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Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore

Twenty-Third Session
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PROPOSAL FOR THE TERMS OF REFERENCE FOR THE STUDY BY THE WIPO SECRETARIAT ON MEASURES RELATED TO THE AVOIDANCE OF THE ERRONEOUS GRANT OF PATENTS AND COMPLIANCE WITH EXISTING ACCESS AND BENEFIT-SHARING SYSTEMS

Document submitted by the Delegations of Canada, Japan, the Republic of Korea and the United States of America

INTRODUCTION

1. On February 1, 2013, the International Bureau of the World Intellectual Property Organization (WIPO) received a request from the Mission of the United States of America to the United Nations Office and other International Organizations, on behalf of the Delegations of Canada, Japan, the Republic of Korea and the United States of America, to submit a "Proposal for the terms of reference for the study by the WIPO Secretariat on measures related to the avoidance of the erroneous grant of patents and compliance with existing access and benefit sharing systems", for discussion by the Twenty-Third Session of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), as a working document under Agenda Item 6.

2. Pursuant to the request above, the Annex to this document contains the proposal referred to.

3. The Committee is invited to take note of and consider the proposal in the Annex to this document.

[Annex follows]

PROPOSAL FOR THE TERMS OF REFERENCE FOR THE STUDY BY THE WIPO SECRETARIAT ON MEASURES RELATED TO THE AVOIDANCE OF THE ERRONEOUS GRANT OF PATENTS AND COMPLIANCE WITH EXISTING ACCESS AND BENEFIT SHARING SYSTEMS

In the context of the IGC's work on mechanisms to address erroneous patents, and misappropriation of genetic resources (GR) and/or traditional knowledge associated with genetic resources (TKa) and in recognition of the commitment of WIPO Members to the Development Agenda Recommendations, the IGC requests the Secretariat with the involvement of the Chief Economist to undertake additional work as follows:

To update the WIPO Technical Study on Patent Disclosure Requirements Related to Genetic Resources and Traditional Knowledge (Study No. 3, 2004), with information regarding disclosure requirements and related Access and Benefit Sharing (ABS) systems that have been implemented by WIPO Members. Having regard to the need for a fact based analysis of whether disclosure requirements and related ABS systems address concerns regarding erroneous patents and address misappropriation, without reducing the incentive to innovate or benefit sharing, the study should analyze:

1. Benefits received by provider countries due to disclosure requirements and related ABS systems;

2. Costs to national offices / jurisdictions resulting from a disclosure requirement; and

3. Costs associated with a disclosure requirement and related requirements (proof of prior informed consent (PIC) and mutually agreed terms (MAT)) to patent applicants. This includes costs incurred by those applicants who have actually used a GR and/or TKa, and those who may not have used a GR and /or TKa but need to determine what is required of them in respect to the disclosure requirement.

In particular, the study should, at a minimum, analyze those national and regional intellectual property laws, regulations and procedures that require the disclosure of source or origin of a genetic resource and/or TKa and, for each country or region (as the case may be) with such a requirement:

- Determine how many disclosures of source/origin have been made by patent applicants.

- Determine what additional requirements are imposed beyond disclosure of the source/origin. This may include for example, determining which authorities require proof of PIC and MAT.

- Where proof of PIC/MAT is required, the study should collect information on the procedures to be followed to obtain PIC/MAT.

- Where an applicant makes an error with respect to the disclosure requirement, how can an applicant correct the error? For example, can the applicant change the source, if without deceptive intent the applicant discloses the source as one country when it was another? Does the Office consider the name of the source new matter, and thus require the patent application to be re-filed?

- For each Office with a disclosure requirement, determine the average processing time of a patent application, and then the average processing time of a patent application where disclosure was required.

- Where disclosure of the source/origin was required, was the genetic resource: directly accessed (*in situ*); accessed from a seed bank or other depository; or purchased as a commodity?

- Since the imposition of a disclosure requirement, has the number of patent applications filed in this area of technology increased or decreased? If it has decreased, have applicants who may have previously filed a patent application decided to maintain their inventions as trade secrets rather than filing a patent application?

- What quantity of benefits have been received since the imposition of a disclosure requirement and related ABS system? How many ABS agreements have been signed since then?

- For WIPO Member States with a disclosure requirement, how many ABS agreements have been signed since imposition of the disclosure requirement?

- If there have been ABS agreements, do the agreements remind the recipients of GRs and/or TKa of the need to disclose the source/origin of the same when seeking intellectual property protection?

- Are criminal or civil sanctions and/or fines imposed for failure to disclosue the source or origin of a GR and/or TKa in a patent application? If so, describe the situations in which these sanctions were imposed and what the sanctions were, and describe any appeals and decisions of the relevant appellate body.

- If there was a disclosure requirement, did the Office also require disclosure of prior art that is material to the patentability of the invention? If not, what was the basis for having a disclosure requirement of the source of GR and/or TKa, but not on prior art that is material to patentability? How did disclosure improve examination?

- How often was the source or origin material to patentability? For countries with an IP law that required disclosure, was there also a national law related to misappropriation or misuse of GR and/or TKa?

- Does the Office provide a mechanism for third parties to submit information material to patentability to a patent application?

- Does the Office provide a mechanism to oppose a patent (pre or post grant)?

- For uses of GRs and/or TKa that are not claimed in a patent or a patent application, how does the WIPO Member State ensure that the GR and/or TKa was appropriately accessed and any requirements for PIC or MAT were satisfied?

This study should aim to be completed as soon as possible so that delegations are able to make an informed decision on our work on GRs and/or TKa.

[End of Annex and of document]