Seminar on Intellectual Property and Genetic Resources, Traditional Knowledge and Traditional Cultural Expressions – Regional, National and Local Experiences

30 March – 1 April 2015

World Intellectual Property Organisation, Geneva

Regional, National and Local Experiences with the Meaning and Relevance of "Public Domain" in the Context of Traditional Knowledge and Traditional Cultural Expressions

Professor Dr Lim Heng Gee
Faculty of Law
Universiti Teknologi MARA,
40450 Shah Alam, Selangor, Malaysia

Scope of Paper

- Concept of “Public Domain” in the Intellectual Property System
- The Role It Plays in the Intellectual Property System
- Differences in the Concepts of “Public Domain”, “Prior Art” and “Publicly Available”
- Limits of the application of the concept of public domain to the knowledge, innovations and practices of traditional communities.
- **Relevance of the "public domain" concept to designing an IP-like system of protection for traditional property**

Concept of “Public Domain” in the Intellectual Property System

- Various use of the terms "publici juris", "public property" and "public domain" used by the courts
- Various definition of "public domain" referred to in my paper.
- So what is the public domain?
- In relation to the intellectual property system, and taking into account the various aplications of this concept, I would suggest the following:
- "Public domain" refers to the status of a piece of information or material for which intellectual property protection has **expired** or has been **withdrawn**, or for which the Goverenment has **no right to grant** any intellectual property rights, and hence is f**ree for all to use and build upon**.

Concept of "Public Domain" in the Intellectual Property System

- The various uses of the public domain doctrine in intellectual property law
  - 1. The Public domain as a restriction on granting intellectual property rights (granting of private property rights)
  - 2. The public domain as a limit to the duration of intellectual propriety rights
  - 3. The public domain as a ground for the loss of intellectual propriety rights

The Role It Plays in the Intellectual Property System

- 1. The public domain as a restriction on granting intellectual property rights, for example:
  - if an invention or design has already been "made available to the public", or had become part of the "prior art" before the filing date
  - refusing application to register a descriptive or generic word as a trade mark
  - not protecting works created before the relevant intellectual property law existed

The Role It Plays in the Intellectual Property System

- 2. The public domain as a limit to the duration of intellectual propriety rights
  - Expiry of duration of protection of copyright, patent registered designs etc

The Role It Plays in the Intellectual Property System

- 3. The public domain as a ground for the loss of intellectual propriety rights, for example
  - invalidation or loss of trade mark rights when a trade mark becomes generic or through non use
  - invalidation through insufficiency or failure to disclose best mode
  - application of the doctrine of patent or copyright misuse (temporary loss)
  - non renewal to maintain registration of intellectual property rights
  - fraudulent applications etc

Differences in the Concepts of “Public Domain”, “Prior Art” and “Publicly Available”

- When would a material be regarded to be "free for all to use"?
- In relation to the public domain as a restriction on granting intellectual property rights, concepts like “**made available to the public**”, or part of the “**prior art**” are often used to **demarcate the territory** within which no intellectual property rights can be granted.
- The **applicant** has to satisfy the requirement that what he is trying to get protected has not been “made available to the public”, or has become part of the “prior art”.

Differences in the Concepts of "Public Domain", "Prior Art" and "Publicly Available"

- However, the boundary of what is, and what is not, part of the public domain (i.e., "made available to the public", or part of the "prior art") is not fixed or absolute.
- It varies according to specific policies and needs of a particular country.
- Two aspect of the novelty requirement will be highlighted here:
  - Novelty – the **source of the prior art**
  - Novelty – **knowledge gained** from the prior art – when is something deemed to be **made available to the public**?

Novelty – the source of the prior art

- A few examples of how the source of the prior art is framed will demonstrate how the boundary of the public domain is enlarged or reduced.
- Registered Design Act 1949, UK (Pre EU Design Directive)
- Section 1(4) A design shall not be regarded as new for the purpose of this Act if it is the same as a design –
- (a) ..., or
- (b) published in the United Kingdom in respect of the same or any other article before the date of application, ...

- Under this provision the novelty requirement is based on l**ocal prior art**.

Novelty – the source of the prior art

- Registered Design Act 1949 (After the EU Design Directive)
- Section 1B(5), Design Directive Art 6 : For the purposes of this section, a **design has been made available to the public** before the relevant date if—
- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; …
- It would be noted that under this new definition, th**e prior art** could potentially be **anywhere in the world** (universal or absolute novelty).
- This, however, is subject to the requirement of "**reasonable community trade knowledge**".

Novelty – the source of the prior art

- Registered Design Act 1949 (After the EU Design Directive)
- Section 1B(6) provides as follows:
- 1B(6) A disclosure falls within this subsection if -
- (a) **it could not reasonably have become known** before the relevant date **in the normal course of business to** persons carrying on business in the European Economic Area and specialising in the sector concerned; …
- Therefore, from what at first sight appears to be the adoption of a **universal novelty system**, the novelty requirement has been changed to an **relative novelty system**, depending on the circumstances.

Novelty – the source of the prior art

- Another example is found in the Patents Act of the United States.
- 35 USC s. 102 - A person shall be entitled to a patent unless:
- (a) the invention was 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, …
- I.e., a mixed novelty system

Novelty – the source of the prior art

- **New Provisions wef from 16 March 2013**
- 35 USC s 102. Conditions for patentability; novelty
- (a) Novelty; Prior Art.—A person shall be entitled to a patent unless—
- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the **effective filing date** of the claimed invention; or …
- Note: No more mention of "in this country …"
- Hence the United States has changed from a mixed novelty system to that of a universal or absolute novelty system.

Novelty – when is knowledge deemed to be made available to the public?

- Patents Act 1949 and Patents Act 1977 - different concepts on "made available to the public" as construed by the Court.
- Under the Patents Act 1949, UK, the grounds to oppose an application for a patent include under subsection (1)(b) "that the invention, so far as claimed in any claim of the complete specification, has been **published** in the United Kingdom, before the priority date of the claim", and under subsection (1)(d), "that the invention, so far as claimed in any claim of the complete specification, was **used in the United Kingdom** before the priority date of that claim".

Novelty – when is knowledge deemed to be made available to the public

- When is existing information or knowledge deemed to be ***disclosed*** to the public?
- The question to ask:
  - "Was (the) person to whom this communication had been made ... ***free both in law and equity to do what he likes with the information***. If so, the information, of course, had been ***given to a member of the public***, and there was nothing further to serve as consideration for any patent.“ - Humpherson v. Syer (1887) 4 RPC 407
- However, **even if it is in principle “made available to the public”, it may still not be regarded to be part of the prior art**.
- A comparison between the approaches of the Court under the Patents Act 1949 and Patents Act 1977 suffices to demonstrate the different understanding and application of the phrase “made available to the public”.

Novelty – when is knowledge deemed to be made available to the public

- **Bristol Myers Co v Beecham Group Ltd,** a case decided under the 1949 Act
- Patent application relating to the antibiotic ampicillin trihydrate
- Opposed on grounds including prior user.
- Prior to filing date, the opponents had made several batches of ampicillin trihydrate, but without recognising that it was the trihydrate form. They blended the trihydrate batches with other batches of ampicillin and sold the blend to the public.
- Not possible to detect by analysis the presence of the trihydrate in the blend.
- House of Lords held that there had been prior use of ampicillin trihydrate by the opponents.
- The application was rejected.

Novelty – when is knowledge deemed to be made available to the public

- Per Lord Diplock at page 66,
- “Any commercial sale by any trader before the priority date of a claim to a product as an invention is “use” of that invention . . . notwithstanding the seller's ignorance of its identity or his lack of knowledge of its composition or his uncertainty as to how or where further supplies of it could be obtained”.

- No requirement for an "enabling disclosure"

Novelty – when is knowledge deemed to be made available to the public?

- The Patents Act 1977 UK provides that:
- 2(1) An invention shall be taken to be new if it does not form part of the state of the art.
- (2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, *information* about either, or anything else) which has at any time before the priority date of that invention been ***made available to the public*** (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

Novelty – when is knowledge deemed to be made available to the public?

- PLG Research Ltd and anor v. Ardon International Ltd and ors, (a case decided under the Patents Act 1877) per Aldous J. at 225:

- "... It is now settled law that for information to be made available to the public the disclosure must be what has been called an enabling disclosure ...
- Under the 1977 Act, patents may be granted for an invention covering a **product** that has been put on the market **provided the product does not provide an enabling disclosure of the invention claimed**."

Novelty – when is knowledge deemed to be made available to the public?

- Under the new law, a product which is freely available to the public could still gain patent protection as long as there is no "enabling disclosure" of how the product could be made.
- The effect of this is that certain product could be withdrawn from the public domain and be protected by the intellectual property system.

A Quick Summary

- Public Domain: Two components -
- Prior Art:
  - Local
  - Mixed
  - Universal
    - Relative – Reasonable community trade knowledge
- "Made available to the public"
  - No need for an enabling disclosure
  - Enabling disclosure required before a piece of information is deemed to be made available to the public
- Depending on how one defines the various terms, the scope of the public domain can be enlarged or reduced.
- Adjusted to fit different needs and circumstances

