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**National Experience in the Protection of
Traditional Knowledge, Traditional Cultural
Expressions and Genetic Resources**

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Scope of Discussion

- This paper will focus of the possible IP protection under Malaysia law in relation to the following:
 - Literary and artistic productions, such as music and visual art;
 - Performances of TCEs;
 - Designs embodied in handicrafts, textiles, carpets and other creative arts;
 - Secret TCEs;
 - Indigenous and traditional names, words and symbols;
 - TK in relation to patent; and
 - Genetic resources.

- Protection of TCE under the Existing Laws

No Sui Generis Law

- In Malaysia, as yet, there is no specially enacted legislation to protect traditional cultural expressions.
- Also, generally there is no incorporation of TCE related provisions into the current IPR legislative framework.
- However, there are some provisions in these statutes which may in some situations provide for some kind of both positive and defensive protection.

Copyright Act 1987

- The following types of works are usually protected:
- Literary works,
- Artistic works,
- Musical works
- Sound recordings,
- Films,
- Broadcasts
- Published editions
- Performers' right

Copyright Act 1987

- Therefore, in principle, many of the TCEs are protectable subject matters under copyright law.
- However, in terms of fulfilling the conditions for subsistence of protection and duration, there would be problems satisfying the requirement of the copyright law.

Copyright Act 1987

- Originality

- The “originality” requirement: copyright protects only “original” works, and many traditional literary and artistic productions are not “original” in this sense.
- On the other hand, adaptations of TCEs can be protected as “original” copyright work and designs, leading to calls for “defensive protection”

Copyright Act 1987

- Fixation

- The fixation requirement in many national copyright laws prevents intangible and oral expressions of culture, such as tales, dances or songs, from being protected unless and until they are fixed in some form or media.
- TCE that is “fixed” (documented etc) in some or other form might be protected by copyright or related rights
- The protection vests not in the content of the TK itself but rather in the form in which it has been expressed or in the recording itself
- Further, rights in recordings and documentation of TCEs vests in the person responsible for these acts of fixation, and not in the TCE bearers.

Copyright Act 1987

- Fixation

- Even certain “fixed” expressions may not meet the copyright requirement as an artistic work, such as face painting, body painting and sand carvings.

- Sand painting?

Copyright Act 1987

- Merchandising Corp. of America Inc. & ors v. Harpbond Ltd & ors [1983] FSR 32
- Facial make-up - The second plaintiff was Adam of the pop group Adam and the Ants. He devised new make-up for himself based on Red Indian facial markings. These comprised two broad red lines done in grease paint, with a light blue line between, running diagonally from nose to jaw on one cheek, a heart over the left eye-brow, and a beauty spot by the left nostril.
- The first plaintiff commissioned the taking of a series of photographs of the second plaintiff in his Prince Charming look, and their reproduction in publications throughout the world.
- The defendants painted a portrait of the second plaintiff in the new look.
- It was held that facial make-up was not a painting within section 3 of the Copyright Act 1956, United Kingdom. It was a question of fact in any particular case whether what was being considered was or was not a painting.
- Furthermore, a painting must be on a surface. If there were a painting in this case, it must be the make-up marks plus the second plaintiff's face. If the marks were taken off the face, there could not be a painting.

Copyright Act 1987

- **Ownership**

- Copyright protection requires the identification of a known individual creator or creators to determine the ownership of rights.
- It is difficult, if not impossible, however to identify the creators of TCEs, because TCEs are usually communally created and held and/or because the creators are simply unknown and/or unlocatable.
- The very concept of “ownership” in the IP sense may also be alien to many indigenous peoples.
- Further, the concept of “communal ownership” of a tribal artwork is not recognised under the Copyright Statute.
- See *Bulun Bulun and Another v R & T Textiles Pty Ltd* 41 IPR 513 – “Copyright is entirely a creature of statute. As the Act provides that the author of an artistic work is the owner of copyright in it, save in cases of joint authorship, the Act precludes any notion of communal or group ownership in an artistic work unless that work is a “work of joint authorship.

Copyright Act 1987

- Term of protection
- The limited term of protection in copyright, related rights and industrial designs protection is said to be inappropriate for TCEs.
 - First, it fails to meet the need to protect TCEs in perpetuity or at least as long as the community exists.
 - The limited term of protection requires certainty as to the date of a work's creation or first publication, which is often unknown in the case of TCEs.
- BUT see : s. 17(2) Copyright Act 1987:
- "Where a literary, musical or artistic work had not been published before the death of the author, copyright which subsists in such work under this Act shall continue to subsist until the expiry of a period of fifty years computed from the beginning of the calendar year next following the year in which the work was first published."

