

Part IV
IMPLEMENTING AN INTELLECTUAL
PROPERTY STRATEGY



Following Through with an IP Option

If potential IPR options were identified while working through the exercises in this handbook, it is now time to discuss ways to implement these options. Before continuing, make sure the community has reviewed and understands the advantages, disadvantages, and criteria relating to any selected IPR option(s).

The next step is work with other members of the community in order to evaluate the possible benefits or consequences of an IPR option. First, identify how the IPR will be used. Do not lose sight of the cultural aspects and community goals identified when selecting the option. Look at the long-term implications of the selection. How will this decision impact the local community in both the short-term and long-term? Is it a sustainable option or only short-term? What will the community do after the IPR protection expires? Make sure that all of the knowledge stakeholders are aware of the decision. Communicating the impact of the decision to the local community and stakeholders is very important.

For some options, it may be necessary to form an official organization that is legally recognized in the country of origin to which all members of the community will be members. This can be especially useful when filing a patent application. This organization will be deemed the "assignee" to the invention. Everyone designated as part of the origin of the knowledge in the community is then an owner of the patent (not an individual).

Designate an IPR Committee Group for the Community

Addressing IPRs for TK can be a very large task for a community. It may be helpful to designate a committee that deals specifically with TK and IPR decisions for the community. This committee may help to organize community meetings, conduct voting among community members, collect TK, and follow-up on community IPR decisions. When creating this committee, it is important to remember that TK belongs to everyone in the community and everyone has the right to voice their opinion and benefit from their TK.

It may also be helpful to engage in community networking outside the local community (without disclosing the knowledge). Look at methods and results of other groups that have used the same IPR option for their local community. How did they approach the option? Were they successful? If not, what did not work? How can the implementation of the IPR option be improved?

Important!

Obtaining Professional Intellectual Property Counsel

It is important to always seek the guidance of intellectual property professionals that are familiar with your state's legislation and can provide specific advice for your community and traditional knowledge. Many lawyers can assist you in your intellectual property endeavors. Public Interest Intellectual Property Advisors (PIIPA) is a new non-profit referral service helping developing country clients find intellectual property professionals who are willing and able to represent them in intellectual property matters as a public service.

For more information, visit their web site at:
<http://www.piipa.org/>

After considering all aspects of the decision, follow it through! Contact the necessary organizations or offices to implement the solution. Also, be aware that local, national, or international organizations (either governmental or non-governmental) may be able to provide technical or legal support and you may wish to consult with any applicable organizations as you begin to pursue the IPR option.

Suggestions when forming an Indigenous IP Committee

1. Choose team members according to skills, but respect local social and authority structures.
2. Become legally recognized.
3. The community itself selects its own representatives.
4. Help outsiders communicate with the community.

Suggestions from: Integrating Indigenous Knowledge in Project Planning and Implementation, Alan R. Emery (CIDA PUBLICATION) pages 58-59

Exercise 4 – Follow Through with an IP Option

The next section of the handbook will assist communities in organizing an action plan for the IPR option(s) selected. A simple series of worksheets featuring the three-step “Brainstorm, Designate & Do” method will help the community to think through the full implementation of the IPR option. On the first worksheet, the reader will recall the previously identified cultural aspects and community goal categories, as well as the overall goal of developing an IPR management strategy. On the second worksheet, the reader should think through the long-term timeline of the selected IPR option. The third worksheet will assist in the designation of responsibility and the formulation of a plan of action for implementing the IPR option. The subsequent pages then provide a “Do” worksheet for each of the options, as well as a checklist of possible actions to pursue in relation to the selected IPR option.

Worksheet Series 4

Following Through with an IP Option

Three Steps:

- Brainstorm
- Designate
- Do

Brainstorm

IPR Option Selected: _____

Cultural and Interest Evaluation Categories Cited:

Overall Community Goal/Purpose in Selecting this IPR Option:

What will the impact be for our community...

In **ONE** year?

In **FIVE** years?

