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Towards an International Framework for the Protection of Traditional Knowledge

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TOWARDS AN INTERNATIONAL FRAMEWORK FOR THE PROTECTION OF TRADITIONAL KNOWLEDGE

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I. Background

At the International Seminar on Systems for the Protection of Traditional Knowledge, organized by UNCTAD and the Government of India, held in New Delhi in April 2002, participants considered *inter alia* how evolving national systems for the protection of traditional knowledge could be supported or augmented by international measures adopted at the regional or global level.¹ Countries supportive of traditional knowledge protection may enact provisions designed to prevent misappropriation of traditional knowledge, but such action will not be effective beyond those countries' borders unless an international system is put in place. For example, even if country A amends its patent law to enable denial of a patent to be based upon the anticipation of the claimed invention by available local (oral) traditional knowledge, those provisions will not prevent the privatization of that knowledge by the grant of patents in Country B unless (i) Country B has similar provisions protecting traditional knowledge, and/or (b) Country B is aware of, and recognizes, the traditional knowledge claim made by the local community in Country A.

Thus, if the objectives of proponents of traditional knowledge protection, including those stated in the Convention on Biological Diversity, are to be realized international initiatives are essential. The need for solutions on the international level has been discussed in a number of fora. Yet, the effective protection of the holders of traditional knowledge requires that these discussions move in some way toward implementation of working systems of protection.

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¹ For background on many of the pertinent policy discussions, *see, e.g.*, Convention on Biological Diversity, Working Group on the Implementation of Article 8(j) and Related Provisions; Council for TRIPS, Review of Article 27(3)(b), and Implementation of the Doha Agenda; UNCTAD Seminar on Systems for the Protection of Traditional Knowledge (New Delhi, April 2002); WIPO Intergovernmental Committee on Intellectual Property Rights, Genetic Resources and Intellectual Property.

It is likely that any initial step toward such implementation will not, in itself, accord holders of traditional knowledge the levels (or perhaps types) of protection that they would regard as ideal. But putting in place a *framework* or *structure* for translating national forms of protection into an international system on an ongoing basis would reassure holders of traditional knowledge that incremental progress is worth pursuing, enabling agreement to be reached on basic issues while discussion continues on contested matters. Such a framework, even if based initially on minimal substantive levels of protection, would allow initial standards to be augmented or developed in a fashion that parallels, replicates and perhaps balances, the system for the protection of forms of intellectual property currently recognized at the international level.

Moreover, if the discussions that have been taking place are to reach fruition in the near future, it might be helpful to develop a system that bears structural resemblance to the system of international intellectual property law dear to the hearts of many developed countries. This is not, of course, to preclude advocates of traditional knowledge protection from considering a system that is wholly new, nor to feel captive to traditional notions of property rights. Rather, in advocating a particular structure of protection for traditional knowledge, it will be useful to know to what extent proponents must articulate the need for a completely new paradigm, or whether instead they can point to historical antecedents in the intellectual property system already favored by otherwise recalcitrant countries. Indeed, this comparative analysis might also suggest models that are more or less likely to be acceptable. Finally, this comparison is important because many of the proposals to protect traditional knowledge necessarily affect the intellectual property system, which otherwise might privatize the resources with respect to which traditional knowledge rightholders wish to assert claims.

II. Scope of this Paper

This paper explores options for the possible reciprocal recognition, through an international treaty, of sui generis regimes for the protection of traditional knowledge adopted at the national level. It thus focuses on framework, or structural, issues, rather than on the substantive elements of sui generis systems for the protection of traditional knowledge. But the two questions cannot wholly be divorced. That is, the framework of any international system will depend in part upon the substantive forms of protection that are accorded. Likewise, the forms of protection that are adopted might reflect the international framework chosen. Thus, although the paper focuses on structural issues, I have noted points where the substantive protections accorded might affect the international framework chosen,² and thus where interested parties developing substantive norms might wish to have particular regard to questions of structural implementation.

It is of course important, especially given the prominence of the debate in the TRIPS Council regarding the interpretation and possible revision of TRIPS (whether Article 27(3)(b) or

²See, e.g., *infra* text accompanying notes 26-27 (discussing possibility of defining the range of traditional knowledge to be protected).

Article 29), that the TRIPS compatibility of any proposals be considered. The TRIPS-compatibility of the principal proposal considered in this paper has already been exhaustively and comprehensively considered by other scholars of international intellectual property law,³ and various governments have advanced positions on that topic in the context of ongoing TRIPS debates. In this paper, I will not repeat that analysis, other than summarily where relevant to my suggestions.⁴ Instead, I will focus on the different components of any international structure that countries might wish to pursue.

As noted above, the following commentary draws in large part (for the several reasons mentioned and with the caveats outlined above) on models found in international intellectual property law. The primary models from which I have drawn inspiration in this paper are models of trademark law and the law of geographical indications. Yet, the principal proposal that I will analyze most directly affects patent rights. (Traditional knowledge protection obviously must also affect the future development of national trademark law; but the proposal discussed below is in large part aimed at the inappropriate privatization that occurs through the patent system). This is a conscious decision. The proposal that is analyzed below is essentially an attempt to derogate from the principle of territoriality that pervades and is at the root of, international intellectual property law. That principle is most resolutely advocated and enforced in the patent context. In contrast, international trademark (and geographical indications) law – while firmly based upon the same general principle – has in several respects developed exceptions to that principle. These exceptions might provide the source for a range of options that countries might consider as the model for a system of traditional knowledge protection that likewise moves away from the principle of territoriality. Moreover, an historical analysis of where resistance to such developments has been most acute in the field of trademark and geographical indications might provide guidance to those seeking to construct an approach to traditional knowledge that encounters less resistance.

