



‘Disclosure of Origin’ for Genetic Resources and Associated Traditional Knowledge Patents: An Overview of the WIPO Treaty

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I. Introduction

One of the key requirements for obtaining a patent is to provide a sufficiently clear and complete disclosure of the claimed invention in the patent application.² This enables the person of ordinary skill in the art³ to make, reproduce or repeat the claimed invention, if necessary. Disclosure of invention primarily serves some private interests, i.e., it helps applicants to secure a patent and examiners in evaluating the patent application. The disclosure also contributes to public knowledge by making the invention available through published applications or patents. Despite its virtues, patent disclosure does not require the applicant to provide information about the source or origin of the claimed invention from where it originated or developed, which is known as ‘disclosure of origin’.⁴ This lack of disclosure could cause erroneous granting of patents⁵ over the genetic resources (GR)⁶ and associated traditional knowledge (ATK) inventions.⁷

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² Article 29(1), The Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) (hereinafter the TRIPS Agreement)

³ Person having ordinary skill in the art (PHOSITA) is a legal fiction in patent law. It is an assessment standard of a patent to assess whether the claimed invention is obvious to a person with ordinary art skill. See for more, Joseph P. Meara, Notes and Comments, Just Who Is the Person Having Ordinary Skill in the Art? Patent Law's Mysterious Personage, 77 Wash. L. Rev. 267 (2002).

Available at: <https://digitalcommons.law.uw.edu/wlr/vol77/iss1/7>

⁴ The disclosure of origin refers to disclosing the source or origin from which the claimed inventions were derived/developed. See for more, Graham Dutfield, Thinking Aloud on Disclosure of Origin, QUNO Occasional Paper 18, (2005), https://www.iprsonline.org/unctadictsd/docs/Disclosure_Dutfield.pdf

⁵ For example, the patents were revoked on the erroneous grants in the Neem Patent Case (EP 0436257B1) and the Turmeric Patent Case (US patent Number: 5,401,504). See for more, Mohammad Ataul Karim, Caught between Rationalising and Protecting? Problematic Premise of Traditional Knowledge in Intellectual Property Regime, European intellectual property review, 2023-11, Vol.45 (11), p.660-672

⁶ Article 2, The WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, 2024, adopts the definition of genetic resources (GR) from the Convention on Biological Diversity (CBD), 1992. https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf Article 2 of the CBD defines that “GRs are genetic material of actual or potential value. Genetic material means any material of plant, animal, microbial or other origin containing functional units of heredity.” <https://www.cbd.int/convention/articles/default.shtml?a=cbd-02>

⁷ The new WIPO Treaty (the aforesaid Treaty) does not define ATK. It means traditional knowledge associated with GR. Traditional knowledge (TK) is “knowledge, know-how, skills and practices that are developed, sustained and passed on from generation to generation within a community, often forming part of its cultural or spiritual identity” <https://www.wipo.int/tk/en/tk/>

Against this backdrop, in 2006, Brazil, Peru, and India proposed a new Art. 29*bis* to the TRIPS Agreement requiring ‘disclosure of origin’ in patent applications covering the GR and ATK inventions.⁸ However, at that time no consensus could be achieved; hence, the proposal was not adopted.⁹ After more than two decades of discussions, deliberations and negotiations, The World Intellectual Property Organization (WIPO) adopted a Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge in May 2024 (hereinafter the Treaty).¹⁰ Accordingly, the contracting parties to the Treaty (mainly the States) are required to implement ‘the disclosure of origin requirement’ in their domestic laws. Therefore, the Treaty is likely to have a significant impact on the streamlining of patent applications for GR and ATK inventions. Given the importance of the Treaty, this paper offers a brief overview of its key provisions. Part II of the paper outlines the basic provisions of the Treaty, while Part III provides a conclusion.

II. An Overview of the WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, 2024

A. Objectives of the Treaty

The Treaty aims to achieve two main objectives.¹¹ The first is to enhance the ‘efficacy, transparency and quality’ of the existing patent system covering the GR and ATK inventions (Art.1). The terms efficacy, transparency, and quality are though not defined in the Treaty. As such, difficulties may arise in their interpretations. For example, it may be challenging to measure whether a contracting party has fulfilled the obligations to achieve the objective of this Treaty.

