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IP Reserch and Use of IP Case Studies for Educational Purposes: Views and Challenges
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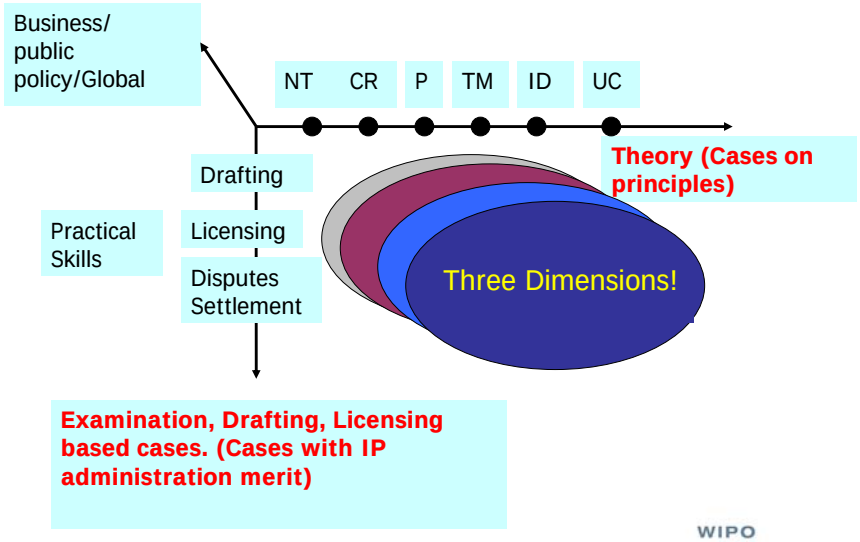
Outline

- Introduction to IP Case Studies
- Commissioned case studies and case studies on Landmark decisions by different courts
- Reinforce the legal, economic, and policy considerations of the rule of IP law
- Illustrate the increasing use of strategic IP management based on collaborative and competitive models.
- Part of Instructional Design- Advanced anchoring of learner knowledge, recollection, and confidence in applying legal principles and creating new knowledge.
- How do we develop Case Studies: Customization of courses by IP Offices using local case studies, Provision by tutors in their discussion forum, Landmark Cases that are internationally recognized.

Introduction: IP Case Studies for various levels of teaching and research



Diamond V Chakrabarty (447 U.S. 303 (1980)

Where as live, human-made micro-organisms, or their parts were generally thought to be outside the scope of patentable subject matter, after the Dimond V. Chakrabarty decision on patenting life forms that are isolated from nature by man with specific function, use and benefit has expanded and many IP Offices have established rules (US, EU, Japan, Australia, India)

- Chakrabarty's claim for process and the bacteria was partly rejected by examiner.
- He appealed to the Court of Customs and Patent Appeals which overturned the case in favour of Chakrabarty- "the fact that micro-organisms are alive is without legal significance for purposes of the patent law"

Diamond V Chakrabarty (447 U.S. 303 (1980)

- Sidney A. Diamond, Commissioner of Patents and Trademarks, appealed to the Supreme Court in light of earlier decisions under under the 1930 and 1970 Plant Variety Protection Act

1. that micro-organisms are “products of nature” and
2. that as living things they are not patentable subject matter.

- Supreme Court held (‘protest’): ‘anything under the sun that is made by man’ to be eligible for patenting. Chakrabarty’s microorganism constitutes a "manufacture" or "composition of matter“- therefore patentable subject matter.

- With 5-to-4 margin the dissenters held that this was a charged social issue and its implications on genetic engineering of all life forms, it should be Congress that should make the decision. However, the majority disagreed and went on to rule on the case.

Diamond V Chakrabarty (447 U.S. 303 (1980)

- Diamond versus Chakrabarty case declared that the "relevant distinction is not between animate and inanimate things but whether living products could be seen as human-made inventions". This decision by the US Supreme Court heralded a new era in which living organisms could be patented (E.g Harvard Oncomouse).

- Directives and Guidelines were established in order to clarify what such decisions meant. (EPO, JPO, and USPTO formed a Trilateral Cooperation project discussing the patentability of genetic inventions, as a result of comparative studies using a hypothetical cases, 1999)

Diamond V Chakrabarty (447 U.S. 303 (1980)

- The recent USPTO guidelines observe that 'an inventor's discovery of a gene can be the basis for a patent on the genetic composition isolated from its natural state and processed through purifying steps that separate the gene from other molecules naturally associated with it.' The guidelines distinguish two illustrative cases:

• a patent application only disclosing the nucleic acid molecular structure for a newly discovered gene, with no utility for the claimed isolated gene – this would not be patentable;

• such a patent application in which the inventor also discloses a use of the purified gene isolated from its natural state – this could be eligible for a patent.

Diamond V Chakrabarty (447 U.S. 303 (1980)

- The European Commission (EC) Biotechnology Directive (98/44/EC) adopted in 1998 aimed to clarify the principles of patent laws in member States of the Community which are applicable to biotechnological inventions with a view to harmonizing patent laws in the EU.

