

PROTECTION FOR MICROORGANISM IN THE NEW INDONESIAN PATENT LAW

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Abstract

The international agreement that has implications on IPR linked to living species and materials of relevance to the propagation of living species. Regulation regarding protection for microorganism has not been regulated in Indonesia. However, based on data from the Directorate General of the Intellectual property there has been 40 (forty) patent application filed in the last 25 years.

Indonesia has not yet become a member of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. Such microorganisms would no doubt satisfy the criteria of novelty, inventive steps, and usefulness for industrial applications.

This article highlights the main changes of the new Indonesian Patent regarding the protection of patent for the microorganism. Indonesia is not yet to address the specific court case regarding microorganism.

Keywords: (Convention of Biodiversity (CBD), Budapest Treaty, Law of the Republic of Indonesia Number 7 of Year 1994 regarding the Ratification of the Agreement Establishing the World Trade Organization, Presidential Decree of the Republic of Indonesia Number 16 of Year 1997 regarding the Ratification of Patent Cooperation Treaty (PCT) and Regulations under the PCT, Presidential Decree of the Republic of Indonesia Number 15 of Year 1997 regarding the Amendment of Presidential Decree of the Republic of Indonesia Number 24 of Year 1979 regarding the Ratification of Paris Convention for the Protection of Industrial Property dan Convention Establishing the World Intellectual Property Organization, Law Number 5 of Year 1994 regarding the Ratification of United Nations Convention on Biological Diversity (Konvensi Perserikatan Bangsa-bangsa mengenai Keanekaragaman Hayati), The Nagoya Protocol on ABS, Law Number 29 of 2000 concerning Plant Variety Protection, Law Number 13 of Year 2016 regarding Patent, Government Regulation of the Republic of Indonesia Number 34 of Year 1991 regarding the Patent Application Procedures, the Government Regulation of the Republic of Indonesia Number 34 of Year 1991 regarding the Patent Application Procedures).

I. Introduction

There are several interrelated international agreements that have implications on IPR linked to living species and materials of relevance to the propagation of living species, namely: TRIPs Agreement (patents and protection of new plant varieties), Convention of Biodiversity (CBD),¹ Budapest Treaty,² and Indonesia is a country with huge genetic resources³ having the biggest challenge protecting its biological heritage and the IP derived from the same. Indonesia ratified the Nagoya Protocol on May 8, 2013 by virtue of Law Number 11 of 2013 regarding the Ratification of Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization (ABS) to the Convention on Biological Diversity. This article highlights the main changes of the new Indonesian Patent regarding the protection of patent for microorganism.

II. Patent Protection for Microorganism

There have been 29 (twenty nine) patents granted for microorganism out of 40 (forty) patent applications filed from August 1, 1991 until November 1, 2016 at the Directorate General of Intellectual property, Ministry of Law and Human Rights of the Republic of Indonesia.⁴ There are several international conventions and agreement related to Patent that Indonesia is a party, namely: (1) Agreement on Trade Related Aspects of Intellectual Property Rights (ratified by Law Number 7 of 1994 regarding the Ratification of the Agreement Establishing the World Trade Organization;⁵ (2) Patent Cooperation Treaty;⁶ (3) Paris Convention

¹ Please see Article 8 letter (j), Article 15, Article 16, Article 17, and Article 18 of Biological Diversity Convention.

² Indonesia has not yet become a member of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

³ Downloaded from <http://lipi.go.id/berita> on March 6, 2017. Currently LIPI has a collection of 1.800 microbes at laboratorium Herbarium Bogoriense, Cibinong, Indonesia.

⁴ Source of data is obtained from the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia on November 1, 2016.

⁵ Please see Law of the Republic of Indonesia Number 7 of Year 1994 regarding the Ratification of the Agreement Establishing the World Trade Organization (Persetujuan Pembentukan Organisasi Perdagangan Dunia).

