

IP BRIEFS®

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The logo for SAIPL, featuring the letters 'SAIPL' in a bold, black, sans-serif font. The letter 'I' is stylized with a red and orange curved shape above it, resembling a drop or a stylized 'i'.

FROM THE EDITOR

Dr. MM Kleyn

Madelein.kleyn@outlook.com



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Crossword

June 10th of this year saw the 25th anniversary of World Anti-Counterfeiting Day, which was founded in 1998 to bring attention to the global problem of counterfeiting.

Some occasions of note are the EUIPO-published study on how EU citizens perceive IP rights, which was based on 25,824 interviews with residents aged 15 years or older from all EU member states, which concluded that the protection of IP rights is still the best way to fight counterfeiting and piracy. It is clear that you can only take action against infringers if you have applied, obtained and maintained IP rights. The 3rd annual Anti-Counterfeiting World Law Summit, which will take place in London on 18th October 2023, will bring together all stakeholders in the anti-counterfeiting space to share best practice and successful enforcement strategies. The program includes the topic "*Recognise what the arrival of ChatGPT and generative AI will mean for IP rights*".

It seems that the OECD's Council at Ministerial Level (MCM) (the OECD's highest-level forum, attended by ministers of finance, economy, foreign affairs, trade and other government departments from OECD Member and Partner countries, and by representatives of International Organisations) celebrated the occasion too as the MCM recommended the enforcement of competition law against anti-competitive IP-related business practices: the same competition principles should be applied to IP rights as to other forms of property, while accounting for the unique characteristics of IP rights; in particular that members should establish procedures to allow effective policy co-operation between their competition authorities and their IP bodies, as well as with other relevant regulatory agencies. They should also put in place mechanisms to foster effective enforcement co-operation between competition authorities of affected jurisdictions. This promises to be interesting.

"We only have to look at ourselves to see how intelligent life might develop into something we wouldn't want to meet."

– Stephen Hawking

Be Prepared to Enforce a Patent

By Patrick O'Brien and Jonathan Whittaker

Patrick O'Brien



Patrick O'Brien is an associate at Spoor & Fisher attorneys. He has a BEng (Hons) (Chem) degree from the University of Pretoria and an LLB degree from the University of South Africa. He works in patent and design litigation across a broad spectrum of fields, including the mechanical, mining, metallurgical, electrical, chemical and pharmaceutical fields.

Jonathan Whittaker



Jonathan Whittaker is a Partner at Spoor & Fisher Attorneys and a Patent Attorney with a BSc (Civil Eng), BProc, LLB and PGDip OL. He is an Attorney of the High Court of South Africa. Jonathan has spent almost three decades in intellectual property litigation and opinion work. His areas of expertise include patents, designs, technical copyright, unlawful competition and plant breeders' rights. Jonathan has extensive litigation experience in a broad spectrum of fields including the mechanical, mining, metallurgical, construction, electrical, electronics, telecommunications, medical, chemical and pharmaceutical fields.

Significant capital and effort are invested in creating an invention, applying for and obtaining a granted patent, and then ensuring that the granted patent is in a valid form that meets all the requirements for patentability. However, protecting an invention doesn't end there - it is just as important to ensure that the granted patent remains in force, and that it can be enforced as soon as any infringement is identified. There are several key areas of patent management that need to be safeguarded to ensure that it is enforceable.

Renewal fees, restoration and enforcement of a patent that has lapsed

In South Africa, renewal fees are payable annually from three years after the date of the patent application. The prescribed fees are payable on form P10 on or before the anniversary of the date of application, or within six months thereafter on application to the Registrar and on payment of the prescribed (late) fee. Provided that renewal fees or late fees are paid correctly, a valid patent will remain in force on the Patent Register. If a renewal fee is not timeously paid, or paid within the 6-month grace period, the patent will lapse. Provision is made in the Patents Act for restoration provided that the patentee did not intentionally allow the patent to lapse, and that there was no undue delay in applying to restore the lapsed patent. Unless and until a lapsed patent is restored, it cannot be enforced against an infringer. Restoration requires a substantive application supported by evidence on affidavit, and an opposition period of two months applies. This may be detrimental to a possible urgent application, and will certainly delay obtaining relief in an infringement action. Such a restoration application may also be opposed, creating further delay. Another difficulty is that damages cannot be claimed for infringement that took place during the period when the patent had lapsed.¹

¹ The applicable period is from 6 months after a missed renewal fee was due until the date on which an application to restore the patent was advertised.

In addition, it is not possible to institute infringement proceedings against a person who, during the period when the patent had lapsed, commenced *using* or *exercising* the invention to which the patent relates and who continues to use or exercise the invention after the patent has been restored.¹ The further use or sale of products produced by such continued use or exercise can also not be prevented.