III. A Preliminary Word about Diversity of Models and Arguments of Premature Internationalization

The principal challenge facing the development of an international system for the protection of traditional knowledge is that, even in those countries that protect traditional knowledge, similar results are achieved through a wide variety of devices. These devices are each thought appropriately to further the same general goals consistent with the different life patterns (and different types of traditional knowledge) in different communities around the

³See, e.g., Cynthia M. Ho, *Disclosure of Origin and Prior Informed Consent for Applications of Intellectual Property Rights Based on Genetic Resources: A Technical Study of Implementation Issues*, Doc. No. UNEP/CBD/WG-ABS/2/INF/2 (July 2003).

⁴See, e.g., *infra* text accompanying notes ___-___ (noting dispute regarding the effect of Article 27 of TRIPS on disclosure proposal).

world.⁵ The challenge therefore is to construct an international system where there is little consensus on *the* perfect system, but general agreement (among countries advocating protection) on the overall goal.

This diversity of approach at the national level is often cited by opponents of traditional knowledge protection as one reason why the development of an international system is premature. In most cases, the international system codifies norms that are generally agreed-upon at the national level, at least among developed countries. Yet, it is not unheard of that international intellectual property norms are articulated before there is consensus on the national level. The most recent example is the WIPO Copyright Treaty,⁶ where provisions addressing anti-circumvention of technological protection measures were adopted before many countries had given any thought to the issue at the national level.⁷

Moreover, the existence of disparate approaches, fueled by similar fundamental sentiments, really goes to the *form* of the international system. If principled compromise or reconciliation of the different national approaches were possible and/or desirable, then efforts might best be directed at the articulation of detailed harmonized standards for protection. But if, instead, the goal is to allow different countries to adhere to their local approaches, the articulation of substantive norms is likely to occur at a very general level with an admonition that each member state had latitude as to the means by which it implemented its obligations. Again, this approach is consistent with the existing international intellectual property system. Article 1(1) of TRIPS recognizes this general principle, and where a particular difference over means of likely implementation was discernable in advance during the negotiations, drafters of TRIPS made specific reference to the options.⁸

Indeed, the choice between detailed international standards and an international system with generally-stated minimum standards (backed up by general obligations such as national

⁵See *Protecting Traditional Knowledge – The International Dimension*, Paper Submitted by the Department of Commerce, Government of India, (New Delhi, April 2002) at 4 (“Each country’s legislation is developed based on the specific requirements of individual country and its communities, their lifestyles and types of traditional knowledge and the way it is being protected or held by the traditional communities and the way it is being accessed for modern scientific purposes. . . . The need is for a system which recognizes such diversity.”)

⁶WIPO Copyright Treaty, WIPO Doc. CRNR/DC/94 (Dec. 20, 1996) 36 I.L.M. 65.

⁷See *id.* art 11.

⁸See, e.g., Agreement on Trade-related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods, art. 1, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments--Results of the Uruguay Round, 33 I.L.M. 81, 93 (1994) [hereinafter TRIPS Agreement], art. 23(1), n.4.

treatment) was precisely the choice that faced the drafters of the Berne Convention.⁹ They chose the latter. Thus, if the goal of countries negotiating traditional knowledge protection is to design a system that accommodates a myriad of ways of reaching the same goal, the development of leading components of the international intellectual property system stands in historical support of (rather than in opposition to) such efforts.

IV. A Specific Proposal to Consider: Some Structural Choices to Debate

At the New Delhi meeting and elsewhere, the Indian Government made a specific proposal that national patent laws should, *as a matter of international law*, be required to contain the following provision:

- (1) patent applicants must disclose the source of knowledge and biological material, and
- (2) give an undertaking that the “prevalent laws and practices of the country of origin have been fully respected.”¹⁰

This is the proposal that is the focus of the discussion in this paper; its implementation would require the construction of an international framework for the protection of traditional knowledge.¹¹ But the observations herein made concerning the Indian government proposal

⁹*See generally* SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986* (1987).

¹⁰*See Protecting Traditional Knowledge – The International Dimension*, Paper Submitted by the Department of Commerce, Government of India ¶ 22 (New Delhi, April 2002).

¹¹A fuller analysis of all aspects of an international system for the protection of traditional knowledge would address a fuller range of issues, all of which would be necessary to ensure the broadest possible protection. Most importantly, mechanisms granting protection can take two forms, though the emphasis between one or the other may depend in large part upon the favored rationale for traditional knowledge protection. One mechanism for protecting traditional knowledge might be intended to *prevent* privatization of the resources, by limiting or conditioning the ability of one person to obtain intellectual property rights in the biological resource or associated traditional knowledge. The other mechanism involves the affirmative grant of property rights in traditional knowledge to the appropriate groups of rightholders, for exploitation by them in accordance with local (or legally defined, but locally-influenced) norms. This bifurcation mimics very closely the rights that attach to geographical indications. Thus, in a fuller system of protection, essential components might include international agreements: (1) mandating affirmative protection for traditional knowledge in national law; (2) mandating that national systems allow the curtailment of intellectual property rights that conflict with traditional knowledge rights; (3) establishing informational mechanisms to provide notice of claims, both to

should also be of broader application.