Performers' Right

- Performers are protected under the Copyright Act under the performers' right provision in relation to their live performances.
 - Section 3 defines "live performance" to include "a performance in relation to expressions of folklore".
- This definition clearly protects the rights of performers of "expressions of folklore".

Performers' Right

- The exclusive rights given to a performer : Section 16A
- (1) Performers' right shall be the exclusive right to control in Malaysia-
 - (a) the communication to the public of a live performance, except where the live performance used in such communication is itself a live broadcast performance;
 - (b) the fixation of an unfixed performance;
 - (c) the reproduction of the fixation of a live performance ..
 - (d) the first making available to the public of a fixation of a live performance, or copies thereof, through sale or other transfer of ownership; and
 - (e) rental to the public of a fixation of a live performance, or copies thereof, irrespective of the ownership of the copy rented.
- However, these exclusives rights cease to exist once the performers have consented to the fixation of the performance.

Performers' Right

- Equitable remuneration – section 23B
- If there is a public performance of a sound recording of their performance, the performers are entitled to an equitable remuneration for each public performance.
- This right to equitable remuneration subsists from the time the sound recording is published until the expiry of a period of fifty years computed from the beginning of the calendar year next following the year of publication.
- Problem: The protection is only in relation to a particular performance. There is nothing to prevent a third party from copying all elements of the performance and coming out with their own protected performance.

Industrial Designs Act

- Under the Industrial Design Act 1996, on compliance with certain formalities, a design can be registered if it is new or original
 - However, traditional designs are not “new” or “original” for industrial designs protection.
 - On the other hand, contemporary adaptations of TCEs can be protected as “original” designs.
 - Application by indigenous community
 - Application by outside applicants
 - Need for “defensive protection” against misappropriation?

Industrial Designs Act 1996

- Is defensive protection under the Industrial Design Act 1996 possible:
- Section 13 – “Industrial designs that are contrary to public order or morality shall not be registrable.”

Industrial Designs Act 1996

- Possibility of Revocation or Cancellation of wrongly registered industrial designs:
- Section 27(1) – At any time after the registration of an industrial design, any person may apply to the Court –
 - (a) ...;
 - (b) for cancellation of the registration of industrial design on ground that registration of the industrial design has been procured by unlawful means;
- The Registrar also has the power to order the revocation of the registration of an industrial design on any other ground as he thinks fit.

Industrial Designs Act 1996

- Rectification of Register
 - any entry made in the Register without sufficient cause,
 - fraud in the registration, or
 - if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;

Trade Marks Act 1976

- Defensive Protection of traditional names, words and symbols
 - Words, names, designs, symbols, and other distinctive signs associated with indigenous communities can be prevented from being registered as trade marks by non-indigenous entities under the Trade Marks Act
 - The Act contains several provisions to ensure that this possibility will not occur, or if it occurred, can be rectified or invalidated.

Trade Marks Act 1976

- Registered Trade Marks: Prohibited Marks
- Under the Trade Marks Act 1976, a mark will be prohibited from registration for, among others, the following reasons:
 - If the use of the mark is likely to deceive or cause confusion
 - If it comprises any scandalous or offensive matter (offends religious sensibilities, sacred etc)
 - If it would be contrary to law :
 - See Karo Step Trade Mark [1977] RPC 255 – infringement of copyright belonging to another person

Trade Marks Act 1976

- Section 45. Rectification of the Register.
- (1) Subject to the provisions of this Act -
- (a) the Court may on the application in the prescribed manner of any person aggrieved by the non- insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as it thinks fit;
- (b) ...
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;

Trade Marks Act 1976

- The Agricultural and Processed Food Products Export Development Authority of India (APEDA), Tamil Nadu Agricultural University and Ors v Syarikat Faiza Sdn Bhd Case D-25IP-1-2010
- The Ponni Rice case – name of a rice variety cannot be validly registered as a trade mark
- Ponni rice was first developed by Tamil Nadu Agricultural University. The popularity of Ponni rice can be attributed for its low glycemic index, which helps in the control of diabetes, obesity & cholesterol.
- Many rice dealers import Ponni rice & sell it under different names. One of them is, Syarikat Faiza Sdn Bhd which has been importing Ponni rice from India and distributing it in Malaysia as Herbal Ponni Rice, under the brand name, ‘Taj Mahal, Ponni.’
- On 10th January 2006, Faiza obtained registration of ‘Ponni’ as a trademark for rice in Class 30 of the Malaysian Trademark Act.
- Faiza then sent legal notices to other importers asking them not to use the word 'Ponni' to describe their product.