Shortfall payment or omission of late renewal fees

If it is discovered that a renewal fee was paid timeously, but inadvertently underpaid, or the late fee was inadvertently omitted when paying the renewal fee within the grace period, a patentee may still launch infringement proceedings in respect of the patent.

The acceptance by the Registrar of a shortfall payment of a renewal fee is an unlawful or irregular administrative act. However, it is settled law in South Africa that an unlawful administrative act remains valid unless and until it is set aside by a court on review. The courts have a discretion whether or not to set aside that irregular administrative act. As such, a patent in such a circumstance remains in force, unless and until the Registrar's administrative act is set aside on review.

The court dealt with a similar set of facts in *Trinamics Inc v Registrar of Patents and Others* 2013 BIP 29 (CP), in which the Registrar had accepted a shortfall renewal payment. Under the set of facts in that case, the court declined to set aside the administrative act complained of. It is arguable that, just like an acceptance of a shortfall payment of a renewal fee, acceptance by the Registrar of a renewal payment within the grace period without the requisite late fees is an unlawful or irregular administrative act, which remains valid unless and until it is set aside by a court on review.

However, if the Registrar's decision is set aside on review, then the patent will have lapsed, and it would be necessary to apply for the restoration of the patent.

Enforcement of an expired patent

In the *Trinamics* case, infringement proceedings were launched in respect of an expired patent with a claim for damages for infringements occurring before expiry of the patent. In such a case, should the court in its discretion have set aside the Registrar's acceptance of a shortfall payment of a renewal fee, the patent would have lapsed. Because the Patents Act does not make provision for restoring an expired patent, it would not have been possible to restore the patent and there could have been no valid claim for damages. A patentee wishing to enforce its patent or recover damages at or after the end of the patent's term should be aware of the seemingly incurable position that may result following a successful review application, in circumstances where renewal fees were underpaid or late fees omitted during the lifespan of the patent.

Assignment, licences and amendment

To obtain the benefit of being able to enforce a patent as soon as one becomes aware of an infringement, it is also important to make sure that any assignments or licences in respect of the patent have been recorded in the Patent Register, to show that a litigant has the necessary *locus standi*. Although a lack of such housekeeping may not cause significant delays in enforcing a patent, it is recommended that it be dealt with prior to considering infringement proceedings.

Importantly however, any question of invalidity that arises during the term of a patent should be dealt with as soon as possible, and certainly prior to considering infringement proceedings, because the invalidity of any one claim leaves the patent invalid and liable to be revoked. Further, a patent cannot be amended (to remedy an invalidity) once infringement proceedings have commenced without leave from the Commissioner of Patents. Should leave be granted, the infringement proceedings will be stayed and any relief that may be granted in respect of the infringement will be delayed. Another factor to consider is that a post-grant application to amend a patent must be advertised in the Patent Journal and lies open to opposition for a period of two months, creating a further delay to obtaining relief in infringement proceedings. Lastly, where a patent has been amended, the Commissioner has a discretion whether to grant damages to a patentee in respect of infringements before the amendment was allowed, and the court may take into account the conduct of the patentee in allowing the patent to remain unamended on the Patent Register.

Conclusion

Given the investment in obtaining a granted patent, a patentee should ensure that it is valid and remains in force. Careful attention must be given to paying all renewal fees correctly, dealing with any housekeeping in respect of assignments or licences, and rectifying by amendment any issues of invalidity as soon as they arise. This will ensure that the patentee is in a position to enjoy the whole profit and advantage accrued through patenting the invention.



Singing out loud to the song



Source: Stock Images

By Professor Ciresh Singh, University of South Africa

On 4 May 2023, a New York jury considered a case of copyright infringement brought by the Townsend family (the family of the late Ed Townsend who was the co-writer to musical singer Marvin Gaye) against modern day pop artist Ed Sheeren. The case centred around the question of whether Sheeren's 2017 Grammy award winning song entitled 'Thinking out loud' had copied Gaye's well-known classical 1973 song 'Lets get it on'.

Arguments by the parties

Sheeren argued that the familiarities with the two songs, and the similarities with the chord progressions, rhythms and other musical elements were the essential '*letters of the alphabets of music*' and could not be owned by anyone. He claimed that there were four common chords that were used in all pop songs. He argued that these chords were the '*common musical building blocks*' (*commonplace*) that all songwriters freely use and were thus not copyrightable.

During his testimony, in the witness stand, Sheeren, with guitar in hand, performed a mash-up of his songs with Marvin Gaye's songs, and illustrated how common the chord progressions (building blocks) of these songs were. He further claimed that these progressions were used well before Marvin Gaye's 'Lets get it on' song, and showed that while the chord progressions and tunes of both songs were similar, they were not identical.

Sheeren further testified that his song was an independent creation, and as a result of his inspiration from the long-standing romantic love between his grandparents and a new relationship he had started. He strongly affirmed that the song was an original creation, co-written by him and his musical partner Amy Wadge (See Sisaro, *New York Times*, 4 May 2023).

