WIPO and the WTO are in the process of establishing international rules for the protection of biodiversity. One of the key questions under consideration is whether or not to create a *sui generis* system to establish the norms and rules for protection. A “*sui generis*” system simply means “one that is of its own kind”. In this case it refers to the creation of a new national law or the establishment of international norms that would afford protection to intellectual property dealing with genetic resources -or biodiversity - and the biotechnology that might result. It also refers to a law that might protect creations, inventions, models, drawings, designs, innovations contained in images, figures, symbols, petroglyphs, art, music, history and other traditional artistic expressions.

“Traditional Knowledge” (TK) refers to a wide range of knowledge and is not limited to a particular field – it covers knowledge about medical treatments, agricultural methods, the threading of beads in a particular way, etc. The reason it is set apart is that it is associated with a particular indigenous community. The knowledge is created, preserved, shared and protected within the community hence the term “traditional”, i.e. passed from generation to generation. The knowledge is often that which has been accumulated by societies in the course of long experience in a particular location and is very often important to the identity of a community.

The diversity of the subject matter is one of the reasons why a *sui generis* system is not advisable, but there are other reasons as well.

**Protections Afforded Under Existing IP Legislation**

WIPO’s Intergovernmental Committee on Intellectual Property and Genetic Resources, *Traditional Knowledge and Folklore* collected information from 14 member countries to establish how TK in all its forms had been afforded protection under existing national IP legislation.

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1 Black’s Law Dictionary
It is clear from the information gathered that existing IP laws, including patent acts, copyright acts, trademark acts, trade secret protections and others all afford the necessary protection for TK in the absence of specific legislation. Where existing IP laws fail, reliance can be placed on the common law. Also, benefit-sharing agreements can be entered into.

Some examples of the protections afforded under existing IP laws are as follows:

**Australia** - In *Foster v Mountford* 1976 the Court relied on the common law doctrine of confidential information to prevent the publication of a book which contained culturally sensitive information.

In *Milpurruru v Indofurn Pty Ltd* 1995 damages were awarded for infringement of copyright. In this case the court recognized the concepts of “cultural harm” and “aggregated damages”.

One example illustrates the use of the common law doctrines of confidential information and breach of confidence the other illustrates how a court can find a community leader in breach of his fiduciary duty to his community.

**Canada** – The court relied on the Copyright Act to protect tradition-based creations. In another case, the Trademark Act and Trade Secret Protection were relied upon.

**France** – Geographical indications and appellations of origin are protected by decree. The consumer code further imposes fraud sanctions when deception has been used to sell a good as belonging to a community or arising from TK.

**Kazakhstan** – Patent Law, the law on trademarks, service marks and Appellations of Origin and industrial design laws have been used to protect TK.

**Portugal** – The Industrial Property Code of 1995 protects trade, collective and certification marks, appellations of origin and geographical indications.

**Vietnam** – A traditional preparation of medicinal plants used to assist in stopping drug addiction was patented while *Truong Sun Balsam*, a traditional balm, was granted a trademark and a fish soy sauce was protected under the appellations of origin laws.

Where countries have found their existing IP laws to be lacking in this area, they have, and New Zealand is a very good example of this, instead of creating a new law, amended their existing laws to provide for advisory committees to establish whether or not, for example, a particular trademark might be offensive to any one indigenous group. The Government has established and funded the development of a “Maori Made Mark” which marks the product as authentic, belonging to an indigenous group and of good quality. It also established the Royal Commission on Genetic Modification, which recommended
that a Maori Consultative Committee develop procedures for assessing patent applications, and facilitates consultation with the Maori community where appropriate.

The New Zealand Government is considering amending its Patent Act to create certain exceptions to patentability where genetic resources have been used without a benefit-sharing arrangement having been entered into.

Further, the IP office has developed guidelines for patent examiners concerning patent applications of significance to the Maori people, relating to indigenous fauna and flora, Maori groups or individuals, indigenous micro-organisms and indigenous material derived from an inorganic source but where the research resulted from TK.

Where countries have considered a *sui generis* system or indeed have already put new legislation in place, WIPO asked how the law:

1) Defines/Identifies the policy objective of the protection
2) Identifies the subject matter
3) Identifies the criteria the subject matter must meet as a condition for protection
4) Identifies the owner
5) Defines the rights conferred on the owner and the exceptions
6) Establishes the procedures and formalities for acquisition and maintenance of the rights conferred
7) Enforces the rights i.e. effectively permits action where there is an infringement of the rights conferred
8) Defines how the rights are lost or expire
9) Interacts with, overlaps or complements existing IP standards.

**Problems Inherent in a Sui Generis System**

The answers to the questions posed by the WIPO Committee are instructive to the problems endemic to a *sui generis* system.

Problems include the diversity of the subject matter, identifying the owner of the rights, procedures and formalities for the acquisition and maintenance of the rights conferred, and time limits conferred on the right.

