Facilitating International Cooperation for the Protection of Traditional Knowledge: The Relevance of Mutual Recognition Agreements

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I. NEED FOR INTERNATIONAL COOPERATION

Traditional Knowledge, Traditional Cultural Expressions and Genetic Resources (collectively referred to herein as "Traditional Knowledge" or "TK") are protected under various national laws that include intellectual property law. Complementing these national legal regimes, the international community has over the years undertaken a number of initiatives, including model laws and recommendations on folklore, and provisions on cultural heritage and human rights. However, beginning with the Convention on Biological Diversity (CBD) in 1992, there is now international interest in a remedial solution premised on facilitating access to genetic resources in exchange for the sharing of benefits. The Nagoya Protocol is a concrete result of that interest, and current discussions in the Intergovernmental Committee on Traditional Knowledge at WIPO (IGC) have also included proposals on access and benefit sharing premised on the use of the intellectual property system.

While the national and international frameworks have improved the protection of traditional knowledge, there are still gaps in protection for which international cooperation would be necessary. This paper focuses specifically on difficulties with protecting traditional knowledge OUTSIDE the source country or country of origin - an issue not adequately tackled under the recent measures on TK.

Part of the problem stems from the territorial nature of intellectual property laws and other relevant laws which means that intellectual property rights granted in one country will not be recognized and enforced as such in other countries absent some applicable international arrangement. Thus, cases of infringement of intellectual property rights that have international dimensions are not being resolved satisfactorily. Some of these issues arise as well under the national legal systems that recognize and protect traditional knowledge.

Because the borders of some countries often cut through many ethnic communities, basing the protection of traditional knowledge on concepts of nationality poses unique problems with identifying the proper communities to control the national and foreign use of the traditional knowledge. For example, given that the Ewe community is straddled across both sides of the

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Ghana-Togo border, could work produced in Togo using the traditional knowledge of the Togolese Ewes that is also common to the Ghanaian Ewes be found to be a reproduction prohibited under Ghana law? Related to this problem is the question of control of the use of works of traditional knowledge abroad when those works are also common to ethnic groups spanning several countries. For example, kente cloth, which is widely used in the United States for making garments, ties, caps, bags, stoles, etc., is produced by the Ashanti, Ewe and Nzima communities found in Ghana, the Ivory Coast and Togo. While it is obvious that those communities have valid claims with respect to the use of their kente pieces abroad, it is unclear how and to what degree the relevant national governments can assert rights on behalf of their respective nationals. An international cooperation agreement could be used as the basis for developing reasonable solutions to these cross-border issues.

A common feature in the access and benefit sharing schemes of the CBD, the Nagoya Protocol, the African Model Law on access to TK and other regional frameworks is that they offer solutions that depend on contractual agreements as a method of regulating access to genetic resources. However, to the extent contract based solutions are largely domestic strategies, like intellectual property rights, they are inadequate for tackling certain problems associated with the use of genetic resources which have international dimensions. For example, the best drafted contract is meaningless if the user party who breaches the contract moves out the state where the contract was entered into to live in another country. Without cooperation from the second country, courts in the first country cannot acquire jurisdiction over the party to make him account for the breach.

Similar issues arise if the party moves out of the country to avoid paying a judgement issued against him for breach of an access and benefit sharing contract. Without cooperation again from the second country, it will be impossible to enforce the judgment.

Thirdly, if the party in breach of the contract acquires intellectual property rights in the second country related to the transferred genetic resources, again without the second state moving cooperatively to revoke the IP rights, the indigenous groups with ownership claims in the resource in general would have no adequate legal remedies. Their option may be to travel to the second state to initiate legal action which would be an unattractive option attendant with high costs and uncertainties given the indigenous groups lack of familiarity with foreign laws.

Fourth, where resources are found in more than one country, there is the potential danger of companies playing indigenous communities against each other to attract the lowest practices. An international or regional arrangement would discourage this by coming up with a predetermined formula for allocating benefits that result from the exploitation of such common resources.

Therefore, an international access scheme which imposes responsibilities on TK provider and user countries in terms of cooperation in connection with jurisdictional, enforcement, allocation of benefits and other matters will improve considerably the regulatory environment on traditional knowledge.