The second objective of the Treaty is to prevent the grant of patents on GR and ATK with GR when the invention does not fulfil the conditions for patentability: the invention must be new, involve an inventive step and be capable of industrial application.¹² The Treaty

⁸ Daniel J. Gervais, *The TRIPS Agreement: Drafting History and Analysis*, Sweet & Maxwell/Thomson Reuters, 5th ed, (2021), p. 103

⁹ TRIPS: Reviews, Article 27.3(B) and Related Issues: Background and the current situation, https://www.wto.org/english/tratop_e/trips_e/art27_3b_background_e.htm

¹⁰ WIPO Member States Adopt Historic New Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, Geneva, May 24, 2024, PR/2024/919, https://www.wipo.int/pressroom/en/articles/2024/article_0007.html The Treaty is the first international legal instrument requiring ‘disclosure of origin’ in the patent application for GR and ATK inventions.

¹¹ Article 1, The WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, 2024.

¹² Article 27.1 of the TRIPS Agreement states that “...patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.”

explicitly recognizes in Art. 1(b) that it aims to prevent erroneous patent grants for GR and ATK inventions because of the lack of ‘novelty or inventive step.’¹³ The industrial application condition of a patent requires a minimum industrial utility or usefulness. This is easier to comply and assess in comparison to novelty and inventive steps. Thus, it appears logical that the Treaty focuses more on novelty and inventive step requirements to evaluate the erroneous grants of patents over GR and ATK inventions.

B. Disclosure Requirement

Article 3 of the Treaty sets out the core issue, i.e., the ‘disclosure requirement’ for the GR and ATK patent applications. It outlines two triggering situations for disclosure where claimed inventions are based on GR. First, each contracting party shall require the patent applicant to disclose the country of origin of the GR where the claimed invention is based on GR (Art. 3.1 (a)). Where there is more than one country of origin, the applicant is required to disclose the country of origin from where the GRs were actually obtained.¹⁴ Second, where the country of origin is unknown to the applicant or where Art. 3.1 (a) of the Treaty is not applicable; the applicant is required to disclose the source of GR.¹⁵ The source of GR refers to any source from which the GR is obtained.¹⁶ This includes research centers, gene banks, indigenous peoples, and local communities.¹⁷

Similarly, the Treaty provides two scenarios where disclosure is required for the claimed inventions based on TK associated with GR. First, according to Art. 3.2 (a), a patent applicant shall be required to disclose the relevant indigenous peoples or local community (as applicable) who provided the TK associated with GR.”¹⁸ Second, if the aforementioned information is unknown to the applicant or where Art. 3.2 (a) is not applicable; the applicant shall disclose the source of TK associated with GR.¹⁹ In this context, the source means any source from which the applicant has obtained TK associated with GR.²⁰ This includes scientific literature, publicly accessible databases, patent applications, and patent publications.²¹

¹³ Article 1(b), The WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, 2024.

¹⁴ See, Footnote 2, *ibid.*

¹⁵ Article 3.1 (a), *ibid.*

¹⁶ Article 2, *ibid.*

¹⁷ Article 2, *ibid.*

¹⁸ Article 3.2 (a), *ibid.*

¹⁹ Article 3.2 (b), *ibid.*

²⁰ Article 2, *ibid.*

²¹ Article 2, *ibid.*

The Treaty outlines an alternative situation for good faith declaration. In case none of the aforesaid information regarding GR or ATK inventions is known to the applicant, the applicant is required to make a good faith declaration to that effect affirming that the contents of the application are “true and correct to the best knowledge of the applicant.”²²

Some relevant aspects on the disclosure requirement can briefly be outlined. First, the key requirement for disclosure is that the patent application must be ‘based on’ the GR and TK associated with GR. The term ‘based on’ means the GR and the ATK with GR must be necessary for the claimed invention,²³ and that the claimed invention depends on the specific properties of the GR and/or ATK with GR.²⁴ Second, a patent applicant shall have an opportunity to rectify any potential failure to comply with the abovementioned disclosure requirement or to correct any information disclosed.²⁵ Third, parties to this Treaty are required to guide patent applicants on how to meet the disclosure of origin requirement.²⁶ Fourth, the patent offices are exempted from verifying the authenticity of the disclosure.²⁷ Finally, the disclosed information shall be available as per the patent procedure and subject to the protection of confidential information (such as certain undisclosed information or trade secrets).²⁸