Trade Marks Act 1976

- On Jan 22, 2010, the Indian Agriculture Export Promotion Agency, along with Tamil Nadu Agricultural College, Indian farmers and two exporters filed an action to have the mark “Poni” removed from the Register under section 45 as an entry made on the Register without sufficient cause and/or an entry wrongfully remaining in the Register.
- Justice Azahar Mohamed held that the term ‘Ponni’ cannot be exclusively used by Faizal since the term describes a rice variety from Tamil Nadu and is recognized by customers as such. Exclusive use of the term would lead to consumer confusion. Further, the registration of PONNI as a trade mark is prohibited by section 14(1) of the Act on the ground that the use of the said word is likely to deceive or cause confusion.
- Therefore the trade mark was ordered to be expunged from the Register.

Tort of Passing Off

- The common law action for the tort of “passing off” or unfair competition
 - The above action can be used to prevent misappropriation of reputation associated with TCEs.
 - Examples of misleading trade practices caught by this tort would include:
 - False claims as to “authenticity” or community association or endorsement.
 - Situation when a distinctive “style”, symbol, signs etc associated with a particular traditional community is used in products not made by that community.
- In addition, the aforementioned activities could give rise to a criminal action against the wrong doer under the Trade Description Act.

Breach of confidence

- Under breach of confidence law, persons in possession of confidential or secret information and who are in a position of confidence, can be stopped from revealing such information.
- Nature of the Obligation:
 - Can arise from contractual relationship:
 - Express stipulation
 - Implied Stipulation
 - In the absence of contract, under equitable obligations.

Nature of the Obligation

- To be entitled to a remedy under breach of confidence law, three conditions must be satisfied.
 - The information itself must be capable in law of being protected – i.e., confidential information
 - That information must have been obtained in circumstances imposing an obligation of confidence.
 - There must be an unauthorised use of that information to the detriment of the party communicating it.
- Protection is under the common law

Types of Information Protected

- The categories of information that could be protected:
 - TRADE SECRETS
 - LITERARY and ARTISTIC WORKS
 - PERSONAL SECRETS
 - PUBLIC and GOVERNMENTAL SECRETS
 - See also *Foster v Mountford* 14 ALR 71 – protection of information of deep religious and cultural significance to the Aborigines.

Geographical Indications Act 2000

- Besides the use of certification mark under the Trade Marks Act 1976, indigenous communities can also rely on the Geographical Indications Act 2000 to provide both positive and defensive protection.
 - Section 2 - "Geographical indications" means an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin”

Geographical Indications Act 2000

- Some product of traditional communities such as handicrafts qualify as “goods” under the Act and can be protected by geographical indications.
 - Section 2 - "Goods" means any natural or agricultural products or any product of handicraft or industry“
- If a name has traditionally been associated with a product from a particular region, both both positive and defensive protection is possible under the Geographical Indications Act 2000.
 - Example: Labu sayong - the famous black gourd-shaped clay pitcher found in Sayong, in the district of Kuala Kangsar, Perak, Malaysia.

Geographical Indications Act 2000

- The Act is especially useful for the indigenous community since protection can be secured without the need for registration.
- S 3. Protection under this Act shall be given to a geographical indication -
 - (a) regardless whether or not the geographical indication is registered under this Act; and
 - (b) ...

