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

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## Introduction

This paper argues that while there is still a place for the application of the concept of public domain, there needs to be a paradigm shift in the understanding and application of this concept in relation to the protection of traditional knowledge and traditional cultural expression, which in this paper will be referred to collectively as traditional property. The public domain as we understand it is based on the western intellectual property rights system, and it would not be fair nor workable to apply to any law or international convention relating to the protection of traditional property

This paper deals first with the concept of "public domain" as understood in the western intellectual property rights system and the various roles it plays in this system. Even in the western intellectual property rights system the concept is not immutable. There are variations in how the concepts of the "public domain", "prior art" and "publicly available" have been applied in the western type intellectual property system. Some of these variations are examined. Following these, limits of the application of the concept of public domain to the knowledge, innovations and practices of indigenous and local communities, which in this paper will be referred to collectively as traditional communities, will be discussed. The paper ends with some thoughts on how the public domain could be narrowed to serve the interests of the traditional communities.

## Concept of "Public Domain" in the Intellectual Property System

The terms "public domain", "publici juris" and "public property" have a long history in the intellectual property system. They have been variously used by the Court to refer to a situation when a person's intellectual property right ceases and he could no longer enforce it.

In *Cheavin v. Walker*,[1] James LJ in the Court of Appeal had this to say in relation to an expired patent, "It is clear that on the expiration of this patent it was open to all the world to manufacture the article which had been patented; that is the consideration which the inventor gives for the patent; the invention becomes then entirely publici juris."

Similarly, in the United States, Justice White in *Singer Manufacturing Company v. June Manufacturing Company*, Justice White said, in relation to an expired patent:

> "It is self evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent."[2]

[1] *Cheavin v. Walker* (1877)5 Ch Div 850 , per James LJ at 863.

[2] *Singer Manufacturing Company v. June Manufacturing Company* 163 U.S. 169 (1894 Sup Ct), per Justice White, at 185.

In the same case, on the question of whether the registered trade mark "Singer" which had been used in conjunction with the sale of the patented sewing machines, had become generic, Justice White said:"

> It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly, in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly by his having so connected the name with the machine as to lend countenance to the resulting dedication. To say otherwise would be to hold that although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly. In other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that at its termination the monopoly should cease, and yet when the end was reached disregard the public dedication and practically perpetuate indefinitely an exclusive right."[3]

In the above case, Justice White was applying the concept of 'public domain" not to a situation when the intellectual property right had come to an end through the expiration of the statutory term but to a loss of right through the actions or inactions of the intellectual property rights owner. The action of the trade mark owner was deemed to be a dedication to the public of the trade mark which had become generic.

The concept of the public domain was applied to a copyright case by Justice Miller in *Merriam v. Holloway Publishing Co*. Justice Miller said:

> "This proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired, may continue that monopoly indefinitely, under the pretense that it is protected by a trade-mark or something of that sort. I do not believe in any such doctrine, nor do my associates. When a man takes out a copyright, for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public and become public property. I may be the first to announce that doctrine, but I announce it without any hesitation. … The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book."[4]

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[3] Singer *Manufacturing Company v. June Manufacturing Company* 163 U.S. 169 (1894 Sup Ct), per Justice White at 185-185.

[4] *Merriam v. Holloway Publishing Co*., 43 F. 450, 451 (C.C.E.D. Mo. 1890), per Justice Miller at 451.

So what is the public domain? Professor Jamie Boyle refers to the public domain as "the material that is free for all to use and to build upon."[5] Anupam Chander and Madhavi Sunder define it as "Resources for which legal rights to access and use for free (or for nominal sums) are held broadly."[6] According to Lee, "Properly understood, the public domain is the public's domain, meaning that it is off-limits to government control."[7]

I would simply suggest that the term "public domain" refers to all information or materials is which not protected or enforceable by any legal rights and hence could be freely used or exploited by anyone without restriction.

**The Various Uses of the Public Domain Concept in Intellectual Property Law**

In relation to the intellectual property system, the concept of "public domain" is applied in at least three distinct ways.

1. The Public domain as a restriction on granting intellectual property rights (granting of private property rights)
    - determining 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
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
3. The public domain as a ground for the loss of intellectual propriety rights
    - invalidation when a trade mark becomes generic or through non use
    - when the trade secret has been made public
    - application of the doctrine of patent or copyright misuse
    - non renewal to maintain registration of intellectual property rights

This paper focuses only on the first and second applications of the public domain concept. If we were to use Professor Boyle's definition of public domain as "the material that is free for

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5 James Boyle, *Foreword: The Opposite of Property?*, 66 Law & Contemp. Probs. 1 (2003).

6 Anupam Chander and Madhavi Sunder, "The Romance of the Public Domain", California Law Review , (2004) Vol. 92:1331 at 1335.

7 Edward Lee, "The Public's Domain: The Evolution of Legal Restraints on the Government's Power to Control Public Access Through Secrecy or Intellectual Property", Hastings Law Journal, