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Disclosure of Provenance of GR and TK Policy Views from an IP Office

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Overview on IP Policy Questions

- How are GR and TK related to disclosure in patents?
- Intersection of policy issues and technical issues for disclosure of provenance in patents
- Two case studies to illustrate key issues
- Aspects of GR text that relate to key issues
- Caveat - View from an office without disclosure!



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How are GR and TK related to patenting

- Two case studies to illustrate key issues
- Munumbicin – patent for a new bacteria
 - wild-growing GR and secret TK
- Kakadu Plum – patent for cosmetic
 - commercially available GR that is the subject of widely known TK



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Key Issues and Policy Implications

- Is the claimed invention directly based on utilization of GR and/or TK?
- Does the claimed invention involve derivatives?
- Can the applicant disclose where the GR and TK were obtained?
- Can the applicant disclose how they obtained the GR and TK?
- What does the patent office do with the disclosure?
- What are the consequences of inaccurate or incomplete disclosures?



Munumbicin

- From the description in the patent document
- “In a preferred embodiment the endophytic streptomycete is *Streptomyces munumbi*. *Streptomyces munumbi* was isolated from *Kennedia nigriscans*, as described herein. *Kennedia nigriscans* (**snakevine**) was obtained from the Northern Territory of Australia where various Aboriginal groups use the ground up mass of snakevine to promote the healing of skin wounds and infections. The snakevine is also known as "**mangerrporlo**" in **Dalabon** and **Mayali**. *Streptomyces munumbi* are capable of producing a set of novel compounds, designated the munumbicins, each of which contributes distinctive reddish-orange coloration to cultures.”



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Kennedia nigricans Photo M. Fagg
Tigersnake vine

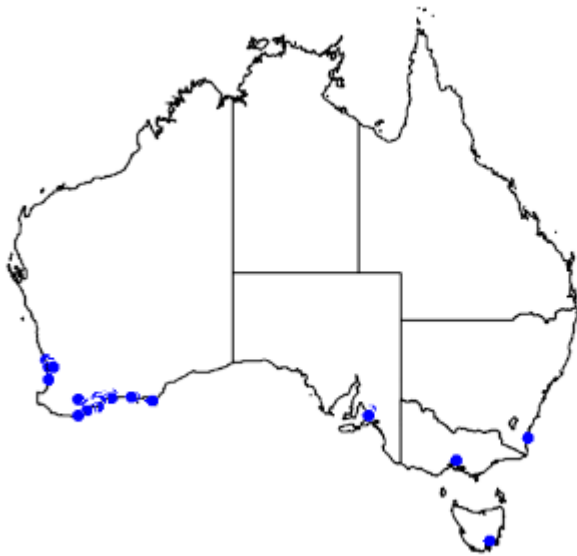


Copyright: State of NSW
Tinospora smilacina
Snakevine

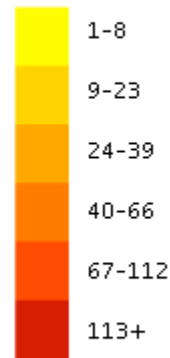


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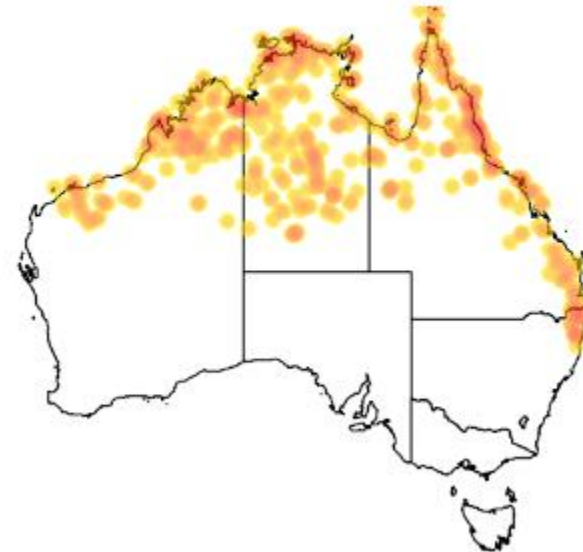
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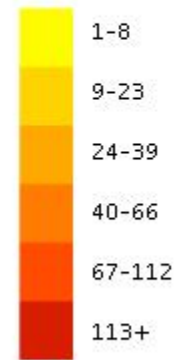
Kennedia nigricans
Tigersnake vine



Occurrence records map



Tinospora smilacina
Snakevine





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Munimbicin

- Claim 1
- An isolated strain of a *Streptomyces* spp. which is an endophyte of a *Kennedia nigriscans* plant stem, wherein the strain is *Streptomyces munumbi* NRRL 30562.