II. ALTERNATIVES TO A GLOBALLY BINDING TREATY ON TRADITIONAL KNOWLEDGE

However, some countries in the North are opposed to a legally binding instrument on traditional knowledge that will address these gaps in protection. While the countries see the need for international action, they would prefer the matter be addressed under guidelines or best practices and are therefore reluctant to make the specific commitments necessary for an effective protection of traditional knowledge. The tactics adopted by these countries at the IGC reveal a lukewarm, if not obstructionist attitude in the quest for solutions. No wonder that we are more than 10 years into the IGC process and the work is still incomplete.

The differing attitudes by developed and developing countries on TK suggests that a regional approach reflecting cooperation among like-minded countries has a greater chance of success than a more encompassing global treaty. To this end, countries that already recognize and protect traditional knowledge would enter into cooperation agreements to regulate uses of traditional knowledge. This could entail the adoption of separate and flexible mechanisms between interested TK source countries and user countries, focusing on the particular types of traditional knowledge for which protection is required, as well as the form of protection that makes sense from the perspective of the participating countries. Such cooperation agreements, unlike international treaties, would be more flexible mechanisms to address specific TK user country concerns that have contributed to the reluctance of certain countries to commit to the protection of traditional knowledge .

III. MUTUAL RECOGNITION AGREEMENTS AS A POLICY RESPONSE

1. Relevance of the Principle of Reciprocity

What should be the basis for recognising and protecting TK under such cooperation arrangements? Two important principles to consider in this regard are national treatment and reciprocity.

National treatment, which is a principle of non-discrimination, holds that an eligible foreign right holder should enjoy the same rights as domestic nationals. On the other hand, under reciprocity or reciprocal recognition, whether a country grants protection to nationals of a foreign country depends on whether that country in turn extends protection to nationals of the first country. Reciprocity requires Country A to recognize the rights of nationals from Country B residing in Country A only where Country B also recognizes the rights of nationals of Country A resident in Country B.

Protection of traditional knowledge on the basis of reciprocity offers the possibility of fuller protection for TK rights holders in user countries than protection on the basis of national treatment, especially where the user countries do not have adequate laws on TK. Under the

principle of reciprocity, Country A may recognize and enforce the traditional knowledge rights of a person from Country B even where Country A does not recognize such rights under its domestic (national) laws. This flexibility of the reciprocity approach makes it suitable for the protection of traditional knowledge in countries that have been reluctant to sign on to a broad and binding international scheme that might require changes in their domestic laws. Thus, under the reciprocity principle, those countries could still commit to protecting foreign traditional knowledge without making such changes.

As an implicit endorsement of the principle, one of the early model intellectual property instruments advocated by both WIPO and UNESCO emphasized the need to protect traditional knowledge on the basis of reciprocity. Specifically, the Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and Other Prejudicial Actions required that "[e]xpressions of folklore developed and maintained in a foreign country [be] protected . . . subject to reciprocity." (Paragraph 14). Similarly, the principle of reciprocity is incorporated in Article 13 of UNESCO's Illicit Trade Convention, which enables an aggrieved signatory party to file claims, based on its domestic cultural property laws, in another signatory state to recover cultural property illegally removed from the complainant's jurisdiction. Thus, incorporation of the principle of reciprocity in a regional or international cooperation agreement would be consistent with international practice.

2. Reciprocity and Mutual Recognition Agreements

An increasingly popular application of the reciprocity principle is found in Mutual Recognition Agreements (MRAs). MRAs have been used particularly in cases where harmonization of different trade international standards have proved difficult. In general, mutual recognition agreements are easier to negotiate than efforts to harmonize regulatory regimes. Unlike harmonization, which requires jurisdictions to make their regulations identical or at least more similar, MRAs can permit entry and sale of products or services without requiring fundamental regulatory convergence. A potential benefit of MRAs is that principles agreed upon under MRAs could form the basis of an international agreement open to other countries.

Similarly, participation by developing countries in mutual recognition agreements on TK could influence the adoption of future international instruments on the subject. Indeed, the African Group at WIPO has advocated the use of mutual recognition agreements in relation traditional knowledge.

