

Business Law
Building Resources and Markets
Ministry of Business, Innovation & Employment
PO Box 1473
Wellington 6140
New Zealand

Submissions on Disclosure of Origin of Genetic Resources and Traditional Knowledge

Dear Sir/Madam,

These submissions have been prepared by the New Zealand Institute of Patent Attorneys Inc. (NZIPA).

The NZIPA was established in 1912. It is an incorporated body representing most Patent Attorneys registered under the New Zealand Patents Act, and who are resident and practising in New Zealand. Members of NZIPA represent a diverse spectrum of local and international clients engaging with the intellectual property system, including owners of intellectual property rights, alleged infringers and other interested parties. Due to this diversity a single unified view may not be possible in certain cases.

The submissions are made in response to the discussion paper entitled Disclosure of origin of genetic resources and traditional knowledge in the patents regime (the Discussion Document).

Question 1 -Do you have any comments on the problem definition?

The Discussion Document defines two issues – the potential that patent applications may not be recognised as being relevant to Māori and requiring consideration by the Patents Maori Advisory Committee (PMAC,) and the lack of information available about the use of genetic resources and traditional knowledge – especially New Zealand genetic resources and mātauranga Māori – in research.

We consider that referring to these two issues in isolation is too narrow. Any conversation about disclosure of origin requirements should be in the context of a wider discussion about Māori rights in and around indigenous species and mātauranga Māori. The Wai 262 report discusses a number of issues and gives a number of recommendations for an overall regime which would recognise the role of Māori as kaitiaki.

We consider that any conversation around a requirement for disclosure of origin should be in the context of a wider public discussion of the entirety of the Waitangi Tribunal's recommendations in the Wai 262 report.

Question 2 - Do you agree with the objectives that we have identified? Do you agree with the weighting we have given the objectives?

Within the limited ambit of the Discussion Document, the stated objectives are appropriate.

We note that none of the objectives relate to ensuring that the rights of indigenous peoples are protected and there is no reference to the Treaty of Waitangi or Wai262. The objectives thus say nothing about whether the existing substantive provisions of the Patents Act 2013 (e.g. sections 14 and 15) are sufficient to protect those rights. In the absence of a wider public consultation on Wai262, considering what rights should be protected and how best to protect those rights (mentioned above), we suggest it is appropriate that the objectives be limited to those provided.

The NZIPA has no single position on the relative weighting of the objectives.

Question 3: Do you have any comments on our preliminary assessment of the options?

We note that the options all treat the requirements for genetic resources and traditional knowledge as being the same. Without being taken as expressing a preference for such an option, we note that there is scope for alternative options where, for example a disclosure requirement for genetic resources, and disclosure of an access and benefit sharing scheme if indigenous knowledge is used.

We agree with the comments at paragraph 79 that in many cases a researcher will not know the origin at the time of conducting the research. Moreover, under the standard approach taken internationally, there is little incentive for the researcher to investigate such an origin at the time of doing the research. It follows that in this international environment it may not be until examination in New Zealand that the applicant must provide the relevant information. Given that this may be six years or more from the original research (calculated from a convention priority date) it may be practically impossible to determine the origin of a resource.

This raises the practical question of a what time is the “knowledge” to be assessed. The traditional patent approach is that disclosure (and the knowledge) is assessed at the time of filing, either of the priority document, or the complete specification. If there is an option as to declaring a lack of knowledge – at what point is this to be assessed? At the priority date? At filing? At the acceptance date? Or will there be an ongoing assessment, whereby if the applicant/patentee needs to make a new disclosure if they become aware of a new origin.

We agree with paragraph 84 that imposing too high a cost may have a detrimental effect on the amount of disclosure in New Zealand. It should be noted that the costs associated with obtaining a patent in New Zealand are already high in New Zealand when compared to the size of our market. It is possible that foreign applicants may forego filing for patent protection in New Zealand if costs are too high. It is also possible that New Zealand applicant’s will choose to pursue protection overseas and not New Zealand if costs are too high. Both of these cases will result in a reduction in disclosure. High costs may also discourage the pursuit of a patent altogether. Aside from the resultant reduction of information, this may be undesirable when Maori have conducted the research, or have a benefit sharing arrangement with the researchers, and stand to gain from the commercialisation of the research.

We agree with point made at paragraph 106, that in the absence of an access and benefit sharing (ABS) regime in New Zealand, Option 3 will benefit indigenous peoples or communities in those

countries with an ABS scheme more than Māori or New Zealand as a whole. This is one of the reasons we advocate that the discussion of disclosure of origin regime should be discussed as part an entire response to the Wai 262 report.