Key issues and this case study

- Claimed invention is directly based on ‘utilization’ of GR and TK but not a ‘derivative’.
- The applicant can disclose where the GR and TK were obtained, both ‘country of origin’ and ‘source’.
- The patent document does not provide a clear picture of how the inventor obtained the TK.



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Kakadu Plum

- From the description “In an alternative embodiment of the present invention there is disclosed compositions of the present invention can include ... Terminalia ferdinandiana (kakadu plum) fruit extract ... extract obtained from the fruit of the kakadu plum can be purchased from Southern Cross Botanicals Pty Ltd (NSW, Australia), which was used in the Examples”.



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Occurrence records map

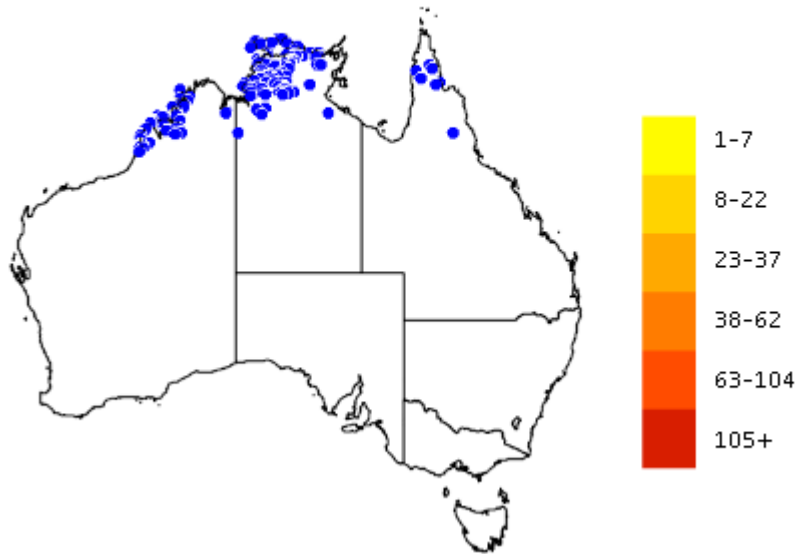


Photo B. J. Carter



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Kakadu Plum

- Claim 1
- A method of firming skin or reducing the appearance of fine lines or wrinkles comprising topically applying, to skin in need thereof, a composition comprising: (a) palmitoyl tetrapeptide 7; and (b) a dermatologically acceptable vehicle comprising: (i) water; (ii) glycerin; (iii) butylene glycol; (iv) propylene glycol; and (v) a **chelating agent**, wherein topical application of the composition to the skin firms the skin or reduces the appearance of fine lines or wrinkles, and wherein the composition is not a sunless tanning composition



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Key issues and this case study

- Patent does not directly claim a composition with Kakadu plum.
- The patent description refers to Kakadu Plum as a preferred embodiment of the claimed invention.
- The applicant can disclose where the GR was obtained.
- The patent document makes no mention of the TK about Kakadu Plum.



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Publication of Disclosures, and Consequences for Inaccurate or Incomplete Disclosures

- The patent office could make it available to national institutions and to the CBD-ABS Clearing House. Need to consider confidential disclosures.
- Inaccurate disclosures can be remedied – if they are identified.
- Applicants can state they cannot or choose not to disclose.
- After grant, changes to the scope of the patent.



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Key issues and the GR Text

- Art. 3.1 chapeaux
 - Is the claimed invention directly based on GR and/or TK?
 - Does the claimed invention involve derivatives?
- Art. 3.1(a), (b), (c)
 - Can the applicant disclose where and how the GR and TK were obtained?
- Art. 6
 - What are the consequences of incomplete or inaccurate disclosures?
- Art. 3.2, 3.3, 3.4
 - What does the patent office do with the disclosure?



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Key Messages

- Patent applicants are making these disclosures, but they are not easy to find and are sometimes inaccurate or incomplete.
- Illustrated how the proposed terminology and mechanisms in the IGC text on disclosure might be applied to two actual patent applications.



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Thank You!

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