⁶ Please see Presidential Decree of the Republic of Indonesia Number 16 of Year 1997 regarding the Ratification of Patent Cooperation Treaty (PCT) and Regulations under the PCT.

for the Protection of Industrial Property;⁷ (4) United Nations Convention on Biological Diversity (ratified by Law Number 5 of 1994 regarding the Ratification of the United Nations Convention on Biological Diversity);⁸ (5) the Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization (ABS) to the Convention on Biological Diversity is a supplementary agreement to the Convention on Biological Diversity.⁹

Article 27.3 of TRIPs Agreement, covers provisions that allow members to exclude from patentability inventions related to diagnostic, therapeutic and surgical methods for the treatment of humans or animals. It also allows the exclusion of plants and animals, other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, members shall provide for the protection of plant varieties either by patents or by an effective sui generis system or any combination thereof.¹⁰ A particular category of biotechnological inventions, namely, inventions concerning microorganisms, is governed by special provisions. The TRIPs Agreement under Article 27 paragraph 3 (b) states that it is obligatory to provide patent protection for 'microorganisms' and 'microbiological processes'. Patentable Microorganisms could be considered to be those that have been produced by human interventions, where the interventions are unobvious and further that they do not involve an essentially biological process. Such microorganisms would no doubt satisfy the criteria of novelty, inventive steps and usefulness for industrial applications. Such patentable microorganisms may include the transgenic viruses, su-viral particles, plasmids, bacteria, actinomycetes, yeast, fungi, and parasites.

The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

Indonesia is not a member of Budapest Treaty. A Member State which allows or requires the deposit of microorganisms for the purposes of patent procedure must recognize, for such purpose, one deposit of a microorganism with any IDA, irrespective of its location. These depositories are required to store a variety of microorganisms, animal viruses, fungi, cell cultures, moulds, yeasts, plasmids, protozoa, seeds, animal embryos, etc. for at least 5 (five) years after the most recent request for a sample and at least 30 years after the most recent request for a sample, and at least 30 years after the original date of receipt of the deposit. The sample in a specified form and condition is to be deposited to an IDA while applying for a patent.¹¹ Every patent office has its defined procedures. PCT also has a set of guidelines for deposit of samples to IDAs with PCT applications.

Indonesian New Patent Law

The old Patent Law Number 14 of 2001 has been amended significantly in light of recent developments in the field of IP and is in conformity with the international standards of the TRIPs Agreement, including the scope of simple patent protection which has been broader include process, use, composition, and product. However, it may be noted that plants and animals and even their parts have been excluded from patentability confining microorganisms as the only biological resource as per definition ratified by Law Number 5 of 1994 regarding the Ratification of the United Nations Convention on Biological Diversity within the scope of patentability.

The new Indonesian Patent Law Number 13 of 2016 stipulates that a patent shall not be granted to an Invention regarding:¹² (a) any process or product of which the announcement and use or implementation contravenes the prevailing rules and regulations, religions, public order or ethics; (b) any method of examination, treatment, medication, and/or surgery applied to humans and/or animals; (c) any theory and method in the field of science and mathematics; (d) all living creatures,¹³ except microorganism; or (e) any biological process which is essential in producing plant or animal, except non-biological processes or microbiological processes. Moreover, the new Indonesian Patent Law stipulates the obligation for the Applicant to clearly and correctly state the origin of genetic resources and/or traditional knowledge in the patent description: (1) if the invention is related to and/or originates from genetic resources and/or traditional knowledge; (2) information on genetic resources and/or traditional knowledge is determined by an official institution recognized by the government; (3) sharing of results and/or access of the utilization of genetic resources and/or traditional knowledge according to the rules and regulations and international agreements in the field of genetic resources and traditional knowledge.

⁷ Please see Presidential Decree of the Republic of Indonesia Number 15 of Year 1997 regarding the Amendment of Presidential Decree of the Republic of Indonesia Number 24 of Year 1979 regarding the Ratification of Paris Convention for the Protection of Industrial Property dan Convention Establishing the World Intellectual Property Organization.

⁸ Please see Law Number 5 of Year 1994 regarding the Ratification of United Nations Convention on Biological Diversity (Konvensi Perserikatan Bangsa-bangsa mengenai Keanekaragaman Hayati).