The Townsends conceded that while they did not own any basic musical elements, they could claim ownership in the way these musical elements were uniquely combined and selected, and that such arrangements were original and distinctive, thereby deserving copyright protection. They claimed that the similarities were evident between the two songs and lead video evidence of a mash-up Sheeren performed merging the two songs during a live music concert, claiming that the easy flow and transition between the two songs was evidence of similarity.

Verdict by the jury

While it was clear that the lyrics and melody of the songs were different, one of the key similarities were the progression chords (similarities were also be noted in the tempo, groove and instrumentals of both songs). Sheeren claimed that these (four) progression chords were common building blocks, commonplace, to all pop music and was thus not copyrightable.

Before sending in the jury into deliberations, the Judge indicated to the jury that *'independent creation is a complete defense to copyright infringement, no matter how similar the song is'*. It seems that the jury strongly took this into consideration and also favoured Sheeren's arguments, as after three hours of deliberation, the jury found that Sheeren had not infringed any copyright. The jury found that Sheeren had created the song independently and had not copied any compositional elements or melodies of Gaye's song. Some jurors indicated that the key factor they considered in making their decision was Sheeren's performance on the witness stand and testimony on his method to creating music.

South African context

In South Africa, copyright infringement is considered by assessing the objective similarity of the two works, and determining whether there is a causal link between the original work and the infringing work. Therefore, in order for copyright infringement to exist it must be shown that the alleged infringer had *'assess' to the*

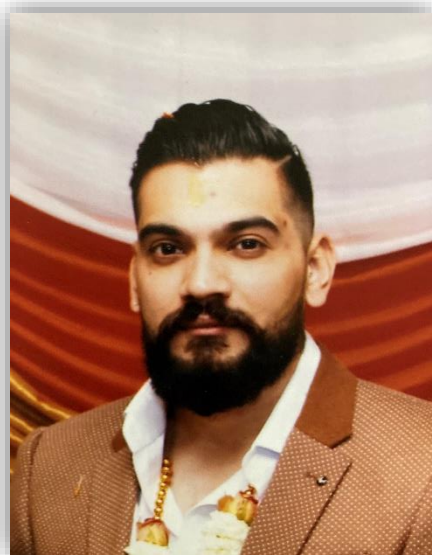
original work, and 'copied' or adapted' the work. (See [Cronje](#), Ed-sheeran-two-steps to victory in copyright dispute across the pond)

In the Sheeren case, the jury found that there had been no copying and thus no infringement. This verdict by the jury is welcoming as it prevents ownership of foundational musical components and other elements that have entered the public domain. Artists should be free to create and build upon the essentials that are before them, if they are prevented from doing so, creativity and innovation will be stifled. A monopoly over a common chord progression would deplete and prevent creativity.

The case does, however, raise the important question – is it possible to claim copyright in a musical style? The key from this case was the element of common building blocks in music. It seems that if the musical style is a common building block, one cannot claim copyright. The question to ask naturally thereafter is what are essential or common building blocks of music and how is this determined?

It will be interesting to see how courts will deal with this question moving forward.

Prof Ciresh Singh



Ciresh Singh is a qualified attorney and possesses a PhD in Law with the University of KwaZulu Natal. Ciresh is currently employed as an Associate Professor at the University of South Africa, wherein he teaches Intellectual Property Law and Banking Law. His key areas of expertise are trade mark and copyright enforcement.



Alternatives to a sui generis Indigenous Knowledge System for South Africa

By: Gerard Verhoef

Introduction

Recent international developments, led by the WIPO IGC, to promote a sui generic system to protect and develop Indigenous Knowledge Systems (IKS)¹ provide an opportunity to reflect on IKS-related legislation in South Africa and how South African policy influencers can offer best advice on IKS protection and development. Two recent developments on IKS are noteworthy: In February 2023, a Draft International Legal Instrument relating to IP, TK and TCEs was considered by the WIPO IGC;² In South Africa, IKS-related legislation has been pending since 2013.³ Yes, a decade has passed since South Africa's attempt to address IKS and now WIPO takes the lead.

This article attempts to review the situation through the lens of the public eye, while focusing on three aspects related to IKS, namely the sacred and secret nature of IKS, the role of discoveries and lastly the influence of land on IKS.

IKS stakeholders often debate the divide between indigenous and other knowledge systems. IP rightsholders seek advice on how they can strengthen and secure their proprietary rights or broaden the public domain, while other interest groups such as indigenous peoples and local communities want to know how the public domain can be enclosed. One reason for this divide seems to be that the IP regime operates in a sphere where the public domain is demarcated by individual rights, as opposed to the indigenous knowledge systems regime where the public domain is demarcated by social embeddedness and connected to the land on which indigenous peoples and local communities live. This problem manifested itself over centuries of colonialism and technological development worldwide, but also because indigenous worldviews do not share the pre-appropriation narrative of the public domain than technological advanced societies.