In **FIFTEEN** years?

In **TWENTY-FIVE** years?

In terms of **SUSTAINABILITY**?

Designate

Should a Traditional Knowledge Community Committee Group be established?

- How many people does the traditional knowledge claim impact?
- Are they all represented?
- Is there a need for organization within the community relating to the decision?

How should the Traditional Knowledge Community Committee Group be established?

- How should members be selected?
- Who is skilled in the knowledge area?
- What is the current socio-political structure within the community?

What tasks should the Traditional Knowledge Community Committee Group be in charge of performing?

- Planning Community Meetings?
- Organizing knowledge?
- Communicating with outside organizations?
- Conducting voting?
- Collecting TK?
- Following through with community IPR decisions?
- Gaining legal representative status?

Plan of Action:

Do

Each IPR Option has a “Do” worksheet that serves as a checklist of suggested follow-through steps in order to carry out the selected IPR option. The sheets are in the following order:

1. Patent [Utility, Petty, Plant, Plant Variety Protection]
2. Trade Secret
3. Public Registry
4. Private Registry
5. Conservation Area
6. Access & Benefit Sharing
7. Geographical Indicators
8. Trademarks

Do – Patent [Utility - Petty Patent – Plant Variety Protection – Plant Patent]

- Contact a patent lawyer or agent for advice and assistance in the filing process.
- Decide what types of patent applications are available (e.g. domestic, international) and if the community wants to file a PCT application making the patent valid in several countries. This is only available for invention/innovation patents.
- File patent application.
- Begin planning stages for the implementation of the patent (if approved).
- How will the community develop the patent? Does the community have the resources to protect against infringement?

Do – Trade Secret

- Remind the community that the knowledge must be kept a secret.
- Consider establishing a fund for the indigenous community (in order to receive royalty payments).
- Designate guidelines for the use of the funds derived from the trade secret.
- Find a company interested in the knowledge.
- Develop a contract with a lawyer; make use of WIPO clauses and clauses/ideas for contracts found in this publication.

Do – Public Registry

- Designate community members to collect and document the knowledge.
- Select a database or design a new database.
- Inform the various national patent office(s) about the database.
- Make use of the documentation guidelines set forth in the handbook.

Do – Private Registry

- Designate community members to collect, document, and maintain the TK.
- Inform the patent offices about the private registry if the local community wishes to grant them confidential access (assuming the documentation is capable of serving as prior art through a *sui generis* mechanism).
- Document relevant TK.

Do – Conservation Area

- Have a community meeting to decide the type of area and location that would best serve the community. Consult *Figure 3, Matrix of Management Objectives and IUCN Protected Area Management Categories* in this handbook.
- Contact outside advisors if necessary.
- Contact government officials with a proposal.

Do – Access & Benefit Sharing

- Decide upon the guidelines for access to the knowledge and identify the people and/or organization that will be granted access.
- Decide upon the extent to which the knowledge may be used.
- Decide on acceptable benefit sharing guidelines.
- Contact a lawyer (and other advisory organizations if necessary) to decide upon and draft a contractual agreement. Make use of WIPO contractual clauses and ideas presented in this publication.
- Develop contractual agreement.

Do – Geographical Indicators

- Decide what knowledge should be protected due to its geographical origin. Establish the qualities associated with the knowledge based on its geographical origin.
- Contact a lawyer for advice and assistance registering the geographical indicator (if possible).
- Document the geographical indicator in the public domain as known if there is no official registration process.
- Enforce the geographical indicator if it is violated.

Do – Trademarks

- Decide what knowledge should be protected due to through the trademark. Establish the qualities specific to the product bearing the trademark.
- Design a distinguishing and new trademark using any combination of words, pictures, symbols, phrases, etc.
- Contact a lawyer for advice and assistance registering the trademark.
- Use the trademark to distinguish products based on traditional knowledge as a “value-added.”
- Consider licensing the trademark.
- Enforce the trademark if it is violated.

