



REPUBLIC OF SOUTH AFRICA



Regional Seminar for Certain African Countries on the Implementation and Use of Several Patent-Related Flexibilities

***Topic 6: Flexibilities Related to the Definition of Patentable
Subject Matter***

**Durban, South Africa
January 29 to 31, 2013**



**WTO-DTI Regional Seminar for Certain African
Countries on the Implementation and Use of
Several Patent-Related Flexibilities
*Durban, South Africa, 29-31 January 2013***

**Flexibilities Related to the Definition of
Patentable Inventions – the TRIPS
Agreement**

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Outline

- The WTO
- The TRIPS (Trade-Related Aspects of Intellectual Property Rights)
- Balance of interests
 - Negotiations, «acquis»
 - Implementation
 - Future and challenges



The WTO in a nutshell

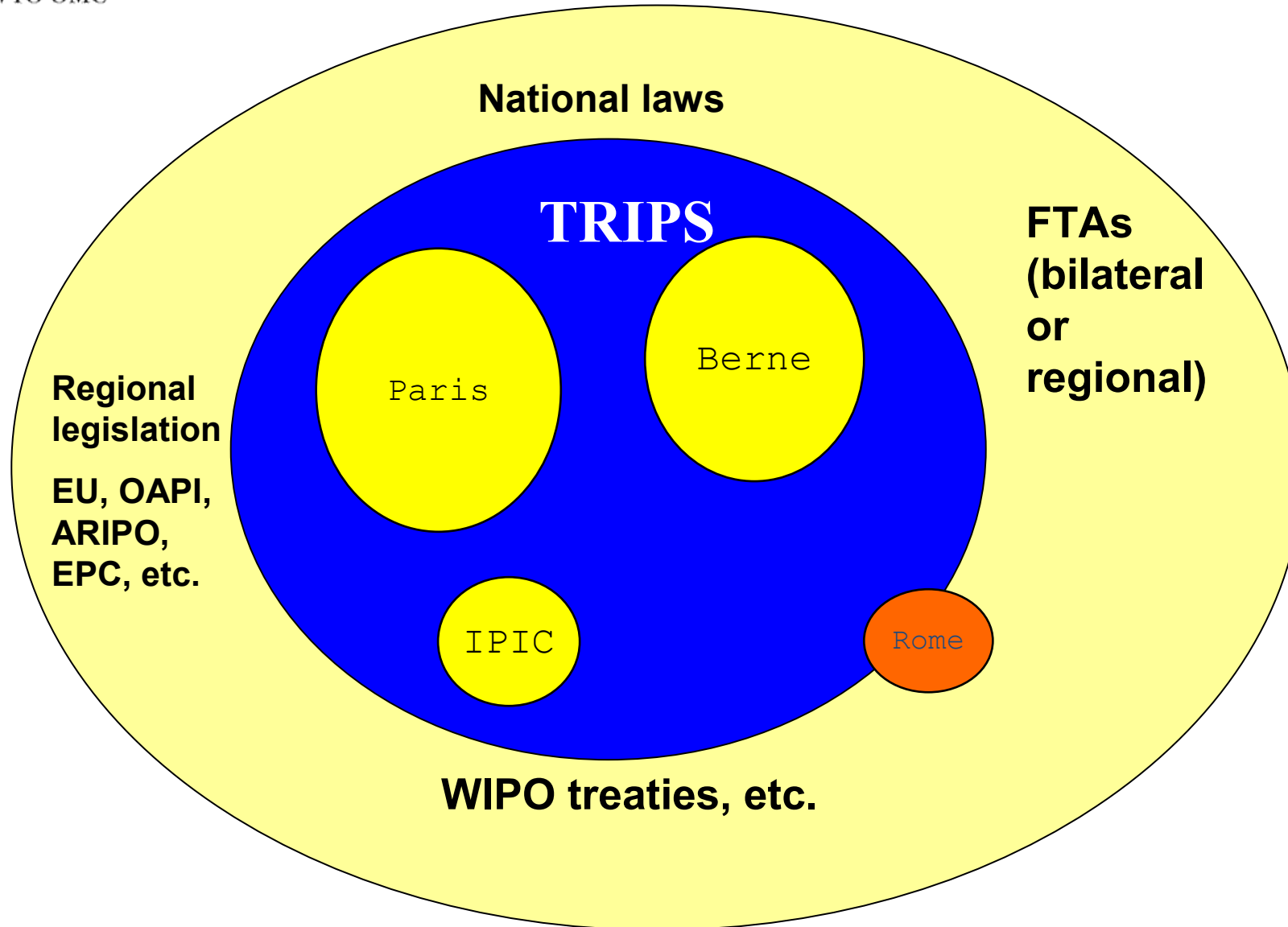
- 158 Members, last being Laos. More than 96 of trade in goods and services (together)
- Multidisciplinary → complex mechanism of negotiations, trade-offs across the board
- Member-driven methodology, consensus rule.
- “Single undertaking”
 - “nothing is agreed until everything is agreed”
 - Pluri-lateral avenue, e.g. Government Procurement Agreement
- Dispute settlement system and sanctions



TRIPS – balance of interests

- Paris, Berne Conventions. Balance of interests already carefully negotiated. Incorporation of WIPO's basic conventions
- TRIPS: Plus certain elements or re-affirmations or clarifications
- Balance of interests → negotiation of flexibilities, e.g. exhaustion of rights, patentability
- “Flexibilities” and “constructive ambiguity”

The IP planet



Minimum level of protection!

