

## New requirements to declare the source of Indigenous Knowledge used in new innovations

### Overview:

As observed in the consultation paper, the disclosure of origin and source of genetics resources and/or traditional knowledge will provide important recognition of Aboriginal and Torres Strait Islander Peoples' rights as custodians of genetic resources and traditional knowledge. Disclosure of source requirements should form part of a broader suite of tools that may be deployed to protect Aboriginal and Torres Strait Islander traditional knowledge. An Australian framework for the protection of traditional knowledge should include a variety of legal tools including access and benefit sharing regime, databases, and bottom up governance structures and institutions.<sup>1</sup>

Disclosure of an invention is fundamental to the bargain at the heart of the patent system. It is the disclosure in a patent specification that justifies the grant of a limited monopoly to the patentee to exploit the invention.<sup>2</sup> Current disclosure obligations require the patentee to 'disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.'<sup>3</sup>

In order to uphold this bargain, patentees should be specifically required to disclose the origin and source of any genetic resources and/or traditional knowledge used to develop an invention. Full disclosure upholds the integrity of the patent system by ensuring that patent examiners are aware of relevant prior art. A recent study by Professor Daniel Robinson and Dr Margaret Raven examined the patent register and identified 'dozens of patents which utilise endemic Australian biological resources' that have known uses by Aboriginal and Torres Strait Islander peoples.<sup>4</sup> While two of the patents involve collaboration with Aboriginal communities, the remainder do not provide any evidence of prior informed consent or benefit sharing with Aboriginal or Torres Strait Islander communities.<sup>5</sup> Failure to engage with Aboriginal and Torres Strait Islander peoples not only causes spiritual and cultural damage, it may result in a lost economic opportunity for Aboriginal and Torres Strait Islander peoples. Protecting against the misappropriation and exploitation of traditional knowledge may act as a form of corrective justice and also help prevent further loss of knowledge and culture.

Disclosure of source may enable more complete examination of patent applications and reduce the need for costly and time consuming interventions by Aboriginal and Torres Strait Islander peoples or other stakeholders. For example, in early 2020 a group of academics requested re-examination of the granted patent Patent AU 2008300612 B2 'Production of leaf extracts of *Pittosporum phillyraeoides* and the use thereof in medicine' under section 97 of the *Patents Act 1990* drawing the Commissioner's attention to relevant prior art relating to the prior use of gumby gumby by

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<sup>1</sup> See generally Evana Wright, *Protecting Traditional Knowledge: Lessons from global case studies* (Edward Elgar, 2020) Ch 6.

<sup>2</sup> *Attorney General of the Commonwealth of Australia v The Adelaide Steamship Company Limited* [1913] AC 781; (1913) 18 CLR 30; IP Australia, 2.11.3A *Clear Enough and Complete Enough Disclosure*, Patent Examiner's Manual of Practice and Procedure (16 December 2020).

<sup>3</sup> *Patents Act 1990* (Cth) s 40(2)(a).

<sup>4</sup> Daniel Robinson, 'Identifying and Preventing Biopiracy in Australia: Patent trends for plants with Indigenous Australian uses' (Submission to IP Australia, 2016)

<[https://www.ipaustralia.gov.au/sites/g/files/net856/f/submission\\_-\\_daniel\\_robinson.pdf](https://www.ipaustralia.gov.au/sites/g/files/net856/f/submission_-_daniel_robinson.pdf)>.

<sup>5</sup> *Ibid* 13.

Aboriginal people in various areas of Australia. The re-examination request is listed as 'In Progress' on AusPat. Identifying patents granted over Australian endemic biological resources and traditional knowledge is burdensome, time consuming and the process of requesting re-examination or formally challenging patents is costly and beyond the reach of many.

The lack of disclosure is not only contrary to the patent bargain, it fails to recognise Australia's sovereign rights in biological resources in accordance with the Convention on Biological Diversity.<sup>6</sup> Disclosure of source requirements would also help Australia meet its obligations under the Nagoya Protocol (upon ratification by Australia). The Nagoya Protocol requires that member countries establish mechanisms to ensure that traditional knowledge associated with genetic resources is accessed subject to prior informed consent and mutually agreed terms.<sup>7</sup>

### Questions:

#### **Q12: Which option do you think provides the best outcomes in supporting fair use of traditional knowledge? Are there other ways to encourage disclosure?**

Option 2 is the most appropriate option to secure the intended benefits of disclosure of source requirements.

While the system may at first focus on encouraging compliance there must be penalties for intentionally withholding information. Self-regulation may fail in the absence of any incentive for compliance especially in the event of conflict between private and public interests.<sup>8</sup> There must be some form of a penalty for non-compliance. These penalties may take the form of fines or failure to disclose (including an incomplete disclosure) may form the grounds for opposition or revocation.

The use of penalties for intentionally withholding information is consistent with the approach taken in a number of jurisdictions including the Andean community, Peru, and India. Under the *Andean Community Agreement Decision 486 – Common Provisions on Industrial Property*, failure to include an access contract or accrediting document in a patent application is grounds for declaring a patent invalid.<sup>9</sup> The *Patents Act 1970* (India) requires that patent applications disclose the source or geographical origin of biological material used in an invention and failure to disclose such information is grounds for opposition or revocation.<sup>10</sup> In Peru, an access and benefit sharing agreement (referred to as a licence agreement) must be submitted with an application for a patent

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<sup>6</sup> *Convention on Biological Diversity*, opened for signature 5 June 1992, 1760 UNTS 30619 (entered into force 29 December 1992) ('CBD') art 3.