The first part of the Indian government proposal (the disclosure obligation) has importance in and of itself, separate and apart from the country-of-origin compliance undertaking (*and* the effect given thereto). Importantly, it would provide information that enabled ongoing assessment to be made of whether countries are complying with their obligations under Article 8(j) of the Convention on Biological Diversity (CBD):

- (i) to ensure that the wider application of traditional knowledge occur with the “approval and involvement of the holders of such knowledge”;
- (ii) to “encourage the equitable sharing of benefits arising from the utilization of” traditional knowledge.

Requiring the disclosure of the country of origin of genetic resources and related traditional knowledge in patent applications would also incidentally assist in identifying and demarcating traditional knowledge. One of the substantive critiques often leveled at proposals for the protection of traditional knowledge is the inability to identify knowledge in which rights are claimed.¹²

The disclosure part of this proposal is already the subject of discussion in a number of fora. It implicates at least two questions. First, does the TRIPS Agreement or any other international agreement (such as the Patent Law Treaty) set ceilings on the type of requirements or conditions to which a patent application can be subjected? This is simply a matter for interpretation of existing international obligations. As noted above, this question has already been addressed by scholars of international intellectual property law¹³ and is the subject of

facilitate limitations on intellectual property rights and to facilitate determinations of ownership and benefit-sharing with respect to traditional knowledge; and (4) constructing a system for recognizing and enforcing determinations regarding traditional knowledge made in so-called “countries of origin.” The need for this last component depends in large part upon the extent to which the first and second components are achieved.

¹²Additional informational components, also aimed at furthering the notice component that is thought important in a number of intellectual property regimes, might include registers of asserted claims of traditional knowledge (regardless of whether related to the subject of a filed patent application). If the argument is to be made to developed countries that patentees not be entitled to obtain patents because of prior traditional knowledge, that argument will be stronger if the patentees are on constructive notice of the claims of traditional knowledge right-holders. That is to say, if a claim is asserted on a register to which patentees have access, the patentees can be deemed to have been aware of such claims, rendering claims of inequity less persuasive.

¹³See Ho, *supra* note 3.

contested views among nations in the TRIPS Council.¹⁴ Without repeating that analysis in detail, the debate would likely center on whether the principle of nondiscrimination in Article 27 of TRIPS applied across-the-board to all aspects of patent law (including disclosure requirements)¹⁵ and whether Article 29, which sets out disclosure requirements that *must* and *may* be imposed upon a patent applicant implicitly precludes any other disclosure requirements from being imposed.¹⁶

Ordinarily, most international industrial property agreements set limits to the types of conditions that may be imposed rather than articulating affirmative disclosure or other obligations that must be imposed on applicants for rights. Thus, the Indian proposal can conceptually be aligned with broader efforts to create substantive maxima¹⁷ as well as substantive minima in international intellectual property treaties. That is, procedural treaties such as the Trademark Law Treaty and the Patent Law Treaty (or the non-formalities provision of the Berne Convention)¹⁸ are in large part driven by the same philosophy that drives treaties imposing substantive minima obligations; they guarantee rights to the rights-applicant, whether substantively or in terms of the maximum procedures to which their application may be subjected. Phrased as such, the argument has substantial academic appeal, but has had little resonance in the policymaking arena to date.

¹⁴See submissions cited in Ho, *supra* note 3.

¹⁵See Graeme B. Dinwoodie and Rochelle Cooper Dreyfuss, *WTO Dispute Resolution and The Preservation of The Public Domain of Science Under International Law*, in INTERNATIONAL PUBLIC GOODS AND TRANSFER OF TECHNOLOGY UNDER A GLOBALIZED INTELLECTUAL PROPERTY REGIME (Maskus and Reichman eds. 2004) (Cambridge Univ. Press) (forthcoming); Graeme B. Dinwoodie & Rochelle Cooper Dreyfuss, *International Intellectual Property Law and the Public Domain of Science*, 7 J. INT'L ECON. L. 431 (2004).

¹⁶In this debate, the meaning of Article 62 of TRIPS might also be of relevance.

¹⁷See Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Industrial Design Protection in the European Union*, 24 AM. INTELL. PROP. L. ASS'N Q.J. 611, 715 n. 274 (1996) (coining the term “substantive maxima”); see also Graeme B. Dinwoodie, *The Institutions of International Intellectual Property Law: New Actors, New Sources and New Structures*, in PROCEEDINGS OF THE 98TH ANNUAL MEETING OF THE AMERICAN SOCIETY OF INTERNATIONAL LAW (2004) (forthcoming). These efforts might also be cast as the creation of “users’ rights,” Rochelle Cooper Dreyfuss, *TRIPS-Round II: Should Users Strike Back?*, 71 U. CHI. L. REV. 21 (2004), but in this context the rights are not truly accorded users. Like such conceptions, however, they are mandatory restraints on national intellectual property rights.

¹⁸ See Berne Convention for The Protection of Literary and Artistic Works (1971 Paris text), 1161 U.N.T.S. 3, art. 5.

A second question is whether, if such a disclosure obligation is permitted (or could, if necessary, be imposed by national law under an amendment to TRIPS),¹⁹ could such an obligation be imposed on WTO members, requiring amendment of their patent laws? This would require a new international instrument creating such an obligation. The contours of such an obligation, though resisted by developed countries in the ongoing debate in the TRIPS Council, are not complicated, even though the political dynamic may be far from simple.

