



## **Utilization of Prior Art Evidence on TK:**

Opportunities and Possibilities in the  
International Patent System

**New Delhi, India  
March 23  
2011**

Begoña Venero Aguirre  
Head, Genetic Resources and Traditional Knowledge Section

# What is “Prior Art”?

- Prior art is, in general, all the knowledge that existed prior to the relevant filing or priority date of a patent application, whether it existed by way of written and oral disclosure. In some legal instruments there is a differentiation between printed publications, oral disclosures and prior use and where the publications or disclosure occurred.

See: WIPO Intellectual Property Handbook, WIPO Publication No. 489 (E), 2008, page 19

# Prior Art and other Terms

- Note on the Meanings of the Term "Public Domain" in the Intellectual Property System with Special Reference to the Protection of Traditional Knowledge and Traditional Cultural Expressions/Expressions of Folklore (WIPO/GRTKF/IC/17/INF/8)
  - Public domain
    - Black's Law Dictionary defines the public domain as "*the universe of inventions and creative works that are not protected by intellectual property rights and are therefore available for anyone to use without charge. When copyright, trademark, patent, or trade-secret rights are lost or expire, the intellectual property they had protected becomes part of the public domain and can be appropriated by anyone without liability for infringement.*"
  - Publicly available
    - The common understanding of publicly available does not mean available for free. The common understanding of public availability could mean that there is a condition to impose mutually agreed terms such as paying for access. TK has often been deemed to be in the public domain and hence freely available once it has been accessed and removed from its particular cultural context and disseminated. But it cannot be assumed that TK associated with genetic resources that has been made available publicly does not belong to anyone. (See UNEP/CBD/WG-ABS/8/2, Report of the Meeting of the Group of Technical and Legal Experts on Traditional Knowledge Associated with Genetic Resources in the Context of the International Regime on Access and Benefit-Sharing)

# Various definitions of “Prior Art”

## ■ IN USA

- Section 35 of the U.S.C. 102 defines “prior art” indirectly through the concept of novelty as anything “*known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, ...*”.

## ■ IN JAPAN

- Section 29 of Japanese Patent Law indirectly defines “prior art” as “*(i) inventions that were publicly known in Japan or a foreign country, prior to the filing of the patent application; (ii) inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent application; or (iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent application*”.

# Various definitions of “Prior Art” (cont’d)

## ■ IN EUROPE

- Article 54(2) of the EPC defines the equivalent term “**the state of the art**” as comprising “*everything made available to the public by means of a written or oral description, by use, or in any other way, before the filing of the European patent application*”. With reference to this provision of the EPC, the Guidelines for Examination in the European Patent Office (EPO) emphasize that “*the width of this definition should be noted. There are no restrictions whatever as to the geographical location where, or the language or manner in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. However, certain specific exclusions exist.*”

## ■ THE PATENT COOPERATION TREATY (PCT)

- “Prior art” is defined by Rule 33.1 of the PCT Regulations as “*everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e. that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date*”.

# The Role of Prior Art

## ■ Novelty

- According to Article 33 of the PCT, novelty is defined as follows: “*For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the **prior art** as defined in the Regulations*”.

## ■ Inventive step (also referred to as “non-obviousness”)

- According to article 33 of the PCT, a claimed invention shall be considered to involve an inventive step “*if, having regard to the **prior art** as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art*”.

# PCT Minimum Documentation

- The Minimum Documentation is set out by the PCT Regulations Rule 34.
- In the PCT International Search Guidelines, the international search minimum documentation is defined as “*a document collection that is systematically arranged (or otherwise systematically accessible) for search purposes according to the subject matter content of the documents, which are primarily patent documents supplemented by a number of articles from periodicals and other items of non-patent literature*”.
- In February of 2003, at the seventh session of the Meeting of International Authorities under the PCT, there was agreement in principle that Traditional Knowledge Documentation should be included in the non-patent literature part of the PCT Minimum Documentation.
- The cooperating offices (the International Authorities under the PCT system) selected TK Documentation on the basis of six criteria: (i) sufficient description of technical content so as to qualify as **prior art**, including ability to **ascertain prior art date**; (ii) practicable access to periodicals, including their availability in electronic form; (iii) availability of an English text of articles or, at least, of English language abstracts; (iv) the range of fields of technology covered by periodicals; (v) geographical context of periodicals; and (vi) access conditions applicable to periodicals, including cost and text searchability.

# International Patent Classification (IPC)

- IPC is a hierarchical system in which the whole area of technology is divided into a range of sections, classes, subclasses and groups. The Classification is a language independent tool indispensable for the retrieval of patent documents in the search for “**prior art**”.
- The IPC was established by the Strasbourg Agreement Concerning the International Patent Classification, 1971. Article 2(1)(a) provides that “*the Classification comprises: (i) the text which was established pursuant to the provisions of the European Convention on the International Classification of Patents for Invention of December 19, 1954 (hereinafter designated as the “European Convention”), and which came into force and was published by the Secretary General of the Council of Europe on September 1, 1968; (ii) the amendments which have entered into force pursuant to Article 2(2) of the European Convention prior to the entry into force of this Agreement; (iii) the amendments made thereafter in accordance with Article 5 which enter into force pursuant to the provisions of Article 6.*”



# IPC and TK

- At its Thirtieth Session, the Committee of Experts of the IPC Union (February, 2002), agreed that a Task Force (made up of representatives from China, India, Japan, United States and the European Patent Office) be created in order to study the Traditional Knowledge Resources Classification (TKRC) of the TKDL as presented by India and assess its information aspects and relation to the IPC. The IPC Committee noted that:
  - a) the most efficient way of developing classification tools for traditional knowledge would be their integration into the IPC,
  - b) the IPC could be used for classifying non-patent, traditional knowledge information,
  - c) work of the Task Force should be carried out with a view of an IPC revision proposal, and
  - d) the Task Force should look at ways in which a revised IPC could be linked to traditional knowledge classifications.
- At its Thirty-Fifth Session, the Committee of Experts of the IPC Union (October, 2004) noted that the revision project C 425 relating to the creation of the new main group A61K 36/00 for traditional medicine could be considered completed and the result would be available in the next edition of the IPC.

# TK as Prior Art

- Secret TK
  
- Oral TK
  - According to PCT Rule 33.1(a) and (b), oral disclosure, use, exhibition, etc. are recognized as prior art only when this is substantiated by a written disclosure. In contrast, according to Art. 54 of EPC, a public oral description, use, etc. is considered as prior art. However, the examiner, in carrying out a European search, should cite an oral description, etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved. Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in opposition proceedings.
  
- Disclosed TK
  - publicly disclosed TK, which can be accessed through physical documentation, the internet and other kinds of telecommunication or recording
    - According to Art 54(2) of EPC, The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application. Establishing a publication date has two aspects. It must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public as of that date.
  - publicly available TK with limited accessibility
  - TK held within indigenous and local communities, which is disclosed and known within such communities

# TK as Prior Art (in practice)

- Spontaneously
- Through a third-party observation or an opposition

Thanks!

<http://www.wipo.int/tk/en>

Email: [begona.venero@wipo.int](mailto:begona.venero@wipo.int)