¹ Note that WIPO use Traditional knowledge (TK), Traditional Cultural Expressions (TCE) and Geographic Resources (GR) as separate terms. In South Africa the term Indigenous Knowledge Systems (IKS) is used.

² See the report at https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=601231.

³ Intellectual Property Laws Amendment Act 28 of 2013; Protection, Promotion, Development and Management of Indigenous Knowledge Act 6 of 2019. Both these South African acts are not yet in force.

Sacred and secret nature of IKS

Today, IKS manifest itself in many ways other than merely as knowledge systems and includes culture, secrets, sacred ceremonies, or symbols that express a group's identity and social embeddedness. Here the Coat of Arms of South Africa serves as an example. As the highest visible symbol of state, it aims to represent a diverse and multi-faceted society. For example, the two San figures are depicted facing one another in unity, with "!ke e: /xarra //ke" written in the Khoisan language of the /Xam people, literally meaning: diverse people unite – indeed a very powerful way to celebrate South Africa's young democracy. The Coat of Arms belongs to all the people of South Africa. To see it as a picture with proprietary rights to some elements of the Coat of Arms is to fail to see what it is doing or what it means in a specific context. Coleman explains this when she analyses recent issues related to the alleged appropriation of Aboriginal visual art in relation to the Australian Coat of Arms⁴ and their AUS\$10 note.

Imagine a scenario where the San community in South Africa claims sacred ownership of the depiction of two San people from the famous Linton Panel on the Coat of Arms. In such a case there will be multiple legal challenges if a route is sought in terms of the current legal framework. For example, they will first have to establish if the legal object (Coat of Arms) is susceptible to ownership, and second that the San community is a juristic person.

Like Australia, South Africa was not spared of controversies concerning our Coat of Arms, albeit not directly – a similar graphic depiction of Khoisan people used on the Coat of Arms, found its way to packaging for wine, as illustrated below. The undignified treatment of the Khoisan⁵ Sarah Baartman in the 19th century⁶ left a scar among the Khoisan people which made it easy to comprehend why the *DAK Netwerk* fiercely opposed wine packaging that resembles a sacred and religious rain dance, saying that "the packaging is making a mockery of their sacred ceremonies, where no alcohol is consumed"⁷ This matter, which is currently under public scrutiny in South Africa, strongly reminds of the *Crazy Horse* case,⁴⁸ and the Australian AUS\$10 controversy.

In the IKS discourse, dignity relates to the respectful dealing with sacred and secret TK and TCE of indigenous people and local communities. The two contrasting pictures below illustrate two extreme examples where no narrative is needed: these examples, namely the Coat of Arms⁹ (Figure 1) and the wine packaging¹⁰ (Figure 2) expose gaps in current and proposed legislation in respect of sacredness

⁴ Graber and Burri-Nenova (eds) *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* 7, 50; She argues that culture is far more dynamic than art. In this book, Coleman illustrates this example with reference to the Australian Coat of Arms. She says "the Australian Coat of Arms does not provide information about kangaroos and emus, although it does depict them, and it is not a picture. To see it as a picture is to fail to see what it is doing or what it means in a specific context".

⁵ Note the difference between Khoi-Khoi, San and Khoisan people, as explained in Annexure A, the Glossary. Khoisan is the collective terms for Khoi-Khoi people, who are nomadic pastoralists, and the San people, who are hunter-gatherers.

⁶ de Haas 2011 *South African Journal of Bioethics and Law* 15.

⁷ Jansen *Rapport* 1.

⁸ *Estate of Tasunke Witko aka Crazy Horse v Hornell Brewing Co (USA)* [2001] 156 F Supp 2d 1092.

⁹ In 1918, the Linton Panel (2m by 8m solid rock), as represented on the South African Coat of Arms was discovered in a cave on the farm Linton that was full of ancient San rock art paintings. It is now housed in the South African Museum in Cape Town.

¹⁰ Jansen *Rapport* 1. The packaging is currently under review; Also see www.daknetwerk.co.za; The DAK Netwerk is a Khoi language pressure group in South Africa. DAK refers to three Khoi leaders, Doman-Nomoa, Autshumao en Krotoa.

of TK and TCE, as well as ownership and human dignity – two human rights entrenched in the *Constitution of the Republic of South Africa, 1996*.¹¹



Figure 1 Coat of Arms of South Africa

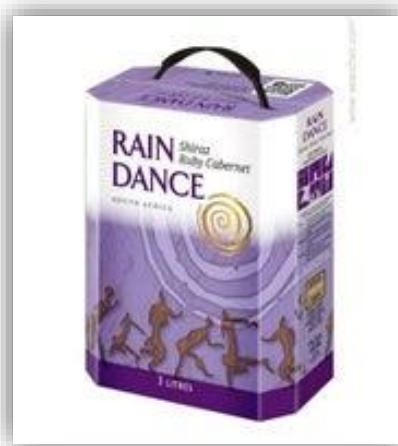


Figure 2 Rain Dance Wine

Discoveries

It is now necessary to move away from the sacred and secret nature of IKS to more tangible attributes of IKS, at least as far as the developed world sees it. A European example of a discovery will be used to provide the necessary objectivity.