The second part of the proposal is what gives the proposal broad international scope. It would provide even greater effect to nationally-recognized traditional knowledge rights. But it would also likely be more controversial, because it implicitly dictates the consequences in the patent laws of Country A of determinations made in accordance with the traditional knowledge protection laws of Country B. (It is implicit because the proposal did not expressly provide the consequences of a false declaration; presumably, it would invalidate the patent.)²⁰ That is the principal focus of the rest of this paper.

An initial objection to this approach is that it is inconsistent with the principle of territoriality which underlies the international intellectual property system. That is, countries may defer (upon treaty accession, or treaty implementation) to *international* norms by adopting them as national law, but that does not involve deferring to *foreign law* or determinations of *foreign institutions*. Deference to foreign law would be implicated simply by requiring patent-granting countries to determine whether the “the prevalent [traditional knowledge] laws and practices of the country of origin have been fully respected.” The prospect of deference to foreign *institutions* is raised if national courts or patent agencies are required to give effect to decisions of courts or agencies in the country of origin determining (non-)compliance with the traditional knowledge laws of that country.

Either approach would be an exception to the rigid principle of territoriality that pervades international intellectual property law. As choice-of-law rules mature in intellectual property law, it may become increasingly common for national courts to apply foreign law to certain issues in multinational litigation.²¹ But, even with such developments, the application of foreign

¹⁹A comprehensive set of reforms would also effect amendments to the Patent Cooperation Treaty and perhaps the European Patent Convention. Such proposals have in fact been floated, but those are not central to this paper.

²⁰To be fully effective, of course, this would also have to be accompanied by the enactment of traditional knowledge protection laws in nations seeking to further the protection of traditional knowledge.

²¹*See, e.g., Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 89 (2d Cir. 1998) (ownership of copyright).

law to determine the *existence* of a domestic intellectual property right is unlikely.²² Indeed, patent law is perhaps the least likely candidate for such radical reform. And deference to decisions of foreign institutions also implicates questions of efficiency and judicial competence that currently bedevil negotiations regarding a broad-based international convention on jurisdiction and enforcement of judgments in intellectual property matters.

It has to be stressed, however, that the territoriality objection is not insurmountable. Even the extant intellectual property treaties contain exceptions to the strict principle of territoriality (though rarely in patent law).²³ For example, although Article 6 of the Paris Convention for the Protection of Industrial Property affirms the principle of independence of trademark rights in different countries,²⁴ Article 6*quinquies* (A)(1) provides that “every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article.”²⁵ As a result of this so-called “*telle quelle*” principle,²⁶ domestic applicants may be denied trademark registration by virtue of a prior conflicting registration (whose sole basis for registration is an analogous foreign registration).²⁷

²²See *The Bridgeman Art Library Ltd. v. Corel Corp.*, 25 F.Supp.2d 421(S.D.N.Y. 1998), *aff’d on reconsideration*, 36 F.Supp.2d 191 (S.D.N.Y. 1999) (copyright originality standard).

²³Patent law does contain (in the Paris Convention, the Patent Law Treaty, and the Patent Cooperation Treaty) procedural devices at the international level designed to facilitate the acquisition of national rights on a multinational basis.

²⁴See Paris Convention for the Protection of Industrial Property, art. 6(1) (“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.”); *id.* art 6(3) (“A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.”)

²⁵In the United States, this principle is reflected in Section 44(e) of the Lanham Act, which provides a basis for trademark registration in the United States without use in the United States. See 15 U.S.C. § 1126(3). The Madrid system for the international registration of marks, to which the United States has recently acceded, likewise raises this possibility.

²⁶The Appellate Body of the World Trade Organization, in its only report on trademark law to date, has offered a relatively narrow reading of Article 6*quinquies*. See United States–Section 211 Omnibus Appropriations Act of 1998, Report of the Appellate Body, WT/DS176/AB/R (WTO 2002). National legislatures and courts have implemented the principle in more generous fashion. See, e.g., *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. 909 (T.T.A.B. en banc 1984).

²⁷See, e.g., *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. 909 (T.T.A.B. en banc 1984).

Likewise, Article *6bis* of the Paris Convention provides that:

“The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.”

Both these provisions might be seen as derogations from the principle of territoriality of trademark rights, thus supporting the general approach that the Indian government proposal would like to pursue.²⁸ And these two provisions have received global national implementation, suggesting that it would not be unprecedented for member states of the WTO to deny the grant of industrial property rights in their own country based upon the recognition of rights accorded by a foreign nation.

These exceptions (*telle quelle*, and the protection of well-known marks) are, however, themselves subject to carve-outs that enable the recognizing state to exercise some control over the rights recognized under its national laws. Thus, the *telle quelle* principle of Article *6quinquies* is subject to Article *6quinquies*(1)(B), which enables recognizing states to refuse to recognize the foreign right in certain defined circumstances.²⁹ Likewise, the protection of well-known marks mandated by Article *6bis* of the Paris Convention allows national courts to exercise sovereignty by virtue of the subset of foreign marks to which it extends these protections. Not all marks are well-known, and determinations of which marks are well-known in the recognizing

²⁸These provisions can be conceptualized in other ways (e.g., as a choice of law rule, or as partial harmonization of substantive protection for unregistered marks). But viewing the provisions in these alternative ways does not undermine the central point here.