Annex 1 – Patent Cooperation Treaty Members (As of April 2002)

Albania	Iceland	Tajikistan
Algeria	India	The former Yugoslav
Antigua and Barbuda	Indonesia	Republic of Macedonia
Armenia	Ireland	Togo
Australia	Israel	Trinidad and Tobago
Austria	Italy	Tunisia
Azerbaijan	Japan	Turkey
Barbados	Kazakhstan	Turkmenistan
Belarus	Kenya	Uganda
Belgium	Kyrgyzstan	Ukraine
Belize	Latvia	United Arab Emirates
Benin	Lesotho	United Kingdom
Bosnia and Herzegovina	Liberia	United Republic of Tanzania
Brazil	Liechtenstein	United States of America
Bulgaria	Lithuania	Uzbekistan
Burkina Faso	Luxembourg	Viet Nam
Cameroon	Madagascar	Yugoslavia
Canada	Malawi	Zambia
Central African Republic	Mali	Zimbabwe
Chad	Mauritania	
China	Mexico	
Colombia	Monaco	
Congo	Mongolia	
Costa Rica	Morocco	
Côte d'Ivoire	Mozambique	
Croatia	Netherlands	
Cuba	New Zealand	
Cyprus	Niger	
Czech Republic	Norway	
Democratic People's Republic of Korea	Oman	
Denmark	Philippines	
Dominica	Poland	
Ecuador	Portugal	
Equatorial Guinea	Republic of Korea	
Estonia	Republic of Moldova	
Finland	Romania	
France	Russian Federation	
Gabon	Saint Lucia	
Gambia	Senegal	
Georgia	Sierra Leone	
Germany	Singapore	
Ghana	Slovakia	
Greece	Slovenia	
Grenada	South Africa	
Guinea	Spain	
Guinea-Bissau	Sri Lanka	
Hungary	Sudan	
	Swaziland	
	Sweden	
	Switzerland	

Annex 2 – Member States to the Convention on Biological Diversity

Afghanistan	Djibouti
Albania	Dominica
Algeria	Dominican Republic
Angola	Ecuador
Antigua and Barbuda	Egypt
Argentina	El Salvador
Armenia	Equatorial Guinea
Australia	Eritrea
Austria	Estonia
Azerbaijan	Ethiopia
Bahamas	European
Bahrain	Community
Bangladesh	Fiji
Barbados	Finland
Belarus	France
Belgium	Gabon
Belize	Gambia
Benin	Georgia
Bhutan	Germany
Bolivia	Ghana
Bosnia and Herzegovina	Greece
Botswana	Grenada
Brazil	Guatemala
Brunei Darussalam	Guinea
Bulgaria	Guinea-Bissau
Burkina Faso	Guyana
Burundi	Haiti
Cambodia	Holy See
Cameroon	Honduras
Canada	Hungary
Cape Verde	Iceland
Central African Republic	India
Chad	Indonesia
Chile	Iran
China	(Islamic Republic of)
Colombia	Iraq
Comoros	Ireland
Congo	Israel
Cook Islands	Italy
Costa Rica	Jamaica
Côte d'Ivoire	Japan
Croatia	Jordan
Cuba	Kazakhstan
Cyprus	Kenya
Democratic People's Republic of Korea	Kiribati
Democratic Republic of the Congo	Kuwait
Denmark	Kyrgyzstan
	Lao People's Democratic Republic
	Latvia
	Lebanon

Lesotho
Liberia
Libyan Arab Jama-
hiriya
Liechtenstein
Lithuania
Luxembourg
Madagascar
Malawi
Malaysia
Maldives
Mali
Malta
Marshall Islands
Mauritania
Mauritius
Mexico
Micronesia
(Federated
States of)
Monaco
Mongolia
Morocco
Mozambique
Myanmar
Namibia
Nauru
Nepal
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Niue
Norway
Oman
Pakistan
Palau
Panama
Papua New Guinea
Paraguay
Peru
Philippines
Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Russian Federation
Rwanda
Saint Kitts and Nevis
Saint Lucia
Saint Vincent and the