- Protection of Traditional Knowledge and Genetic Resources under the Present Laws

Genetic Resources as a Source of Wealth

- “An ethical battle rages as prospectors scour the globe to find - and profit from - organisms that could cure some of the world’s worst diseases”. (Dealing in DNA , Tim McGirk, TIME, November 30, 1998, p 58)
- “... Organisms that are of no apparent use may be tomorrow’s saviours.” (The Value of Biodiversity, Rick Cannell, Financial Times, July 21, 1998)
- “Scientists ... realise that forests and oceans hold a bounty of useful chemicals - ” (Nature's Drug, William Underhill, Newsweek, November 7, 2005, p 50)

Paradigm Shift

- From Common Heritage (Article 1 of the FAO International Undertaking on Plant Genetic Resources 1983)
 - unrestricted access
- To National Sovereignty
 - controlled access (CBD 1993)
 - Prior informed consent
 - Benefit sharing
- In relation to traditional knowledge:
 - “equitable sharing of the benefits arising from the utilization of such knowledge, innovations and practices”

Mandatory Obligations under TRIPS - 1

- Art 27(1) - ... patents shall be available for any inventions, whether products or process, in all field of technology, provided that they are new, involves an inventive step and are capable of industrial application. Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology ...

Mandatory Obligations under TRIPS - 2

- Art 29 – Conditions on Patent Applicants
- (1) Member shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art
- Question: Should the patent application be required to contain disclosure of information relating to source of genetic resources, evidence of prior informed consent and benefit sharing?

Conflict in the International Arena?

- The World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) 1994
 - Obligates
 - Private rights
- Convention on Biodiversity (CBD) 1992
 - Empowers
 - Public rights

Protection of TK and GR - Work in Different Fora

- Convention on Biological Diversity 1992
 - Nagoya Protocol on Access and Benefit Sharing 2010 [Note: As of 9 July 2012, the Protocol has 93 signatures and 5 ratifications. The Protocol will enter into force on the 90th day after the date of deposit of the 50th instrument of ratification, acceptance, approval or accession by states or regional economic integration organizations that are parties to the Convention]
- World Trade Organisation – TRIPS: Efforts to add a new Article 29bis to the TRIPS Agreement [To provide for mandatory disclosure of source of genetic resources and evidence of PIC and benefit sharing]
- World Intellectual Property Organisation
 - Negotiation for an International Agreement for the protection of genetic resources, traditional knowledge and folklore

Are TK and GR protected under our Intellectual Property Laws?

- Back to Malaysia:
- Are Traditional Knowledge and Genetic Resources protected under our Intellectual Property Law?
- Note:
- Genetic resources per se, as encountered in nature, are not IP.
- Since they are not creations of the human mind they cannot be directly protected as IP.

Malaysia's Response to the CBD - Policies

- Policies:
- Malaysia has already in place several policies related to biodiversity conservation and sustainable use:
 - National Policy on Biological Diversity,
 - National Forestry Policy,
 - National Policy on Environment and
 - National Policy on Wetlands,
 - National Biotechnology Policy, 2005
 - etc

Malaysia's Response to the CBD - Policies

- National Policy on Biological Diversity 1998
- Strategy VIII: Review legislation to reflect biological diversity needs legislative framework
- Among Programmes and Activities:
 - Reviewed legislations – eg Wildlife Protection Act 1972 is under review to include more holistic biodiversity management
 - Proposed Biosafety Bill by Ministry of Natural resources and Environment [Enacted Biosafety Act 2007, wef from 1 December 2009]
 - Proposed ABS Bill [Access to Genetic Material Bill] by Ministry of Natural Resources and Environment
 - Proposed Plant Variety Protection Bill [Enacted Protection of New Plant Varieties Act 2004,wef from 20 Oct 2008]

Legislative Response to the CBD – Federal Level

- Legislative Framework:
- In Peninsular Malaysia, currently there is no dedicated law on the protection of genetic resources and traditional knowledge and access and benefit sharing (ABS).
- All the biodiversity related law were legislated prior to the CBD and their main objectives are in relation to the preservation, protection, utilisation and management of the flora and fauna of the country. For example:
 - National Forestry Act 1984, Act 313
 - National Parks Act 1980, Act 226
 - Protection of Wild Life Act 1972, Act 76
 - Fisheries Act 1985 - Act 317 etc

Patents Act 1983

- Patent

- Universal novelty system – prior art consist of everything disclosed to the public however disclosed
 - So no possibility of oral or “unfixed” traditional knowledge been patented - orally disclosed TK is recognized as prior art in the patent law system
- However, absence of provisions requiring prior informed consent and evidence of benefit sharing, procedure for examining TK related patent application
 - so inventions that were derived from TK may be patented if it satisfies the novelty and inventive sep requirements.
- Possible reform – mandatory disclosure rule

Protection of New Plant Varieties Act 2004

- Preamble to the Act states, inter alia, that the objectives of the Act is, inter alia, to provide for the recognition and protection of contributions made by farmers, local communities and indigenous people towards the creation of new plant varieties.
- Section 12 of the Act specifies the information and supporting documents that need to be disclosed by the applicant for purposes of application.
 - PIC - In relation to cases where the plant variety is developed from traditional varieties, the prior written consent of the authority representing the local community or the indigenous people is required.