The subject matter definition (discussed below) may further inform the option taken. For example, if viruses and other microscopic organisms are included within the definition then disclosure of origin may in some cases be impossible given the rapid spread of such viruses. We feel that if viruses and other microscopic organisms are included there should be a provision for disclosure of source in place of disclosure of origin. Similar issues will apply to transitory or migratory organisms who may have multiple places of origin.

A further point to note is that a disclosure of a country of ‘origin’ may not necessarily provide the information necessary to aid in determining whether a patent should be referred to the PMAC. As recognised in paragraph 69 the country of origin for a marine species (for example) could legitimately be declared as outside New Zealand, yet the species itself could have special significance to Maori. An example of this could be whales, which are considered taonga (see [here](#)), yet a disclosure of origin could be given for another country, leading to an application utilising a whale or part of a whale as not being referred to the Maori Advisory Committee.

Question 4: What is your preferred option? Why

The NZIPA does not have a preferred option.

We do consider it important that any option allows the applicant to declare that they do not know the origin of the genetic resource/indigenous knowledge for the reasons given above.

Question 5: Do you have any comments on how New Zealand should approach international discussions relating to disclosure of origin requirements?

New Zealand’s international approach needs to be informed by a full discussion of the Māori rights in and around indigenous species and mātauranga Māori. Formulating an international position before having this discussion is premature.

Question 6: What are your views on the design features of a potential disclosure of origin requirement?

Subject matter

NZIPA does not have a single view on the subject matter to be included. However, we do consider that, for certainty, a definition of the subject matter for which a disclosure must be made should be made explicit. Failure to do could result in an increase in costs to patent applicants and the Intellectual Property Office where it is uncertain as to whether disclosure of origin is required.

With regard to the inclusion of “derivatives”, on the one hand we note that various valuable products such as mānuka honey and totarol likely fall within the meaning of derivatives, as they do not contain functional units of heredity (although it is possible that these particular examples also take advantage of traditional knowledge). On the other hand the isolation and characterisation of derivatives may be a step removed from the organism itself.

Trigger

It is important that the trigger is based on the invention as claimed. A specification may refer to a number of organisms by way of background, by way of comparison, or by way of the specification disclosing multiple inventions, only one of which is claimed. It should only be necessary to disclose the origin of a species for which a monopoly is claimed. In this regard we note that it is the claimed invention which will be the subject of the enquiry by the PMAC. Requiring a disclosure of origin for any species utilised in the specification would place an undue burden on the inventor/applicant without achieving the first objective mentioned (although it may assist in the second objective).

The above may further be relevant to the specific trigger, although NZIPA does not have a particular preference for a trigger. We do, however, consider that a different trigger for genetic resources and traditional knowledge could be appropriate. This is on the grounds that if an invention is informed by traditional knowledge in any way, then this has contributed to the invention.

Sanctions and Remedies

We agree that the sanctions suggested by the Tribunal at 125 result in uncertainty for applicants. We also note that the variable sanctions may also result in a lack of certainty for third parties who may be interested in challenging the disclosure of origin (assuming there is a mechanism for doing this). For example, it may be a disincentive to challenging a disclosure of origin (or lack thereof) if the Commissioner retains the option of not imposing a sanction. In this regard we favour the certainty of the proposals at 128 and 129.

We further agree with the provision that the information disclosed would not be examined for accuracy unless considered relevant to patentability. Examining the accuracy of a disclosure of origin may be a considerable time burden on an examiner in some cases, thus increasing the overall cost. Moreover, if the intention is to have the examiner investigate the origin of a genetic resource or traditional knowledge then the disclosure of origin by the applicant may provide little further value. We further note that the option of providing a declaration the applicant is not aware of the origin is inherently subjective to the applicant and thus not within the purview of an examiner.

Question 7: Are there other design considerations that we should consider?

It is important that the applicant be given time to address any disclosure requirement in New Zealand. At least until there is a unified global requirement for disclosure of origin, then many cases coming through the PCT will not include the necessary disclosure at the filing date. There therefore needs to be an option to allow disclosure of origin while the application is before the Intellectual Property Office of New Zealand.

Question 8: Additional Comments

As noted in relation to question 1, a disclosure of origin regime should be considered as part of a wider discussion that includes the recommendations made by the Waitangi Tribunal in the Wai 262 report. This includes discussion of a bioprospecting regime.

We note that any disclosure of origin regime will only apply to the use of taonga species or mātauranga Māori in cases where a patent is sought. Given that the number of patents filed in

relation to research carried out in New Zealand is low, the disclosure will only be required in a minority of the cases where research is conducted on taonga species or in relation to mātauranga Māori. Thus a disclosure of origin regime in isolation is likely to be an ineffective tool in addressing concerns about the misuse of taonga species or mātauranga Māori.

Yours faithfully

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NZIPA Council Member