Sir Alexander Fleming grew up as the son of a Scottish farmer. He discovered antibiotics from the mould *penicillium rubens* in 1928. The wild-type GR, *penicillium rubens*, is a common fungus occurring in any indoor environment and not endemic to any specific country. Fleming was a natural scientist who drew on his peers' knowledge in the public domain and his experience gained on bacteria while serving in French hospitals during World War I – he stood on the proverbial shoulders of giants. Some 12 years later, his PhD students, Florey and Chain, successfully isolated and described the chemical nature of penicillin at Oxford University. The optimisation of the fermentation process and the method of extracting penicillin from the mould by other scientists, Heatley and Moyer, followed between 1940 and 1945, just in time to make a difference in the lives of many wounded soldiers after the Pearl Harbour attack.

It would be easy to observe that in this case study, the public domain is a universal concept that equally applies worldwide. More specifically, Fleming merely discovered the wild-type mould that was in the public domain and later, other researchers obtained IP protection for their creations of the mind. Today, the patents have expired, and the whole world benefits from the principles related to antibiotics that are in the public domain. If it were not for the public domain, humankind would not reap the benefits of antibiotics as is done around the world.

Hypothetical questions can be asked, with reference to the Fleming case study: Who owns knowledge? Is it the indigenous farming community of Scotland where Fleming grew up and learned to observe nature and the public domain? Is it the French doctors who collaborated with Fleming in

¹¹ *Constitution of the Republic of South Africa 1996*.

their hospitals and where he observed the resistance of many bacteria? Is it perhaps Fleming's peers who published their earlier findings in academic journals; or the French, the country in which the mould was first described in literature? Florey and Chain who described the active compound should also be considered; as should Oxford University, their employer at that time. Is it Heatley and Moyer and their engineering team who optimised and scaled the industrial production processes; or the USA pharmaceutical companies that profited from this new drug to the exclusion of Fleming, Florey, Chain, Heatley, and British companies?

Land

The ownership of land is one of the most controversial debates in South Africa, with the public hearings^{1293F12} on the possible amendment of section 25 of the *Constitution* which commenced in June 2018, as a case in point. The IP regime can therefore not be ignorant of the important role that land tenure plays in the IKS discourse. Rooibos, cancer bush, buchu and other IKS examples all have one common denominator, namely land tenure: In the case of Rooibos, the land is not (and never was) owned by indigenous people. Marula grows on private and communal land. Cancer bush grows in the wild, contributing to South Africa's richness of biodiversity.

These examples, namely the Coat of Arms, Flemming's discovery, and land tenure attempt to contribute to the discourse on a sui generis system for IKS in South Africa. The Intellectual Property Laws Amendment Act 28 of 2013 and the Protection, Promotion, Development and Management of Indigenous Knowledge Act 6 of 2019 are both not yet in force, which leaves policy makers in South Africa with the opportunity to revisit the whole approach towards IKS. A sui generis approach seems not to be suitable for South Africa, or is it?

ABOUT THE AUTHOR

Gerard Verhoef



Gerard currently holds the position of Executive Manager: UJInvnt (Pty) Ltd at the University of Johannesburg, where he is responsible for the commercialisation of UJ's IP portfolio. He holds an engineering degree, as well as a PhD in law (IKS and the Public Domain); he is a registered Professional Engineer and he is also a Certified License Professional (CLP) and RTTP, with more than 20 years' experience in innovation and entrepreneurship management, as well as technology transfer.

¹² Constitutional Review Committee on Section 25 in Parliament of 27 February 2018.



COPYRIGHT REFORM OR REFRAME?

A REVIEW

By Andre van der Merwe

Nine members of the [Institute](#) being experienced IP legal practitioners have collaborated to produce a thorough and critical analysis of the provisions of the Copyright Amendment Bill, 2017 and the Performers' Protection Amendment Bill, 2016 published by Juta as a monograph entitled "[Copyright Reform or Reframe?](#)", which is freely available on Juta's online platform.

This provides a full and informative overview of the two Bills, and gives some direction on how these two Acts should be amended in the best interests of authors, copyright owners and performers, and how South Africa's law of copyright and of performers' protection should be modernized for the digital age.