²⁹*See* Paris Convention art. *6quinquies*(1)(B) (“Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.”)

state will be made by the courts or administrative agency of the recognizing state.³⁰

Indeed, where treaty drafters have made efforts to go further (such as in some treaties dealing with geographical indications) and have recognizing countries defer entirely to foreign rights or foreign determinations, some countries have been resistant to accession. For example, one of the reasons for opposition in the United States and elsewhere to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration was that member countries would have been required to accept determinations of protectability under the law of the country of origin without any exceptions (such as whether the term was generic in the recognizing country).³¹ The ongoing debate in the TRIPS Council regarding the effect of a geographic term being included on the proposed multilateral register of geographical indications illustrates that this resistance is still strong. Indeed, in TRIPS Council discussions, the United States (and others) have objected to hard legal consequences flowing from inclusion on such a register even when there would be an ability on the part of third countries to object to a term's inclusion.

Drafters of a proposal along the lines suggested by the Indian government might make their proposal more attractive by:

- * including exceptions (such as those to which the *telle quelle* principle is subjected); or
- * conditioning the types of traditional knowledge that would receive extra-territorial protection (as in the case of well known marks).

Both of these structural concessions might ameliorate in the minds of opposing countries the derogation from territoriality (often cast as an intrusion on sovereignty) that is seen as unsettling. Each would, however, require drafters to enter into discussion about substantive principles of protection; as noted above, there are some points at which the structural questions will inevitably be intertwined with substantive issues. To give examples that parallel the exceptions to Article 6*quinquies* or the conditions of Article 6*bis*, negotiators could consider whether:

- * there are particular determinations (e.g., oral prior art) on which recognizing nations would specially wish to retain sovereignty?; and
- * there are certain types of traditional knowledge that protecting states would most wish to give enhanced (i.e., additional automatic international) protection?

³⁰Suggestions to create an international registry of well-known marks has never received substantial support. *Cf.* Lars S. Smith, Implementing a Registration System for Famous Trademarks, 93 TRADEMARK REP. 1097 (2003) (discussing famous marks registry).

³¹See Albrecht Conrad, *The Protection of Geographical Indications in The TRIPS Agreement*, 86 TRADEMARK REP. 11 (1996).

These questions are of course essentially political matters, driven not simply by where harmonization of legal concepts seems possible but also by where political priorities are most acute. Thus, to reach such agreements, some concessions would likely be required. But it should be remembered that concessions in the framing of mandatory international obligations need not derogate from the ability of nation-states to implement more far-reaching protection of traditional knowledge at the national level. But that is a battle that must be fought at the first stage of the Indian proposal, namely in securing an interpretation or amendment of TRIPS that permits the imposition of such additional disclosure requirements in national law.³² If that flexibility is secured, then *any* international agreement, even with exceptions or conditions, might be regarded as progress by those seeking the protection of traditional knowledge.

V. Further Amendments to the Proposal?

At least three other approaches might be considered, all of which are efforts to mitigate concerns that might be expressed by countries reluctant to allow their patent laws to be subject to *foreign laws and/or institutions*. The first approach would replace *foreign laws* with *international laws*; the second approach would replace *foreign decision-making institutions* with international decision-making institutions; and, finally, one might seek to implement the proposal by casting it as a “public private international law” solution grounded in “applicable law” concepts. Each approach presents problems that would have to be addressed.

(1) *International norms*. If recognizing countries are hesitant to apply foreign norms in allocating property rights under their national laws (i.e., requiring compliance with the local laws of the country of origin of the biological material), then the application of an international norm may seem less of an intrusion upon sovereignty. Thus, for example, although national traditional knowledge law might articulate a broad notion of traditional knowledge protection and be subject to continuing modification or enhancement by national authorities, the international rule might articulate a narrower and more settled set of rights making the recognizing countries less vulnerable to changes in the traditional knowledge law of foreign countries into whose lawmaking processes they would have no input.

Courts and administrative panels already apply international norms in the trademark context in at least two senses. First, in applying a basic norm applicable in all national systems, courts may infuse the content of that norm with international meaning. An example of this is Article 10*bis* of the Paris Convention. Article 10*bis* provides that “the countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition” and further notes that “any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.”

Although in most states this international obligation is specifically implemented in national law by a provision prohibiting unfair competition (and thus any actions are strictly

³²See *supra* text accompanying notes 13-16.

brought under the national statutory provision) the meaning of what amounts to unfair competition might on occasion be supplied by international norms. Thus, the leading authority on the Paris Convention has suggested that:

what is to be understood by “competition” will be determined in each country according to its own concepts but that whether an act is contrary to honest practices in industrial or commercial matters is not limited to honest practices existing in the country where protection against unfair competition is sought but should also take into account “honest practices established in international trade.”³³

To be sure, the application of this commitment to international norms is far from consistent. But the structure is in place. Article 10*bis* has been invoked by courts as disparate as the High Court of Beijing (in a cybersquatting case) and the federal district court for the Eastern District of Michigan (in a trade secret case).³⁴ If this model were pursued, of course, the central issue for delegates to debate would be the substantive norms that national courts would apply (or, if drafters were more willing to adopt a flexible standard, to where would national courts look for the ascertainment of those international norms).

A second (related) sense of the application of international norms would be where the legal standard itself is set out in detail at the international level (as opposed to Article 10*bis*, where the standard is initially implemented and determined under national law, though shaped by international practices). In this category, one might place the Uniform Domain Name Dispute Resolution Policy (the “UDRP”). This is also an example of using an international *institution*, and I discuss it in that context immediately below.

