

COMMENTS ON THE WIPO FIRST DRAFT ON EXAMINATION OF  
ISSUES RELATING TO THE INTERRELATION OF ACCESS TO  
GENETIC RESOURCES AND DISCLOSURE REQUIREMENTS IN  
INTELLECTUAL PROPERTY RIGHTS APPLICATIONS  
(WIPO/IP/GR/05/01)

JAPAN

1. In accordance with the decision adopted at the 31st session of the WIPO General Assembly in October 2004, Japan furnished its comments entitled “Japan’s Comments on Draft Guide on Intellectual Property Aspects of Agreements on Access and Equitable Benefits Sharing Relating to Genetic Resources” on December 17, 2004.

2. In regard to the first draft on *Examination of Issues Relating to the Interrelation of Access to Genetic Resources and Disclosure Requirements in Intellectual Property Rights Applications* (WIPO/IP/GR/05/01), this compilation of comments from every member state is very constructive for future discussions of the relevant issues. Taking this opportunity, Japan would like to thank the WIPO secretariat for its efforts to compile the first draft.

3. The following are our comments on the first draft (which utilize and correspond to the numbering of paragraphs in the first draft):

I. Paragraphs 99 to 101: *Concerns about or limits to the development of model provisions*

We assume that a possible explanation of “the need for disclosing the source/country of origin” cannot be found in the disclosure requirements which are required as a prerequisite for granting a patent to an invention under the patent system.

Please add the sentences below as paragraph 102, some of those comments were already submitted from Japan in December 2004.

102. Japan has been making a point that “a patent system provides for two categories of disclosure requirements (i.e. substantive and formative requirements) as a prerequisite for granting patent right for an invention. The necessity to disclose the

source/country of origin cannot be explained by the requirements of a patent system. Unless the need for such disclosure is clearly explained, any administrative sanctions including invalidation of a patent right should not be incorporated into a patent system.”

Specifically, in regard to the substantive requirements, Japan expresses the following point.

Currently, the microorganism deposit system has been able to fully satisfy the application description requirements (including enablement requirements). Therefore, imposing a new obligation to disclose the source/country of origin of genetic resources in patent applications cannot be considered to be such a meaningful approach. For an application for an invention based on a microorganism, which any person skilled in the art can easily access, the applicant is not required to deposit the microorganism. The applicant only has to describe how the invention can be worked, using such a microorganism which is accessible to the public in a manner for any person skilled in the art to be able to work the invention. Information about the source/country of origin of genetic resource cannot be used to satisfy application description requirements (including enablement requirements). Therefore, as for microorganisms made accessible to the public with which the application deals, imposition of a new obligation on applicants to disclose the source/country of origin of genetic resources in their patent applications cannot be considered a meaningful approach in terms of application description requirements (including enablement requirements). Information about the source/country of origin of genetic resources might be unnecessary for judging the level of novelty and inventive step of an invention. Such information cannot be considered to be essential for prior art searches, either. Therefore, there is no reason why such information should be furnished as an additional disclosure requirement from the perspective of the examination process.

In addition, in regard to the formative requirements, Japan raised the following point:

Such entries as applicant names are to be made formative requirements only when such requirements are regarded as reasonable (see Article 62 of the TRIPS Agreement). As regards the disclosure of the source/country of origin of genetic resources, therefore, we are not convinced that such disclosure requirement is regarded as “reasonable procedures and formalities.” Even without such disclosure, there is no problem in carrying out the patent procedure and such lack of disclosure does not make the patent procedure ineffective.

Japan considers that “access to genetic resources and fair/equitable benefit sharing in the context of CBD can be secured without making it an obligation to disclose the source/country of origin of genetic resources in a patent application. Imposition of such an obligation can dampen applicants’ will to create an invention using genetic resources and to obtain a patent for that invention. As a result, benefits deriving from genetic resource-related inventions can be reduced, which, thus does not meet the purposes of CBD.”

II. Paragraph 126: *Possible undesirable or perverse incentives*

In Paragraph 126, Japan submitted comments in December which were quoted, and we would appreciate, in addition to those comments, that the following comments be added. Specifically, following the last sentence of Paragraph 126, we would like to add the following.

Japan also added that “where evidences for a prior informed consent or fair/equitable benefits sharing are to be disclosed in a patent application, contracts can be counted as possible evidence. A contract normally contains much information such as trade secrets, which the applicant does not want others to know. If the contents of a contract are to be made open in a patent application, this will not only simply lead to an increased workload but also involve the risk of disclosing important trade secrets. In the end, therefore, the incentive to carry out R&D activities using genetic resources is substantially reduced.”