

WIPO



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INTERGOVERNMENTAL COMMITTEE ON INTELLECTUAL PROPERTY AND GENETIC RESOURCES, TRADITIONAL KNOWLEDGE AND FOLKLORE

Sixth Session

Geneva, March 15 to 19, 2004

GENETIC RESOURCES AND PATENT DISCLOSURE REQUIREMENTS:
TRANSMISSION OF TECHNICAL STUDY TO THE CONVENTION ON BIOLOGICAL
DIVERSITY

Document prepared by the Secretariat

I. SUMMARY

1. At its fifth session, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“the Committee”) considered and transmitted to the WIPO General Assembly a draft technical study on patent disclosure requirements relevant to genetic resources and traditional knowledge. This document reports on ensuing developments, including the decision by the WIPO General Assembly to transmit the study as a technical reference document to the Conference of Parties (COP) to the Convention on Biological Diversity (CBD) and subsequent developments in CBD subsidiary processes. It also notes possible directions for future work, including the possibility of proposals emanating from other international fora.

II. TECHNICAL STUDY

2. The CBD Secretariat reported to the Committee at its second session (document WIPO/GRTKF/IC/2/11) on the outcome of the first meeting of the CBD Ad-Hoc Open-ended Working Group on Access and Benefit-sharing (“the Working Group”). The report indicated

that the Working Group had developed the draft Bonn Guidelines on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising From Their Use, and had recommended “that the Conference of the Parties at its sixth meeting invite [WIPO] to prepare a technical study on methods [for requiring disclosure within patent applications of certain information] which are consistent with obligations in treaties administered by [WIPO].”¹

3. The Working Group’s Report was considered by the COP at its sixth meeting (held from April 7 to 19, 2002), and as part of its decision on this matter (decision VI/24), the COP invited WIPO to:

“prepare a technical study, and to report its findings to the Conference of the Parties at its seventh meeting, on methods consistent with obligations in treaties administered by the World Intellectual Property Organization for requiring the disclosure within patent applications of, *inter alia*:

- (a) Genetic resources utilized in the development of the claimed inventions;
 - (b) The country of origin of genetic resources utilized in the claimed inventions;
 - (c) Associated traditional knowledge, innovations and practices utilized in the development of the claimed inventions;
 - (d) The source of associated traditional knowledge, innovations and practices;
- and,
- (e) Evidence of prior informed consent.”

4. This invitation was transmitted to the Committee at its third session (document WIPO/GRTKF/IC/3/12), which agreed to respond positively and adopted a work schedule which would allow for the completion and transmission of the study in time for the seventh meeting of the COP, to be held in Kuala Lumpur from March 9 to 20, 2004. Between the Committee’s third and fourth sessions, a questionnaire was developed in consultation with Member States and then circulated to Member States regarding the intellectual property issues identified for study in the invitation contained in Decision VI/24.

5. At its fourth session, the Committee considered and commented upon a draft technical study, including a compilation of responses received from Committee members and a draft analysis of those responses. The Committee also invited further comments for incorporation into a revised version of the technical study, which was then prepared and submitted to the Committee at its fifth session (document WIPO/GRTKF/IC/5/10). The Committee agreed to transmit this draft technical study to the WIPO General Assembly for consideration and possible transmission to the seventh meeting of the COP.

6. At its Twenty-Ninth Session, the WIPO General Assembly adopted the draft revised technical study for transmission to the seventh meeting of the COP. This decision was subject to the following understanding:

¹ See document WIPO/GRTKF/IC/2/11, Annex, and document UNEP/CBD/COP/6/6, Annex.

“The attached draft technical study has been prepared to contribute to international discussion and analysis of this general issue, and to help clarify some of the legal and policy matters it raises. It has not been prepared to advocate any particular approach nor to expound a definitive interpretation of any treaty. It is to be regarded as a technical input to facilitate policy discussion and analysis in the Convention on Biological Diversity and in other fora, and it should not be considered a formal paper expressing a policy position on the part of WIPO, its Secretariat or its Member States.”