The Copyright Act 98 of 1978 and the Performers' Protection Act 11 of 1967 have each been amended several times but have been overdue for reform and for updating in the digital age. Government has put forward various provisions in the two Bills which are new, far-reaching and, with respect, flawed in various respects. These provisions have in the past few years been strongly criticized by both copyright stakeholders and copyright law experts alike – and even after revision by the National Assembly, these Bills remain largely controversial. In the opinion of the authors of the above work, the Bills will not meet their stated objectives of benefitting authors and performers and updating the law for the digital era.

"*Copyright Reform or Reframe?*" is based on the submission by the Institute to the National Council of Provinces in January 2023. All the authors of the above work had contributed to that submission, and such work adds further background and analyses.

An issue raised in the media prominently namely the proposed introduction of the USA "fair use" doctrine into our copyright law is examined closely in the above work which also confirms a recent finding by the SAIPL that the research relied on by Government to justify this proposed provision in the Bills does not support the dispossessive "fair use" provision. In fact, some of that research indicates that a case for "fair use" has clearly not been established.

"*Copyright Reform or Reframe?*" deals in detail with the Bills' 25-year limit on assignments; a new statutory royalty entitlement for authors and performers; limits on contractual freedom of parties; and extensive new copyright exceptions from infringement – several of these being

entirely new concepts without a corresponding legal provision to be found elsewhere in the world. The above work points out *inter alia* the consequences of these provisions, especially for the publishing and film industries.

Other controversial issues are also identified and criticized where necessary in the above work (including a number of basic drafting errors).

“*Copyright Reform or Reframe?*” is an important and insightful work because, in addition to the responsibility that Government (including its Legislature) has towards its citizens to provide sound and proper legislation, the Bills raise questions of non-constitutionality and non-compliance with international treaties on copyright and performers’ rights. The above work describes South Africa’s relationship with such international treaties, and provides grounds for the Bills to be referred to the Constitutional Court if passed by the National Assembly.

A major omission in the Bills is *inter alia* that these do not provide any legal remedies for on-line and cyber infringement. This is both an unfortunate and glaring omission because of the stated objective of bringing South Africa’s copyright legislation into the digital era.

For IP legal practitioners and students interested (and especially if involved) in these fields of law, “*Copyright Reform or Reframe?*” is a particularly relevant work, and is well worth studying.

Andre van der Merwe



Andre van der Merwe is a former director of Kisch IP and is now a retired patent and IP attorney.



Source: Free Stock Images

International agreement on intellectual property, genetic resources and associated traditional knowledge - is it finally in sight?

by Wend Wendland¹

In a dramatic development in July 2022, WIPO member countries fast-tracked negotiations on genetic resources and associated traditional knowledge by convening a Diplomatic Conference to conclude an international agreement on these matters no later than 2024. This step-change development, welcomed by many countries, is also revitalizing the parallel discussions on traditional knowledge more broadly and traditional cultural expressions/expressions of folklore. These exciting developments come after many years of intensive negotiations and mounting concerns about how they would evolve.

A Diplomatic Conference is a high-level meeting, where representatives of member countries come together to finalise and adopt an international treaty or convention. Countries and regional organizations that sign up to the treaty would then integrate its provisions into their national laws.

The successful conclusion of a Diplomatic Conference would close a long, complex, and often frustrating negotiation and would launch a new phase of work at WIPO on these issues. The ups and downs of these negotiations, spanning more than two decades, are outlined in an [article](#) published in February 2022.

¹ This is an abridged version of an [article](#) that first appeared in the WIPO Magazine in February 2023

This earlier article, expands on the broader work of the WIPO Intergovernmental Committee (IGC), in which the negotiations are taking place.

The journey to the Diplomatic Conference

In preparation for the Diplomatic Conference, a Preparatory Committee will meet from September 11 to 13, 2023, to establish the necessary modalities of the Conference, including the venue, dates and rules of procedure. It will also approve the “Basic Proposal” for the administrative and final provisions of the treaty.

On the substance of the negotiation itself, the IGC will meet in a Special Session ahead of the Preparatory Committee, from September 4 to 8, 2023, to “further close any existing gaps to a sufficient level.”



[Source](#)

The substantive issues: the high-level policy conundrum

Modern life sciences research, including through the use of genetic resources and traditional knowledge, offers humanity great benefits. However, many countries have been concerned that patents are granted for inventions that are based on genetic resources and their associated traditional knowledge, but that do not fulfill patentability requirements, such as novelty, inventiveness or industrial applicability. The granting of such “erroneous patents”, it is argued, facilitates the misappropriation of genetic resources and their associated traditional knowledge. Colloquially, this is referred to as “biopiracy.”

How then can the patent system help scientists, businesses and public sector research institutions realize the immense benefits of scientific research while simultaneously protecting the interests of biodiversity-rich countries, Indigenous Peoples, local communities and the broader scientific community?

What’s up for negotiation?