Certain features of the MRA make it worth pursuing as a mechanism for the protection of traditional knowledge. Unlike an agreement based on national treatment, an MRA can be negotiated and implemented where the regulatory systems differ, as when one country provides for rights not recognized in the other. Thus, Country A could agree to recognize and protect traditional knowledge rights from Country B on the basis of an agreement reached between the two countries, even though the former does not have laws respecting traditional knowledge.

3. Scope of Mutual Recognition Agreements on Traditional Knowledge

The principal objective of an MRA would be to create a suitable environment in the TK user country to facilitate access to, as well as prevent the misappropriation of, traditional knowledge originating from the source country or source countries party to the MRA. To assuage TK user country concerns about difficulties in identifying traditional knowledge and the appropriate methods of regulating it, the MRA should carefully delineate the scope of protectible matter and clarify the general customary law principles that govern access, including prior informed consent and benefit sharing requirements and other obligations that could be imposed on users by indigenous rights holders. It will also be necessary to specify the prohibited acts of misappropriation with respect to which sanctions would be sought in the TK user country.

To ensure the effectiveness of the MRA, it is of vital importance that a central agency is established in the TK user country to administer the MRA's provisions. (TK Agency) A principal role of the TK Agency would be to articulate, assert and defend the traditional knowledge rights of the TK source country subject to exploitation in the TK user country. A second role of the TK Agency would be to act as the conduit either for processing requests to use traditional knowledge received from interested persons in TK user country, or passing to the TK source country benefits received from uses of TK in the TK user country.

The MRA should provide a general definition as well as an illustrative list of categories of traditional knowledge to be regulated under the agreement. It is equally important to qualify the definition with a provision that the determination whether a particular item or practice of traditional knowledge was covered by the MRA for purposes of authorizing access or enforcing traditional knowledge rights in the TK user country would be made by the TK Agency in consultation with the TK source country.

It would be useful to require in the MRA that applications in the TK user country for access to traditional knowledge be directed to the TK Agency to be forwarded to the traditional knowledge source country or source countries unless the TK Agency is also authorized to provide consent for the particular type of traditional knowledge.

The MRA should recognize the right of the traditional knowledge source countries or the TK Agency to impose reasonable obligations or conditions on applicants for access to traditional knowledge. Such obligations may include the disclosure to the TK Agency of significant commercial uses of traditional knowledge and any intellectual property sought or obtained in connection therewith. To help enforce these obligations as they relate to intellectual property rights, the TK user country could require patent offices to reject applications for patents derived from traditional knowledge, the transfer of which to the TK user countries was not certified by the TK Agency or traditional knowledge source country as being in compliance with national requirements governing access and benefit sharing.

The description of prohibited acts of misappropriation of traditional knowledge should include the unauthorized acquisition and use of traditional knowledge or obtaining commercial benefits from the acquisition and use of traditional knowledge, when the person has reason to know or

ought to have known that it was improperly acquired. As an illustration, the MRA might refer to the following as acts of misappropriation: (a) the acquisition of protected traditional knowledge by theft, fraud, or other illegal and unfair means; (b) failure to comply with prior informed consent procedures governing acquisition and use of traditional knowledge; (c) failure to comply with benefit sharing arrangements or provide appropriate compensation to the relevant holders for commercial uses of traditional knowledge, especially where benefits were realized from such utilization; (d) use of traditional knowledge in violation of the terms of any contract governing access to traditional knowledge, executed either in the TK user country or the source countries; (e) misrepresentations that a product or service is authentic traditional knowledge; and (f) distortion or use of an item of traditional knowledge in a way prejudicial to the honor, dignity or cultural interests of the community in which it originates.

Effective enforcement systems would be critical to the use of the MRA for the protection of traditional knowledge. At a minimum, the MRA should permit rights holders in the traditional knowledge source countries through the TK Agency to file lawsuits in the TK user country to protect their rights. This type of right is not novel and is found in several cultural heritage instruments. Sanctions for unauthorized uses of traditional knowledge may include injunctive relief, seizure and forfeiture of infringing material, accounting for profits, damages, attorneys' fees, and costs. Criminal penalties such as jail terms should also be considered for very egregious cases.

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