⁹ *The Nagoya Protocol provides a transparent legal framework for the effective implementation of one of the three objectives of the CBD: the fair and equitable sharing of benefits arising out of the utilization of genetic resources. The Nagoya Protocol on ABS was adopted on 29 October 2010 in Nagoya, Japan and entered into force on 12 October 2014, 90 days after the deposit of the fiftieth instrument of ratification. Its objective is the fair and equitable sharing of benefits arising from the utilization of genetic resources, thereby contributing to the conservation and sustainable use of biodiversity.*

¹⁰ In Indonesia, the Patent Laws exclude plant variety from patenting. Plant variety protection is governed by the sui generis method, under Law Number 29 of 2000 concerning Plant Variety Protection.

¹¹ Id.p. 131.

¹² Please see Article 9 of Law Number 13 of Year 2016 regarding Patent.

¹³ Living creatures, including human, animal or plant, while the microorganisms are living organisms that are very small and can not be seen by the naked eye but should be, with the help of a microscope, for example amoeba, yeast, viruses, and bacteria.

The new Patent Law stipulates that if the Applicant does not clearly and correctly state the origin of genetic resources and/or traditional knowledge, the Patent shall be invalidated through the Commercial Court filed by third party against the Patent Holder.

Article 18 of the Government Regulation Number 34 of 1991 regarding the Patent Application Procedures stipulates that:¹⁴

- (1) In the event that the description regarding an invention related to a certain microorganism, while said microorganism is not possible to be disclosed or available to the public at the time of filing the Patent Application, therefore such a description is still acceptable if said description completely disclosed and clearly explains the use of the microorganism and as far as the requirements have been fulfilled:
- a. sample of said microorganism has been delivered to be stored at the microorganism institution which has been acknowledged by the Patent Office before patent application was filed or before the filing date of patent application is received;
 - b. said Patent Application includes sufficient explanation regarding the characteristics of the relevant microorganism;
 - c. name of microorganism, date of its submission to be deposited, name of the institution and said microorganism's storage number mentioned in the description of the relevant patent application;

Furthermore, Article 18 paragraph (2) of the Government Regulation Number 34 of 1991 regarding Patent Application Procedures stipulates that if the name of the microorganism, date of its submission to be deposited, name of the institution and said microorganism's deposit number are not mentioned in the description of the relevant patent application, therefore that requirement must be submitted to the Patent Office, at the latest 3 (three) months from the date of acceptance of the patent application. The submittance regarding the microorganism, as referred to the above, is considered as the consent without condition from the person applying for patent to any body that is at or after the publication of the patent application, applying in writing to the Patent Office asking for a sample of the deposit of the relevant microorganism. Although the person who is applying for a patent is considered to have agreed to give the sample of microorganism if there is a person who is requesting a sample of microorganism, the issuance of the relevant sample by the depository institution requires written permission from the Patent Office.¹⁵ The above mentioned institution or depository institutions of the sample of microorganism are the institutions recognized according to the Budapest Treaty of 1980 (*Budapest Treaty on the International Recognition of Deposit of the Microorganism*).¹⁶

III. Conclusion

Indonesia is not yet a party to the Budapest Treaty and has no institution for the deposit of microorganisms with international standards where a depository is needed to comply with the descriptive requirement from the Patent Law for inventions related to microorganisms or the use of microorganisms based on the Budapest Treaty. The protection of biological resources, their access and regulation along with application of benefit sharing principles are still in the process of discussion among related government institution and the draft of Law regarding the Traditional Knowledge and Expression of Traditional Culture is also in the process of finalizing. There have not been any court cases specific to IP on biological diversity, and the recognition of bioresources as intellectual property is being appreciated and the awareness of rights is increasing as well in Indonesia.

¹⁴ Please see Article 18 of Government Regulation of the Republic of Indonesia Number 34 of Year 1991 regarding the Patent Application Procedures.

¹⁵ Please see the Elucidation of Article 18 para 3 of Government Regulation of the Republic of Indonesia Number 34 of Year 1991 regarding the Patent Application Procedures.

¹⁶ Please see Article 19 paragraph 3 of Government Regulation of the Republic of Indonesia Number 34 of Year 1991 regarding the Patent Application Procedures.