

## D.C. Team Gets to the Root of the Problem

Pro bono lawyers challenge N.J. company's patents involving tubers used for centuries by indigenous Peruvians.

BY ALICIA UPANO

In Inca folk medicine, the maca tuber has been used for ages as a natural Viagra.

So when a New Jersey company in 1999 snagged the first in a series of U.S. patents related to maca's qualities as an aphrodisiac, a coalition of public and private Peruvian organizations cried foul.

Now, **Sterne Kessler Goldstein & Fox** managing partner Jorge Goldstein has taken on pro bono representation of the coalition, the Working Group on Maca. At issue: whether the patents misappropriate indigenous know-how and close off the U.S. market to maca exports.

Goldstein landed the assignment through the newly formed **Public Interest Intellectual Property Advisors**, or PIIPA, an international nonprofit founded by D.C.-based **Venable** partner Michael Gollin. It's the first case brought under PIIPA's auspices in the United States.

Though Goldstein is still in the final stages of examining the patents, he says the Working Group on Maca now has a couple of legal options: attempt to revoke existing patents through re-examination at the U.S. Patent and Trademark Office or add an inventor to the patent—a method in which Goldstein says a tribe or shaman that provided traditional knowledge could share patent ownership with the company.

Gollin says Goldstein was a natural fit for the case because "he was the only bilingual biopatent attorney of his caliber that I know."

Goldstein, born in Buenos Aires, is utilizing both his language and biopatent skills in the case. With the Working Group on Maca, he has collected a plethora of literature on the root, *lepidium meyenii*, which is grown in the Andes and sold in the marketplaces of Lima. Maca can be cooked like potatoes and eaten as a side dish by adults. According to folk medicine, maca can also stimulate fertility—curing sexually dysfunctional men and women.

Much of the maca-related literature and documents had not been translated from Spanish and was unknown to the PTO. The existence of such material, known as prior art, could provide grounds to invalidate the patent.

The PTO awarded South Hackensack, N.J.-based PureWorld Botanicals four patents on different uses of the root, including remedies for sexual dysfunction, as well as methods of maca preparation. Several patents are pending, Goldstein says.

Dr. Quanyi Zheng of PureWorld Botanicals could not be reached for comment.

Beyond the maca case, Goldstein says he hopes other IP lawyers will get involved with PIIPA "in the interest of worldwide fairness."

"What we're trying to do is make sure no one gets exploited," Goldstein says. "There is a wide world of pro bono work, if we sort of look beyond our national boundaries."

PIIPA matches lawyers and clients through referrals. The organization plans to work in the areas of health care, agriculture,



JEROME BLACK/HERBS AMERICA

**DEFENDING TRADITION:** The maca root, used by the indigenous people of Peru, is the subject of a legal fight in the United States.

biodiversity, environmental protection, traditional knowledge, scientific research, and technology.

"[Intellectual property] is incredibly crucial to development, so you need access to the experts to deal with it, and you need to deal with it to have a fair stake in the economy," Venable's Gollin says.

Although Gollin launched PIIPA in 2002 and has already appointed an international advisory committee, recruited lawyer volunteers, and received grant money to expand, he says he has merely set the foundation of what PIIPA will ultimately become.

If things go as planned, thousands of IP lawyers like Goldstein will create a worldwide corps committed to providing free legal counsel and to leveling the IP playing field between the developed and developing worlds.

Among contributors to the group are Venable and **Sidley Austin Brown & Wood**. PIIPA was also recently awarded a \$35,000 International Cooperative Biodiversity Groups grant through the National Institutes of Health that will help fund programs in developing countries including Madagascar, Samoa, and Papua New Guinea. The United Kingdom Department for International Development has also pledged to match donations to PIIPA, up to 150,000 pounds (about \$250,000) a year for the next three years.

Perhaps because pro bono opportunities are limited since the nation's indigent do not often need IP help, Gollin says IP law lacks the traditional commitment found in other practice areas. That's why his plan is ambitious. "There's a prejudice against pro bono and that's embarrassing," says Gollin. "That's going to have to change."

Many firms use their pro bono programs to train junior attorneys. IP firms and groups, by the same token, could use PIIPA to train their young lawyers, Gollin says. He recalls that as a second-year associate at Kenyon & Kenyon, he created a pro bono policy because none existed at the time.

"Since there aren't opportunities, the room for improvement is vast," he says.