Protection of New Plant Varieties Act 2004

- There is also a need to furnish information:
 - Relating to the source of the genetic material or the immediate parental line of the plant variety.
 - Documents relating to the compliance with any law regulating access to genetic or biological resources
 - Also documents relating to the compliance of any law regulating activities involving genetically modified organism in cases where the development of the plant varieties involves genetic modification.

Protection of New Plant Varieties Act 2004

- Effect of non compliance?
- Section 23 - one of the grounds of opposition - that the application for registration of the new plant variety and grant of a breeder's right does not comply with the requirement of the Act.
- Also under section 39(2) of the Act in relation to invalidation, the grounds included:
 - that the holder has furnished to the Board false or misleading information or statement in respect of the application for registration of the new plant variety and grant of a breeder's right.
 - that the holder has not complied with the requirement of the Act.

Economic Planning Unit Guideline

- Circular No. 3/1999 - Regulations for the Conduct of Research in Malaysia
- This is a general circular regulating certain researches in Malaysia, and is not specific to researches relating to the natural sciences.
- Problem: This Circular is merely a guideline and does not have the sanction of law.

Legislative Response to the CBD – State Level

- Unlike West Malaysia, the states of Sabah and Sarawak have already enacted their own legislation to protect biodiversity which incorporate the ABS elements of the CBD.
- Note: Although not enacted to protect traditional knowledge as such but to incorporate the ABS elements of the CBD, the above two states have enacted laws which impact on the protection of traditional knowledge.
 - 1. Sarawak Biodiversity Centre Ordinance 1997
 - 2. Sarawak Biodiversity Centre (Amendment) Ordinance 2003
 - 3. Sarawak Biodiversity Regulations 2004
 - 4. Biodiversity Ordinance Sabah 2000

State Level - Sarawak

- Sarawak Biodiversity Centre Ordinance 1997
- Section 35, among others, provides for regulations to be made in respect of the terms and conditions for access to and use of the biological resources of the State or such resources, data, exhibit, information or material kept, stored or maintained in the Biodiversity Centre, and permits to be issued under the Ordinance.
- Pursuant to section 35 of the Ordinance, the Sarawak Biodiversity Regulations, 2004 were made.

State Level - Sarawak

- Sarawak Biodiversity Centre Ordinance 1997
- Under the Regulations no permit for access to, collection of and research on protected biological resources shall be issued until the applicant signs a research agreement with the Government as provided in regulations 6 and 21
- One important term to be included in the agreement is in relation to the rights of the Government to patent and intellectual property to or over any discovery resulting from the research undertaken, and where appropriate, the sharing of such rights with other parties to the research agreement.

State Level - Sarawak

- Sarawak Biodiversity Centre Ordinance 1997
- Ethnobiological research is regulated under Part VI of the Regulations.
- Besides the requirement for a research agreement, the permit holder may be required to make payment to the natives as reward for the knowledge or information provided by them in connection with the research. Such payment may be made regardless of whether such research results in the commercial development of any medicinal or other products.
- In addition to the above payment, where the research leads to the development of any pharmaceutical or medicinal compounds etc, the patent or intellectual property right to such products shall be shared with the natives involved in the research.
- Problem: No nexus to Patents Act

Concluding Remarks

- Protecting TCC, TK and GR:
- Two main options possible:
 - i) To revise the existing IP laws to make them more amenable to TK, with both positive and negative rights incorporated within their legal framework.
 - ii) To have a sui generis law recognizing the right of indigenous people to communal property over their TK, TCE and GR

Concluding Remarks

- Domestic legislation alone will not solve the problem of biopiracy
 - Need to have an international agreement
 - Need to have a regional or trans-boundary mechanism for solving dispute relating to:
 - Cross Borders Endemic Species
 - Shared traditional knowledge
 - Shared traditional cultural expressions
- To minimise instances of disputes between neighbours:
 - For example that between Malaysia and Indonesia
 - 2007 - Rasa Sayang, batik and wayang kulit
 - 2009 - Pendet dispute
 - 2012 – Tor Tor dance

END

- Thank you for your kind attention