

Summary of possible options for model provisions

Concerning the form or status of model provisions, some possible options include:

- (a) model provisions for practical guidance (including for coordinating technical assistance to countries who elect to introduce disclosure requirements and other measures at the national level),
- (b) non-binding recommendations in the form of model provisions (such as more detailed elaboration of the recommendations already present in the Bonn Guidelines),
- (c) model provisions that serve to illustrate the range of options available for national legislation,
- (d) model provisions that serve to illustrate the range of options available for international debate, policy coordination or textual negotiations,
- (e) draft provisions intended to serve as the basis for coordination and negotiation on a future binding legal instrument or provisions within a revised international legal instrument, or
- (f) viewing the form or status of such model provisions as “not relevant”<sup>90</sup>

There may be other options concerning forum and status depending on the purpose of the model provisions. A key concern is that the discussion, development or promulgation of any model provisions should not prejudice the position or interests of Member States on the development of legally binding international law, including prejudice on substantive policy or legal points, but also potential prejudice to the procedural opportunities and the allocation of resources.

Options on the substance of model provisions interact with each of the other elements of the examination which are discussed below (IV.B to IV.E). These options include enhanced use of existing patent law and principles, and new or *sui generis* mechanisms. A number of Member States have stressed that new mechanisms specific for TK and GBMR are required, but other mechanisms are mentioned as well for the sake of completeness.

One way of organizing options would be to use the following categories:

- (i) Nature of mechanism
- (ii) Subject matter of disclosure
- (iii) Required linkage with claimed or patented invention (or substantive trigger)
- (iv) Procedural trigger for disclosure requirement
- (v) Legal principle forming the basis of the requirement
- (vi) Nature of the obligation on the applicant
- (vii) Consequences of failure to comply and incentives to comply
- (viii) Implementing, verifying or monitoring the requirement

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<sup>90</sup> Submission of the United States of America on WIPO/IP/GR/05/1. Comments by the United States of America subsequent to the June 3, 2005 Ad Hoc Meeting amplify the view that “new disclosure requirements would not be effective in achieving their intended objectives of facilitating access to genetic resources and equitable benefit sharing or ensuring transparency.”

The following table has been developed to illustrate some of these options. It is stressed that this means of summarizing information is not intended to interpret, limit or promote any particular mechanism; nor does it reflect on the consistency or otherwise of any approach with existing treaty standards.

## Illustrative table of options for disclosure and related mechanisms\*

Nature of mechanism	Subject matter	Linkage with invention	Legal basis	Nature of obligation	Consequences of failure	Implementation
Acknowledgement of inventorship	Traditional knowledge	Part or entirety of the claimed inventive concept	Entitlement to apply derived from actual inventor(s); Paris Convention obligation to identify inventor	If TK holder contributes to claimed inventive concept, requirement to disclose identity.  Possible requirement to identify TK holder as co-applicant/co-owner, or as sole applicant/owner.	Application may be refused	Office may request further information in the event prima facie doubt exists re identity of inventor  Administrative or judicial proceedings for opposition, revocation or full/partial transfer of patent to TK holder
Declaration of TK as relevant prior art	Traditional knowledge that meets legal criteria for prior art [and that is known to applicant]	Relevant to the patentability of the claimed invention (e.g. novelty and inventiveness/non-obviousness)	Patentability of invention includes novelty and inventive step (or non-obviousness).  Obligation to inform office of known relevant information.	Applicant is obliged to disclose all known prior art relevant to patentability of claimed invention, including traditional knowledge.	'Fraud on the office' or similar offence; sanctions for inequitable behaviour;  Failure to disclose known TK may render patent unenforceable.	Failure to disclose may become apparent during examination or enforcement of patent, or in opposition or revocation proceedings
Definition of prior art	Traditional knowledge	TK explicitly designated as prior art that vitiates novelty and/or non-obviousness	Clarification of existing law of patentable inventions	Invention must be novel and non-obvious	Claims may be narrowed, refused or revoked.	Relevant to examination, opposition or revocation proceedings.
Definition of patentable invention	Traditional knowledge and/or GBMR	Invention cannot consist of existing TK or certain GBMR	Law defining scope of patentable subject matter	Claimed invention must fall within permitted subject matter	Claims may be narrowed, refused or revoked.	Relevant to examination, opposition or revocation proceedings.