Many argue that a new mandatory disclosure requirement in patent law would help to achieve this balance. But what is the scope and, indeed, the rationale for such a new requirement?

Transparency through the disclosure of a description of inventions is a defining feature of the patent system. Under current patent law, in order to obtain patent protection for any invention, it is necessary, among other things, to disclose sufficiently detailed technical information about it. From society's viewpoint, such disclosure is critical to promote scientific and technological progress and further innovation. This is one of the primary justifications for the patent system.

The proposal at the heart of the upcoming Diplomatic Conference is that applicants seeking patents for inventions that are based on genetic resources and associated traditional knowledge should include certain additional information, as part of the patent application. This includes information about the source or origin of the genetic resources and associated traditional knowledge.

At present, such information does not normally need to be disclosed in a patent application, as it is generally not relevant to determining the patentability of an invention.

There are arguments for and against the introduction of such a new obligation.

At present, more than 30 countries, including a mix of developing and developed countries, have adopted, or are in the process of adopting, some form of this kind of additional disclosure requirement in their national laws. The WIPO publication entitled Key Questions on Patent Disclosure Requirements for Genetic Resources and Traditional Knowledge examines and compares these national provisions.

IGC negotiations on traditional knowledge and traditional cultural expressions

While the decision by GA 2022 does not directly relate to on-going negotiations on traditional knowledge and cultural expressions – these continue as per the IGC's current mandate – it has boosted interest in these negotiations. Indeed, the current IGC Chair, Lilyclaire Bellamy (Jamaica), is already consulting on a Chair's Text to address the complexities of the IP and traditional knowledge/ cultural expressions nexus. This text could well provide fresh impetus to the IGC's work in this area.

A final word

The decision by GA 2022 to accelerate negotiations on genetic resources and associated traditional knowledge is a step-change in the work of the IGC. The decision itself, while dramatic, is merely procedural throat-clearing – much substantive work lies ahead. Born of understandable frustration with the slow progress made in the IGC over the years, this unanticipated jolt has brought into sight the exciting possibility of bringing these long-standing negotiations to a successful conclusion.



About the Author: Wend Wendland

Wend has more than 30 years' experience in intellectual property, in both the private and public sectors. As a Director of the World Intellectual Property Organization (WIPO), he has for many years devoted himself to multilateral norm-setting and capacity-building at the interface between intellectual property and global challenges such as biodiversity, food and agriculture, cultural heritage and human rights. He is passionate about economic, social and cultural development in developing and least-developed countries. Wend is also an Adjunct Professor, Faculty of Law, University of Cape Town, South Africa. Before joining WIPO, he practiced law as a partner of a leading South African law firm, Webber Wentzel, from 1987 to 1997.



From the Juta Law Reports

The following judgments were reported March to June 2023

Patent - Infringement – Alleged infringement of applicants' BOUWA mark – Application for interdict and removal of allegedly offending mark – Essence of dispute relating to question as to who may rightfully lay claim to BOUWA mark – Court finding that registration of mark conferring exclusive use and preceding alleged common-law right and that there can be no partial assignment or transmission of a mark – Court certifying validity of registration of mark and interdicting respondents from infringing it. *Roselt and Another v Bouwa Machinery South Africa (Pty) Ltd and Another* GJ 29672/2021, **Juta 2023 JDR 1709 (GJ)** (Wepener J), 25 May 2023, 6 pages.

Patent - Infringement – Application for interim interdict, pending outcome of trial, preventing consequential infringement of patent – Court pointing out that interdict granted in another court in related application clearly being defeated by respondent – Bringing of a separate urgent application warranted – Since irreparable harm would potentially be suffered by applicants with any delay in asserting their rights, urgent application justified – Court finding on facts that requirements for interim interdict met – Interim interdict granted. *Bayer Intellectual Property GmbH and Others v New Clicks South Africa (Pty) Ltd and Others* COP 2022/8099, **Juta 2023 JDR 2024 (COP)** (Collis J), 7 June 2023, 11 pages.

Omnibus IP case - Trademark infringement, passing-off, copyright infringement, unlawful competition and counterfeiting – I-CAT versus E-CAT in respect of dust suppression goods and services – Court finding against first respondent on every aspect – Court (i) ordering cancellation of E-CAT and device trademark, (ii) restraining the first respondent from infringing applicant's registered marks, (iii) restraining the first respondent from passing-off its dust suppression goods and services as those of applicant, (iv) restraining the first respondent from infringing the applicant's copyright in listed artistic works, (v) restraining the first respondent from unlawfully competing with the applicant for six months, (vi) and ordering enquiry to determine royalty due to applicant arising from infringement of its marks and copyright. *I-Cat International Consulting & Trading (Pty) Limited Trading v Purpleglaze 3 (Pty) Limited Trading and Another* NCK case No 2069/2021, **Juta 2023 JDR 1671 (NCK)** (Phatshoane DJP), 5 May 2023, 28 pages.

