs, for research or commercial uses, can potentially result in a number of IP rights
  - Should IP rights be used?
  - If so, under which conditions?



# Some options on how to manage IP issues

- To **avoid IP rights**, in which case access to GRs is subject to agreement not to seek IP rights on the material received
- To **vest IP rights in the custodian** of the GRs
- To **jointly own** the IP rights
- To **give rights** derived from the use of the resources **to the user**, subject to various **conditions and safeguards**, such as
  - rights to receive benefits such as royalties and other payments
  - access to benefits of research
  - involvement in community-based development initiatives
  - contribution to various forms of appropriate social and economic development
  - Etc..

# The nature of the activity

- Access to GRs may have as its intention
  - the development of a product, process or technical solution that may be eligible for patent protection
  - Research activities that are wholly academic in nature
- Note: an academic collaboration may subsequently or inadvertently result in a patentable invention

# Sample clause

*“The recipient will not claim ownership over the GRs received, nor seek intellectual property rights over them or related information. If the recipient wishes to utilize or exploit such organisms commercially he will first inform the provider; when applicable, suitable and adequate recompense to those entitled to be rewarded, and the country of origin will be discussed in the spirit of the CBD/Nagoya Protocol.”*



# Some questions to consider

## ■ Right to application

- Who will decide whether to acquire a patent?
- What are the agreed arrangements concerning the obtaining of patents for an invention resulting from the access to the GRs?

## ■ Ownership

- Who will be the owner(s) of the resulting patent?
- Will ownership be dependent upon such issues as the value of the contribution of GRs and TK, the level of scientific contribution and other contributions?
- Will the patent be jointly owned by the provider and user, regardless of their contribution to the invention?
- Or will the access provider retain ownership?

## ■ Joint ownership

- How will responsibilities flowing from the co-ownership be apportioned? For instance, relating to filing, maintenance and enforcement of the patent
- Where will the resources come from to carry out these activities?

## ■ Exploitation of the patent

- What is the most appropriate model for the exploitation of the patent and for the use and dissemination of the new technology developed. For instance, a license, assignment or joint venture?
- Who will negotiate and agree the terms of any subsequent arrangement to exploit the patent?

## ■ Sharing of benefits

- How, when and between whom will any monetary or non-monetary benefits arising from the commercial exploitation of the patent be distributed?

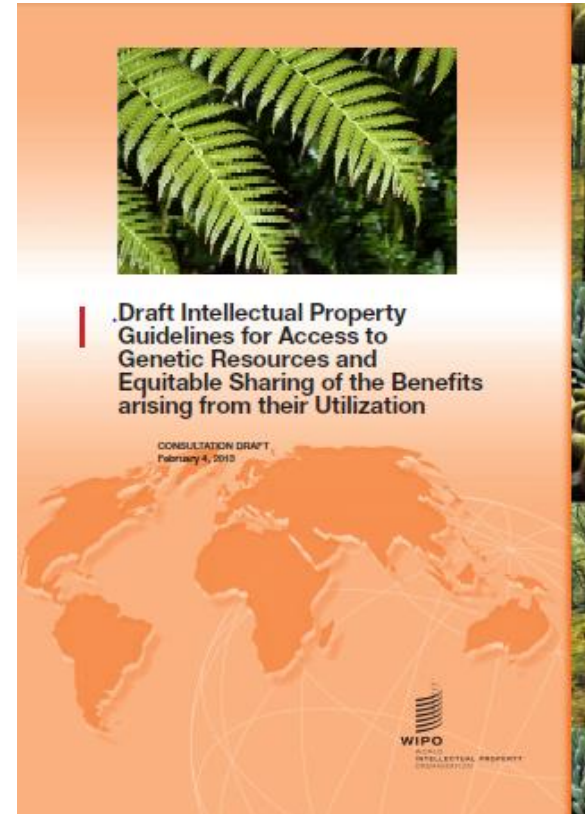
## ■ Confidentiality

- The leaking of any confidential information into the public domain can adversely affect the securing of future patents. It is therefore important that confidentiality is maintained until adequate protection is in place

# Additional information

- Draft Intellectual Property Guidelines for Access to Genetic Resources and Equitable Sharing of the Benefits arising from their Utilization

[http://www.wipo.int/export/sites/www/tk/en/resources/pdf/redrafted\\_guidelines.pdf](http://www.wipo.int/export/sites/www/tk/en/resources/pdf/redrafted_guidelines.pdf)



# Group work on case studies

- Questions to consider
  - Who are the actors/parties involved?
    - Who is entitled to negotiate?
    - Who will apply for the IP right/patent?
    - Who will own the IP right/patent?
  - How could the benefits be shared fair and equitably?
    - What type of benefits could/should there be?
  - Are there matters of confidentiality?

# Video

- Hoodia case study (South Africa)
- Argan oil case study (Morocco)

# Group work on case studies

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# Thank you

.....more on ABS and the  
ABS Capacity Development Initiative

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