To state these comments more concretely, the Indian proposal might instead require that patent applicants certify that they have complied with the rules regarding biological resources set out in an international agreement.³⁵ Some developing countries might fear that, given the

³³G.H.C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 142-46 (1968). Similarly, the notes that accompany WIPO’s Model Provisions on Protection Against Unfair Competition argue for account to be taken of conceptions of honest practices in international trade, rather than solely the country where the conduct occurs. See MODEL PROVISIONS ON PROTECTION AGAINST UNFAIR COMPETITION, Notes 1.03, 1.04 (WIPO 1996).

³⁴See *General Motors v. Lopez*, 948 F. Supp. 684 (E.D. Mich. 1996); *China IP Express*, No. 24 (June 22, 2000) (Rouse & Co. Int’l) (discussing IKEA case before Beijing court).

³⁵There would be several sub-issues that would be generated by any of these approaches. For example, would identification of a group of persons as the owners of traditional knowledge on a multilateral register automatically give them standing to contest any grant of rights in the

consensual nature of international treaty negotiation, substantive international standards would likely be very easy to satisfy. To assuage those concerns, it might be possible for individual states to mandate compliance with stricter traditional knowledge standards for the purposes of applications under that country's national laws. The capacity of member states to require compliance with higher standards for domestic applications would no doubt be part of any negotiated compromise.³⁶ The argument for such flexibility might stress an analogous structure in current international intellectual property treaties. Thus, WTO member states are presently entitled to offer intellectual property protection in excess of international minimum levels. Under this proposal, members could impose traditional knowledge compliance obligations in excess of the international minimum.

(2) *International Institutions.* Once rights in Country A are made dependent upon compliance with legal rules of Country B, a jurisdictional question arises: which institution is to determine the question of compliance with the law of country B? The most obvious parallel would be the methods used by courts directed, either by a contractual choice of law clause or its own internal choice-of-law rules, to apply a foreign *lex causae*. Ordinarily, determinations under that foreign law are made by the forum, giving the forum courts some latitude to interpret foreign law narrowly or broadly. Alternatively, the forum could refer the question of foreign law to the courts of the *lex causae*; reference procedures are sometimes used, for example, by U.S. federal courts sitting in diversity proceedings and thus applying the law of the State in which they sit.

The tradition of exclusive jurisdiction in the patent-issuing state in patent litigation suggests that forum courts would likely retain decision-making powers in the circumstances presented by the Indian government proposal. However, judicial competence or expertise – another rationale often invoked in support of exclusive jurisdiction – might counsel in favor of input from courts in countries with developed bodies of traditional knowledge law. And the question may become even more complicated (and contested) if the courts in Country B have previously rendered decisions regarding whether the patent applicant in Country A has complied with the traditional knowledge laws in country B. What weight should the courts in Country A afford such decisions? Given the history of the Hague Convention negotiations, it is likely that developed countries will resist any substantial deference to foreign institutions.³⁷

If certain countries are hesitant to allow the allocation of their domestic patents rights to

recognizing state? Or perhaps only nation states, or a specially created agency such as a National Biodiversity Authority, would have standing to object?

³⁶To enable such an approach, member states would also require to resolve the TRIPS interpretation questions noted above.

³⁷*See* Hague Convention on Jurisdiction, Recognition and Enforcement of Foreign Judgments in Civil and Commercial Matters, Work. Doc. No. 110E (Revised) (27 April 2004), at www.hcch.net/doc/jdgm_wd110_e.pdf.

be affected by determinations of foreign administrative agencies regarding compliance with traditional knowledge rules, one might consider using an *international institution* to make compliance determinations.³⁸ Such an approach might seem attractive especially given the success of the UDRP in addressing the claims of trademark owners against cybersquatters. For example, an international institution could be authorized to make determinations regarding traditional knowledge claims that would then be used for the purposes of the international recognition system.³⁹

Although determinations of non-compliance would be binding on countries and thus a bar to patent grants on a multinational basis, a system could be constructed that would allow member states to make their own determinations of compliance for domestic purposes (where the international institution makes an affirmative determination of compliance with country of origin law). An argument to allow member states to retain this domestic capacity would be strongest if the role of international institutions was limited to detecting clear cases of non-compliance,⁴⁰ or if the international institution made its determinations according to a relatively liberal international norm. But it is likely that developed countries would take the position that compliance determinations be equally as binding as determinations of non-compliance. That is, the ability to offer broader protection to traditional knowledge under national law might be part of a political compromise with developed countries.

The UDRP contains many features that might caution against its use as a model here, of which only three are highlighted here. First, ICANN's ability to regulate the domain name

³⁸This option could be pursued whether compliance is to be measured against country of origin laws or international norms. Expertise arguments are perhaps strongest where international norms are involved, but an international institution would still be capable of interpreting national (country of origin) law. In administrative proceedings under the UDRP, international panelists frequently are obliged to make determinations (e.g., regarding the existence of trademark rights) under national law.

³⁹For the purposes of the bare text advanced by the Indian government, the only relevant question is compliance with local (country of origin) law. But ancillary questions will inevitably arise. For example, if standing to object to a patent grant is based on *ownership* of traditional knowledge, *see supra* note 35, determinations of ownership will become crucial. It is possible that certain questions such as ownership be reserved to courts of the country of origin, while compliance be treated as a matter for the international institution. Ownership of existing intellectual property rights is often analytically separate from the existence or scope of rights. *See, e.g., Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 89 (2d Cir. 1998). As a matter of international trademark law, national ownership rules are largely unregulated. *See United States–Section 211, supra* note 26.