'inventions which are new, which involve an inventive step and which are susceptible of industrial application shall be patentable even if they concern a product consisting of or containing biotechnological material or a process by means of which biotechnological material is produced, processed or used, and biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature.'

- **Commissioned Case Studies in the Academy's Programs: Hoodia Plant**1 (January 2008)

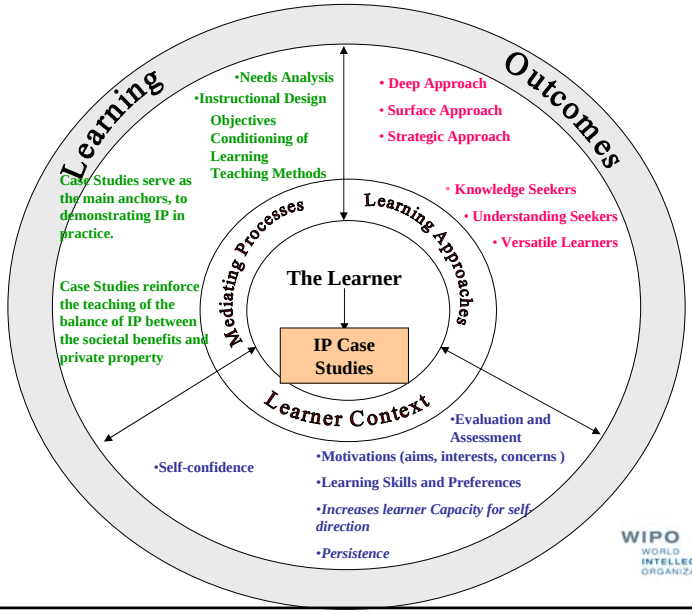
- This concerns a dispute and subsequent partnership between the San people in Sout Africa and pharmaceutical companies in developed countries over the ownership and the right to commercially exploit as well as benefit sharing of the use of Hoodia plant which contains traditional medicinal knowledge and patentable active components. An appetite-suppressant drug developed by pharmaceutical companies are faced with counterfeiting drugs. The case involves several players in different countries and poses a number of questions on IP management, transfer of technology and knowledge between the North and the South and mutually beneficial and sustainable partnerships of all the parties.

- **Commissioned Case Studies in the Academy's Programs:**

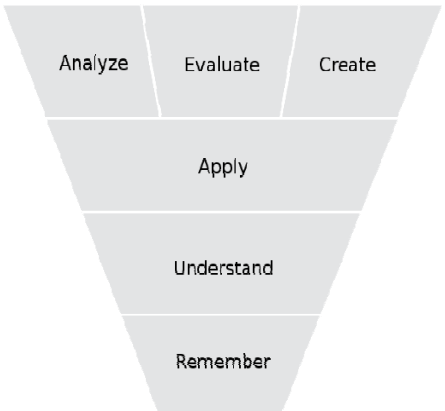
Black Berry Case (Patent)

Ethiopian Government and Starbucks Dispute over Coffee designation names (Trademark and Geographical Design)

Use of IP Case Studies in the Learning Process



Learner Centred Approach- (over 4,000 hrs of course development for each 50 hr of learning)



Case studies are critical in teaching IP and its practical use

- 1. Differentiate — Effective strategic use of IP requires that many different elements of a situation be evaluated at once. When analyzing cases, it is important to isolate legal principles, other critical facts, evaluate whether assumptions are useful or faulty, and to distinguish between good and bad information.

Case studies are critical in teaching IP and its practical use

- 2. Speculate — Being able to imagine different scenarios or contemplate the outcome of a decision can aid the analysis. Case materials often seem to be missing data or the information provided is contradictory. An ability to speculate about details that are unknown or the consequences of an action can be helpful. (A real life situation)

Case studies are critical in teaching IP and its practical use

- 3. Integrate Strategy- involves looking at the big picture and having wider perspective. Integration involves comprehending how all the factors of a case will interact.

  Changes made in policy or national strategy one area affects other parts of the use of IP. Thus, a holistic perspective that integrates the impact of various decisions and environmental influences on all competitors are needed."

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Dess, Lumpkin and Eisner (*Strategic Management: Text and Cases*) note that Case Studies allow:

1. **Keep an open mind.**
2. **Take a stand for what you believe.**
3. **Draw on your personal experience.**
4. **Participate and persuade.**
5. **Be concise and to the point.**
6. **Think out of the box.**
7. **Learn from the insights of others.**
8. **Apply insights from other case analyses.**
9. **Critically analyze your own performance.**
10. **Conduct outside research.**

Challenges:

1. **Lack of access to court decisions in developing countries**
2. **Customizing case studies for development purposes**
3. **Fundamental changes in interpretation of the IP Law**
4. **Learners from civil law and common law practices have different expectations**
5. **Access to publications and publishing by learners in developing countries (Less research in DC)**

Thank You

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