Trademark - Infringement – Inciting, aiding and abetting – In respect of applicant's MINA mark – Application for leave to amend notice of motion by introducing inciting, aiding and abetting as further ground – Such conduct amounting to infringement of those mark *per se* – Leave to amend granted Respondent interdicted from infringing MINA mark, as well as from inciting others to do so and passing-off, granted – Expungement application dismissed. *Bousaada (Pty) Limited and another v FCB Africa (Pty) Limited and Another* GJ 16949/2021, **Juta 2023 JDR 2128 (GJ)** (Adams J), 14 June 2023, 25 pages.

Trademark - Registration – Opposition – By applicant to GET CRACKING and EGGMAN with peak hat device – Court finding that while both parties’ marks containing visual image of egg with a peak cap, applicant’s mark depicting actual chicken egg with prominent peak cap whereas respondent’s mark depicting personified egg and peak cap not as prominent – Peak cap is a dominant feature of applicant’s mark but not respondent’s – Public would be able to distinguish – Not sufficiently similar for confusion – Objection dismissed. *Quantum Foods (Pty) Ltd v Kemell Investments (Pty) Ltd* GP 45960/2021, **Juta 2023 JDR 1623 (GP)** (Van der Schyff J), 3 May 2023, 4 pages.

Trademark - Registration – Opposition – Whether well-founded – Test – SALTICRAX (registered in 1951) versus SNACKCRAX for biscuits – Badge of origin and anti-dilution – Supreme Court of Appeal finding that products marketed under SNACKCRAX mark virtually the same as SALTICRAX biscuits, with former having strong market penetration over many years – Owner of SNACKCRAX would therefore not have to embark on marketing campaign of its own to achieve market penetration despite fact that it will be trading in same stores with a similar product and in same consumer niche market – Registration of SNACKCRAX would take unfair advantage of distinctive character or repute of SALTICRAX – Ought to have been refused by court a quo. *National Brands Limited v Cape Cookies CC and Another* SCA 309/2022, **Juta 2023 JDR 2056 (SCA)** (Ponnan JA, Gorven JA, Hughes JA, Goosen JA and Siwendu AJA), 12 June 2023, 14 pages.

Interdict - Application for return of intellectual property – After termination of creative services agreement between parties – Whether respondent advertising agency entitled to retain applicant’s IP assets – Court assessing agreement to ascertain parties’ obligations – Whether debtor/creditor lien in favour of respondent established – Court finding that, properly constructed, agreement between parties not affording respondent debtor/creditor lien over assets in question – Hence no clear right established by respondent – Court ordering respondent to surrender assets in question. *Diageo South Africa (Pty) Ltd v TTG Communications Group (Pty) Ltd* GJ case No 27069/23, **Juta 2023 JDR 1185 (GJ)** (Dippenaar J), 5 April 2023, 12 pages.

Interdict - Application for declaratory relief in respect of alleged defamation – Contention in letter of demand that applicant passing-off products sold in its stores as those of respondent and violating its trademarks – Respondent denying that statements defamatory because it was vindicating its rights and lacked intention to defame, alternatively arguing that they were published during course of a privileged occasion and therefore excluded wrongfulness – Court finding that interdictory proceedings inappropriate because award of damages at trial would constitute adequate redress in vindicating applicant’s reputation. *Evrigard (Pty) Ltd and Another v Select PPE (Pty) Ltd* GJ 44317/2021, **Juta 2023 JDR 1327 (GJ)** (Strijdom AJ), 25 April 2023, 6 pages.

Crossword puzzle

Across

- 3 A trademark is a name, _____ or picture that a company uses to distinguish itself
- 7 A trade secret on HOW something is manufactured
- 8 There is no difference between a trademarks and trade_____
- 9 Dance routines are called _____ works
- 11 You can get a PATENT for a product, process or composition of ...
- 12 Property that has been created by the mind
- 13 A patent for how something looks
- 15 The functional features of an invention

Down

- 1 An example of a trade secret
- 2 Books have copyright protection as a _____ work
- 3 Trade secrets also include computer _____
- 4 Another word for movie that is also copyrighted
- 5 Songs have copyright protection as a _____ work
- 6 An example of a trade secret
- 10 Exclusive right to make/use/sell an invention for a period of time
- 14 Information not generally known to the public that is protected

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Soduko Solution from March edition

1	5	6	2	3	9	7	8	4
7	4	3	8	5	6	9	2	1
9	8	2	1	4	7	5	6	3
3	7	5	4	1	2	8	9	6
6	1	4	9	7	8	2	3	5
2	9	8	3	6	5	4	1	7
4	6	9	7	8	3	1	5	2
5	2	1	6	9	4	3	7	8
8	3	7	5	2	1	6	4	9