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Is the concept of public domain is applicable in designing an IP-like system of protection for traditional property?
- Not surprisingly, there are two opposing views.
- On the traditional property side, it is argued that the concept has no place in discussions for the protection of TK and TCEs.
- Proponents of the western intellectual property rights system argue that it is an essential principle by which to achieve balance between the producers and users of TK and TCEs.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- A quick comparison is made of the western perception of property ownership as opposed to traditional communities'.
  - Western type property based system is centered on individual creation and private individual ownership.
  - The emphasis in traditional communities is on communal ownership with community obligations.
  - There are also elements of **spirituality** involved.
  - The collective traditional knowledge of traditional communities is the very foundation of their culture.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- **However, to define "public domain" as understood and applied presently in the western intellectual property system would be to deprive them of their cultures and identities.**
- In the words of Preston Hardison, "The concept of public domain … means exhaustion of our rights."
-
- As Otto Kahn-Freund noted, legal transplants are not mechanical processes and there is a chance of rejection.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Despite these differences, the concept of the public domain has a place in any future law or agreements relating to the protection of traditional property.
- There is a need to have a cut-off or demarcation point to determine what traditional property is, and what is not protectable.
- Traditional property that has been **assimilated** into the **mainstream culture** should, it is submitted, be considered to be in the public domain, free for the general community to use.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Between the two extreme, i.e, secret and sacred on the one habd, and wide assimlation and absorption into the mainstream culture, on the other, there is a wide spectrum of traditional property that has been known and used by the public.
- How do we decide what is in the public domain and what is not?
- The prevailing Western concept of what is deemed to be made available to the public – as long as it is known to even one member of the public who is free in law and equity to use the information as he likes, cannot be transplanted into the traditional property system.
- Just because a piece of traditional property has been **accessible to the general public** does not mean that it should be in the public domain, free for all to use without restrictions.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Some questions that need to be asked:
  - Has the traditional property been used and disseminated without the consent, or possibly even without the knowledge of the traditional communities.
  - Were members of the public able to gain acccess to the traditional property as of right?
  - Was there a dedication to the public of such knowledge?
  - What kind of rights?
    - Full exclusive rights
    - Limited exclusive rights?
    - Only moral rights?

Relevance and Applicability of the Public Domain in the Traditional Property Context

- In addition, it is arguable that even though the general public may have been using the traditional property, **without a full understanding and appreciation of its holistic content** however, there may not have **been** an "enabling disclosure" in the western intellectual property rights sense to consign it to the public domain.
- Under the western intellectual property rights system the scope of the public domain has been **enlarged or reduced** by changing the definition of the "**prior art**" and the concept of "**availability to the public**" to suit particular needs.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Similarly, for the **traditional property** system, the scope of the public domain needs to be **redefined to be in tune with, or based on, traditional community's understanding** of when a piece of knowledge is deemed to be freely available for the general public's use, and hence in the public domain.
- The result may be that what had presently been regarded as public domain property may be "**clawed back**".
- This however, is not unprecedented, as can be seen in the European Union advocating a clawback action to reclaim geographical indications that have been lost through genericization.

Relevance and Applicability of the Public Domain in the Traditional Property Context

- An example of a definition is found in the Draft Legal Framework for the Protection of Traditional Knowledge in Sri Lanka.
- Section 3 of the Draft Legal Framework defines "Public domain" to mean "anything disclosed to the public by a holder of traditional knowledge by publication, written or otherwise, or by use in such a manner that manifests an intention to make the said knowledge public and also traditional knowledge distinctively linked to, and commonly available in, Sri Lanka by the date which this Act becomes effective."

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Peru Law 278111 for the Propetection of Collective Knowledge of Indigenous Peoples Regarding Biodiversity
- Art 13: For the purposes of this regime, collective knowledge in the public domain shall mean collective knowledge that has been made acessible to persons other than indigenous peoples by mass media such as publications or, if it is concerning properties, uses or characteristics of a biological resource, that it has become extensively known outside the confines of the indigenous peoples and communities. ...

Relevance and Applicability of the Public Domain in the Traditional Property Context

- Other variations?
- “not made available with the prior informed consent of the relevant traditional community”?
- “not made available with the consent of the relevant traditional community to people outside the community for commercial exploitation”?

Relevance and Applicability of the Public Domain in the Traditional Property Context

- In addition, it might be desirable to have in place a Register of Traditional Property. Based on the definition of the public domain, a competent authority, working closely with the traditional communities could determine which component of their traditional property is desired to be protected and what they would "surrender" to the wider general community.
- Those that are desired to be protected should, where possible, be listed in this Register to serve as **notification** to the world at large that this traditional property belongs to a particular traditional community and hence are subject to their exclusive rights.
- In drawing up such a list, care should be taken to ensure that what has already been absorbed by the wider community and has entered the mainstream culture should be excluded.

Concluding Remarks

- In conclusion, I would like to quote the caution urged by Anupam Chander and Madhavi Sunder:
- "... The current habit of critiquing each and every new claim for property rights as an encroachment on the public domain carries some risks, as it may: (1) legitimate the current distribution of intellectual property rights, (2) mask how current constructions of the public domain disadvantage and subordinate indigenous and other disempowered groups globally, and (3) impair efforts by disempowered groups to claim themselves as subjects of property - that is, as autonomous with constitutive personhood interests in property - rather than as mere objects, or someone else's property."

Concluding Remarks

- The western intellectual property rights system has constantly redefined the scope of the public domain to suit various needs.
- Simlarly, the scope of the public domain in relation to traditional property should be fine-tuned to suit the needs and expectations of the traditional communities by means of suitable drafting techniques.
- However, care has to be taken to ensure that the public domain is not too narrowly or widely defined to the prejudice of the traditional communities or the wider public respectively.

END

- Thank you for your kind attention