

# **‘Disclosure of Origin’ in Patent Specifications - an industry view**

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# Outline

- Qualifications and Disclaimers
  - as industry lawyer
  - representing interested circles (ICC, ISF, CNIPA)
  - but views only personal
- Is disclosure a good idea in principle?
- How will it work in practice?

# CBD Objectives

- *The conservation of biological diversity*
- *The sustainable use of its components*
- *The fair and equitable sharing of the benefits of such use*

## IP to support CBD: Art 16.5

5. The Contracting *Parties*, recognizing that patents and other intellectual property rights may have an influence on the implementation of this Convention, ***shall cooperate*** in this regard subject to national legislation and international law in order ***to ensure that such rights are supportive of and do not run counter to its objectives.***

## “..legislative, administrative or policy measures...”

- [CBD Art 15.7] *Each Contracting Party shall take legislative, administrative or policy measures, as appropriate, .. with the aim of sharing in a fair and equitable way the results of research and development and the benefits arising from the commercial and other utilization of genetic resources..*
- Is disclosure of origin appropriate?
- Is it efficient? Indirect control doesn't work well

# Specific proposals

- Patentees should be required
  - 1. to disclose origin of biological material, or ‘traditional knowledge’
  - 2. to prove Prior Informed Consent
- Assumptions?
  - Unique material, unique known overseas origin?

## Pressure for Change - Example

- UK Government Commission on Intellectual Property Rights (CIPR)

*“The principle of equity dictates that a person should not be able to benefit from an IP right based on genetic resources or associated knowledge acquired in contravention of any legislation governing access to that material.”*

- *“all countries should provide in their legislation for the obligatory disclosure of information in the patent application of the geographical source of genetic resources from which the invention is derived”*

# “Disclosure of origin” - Bioprospecting - the paradigm case

- Will typically be carried out under a formal agreement
- Samples collected from wild (or other defined locale)
- Inventions probably related to specific properties of novel materials collected
- Disclosure of origin generally practicable



# ‘Disclosure of origin’ - general

- 99% of biological inventors are **NOT** bioprospectors!
- Uncertainties
  - When required? (wooden furniture???)
  - Generic or specific? (defining feature or substrate?)
  - Essential or accidental?
  - What kind of access (only physical samples?)
  - Where it originated or where you got it?
  - Strict conformity with CBD?
  - Penalty for errors? Are they correctable?
- One patent may require multiple disclosures

## Disclosure of origin - TK

- Not too clear what TK is (quinine? - public domain?). Definition fuzzy at best.
- 3 cases
  - you know it's TK and you know where it came from  
Disclosure possible
  - you know it's TK, but not where it came from  
Disclosure difficult
  - you don't know it's TK  
Disclosure impossible

## ‘Prior informed consent’ - general

- Like disclosure but even more difficult
  - access with formal consent is rare
  - few countries require it
  - there may not be any easy mechanism for obtaining it
  - what do you do if you don’t have it?
  - can you prove it’s not required?
  - **unduly burdensome**
- **Too restrictive - hinders an object of CBD**

## ‘Disclosure of origin’

- Even a carefully defined requirement could be burdensome and counterproductive
- If it is to be introduced: at least try it out thoroughly first
- Limit it to bioprospecting - see how this works?

# Conclusions

- IP systems are instruments of economic policy, not easily adapted to promote other social goals
- No common understanding yet of goals or means to achieve them
- Obstacles to patenting also obstruct use
- Industry needs clear and practical rules
- One size doesn't fit all!