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WIPO Seminar: Use of Databases and other Defensive Measures relating to Genetic Resources and Associated Traditional Knowledge

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Overview

- Role of Patent Systems
- Patent Application Process
- Patentability Criteria in Canada
- Search for Prior Art
- Use of Databases
- TK Databases
- Proposal for WIPO Portal
- Codes of Conduct/Protocols



Role of Patent Systems

- Promote innovation
- Encourage investment, economic growth
- Promote sharing of knowledge in return for the exclusive right to exploit an invention
- Patent quality is a key aspect of how the patent system functions to ensure that patents granted meet the respective legal, social and economic requirements
- Patent offices contribute significantly to the well-functioning of the system, including through prior art searches using databases



Patent Application Process

- Application
- Request for Examination
- Examination
 - Search
 - Report
 - Interaction with applicant
- Final Decision/Action



International Patent System

- Canada is a party to the PCT
- Patents filed under the PCT are examined and subject to a preliminary opinion ISR (international search report) and IPRP (international preliminary report on patentability)
- Applicants can determine whether to seek patent protection in PCT Member Countries, which may include Canada
- Canada's IP Office (CIPO) is an international authority under the PCT



Patentability Criteria in Canada

- What can be patented?
 - Must comply with S.2 definition of Canada's *Patent Act*
 - "invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter



Patentability Criteria in Canada (cont'd)

- Patent must
 - ...be NOVEL (new)
 - ...have UTILITY (useful)
 - ...NOT BE OBVIOUS
 - ...be STATUTORY SUBJECT MATTER
- In addition to other requirements including support for claims, sufficient disclosure and clear language



Patentability Criteria in Canada (cont'd)

- Some subject-matter is excluded from patentability:
 - Scientific principles and abstract theorems (*Patent Act*)
 - Method of medical treatment and surgery (Jurisprudence)
 - Higher life forms (Jurisprudence)



Search for Prior Art

- Examiners conduct prior art searches to determine whether the claims of a patent application are novel and non-obvious (inventive)



Search for Prior Art (cont'd)

What is Prior Art?

- In Canada, in accordance with sections 28.2(1) and 28.3 of the Canadian *Patent Act*, the following can be considered as prior art:
 - Information that existed before claim date (can be filing date or priority date) and has a verifiable date; and
 - information that is publicly available; secret information cannot bar patentability



Search for Prior Art (cont'd)

- Databases are a source to search for prior art
- Relevant information includes:
 - Patent databases (e.g. Questel Orbit, STN)
 - PatentScope
 - Scientific journal/research publications databases (e.g. Scopus, Pubmed)
 - Company reports
 - Internet (the web in general)



Use of Databases

- Searched by:
 - date, classification (IPC), compound structure, applicant, key word, etc.
- An examiner must disclose the contents of any relevant prior art in the examiner's report
- An applicant must be able to review any cited prior art



TK Databases

- Foreign
 - Indian Traditional Knowledge Digital Library
 - Korean Traditional Knowledge Portal
 - Chinese Medicine database
- Canadian
 - Recording and mapping traditional knowledge about ecosystems
 - Traditional medicinal use of plants



Proposal for WIPO Portal Site

- Joint Recommendation for a one-click database search system
- System comprised of a WIPO portal site linking databases of WIPO Member States
- Searchable databases under proposed system in possession of, and maintained by, each participating WIPO Member State



Other Defensive Measures – Codes of Conduct/Protocols

- Documents that are voluntarily elaborated
- By companies, professional associations, research institutions, etc.
- Principles of behavior or conduct which are voluntarily adopted and implemented



Concluding Remarks

- Errors in granting of patents can cause legal uncertainty and increase costs for all
- Availability and use of databases on existing genetic resources and associated traditional knowledge improves efficiency of prior art searches and works to prevent erroneous grant of patents
- Internationally, ensuring databases are accessible to all patent authorities is key
- Consistency in how these databases are indexed or classified could facilitate use by patent examiners
- WIPO can play an important role in facilitating creation of databases and as a central access point through a WIPO portal

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