- Problems in identifying the owner of the right are obvious and go to the idea of community and shared knowledge
- Many communities might have problems meeting formal requirements to acquire and maintain rights.
- As Panama states in its answer to the WIPO Committee, in a strict sense TK is not a temporary concept. That country’s *sui generis* legislation makes a clear distinction between the TK and an invention stemming from its use. Therefore what is in the public domain is the invention and the patent is granted or expires
on that invention not the traditional knowledge. But TK and the products invention stemming from it are sometimes indistinguishable, thus this neat distinction does not always apply.

• The answers to the last question were instructive, even though it was necessary to set out the policy considerations around creating a new law that could specifically deal with TK, there was considerable overlap with existing IP laws. This leads to confusion for litigants, uncertainty in the law and if it is possible to rely on the provisions of an existing law, it is undesirable and unnecessary to create another law.

• Insofar as a sui generis system might add constraints to existing laws, for example, the Patent law of a country, this might make the law inconsistent with International Agreements such as TRIPS.

• Where breach of a contract will result in similar sanctions being imposed by a court that might be prescribed by a sui generis law, why create the law?

Independent Indicators of Fairness and Equity?

An example of an enforcement clause is Article 24 of Brazil’s sui generis law:

“The benefits resulting from the economic development of the product or process created from the genetic heritage sample and the related TK, obtained by a national institution or one which has its headquarters abroad, shall be shared in a fair and equitable manner, between contracting parties in accordance with the relevant regulations and legislation.”

Where there is concern that there might be disparity between contracting parties, which will be the situation in most cases, Brazil’s sui generis law correctly tries to provide independent indicators for fairness and equity. These indicators include:

• A division of profits
• Payment of royalties
• Technology access and transfer
• Unrestricted licensing of products or services
• Training of human resources

However, even these are notional indicators of fairness and equity only as each circumstance will vary. This is one of the reasons why a standard agreement in multilateral treaties is not advisable. These treaties should deal only with policy considerations and commitments.

An international treaty such as that discussed by the Megadiverse Countries – Brazil, China, Columbia, Costa Rica, Ecuador, India, Indonesia, Kenya, Mexico, Peru, South
Africa and Venezuela - at Cancun, will set out the policy for the conservation and sustainable use of genetic resources and commit to, amongst other things, benefit sharing.

These initiatives focus on one aspect of TK and commit to creating a regulatory framework for the governance of the use of biodiversity. They do not seek to amend international norms relating to, for example patents.

**Benefit Sharing Agreements – An Example**

The world’s oldest indigenous culture, the San tribe, lives on the South Africa/ Botswana border and in some parts of Namibia. The Khomani San of South Africa have used the Hoodia plant (or Xhoba) to quell hunger – useful when hunting for several days – for thousands of years. In 1963 the SA CSIR started tests on the Hoodia plant and eventually isolated its proactive compound, P57. Later CSIR licensed P57 to Phytopharm, a British pharmaceutical company which then sub-licensed it to Pfizer. The San Tribe’s lawyer, Richard Chennels, contacted the CSIR which acknowledged its 1998 biopolicy, that the owners of TK will benefit from the commercialization of research findings.

In February 2003, the CSIR and the Khomani San tribe entered into a Memorandum of Understanding which will, in the event that the product of the Hoodia plant is marketed in 2007 as predicted, result in several million Rands a year to be shared between the San tribes of Southern Africa.

Many companies have entered into similar agreements including Merck, NCI, Medichem Research and GSK.

Essential clauses in a benefit sharing agreement (one which deals with the commercial development and exploitation of a plant for example) include the following:

1. The Parties – both the individual owner of the TK or the community which owns the TK (represented by a representative of the community) and the institution/company contracting with the community;
2. Authority to bind the parties;
3. Purpose of the research and/or intended final product;
4. Elements and quantification of the samples;
5. The community/scientific name for the sample and a list of uses that the community has used the plant for i.e. the intellectual property;
6. The method for fair and equitable sharing of benefits;
7. Rights and obligations of the contracting parties;
8. Termination;
9. Provision for what will occur should the research not result into a saleable product;
10. Penalties;
11. Jurisdiction – in the country where the TK is found and the indigenous community located. This clause is vital because the community must avoid litigating, at huge expense, in a foreign court.
12. Possible arbitration clause to international arbitration body.

Summary

A *sui generis* system incorporating all TK is inadvisable. Criticisms include:

- Subject matter too diverse.
- Why create a new law when existing laws and norms suffice?
- Difficulty with establishing owner of right – also exists with benefit sharing agreements.
- Difficulties with applying for right and maintaining it.
- Difficult to place time limit on TK.
- Constraints placed on existing laws that might make them non-compliant with International Agreements.

It is important to create independent indicators to protect biodiversity of communities but there are many ways to do this. On the international level, declarations, treaties and the Convention of Biological Diversity and at the national level through consultative committees, watchdog bodies, amendments to existing legislation and best practice guidelines.