C. Sanctions and Remedies for Non-Disclosure

The Treaty obliges the contracting parties to adopt ‘appropriate, effective, and proportionate legal, administrative and/or policy measures’ to address any information disclosure failure as required by Art. 3 of the Treaty.²⁹ However, the contracting parties have a limited capacity to impose sanctions and remedies for any non-compliance with the disclosure obligation.³⁰

Moreover, the Treaty puts in place certain safeguards for patent applicants before being subject to any sanctions. The contracting parties are required to provide an opportunity to the patent applicant to rectify a failure of disclosure obligation before imposing any sanctions or

²² Article 3.3, *ibid.*

²³ Article 2, *ibid.*

²⁴ Article 2, *ibid.*

²⁵ See section C below.

²⁶ *ibid.*

²⁷ Article 3.5, *ibid.*

²⁸ Article 3.6, *ibid.*

²⁹ Article 5.1, *ibid.*

³⁰ Article 5, *ibid.*

directing remedies.³¹ The only exception is the *fraudulent conduct or intent* of the applicant.³² Therefore, a fraudulent conduct or intent for non-disclosure may be subject to post-grant sanctions and remedies in accordance with the relevant national law.³³ However, a patent shall not be rendered invalid, revoked, or unenforceable only due to the failure of disclosure obligation as required by the Treaty.³⁴

D. Membership and Entry into Force

Any WIPO Member may become party to the Treaty.³⁵ Any inter-governmental organization (such as the European Union) may also become a party upon the approval of the assembly.³⁶ Any State or intergovernmental organization may submit an instrument of ratification (in case of being a signatory) or an instrument of accession (in case of not being a signatory) to the Director General of WIPO.³⁷ The effective date of such ratification or accession, as applicable, shall be the date on which the instrument is deposited with the WIPO depository.³⁸ The Treaty shall be entered into force three months after the deposit of ratification or accession instruments of fifteen (15) contracting parties.³⁹ The Treaty shall bind each contracting party from the date of entry into force and three months from the deposit of ratification or accession instruments.⁴⁰ The Treaty may be denounced by notification to the Director General of WIPO which shall be effective after one year of receiving the notification.⁴¹ No reservation to this Treaty is permitted.⁴²

E. Miscellaneous Issues

The Treaty incorporates a commitment to a self-contained future review by the Member States. This review may take place four years after the Treaty enters into force.⁴³ The contracting parties are committed to a review of the scope and contents of the Treaty on possible extension of the disclosure requirement to other areas of intellectual property.⁴⁴ The

³¹ Article 5.2, *ibid.*

³² Article 5.2 (*bis*), *ibid.*

³³ Article 5.4, *ibid.*

³⁴ Article 5.3, *ibid.*

³⁵ Article 12.1, *ibid.*

³⁶ Article 12.2, *ibid.*

³⁷ Article 13.1, *ibid.*

³⁸ Article 13.2, *ibid.*

³⁹ Article 17, *ibid.*

⁴⁰ Article 18, *ibid.*

⁴¹ Article 19, *ibid.*

⁴² Article 20, *ibid.*

⁴³ Article 8, *ibid.*

⁴⁴ *ibid.*

review also includes addressing issues arising from new and emerging technologies which are relevant to the application of this Treaty.⁴⁵

The contracting parties may establish an information system (such as a database) on GR or TK associated with GR at the national level.⁴⁶ This should occur in consultation, where applicable, with indigenous people, local communities, and other relevant stakeholders, considering the national circumstances. The contracting parties should make the information system accessible (with due safeguards) to other IP/patent offices for the purpose of patent search and examination.⁴⁷ The assembly of the contracting parties may establish one or more technical working groups to address any matters on information systems, including accessibility to offices with appropriate safeguards.⁴⁸

III. Conclusion

The demands for disclosure of origin in the GR and ATK patents have been around for quite some time. In this sense, the adoption of this new WIPO Treaty is historic. After more than two decades of discussions, debates, and negotiations, WIPO has set a new trajectory for the GR and ATK patent system. It is expected that the Treaty will have a great impact on the patent applications for GR and ATK inventions. However, it is too early to comment on the Treaty's future implications. It remains to be seen how things unfold, especially regarding the national implementation of the Treaty.

⁴⁵ Ibid.

⁴⁶ Article 6.1, *ibid.*

⁴⁷ Article 6.2, *ibid.*

⁴⁸ Article 6.3, *ibid.*