\* This table is to illustrate mechanisms that have been discussed or proposed. It is not intended to suggest, interpret or promote any particular mechanism, nor to limit choices available. It does not imply that any specific choice is consistent or otherwise with treaty obligations.  
Sources: Member State submissions and responses to WIPO/GRTKF/IC/Q.3, Technical Study, and measures in Part II above.

Nature of mechanism	Subject matter	Linkage with invention	Legal basis	Nature of obligation	Consequences of failure	Implementation
Specific disclosure of TK or GBMR, or related ABS-compliance measure	<p>(i) TK (ii) TK associated with GR (iii) genetic resources (iv) biological resources and/or (v) biological material</p> <p>Where (i) source/origin of TK/GR is already known to applicant; or (ii) applicant can determine its source/origin through reasonable effort; or (iii) TK/GR is not subject to any such qualification]</p> <p>TK/GR may be in public domain [or may be hitherto undisclosed]</p>	<p>Invention (i) directly based on TK/GBMR (ii) [essentially] derived from TK or GBMR (iii) uses biological material (iv) makes immediate use of GR (depends on its specific properties) (v) resulted from research using GBMR or TK, which were - essential/necessary - incidental - necessary</p> <p>to deriving the invention (vi) partly or entirely comprises TK/GBMR</p> <p>or there is an obligation or responsibility under ABS law, regulation, permit, licence or agreement relating to TK or GBMR that covers  (i) the research or related activities that lead to the invention, or (ii) the attainment of the invention, or (iii) the act of filing for patent on the invention.</p>	<p>Compliance with ABS laws in the country of origin, with the terms of an ABS licence or permit, or with specific contractual obligations to provider of GBMR or TK.</p> <p>Ownership rights established on the basis of an ABS law or specific ABS agreement.</p> <p>Expanded application of patent law disclosure principles.</p> <p>Principles governing equitable behaviour and the equitable basis of an entitlement to apply for, be granted or enforce a patent.</p>	<p>Patent applicant is obliged to: (i) disclose the origin or source of the GBMR or TK (ii) provide a declaration, evidence or certification of prior informed consent relating to access (iii) provide a declaration, evidence or certification of an agreement to share benefits, or of actual sharing of benefits and/or (iv) ensure TK or GMBR used in invention are legitimately sources (v) ensure applicant has derived proper title from the inventor and third party interests (e.g. provider of TK or GBMR) are reflected in identification of applicant.</p>	<p>(i) Application considered incomplete upon filing without required declaration or documentation (ii) Application rejected during formality examination (with/without procedure for rectifying) (iii) Application rejected during substantive examination (with/without procedure for rectifying) (iv) Patent not granted or sealed until/unless required material is provided (v) Patent opposed or revoked if required material is lacking. (vi) Patent ownership transferred in whole/in part to beneficiary of ABS law or agreement. (vii) Patent is not enforceable on basis of equity.</p>	<p>(i) routine step during formal/substantive examination (ii) grounds for opposition, revocation, or unenforceability of patent (iii) basis for claim of assignment or transfer of patent in whole or part to ABS beneficiary.</p>

Nature of mechanism	Subject matter	Linkage with invention	Legal basis	Nature of obligation	Consequences of failure	Implementation
Obligation outside patent law to disclose details of access/use, or to cede/share ownership	GBMR and/or TK provided under an ABS or related law, or within the terms of a specific ABS agreement.	Defined by obligations under the ABS or related law, or the specific ABS agreement.	ABS or related law in country of origin Contract obligation in country of origin, to be recognized in patenting country.	Obligation to disclose TK or GBMR Obligation to include ABS beneficiary as applicant or co-applicant	Breach of obligation under law or contract Transfer of ownership in whole or part.	Counterclaim during patent enforcement Challenge by interested party
Deposit of microorganisms or biological material	Microorganisms, or biological material	Relevant to patent procedure (e.g. invention cannot be fully disclosed or enabled without access to microorganism or biological material)	Obligation to disclose invention under basic patent law principles cannot be fulfilled without deposit of actual sample. Budapest Treaty arrangements for international recognition of deposit.	Disclosure of actual sample; Provision of certification regarding deposit to patent authorities.	Patent may be found inadequately disclosed, resulting in	Certification provided during patent procedure.