<sup>7</sup> *Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization to the Convention on Biological Diversity*, opened for signature 2 February 2011, UNEP/CBD/COP/DEC/X/1 (entered into force 12 October 2014), arts 7, 16 and 17.

<sup>8</sup> See for example, Organisation for Economic Co-Operation and Development (OECD) *Industry Self-Regulation: Role and Use in Supporting Consumer Interests – DSTI/CP(2014)4/FINAL* (2015) 23; A. Williams, "An Economic Theory of Self-Regulation", Working Paper prepared for The Political Economy Doctoral Workshop, Department of Government, LSE (2004)

<<http://citeseerx.ist.psu.edu/viewdoc/download?doi=10.1.1.509.1219&rep=rep1&type=pdf>>.

<sup>9</sup> Decision 486 art 26(h). See Evana Wright, *Protecting Traditional Knowledge: Lessons from global case studies* (Edward Elgar, 2020) 64.

<sup>10</sup> *Patents Act 1970* (India) ss 25(1)(j), 25(2)(j) and 64(1)(p).

over any invention produced or developed on the basis of traditional knowledge.<sup>11</sup> Failure to submit such evidence may be grounds for refusal or invalidation of the patent.<sup>12</sup>

**Q13: Should a disclosure of source be required for use of traditional knowledge that led to a new plant variety or was used in research to develop a new plant variety?**

A disclosure of source should be included in any plant breeder's rights application where traditional knowledge is used in the development of a new plant variety. Disclosure of source could assist in preventing the grant of plant breeder's rights over Australian native plants with known traditional uses. Examples of such exploitation have been documented by Rural Advancement Foundation International (RAFI) and Heritage Seed Curators Australia (HSCA) in their report 'Plant Breeder's Wrongs: An Inquiry into the Potential for Plant Piracy through International Intellectual Property Conventions'.<sup>13</sup>

**Q14: Do you think having the ability to attach information on ABS or consent to IP rights would provide a useful basis for better conversations about ABS and consent?**

The disclosure of source requirement must involve a disclosure of the source or origin of the genetic resources and/or traditional knowledge and provide evidence of both the prior informed consent of the relevant Aboriginal or Torres Strait Islander community as well as mutually agreed terms governing access and benefit sharing. The requirement to provide evidence of prior informed consent and benefit sharing is critical to ensure that informed consent is obtained prior to access and use of traditional knowledge and that benefits are returned to the relevant Aboriginal or Torres Strait Islander peoples in recognition of their important role as custodians of traditional knowledge.

A requirement to provide evidence of access and benefit sharing or consent to intellectual property rights would support the fulfilment of Australia's obligations under various international agreements. As set out in UNDRIP, Aboriginal and Torres Strait Islander peoples have the right to 'maintain, control, protect and develop their cultural heritage, traditional knowledge and traditional cultural expressions'.<sup>14</sup> Access and benefit sharing arrangements with Aboriginal and Torres Strait Islander peoples are central to meeting the standards set out in UNDRIP. Furthermore, in accordance with the Convention on Biological Diversity, member countries must 'respect, preserve and maintain knowledge, innovations and practices of indigenous and local communities...and encourage the equitable sharing of benefits arising from the utilization of such knowledge, innovations and practices.'<sup>15</sup>

**Q15: What types of evidence of ABS/consent would it be possible to make available to IP Australia?**

There are a number of ways that parties could provide evidence of ABS/consent in support of any new disclosure obligations. The parties to an access and benefit sharing arrangement could complete a declaration to be lodged along with a patent application. This would confirm that there is

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<sup>11</sup> Law 27811 *Introducing a Protection Regime for the Collective Knowledge of Indigenous Peoples Derived from Biological Resources* (Peru) Second Complementary Provision.

<sup>12</sup> Ibid.

<sup>13</sup> Rural Advancement Foundation International (RAFI) and Heritage Seed Curators Australia (HSCA), *Plant Breeders Wrongs: An Inquiry into the Potential for Plant Piracy through International Intellectual Property Conventions* (RAFI and HSCA, 1998) 10.

<sup>14</sup> *United Nations Declaration on the Rights of Indigenous Peoples*, GA Res 61/295, UN GAOR, 61st sess, Supp No 49, UN Doc A/RES/61/295 (2 October 2007) art 31(1).

<sup>15</sup> CBD art 8(j).

an access and benefit sharing agreement is in place and is based on principles of mutually agreed terms and prior informed consent. The use of a declaration rather than depositing the access and benefit sharing arrangement itself would avoid any issues associated with disclosing confidential information in the public patent register. Other evidence could include the inclusion in the patent application of an Aboriginal or Torres Strait Islander individual as co-inventor or an Aboriginal or Torres Strait Islander community or organisation as co-owner.

Alternatively, an Indigenous Advisory Body or other competent authority could be established to collect and retain information on access and benefit sharing arrangements and to validate the existence of such arrangements for the purpose of patent applications.