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*
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

National laws

TRIPS

FTAs (bilateral or regional)

Regional legislation
EU, OAPI, ARIPO, EPC, etc.

WIPO treaties, etc.

Paris

Berne

IPIC

Rome

National laws

FTAs (bilateral or regional)

Regional legislation
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WIPO treaties, etc.

Paris

Berne

IPIC

Rome
TRIPS: general

Minimum level of protection!

- Subject to transitional arrangements for certain Members

- 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

- "Shall" provisions and "may" provisions + obligations tempered ("shall have the authority")

- WTO Dispute Settlement System
TRIPS – Invention

• NO definition

• See, however, national / regional legislation
  – OAPI: accord de Bangui, annexe I, article 1er
  – 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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• 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 microorganisms (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

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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