

# Defusing Disclosure in Patent Applications



**UNU IAS Biodiplomacy Initiative**

© **Geoff Burton** Senior Fellow, United Nations University Institute of Advanced Studies.  
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# Defusing Disclosure in Patent Applications

- This presentation will outline:
  - The dysfunctional relationship between CBD, WIPO & WTO
  - Its consequences
  - Suggest a way forward, and
  - describe the basis for concrete action within the WIPO IGC



# Defusing Disclosure in Patent Applications

Why disclosure?

- Patents – are a proxy for the commercialisation of genetic resources
- Patents track commercialisation

Disclosure:

- Tracks lawful use
- Evidence of legal certainty
- Supports commercialisation of patents



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Why disclosure?

- creates comparative advantage for lawful user
- creates disincentive to commercialise unlawful use
- informs research and investment market about GR sources for commercialisation



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Why no progress?

- After more than a decade of effort
- Issue is prominent at CBD, WIPO, WTO–Doha development agenda & TRIPS Council
- Mountain of technical and written submissions have been produced



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Authority to act:

- WSSD: Para 44 of the Plan of Implementation
- UNGA Resolution 57/253



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Still no progress – why?

Conventional explanations:

- 1. CBD an Env treaty – has no competence to address IP matters
  - The 3<sup>rd</sup> obj – is a trade and economic matter
- 2. Wrong to use IP syst for non-IP uses
  - Long history of multiple public policy uses



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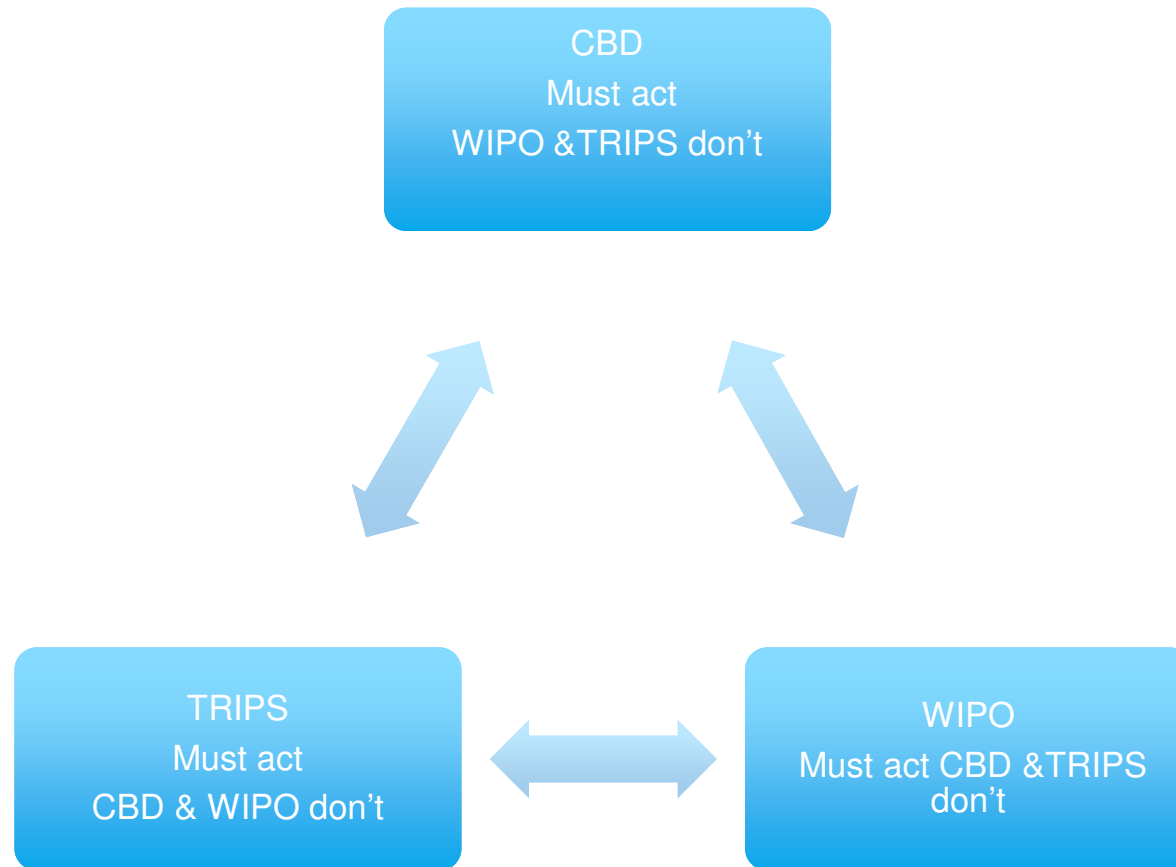
Explanation:

The CBD, WIPO, WTO/TRIPS unable to deliver because they are in tension:

- Triangular relationship created and based on absence of progress in each of the other two.
- This is dysfunctional



# Defusing Disclosure in Patent Applications: Dance of the imperitives





# Defusing Disclosure in Patent Applications

Consequences:

- Stasis for 8 years
- Perception of subservience to other issues under neg
  - Eg GIs, Market access, delay for domestic issues, Co-operation in Trade negotiations



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Consequences:

- Builds distrust
- Leads to positional bargaining
- Encourages unrealistic demands
- Frightens stakeholders
- Leads to more rigidity
- Rejection of reasonable proposals eg Swiss, PCT/ PLT proposal



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Sleeping Issue: Spread of disclosure in national patent law:

- Includes:
  - Some EU and broader European countries
  - India
  - Brazil
  - China and
  - more in the pipeline



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Factors to consider:

- Any disclosure in one market, is global disclosure
- The more valuable the invention the more likely it is to be patented in a disclosing jurisdiction
- Process of creating international customary law



# Defusing Disclosure in Patent Applications

Breaking the dynamic:

- Action by one institution breaks the tension between all three
- CBD best to start – disclosure obligation as part of MAT
- THIS DOES NOT ALTER IP SYSTEM
- Precedent :US Bayh Dole Act 1980 - requires disclosure in patent applications of federal funding support



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Breaking the dynamic:

- Legal opinion: this action is not inconsistent with international legal obligations



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Consequences:

- Removes pressure to re-open TRIPS,
- Encourages IGC discussion focus on practical and effective mutually supportive measures
- Encourages IGC analysis of impact of national action and harmonising disclosure arrangements for the future





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Finally:

- action within the CBD reinforces national sovereignty when framed to be undertaken as part of the application of MAT.
- Starting point text is already on the table this week:



# Modified Montreal Annex Text:

## ...Option 1

- *(Users of genetic resources must disclose in)* patent applications whose subject matter is directly based on GR and/or associated TK the country providing GR in accordance with the Convention or source of such resources and/or associated TK as well as information on prior informed consent and evidence that provisions regarding prior informed consent, mutually agreed terms and benefit-sharing have been complied with, in accordance with the national legislation regulations and/or requirements of the country providing the resources in accordance with the Convention.



**All Problems have solutions**

Thank You.