⁴⁰A finding for the respondent under the UDRP does not preclude the trademark owner from bringing a complaint under national laws (which may afford greater rights).

system and impose the UDRP on the vast majority of cybersquatting disputants is achieved through the powerful (and sometimes despised) cocktail of contract and technology. Such a mix is not present here. Such an apparatus for traditional knowledge would have to be established by international agreement. Second, national authorities have only been willing to defer to the injection of UDRP panel jurisprudence because UDRP determinations are soft law, which can be overturned by the application of local national law without regard to international standards. In large part, national over-rides have not occurred (with some exceptions, mostly in the United States). But that is in part is because of the relatively impecunious nature of the persons (individual domain name registrants) whose rights are defeated by the international system. If the soft law nature of the UDRP were followed, patent applicants would be likely to exploit any softness in the model by pursuing actions under “hard” national law. Finally, the expertise required to make determinations under traditional knowledge regimes, and the development of the evidence necessary evidence to make those determinations, may best be found in local courts of the country of origin. The issues addressed in UDRP proceedings are typically more routine.

These comments are not intended to discourage discussion of whether using an international institution might overcome some of the concerns of transfer of sovereignty to a foreign nation. Rather, if such an approach is to be adopted, these structural components of how to mandate international jurisdiction, the relationship between national and international decisions, and the development of the appropriate expertise and evidence, would require attention.

(3) *A Choice of Law Approach.*

As suggested above, one might imply view the Indian government proposal as a choice of law rule and cast it as such in negotiations. It certainly has the feel of such a rule: it suggests that the prescriptive authority to regulate private ownership of genetic resources taken from a particular country should normatively rest with that country. Viewing the proposal in those terms might be an attractive theoretical approach,⁴¹ but would probably not be helpful for several reasons of practical international politics. Most importantly, the development of international agreement on choice of law in intellectual property matters is one of the few areas where agreement is perhaps even less likely than with traditional knowledge.

VI. Some other basic choices

⁴¹For example, U.S. courts applying conflicts analysis have been willing to defer *in copyright matters* at least to foreign law in determining ownership of copyrighted works produced abroad where protection is sought against activity in the United States, although that willingness would likely not extend to determinations of whether copyright protection existed. *See supra* notes 21-22 (citing cases). In patent cases, however, the applicable law would surely be regarded as the law of the patent-issuing state. *See American Law Institute Project on Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes* (Prelim. Draft No. 2 Jan. 20, 2004).

(1) Soft or Hard systems

In developing an international system, interested parties must confront several choices that arise in the construction of any international regime. Most prominently, those developing the international system must choose how mandatory (or “hard”) to make the obligations of participating parties. If the obligations imposed by the system are rigid, the protections accorded by the system are made more real. Yet, that very effectiveness may make countries that are not fully convinced of the merits of the protection of traditional knowledge balk, thus initially reducing the reach of the system. On the other hand, creating a system that is so “soft” that its obligations are voluntary might expand the reach of the system at the expense of its effectiveness.

A related dynamic (though not in conventional terms a question of hard or soft law)⁴² can be seen in the early stages of the development of the international intellectual property system. Both the leading intellectual property conventions of the last century, the Berne Convention for the Protection of Literary and Artistic Property and the Paris Convention for the Protection of Industrial Property, initially expanded only by incremental expansion of substantive obligations largely consistent with norms upon which members had developed consensus through their experience at the national level (and without real enforcement). As a result, membership in these conventions imposed minimal obligations and membership grew readily.

Yet, it was impatience with that inclusive process (as reflected in the activities of the World Intellectual Property Organization) that in part caused developed countries to seek to expand intellectual property protection more speedily by shifting its discussion into a forum (the revision of the General Agreement on Tariffs and Trade) that might impose obligations in advance of a true consensus. Ordinarily, of course, making obligations more real – as happened with the incorporation of the Berne and Paris Conventions in the TRIPS Agreement and subsuming that agreement within the WTO dispute settlement system – might be expected to disincentivize membership from reluctant nations. But the conclusion of TRIPS can be explained on other grounds, including the pressure of trade and other considerations external to the intellectual property obligations undertaken. More telling, perhaps, is the much slower pace of negotiation of issues in the WTO post-TRIPS where those external social pressures do not exist (or may in fact push in the other direction).

Although this dynamic is well-understood, it is very often discussed only in the context of substantive levels of protection; more countries will agree more easily to lower mandated levels of protection. Yet, the same dynamic operates with respect to structural issues; more countries will agree to undertake obligations where they believe there is an accepted level of noncompliance, or latitude, that they can exploit if national interests run counter to full compliance. (This may explain, for example, some of the current debate in the TRIPS Council

⁴²The usual determination of whether a law is soft or hard pivots around the question of bindingness. See Dinah Shelton, *Law, Non-Law and the Problem of Soft Law*, in COMMITMENT AND COMPLIANCE (Shelton ed. 2000).

over the consequences to attach to the inclusion of a geographical indication on the proposed multilateral register of such indications.⁴³) Of course, countries generally take seriously even non-binding obligations. And for good reason: renegeing on international commitments, even when compliance might not be compelled by others, is not cost-free; and non-binding obligations, once articulated, often begin to pervade the arteries of the international system in ways that render them far less discretionary in the long-term.

I introduce this basic choice simply to note that the choice of structures will not be divorced from the broader geo-political considerations that might allow countries advancing the protection of traditional knowledge to seek “softer” structures at some times, and “harder” structures at others. In the current debates over the protection of traditional knowledge, this variable is apparent, with various scholars contemplating voluntary guidelines for access sharing and the implementation of benefit sharing arrangements.⁴⁴

(2) Within the Intellectual Property System?