Grenadines
Samoa
San Marino
Sao Tome and
Principe
Saudi Arabia
Senegal
Seychelles
Sierra Leone
Singapore
Slovak Republic
Slovenia
Solomon Islands
Somalia
South Africa
Spain
Sri Lanka
Sudan
Suriname
Swaziland
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The Former
Yugoslav Republic
of Macedonia
Togo
Tonga
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Tuvalu
Uganda
Ukraine
United Arab Emirates
United Kingdom
of Great Britain and
Northern Ireland
United Republic of
Tanzania
United States of
America
Uruguay
Uzbekistan
Vanuatu
Venezuela
Viet Nam
Yemen
Yugoslavia
Zambia
Zimbabwe

Annex 3 – Member States to the Agreement on Trade Related Aspects of Intellectual Property (TRIPs)

Albania	Ghana	Oman
Angola	Greece	Pakistan
Antigua and Barbuda	Grenada	Panama
Argentina	Guatemala	Papua New Guinea
Australia	Guinea Bissau	Paraguay
Austria	Guinea	Peru
Bahrain, Kingdom of	Guyana	Philippines
Bangladesh	Haiti	Poland
Barbados	Honduras	Portugal
Belgium	Hong Kong, China	Qatar
Belize	Hungary	Romania
Benin	Iceland	Rwanda
Bolivia	India	Saint Kitts and Nevis
Botswana	Indonesia	Saint Lucia
Brazil	Ireland	Saint Vincent & the Grenadines
Brunei Darussalam	Israel	Senegal
Bulgaria	Italy	Separate Customs Ter- ritory of Taiwan, Pen- ghu, Kinmen and Ma- tsu
Burkina Faso	Jamaica	Sierra Leone
Burundi	Japan	Singapore
Cameroon	Jordan	Slovak Republic
Canada	Kenya	Slovenia
Central African Republic	Korea, Republic of	Solomon Islands
Chad	Kuwait	South Africa
Chile	Kyrgyz Republic	Spain
China	Latvia	Sri Lanka
Colombia	Lesotho	Suriname
Congo	Liechtenstein	Swaziland
Costa Rica	Lithuania	Sweden
Côte d'Ivoire	Luxembourg	Switzerland
Croatia	Macao, China	Tanzania
Cuba	Madagascar	Thailand
Cyprus	Malawi	Togo
Czech Republic	Malaysia	Trinidad and Tobago
Democratic Republic of the Congo	Maldives	Tunisia
Denmark	Mali	Turkey
Djibouti	Malta	Uganda
Dominica	Mauritania	United Arab Emirates
Dominican Republic	Mauritius	United Kingdom
Ecuador	Mexico	United States of Amer- ica
Egypt	Moldova	Uruguay
El Salvador	Mongolia	Venezuela
Estonia	Morocco	Zambia
European Community	Mozambique	Zimbabwe
Fiji	Myanmar	
Finland	Namibia	
France	Netherlands	
Gabon	New Zealand	
The Gambia	Nicaragua	
Georgia	Niger	
Germany	Nigeria	
	Norway	

**Annex 4 – Member States to the Convention for the
Protection of New Plant Varieties (UPOV)**

Argentina	Kyrgyzstan
Australia	Mexico
Austria	Netherlands
Belgium	New Zealand
Bolivia	Nicaragua
Brazil	Norway
Bulgaria	Panama
Canada	Paraguay
Chile	Poland
China	Portugal
Colombia	Republic of Korea
Croatia	Republic of Moldova
Czech Republic	Romania
Denmark	Russian Federation
Ecuador	Slovakia
Estonia	Slovenia
Finland	South Africa
France	Spain
Germany	Sweden
Hungary	Switzerland
Ireland	Trinidad and Tobago
Israel	Ukraine
Italy	United Kingdom
Japan	United States of America
Kenya	Uruguay

Endnotes

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