Following the General Assembly decision, the Technical Study was transmitted to the Secretariat of the CBD (SCBD) with the above-mentioned understanding attached to the Study.

7. The Study was subsequently issued by the SCBD as document UNEP/CBD/WG-ABS/2/INF/4 for the second meeting of the Working Group, which took place in Montreal from December 1 to 5, 2003. The Study and the above-mentioned qualification were introduced to the Working Group² and provided the basis for deliberations which led to the adoption of Recommendations to the COP on the issues addressed in the Study.³ The Preamble of the Recommendations reflects the positive reception by the Working Group of the Technical Study. It specifically states that the Working Group issues its Recommendations while:

*“Noting with appreciation the Technical Study on Disclosure Requirements Concerning Genetic Resources and Traditional Knowledge prepared by World Intellectual Property Organization at the request of the Conference of the Parties in decision VI/24 C and considering the contents of the Technical Study to be helpful in the consideration of intellectual property-related aspects of user measures.”*⁴

The Recommendations of the Working Group on modalities for further addressing the issue of disclosure requirements in patent applications also contain bracketed text which, if retained and adopted by the COP, might imply a request to the Committee for carrying out follow-up studies and activities related to the issues identified in the original Study. The relevant text reads as follows:

The Working Group recommends that the COP at its seventh meeting:

“[Invites the World Intellectual Property Organization to address measures regarding the interrelation of access to genetic resources and disclosure requirements in intellectual property rights applications, while recognizing the leading role of the Convention on Biological Diversity in international biological diversity issues, in particular the intellectual property-related issues raised by a proposed international certificate of [origin/source/legal provenance], as part of the accelerated work under the renewed mandate of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, including:

² See document UNEP/CBD/COP/7/6, paragraphs 10 to 12, and 81.

³ See document UNEP/CBD/COP/7/6, paragraph 75 to 85.

⁴ See document UNEP/CBD/COP/7/6, Annex, page 27.

- (i) Options for model provisions on proposed disclosure requirements;
- (ii) Practical options for patent application procedures with regard to the triggers of disclosure requirements;
- (iii) Options for incentive measures for applicants;
- (iv) Identification of the implications for the functioning of disclosure requirements in various World Intellectual Property Organization-administered treaties;]

“[Further invites WIPO to prepare a report for submission to Conference of the Parties at its eighth meeting on the progress of this work, taking into account, in particular, any issues that may be identified in the Ad Hoc Open-ended Working Group on Access and Benefit-Sharing in the interim.]”⁵

The recommendations of the Working Group are being transmitted to the COP at its seventh meeting for its consideration and decision as an Annex to document UNEP/CBD/COP/7/6.

8. The Technical Study will be issued as document UNEP/CBD/COP/7/INF/17 for the COP and will be considered by the CBD Contracting Parties. At the time of issuance of this document, the seventh meeting of the COP, which is scheduled to take place in Kuala Lumpur, Malaysia, from February 9 to 20, 2004, had not yet taken place. It is foreseen that the Secretariat of the CBD will report to the Committee’s sixth session on the outcomes and decisions of the seventh meeting of the COP.

9. The Committee may wish to consider any further work that may be appropriate regarding the substantive intellectual property issues addressed in the Technical Study. In particular, document WIPO/GRTKF/IC/5/10 invited the Committee “to consider possible future work on this issue, including the continued exchange of national experience and case studies, and the development of guidelines and recommendations concerning the interaction between access to genetic resources and patent disclosure.” The range of such interaction considered by the Committee has included general disclosure requirements under patent law, specific requirements for genetic resources or traditional knowledge, and contractual obligations for disclosure linked to access to genetic resources.

10. The Intergovernmental Committee is invited:

- (i) to take note of the transmission of the Technical Study and of recent developments in other fora on this issue; and*
- (ii) in the light of such developments and other proposals to consider possible future work for the Committee on this issue, including the proposals in paragraph 12(ii) of document WIPO/GRTKF/IC/5/10.*

[End of document]

⁵ See document UNEP/CBD/COP/7/6, Annex, page 28.