- n Subject to transitional arrangements for certain Members
- n Freedom to go beyond this level: national laws (CH, US, Japan, Korea, etc.), regional laws (EU), bilateral and regional agreements, e.g. Free Trade Agreements, WIPO treaties
- n "Shall" provisions and "may" provisions + obligations tempered ("shall have the authority")
- n **WTO Dispute Settlement System**



TRIPS – Invention

- NO definition
- See, however, national / regional legislation
 - OAPI: accord de Bangui, annexe I, article 1^{er}
 - ARIPO: part III, article 7
 - etc.



Techniques of defining: “patentable inventions”

Patentable inventions ; TRIPS «patentability» and exclusions from patentability

- Non-discrimination between fields of technology (in principle: see following slides or other sessions, e.g. on compulsory licenses): Art.27.1
- Product and process inventions: mandatory (Art. 27.1)



Techniques of defining: “patentable inventions”

- Requirements for an invention to be patentable (Art. 27.1):
 - Novelty, inventive activity and industrial application
 - + [Disclosure under Article 29]
- Exclusions from patentability:
 - An invention fulfills the three conditions but it can be not patented (n.b.: simplified summary of Art. 27.2):
 - Ordre public
 - Morality
 - Damage to human, animal and health, environment



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Techniques of defining: “patentable inventions”

- A Member may exclude
 - a whole category of inventions for certain considerations; methods (diagnostic, therapeutic, and surgical) for human and animals (art. 27.3(a))
- A Member may exclude:
 - Plants and animals (Art.27.3(b))
 - Essentially biological processes for production of micro-organisms (Art. 27.3(b))
- Members shall not exclude from patentability
 - Micro-organisms
 - Non-biological and microbiological processes (Art.27.3(b))



Techniques of defining: “patentable inventions”

- Members shall protect plant varieties
 - By patents or
 - By an effective *sui generis* system or
 - By any combination thereof (Art.27.3(b))
- Article 27.3.(b) shall be reviewed in 1999: different interpretations of “review”
 - Review of implementation
 - Review with a view to revision
- Traditional knowledge and farmers’ rights not addressed in TRIPS → flexibility



“Patentable inventions” and related issues and work

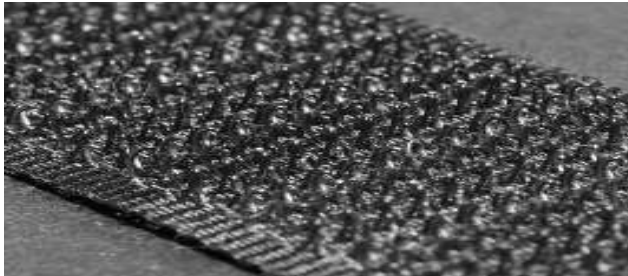
- WTO’s Work on issues of biotechnology/TRIPS-CBD/traditional knowledge (“triplets”), e.g in.
- TRIPS Council, regular session
- Declaration of Doha (WT/MIN(01)/DEC/1) and Declaration of Hong Kong (WT/MIN(05)/DEC)
- Director-General’s consultations. Focused on issues of disclosure in patent applications regarding genetic resources and related traditional knowledge.
- Grant of erroneous patents (e.g. lacking novelty or inventive activity): neem tree, turmeric
- The hoodia gordonia case



What relation between
this and a dog ?

Burrs of the
thistle (distel)

VELCRO



Discovery and invention

Sept. 13, 1955

G. DE MESTRAL

2,717,437

VELVET TYPE FABRIC AND METHOD OF PRODUCING SAME

Filed Oct. 15, 1952



Fig. 1

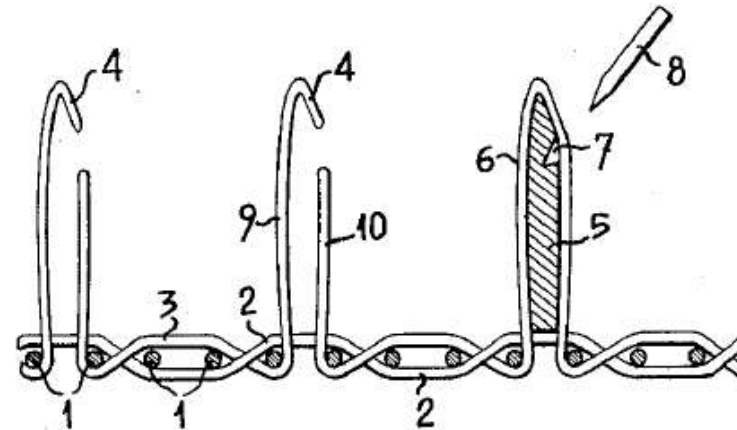


Fig. 2





Remarks

- Flexibilities in defining patentable inventions
- “Common sense” use of IP, of rights and obligations, of flexibilities (e.g. patentable inventions), otherwise “Pendulum effects”, which is not in the benefit of any party
- Sound and reasonable use of IP → Foreign direct investment (even if it is one pre-requisite only among others).
- Africa: continent of hopes and possibilities (natural resources → inventive activities → patentable inventions)



Consult our website

www.wto.org

Other questions to:

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