A dilemma evident in much recent scholarship regarding traditional knowledge is whether the protection of traditional knowledge should be pursued within the rubric of intellectual property law. Amendments to existing intellectual property protection and the *sui generis* protection of traditional knowledge are not mutually exclusive options. That is, developing countries might still seek to vindicate traditional knowledge protection against broad patent protection in the context of Article 27(3)(b) of TRIPS, while developing a system for affirmative traditional knowledge protection separate from the conventional intellectual property regimes.

To some extent, the Doha Declaration already commits WTO members to attend to traditional knowledge within that institution (and within the TRIPS Council in particular).⁴⁵ But

⁴³See *supra* text accompanying note 31.

⁴⁴One context in which the “hardness” of the international law might be relevant is the weight given to inclusion on any register that might be created under alternative proposals. Would the determinations of registering countries as to what is traditional knowledge, and *who owns* or has rights in that traditional knowledge, be accepted fully (or fully subject to exceptions sufficient to protect the sovereignty of the recognizing nation)? Or, alternatively, would the drafters simply allow states to assert and state claims to traditional knowledge protection but leave it to recognizing states to determine whether the holders of traditional knowledge have the right under national law (of the second state) to preclude privatization of property by others or to obtain protection for themselves?

⁴⁵See World Trade Organization, Ministerial Declaration of 14 November 2001 (WT/MIN(01)/DEC/1, ¶ 19 (instructing the TRIPS Council, in pursuing its work programme including under the review of Article 27(3)(b) . . . and work foreseen by Article 12 [of the Doha

addressing the matter fully within the WTO carries with it a full set of institutional and structural commitments (e.g., national treatment for WTO members, the need for broad consensus, a binding dispute settlement system) that might make it less easy to move toward a working system.⁴⁶ By the same token, advantages may attach to using the WTO's institutional apparatus, which would allow developing countries to bring actions for effective enforcement.

VII. Bilateralism

Without wishing to be unduly defeatist given the global aspirations of interested parties, it is appropriate to consider the role of bilateralism. At present, the developed countries are deploying the bilateral mechanism in a wide range of international intellectual property contexts.⁴⁷ But the conceptual parallels to the struggle over protection for geographical indications⁴⁸ may suggest that it may be particularly appropriate to use bilateralism to advance the objectives at the heart of the Indian government proposal. Bilateral agreements have been crucial to the development of protection for geographical indications.

Declaration] to examine, *inter alia*, the relationship between [TRIPS, the CBD, and traditional knowledge].”)

⁴⁶Indeed, this – like the inclusion of any substantive maxima with respect to intellectual property protection – sets up a disincentive for developed countries to push for activism in the WTO dispute settlement body in interpreting affirmative intellectual property obligations. Although it is beyond the scope of this brief paper, developing countries should consider whether they wish to characterize affirmative protection of traditional knowledge as “intellectual property.” If the rights granted are within the intellectual property rights covered by the TRIPS Agreement, they must as a rule (subject to few exceptions) be accorded on a national treatment basis. Benefit sharing, for example, could be conceptualized as a rule regulating ownership or scope of rights subject to TRIPS. Or could it be conceptualized as a right wholly unrelated to those IP rights. As the EU has shown, both new forms of exclusive rights (*sui generis* database rights) and rights to compensation (private copying levies and royalties) might be treated as outside the confines of the TRIPS Agreement, though the EU's arguments in this regard have not been tested in the WTO dispute settlement system. Of course, if the rights accorded holders of traditional knowledge are conceptualized as existing intellectual property rights, then other substantive provisions of the TRIPS Agreement might also intrude. Thus, the Agreement sets out the rights that a patentee or trademark holder or copyright owner must obtain and any derogation from them (for the purpose of sharing the benefit with traditional knowledge holders) must comply with the Agreement in terms of affirmative rights and limits thereon.

⁴⁷See Dinwoodie, *The Institutions of International Intellectual Property Law*, *supra* note 17.

⁴⁸See *supra* text accompanying note 31.

Although the Lisbon Agreement failed to establish a geographically broad system of protection for geographical indications, several countries moved (and are still moving) toward a broader network of protection through bilateral agreements structured around the same derogation from territoriality exhibited by the Lisbon Agreement. Thus, under this approach, during negotiation of the bilateral agreement, each country submits a list of protected geographical names. Producers from each of these geographic regions obtain the exclusive right to use the geographic indication in both countries. Thus, as under the Lisbon Agreement, the country of origin controls the requirements for the legitimate use of certain geographical indications at home and abroad. Although the objection to the Lisbon Agreement – that recognizing courts would be bound by the laws or decisions of a foreign jurisdiction – also applies here, this model has spread quite broadly in the area of geographical indications, an area where multilateral agreement has been difficult to reach. If an impasse is reached likewise with traditional knowledge, countries might consider the bilateral route in the interim as a step toward multilateral solutions.

VIII. Conclusion

As noted above, any comprehensive system for the protection of traditional knowledge would in fact be comprised of several components. This brief paper has used the proposal of the Indian Government as a launching pad to place before seminar participants in Geneva some structural variables that might be useful to consider. Full consideration of these variables might help develop a system that more easily accommodates differences of views on the topic.⁴⁹

⁴⁹ It might also (though this too is beyond the scope of the paper) effect intriguing changes to the dynamics of the international intellectual property system (paradoxically by articulating an approach with conceptual or structural parallels to the international intellectual property system).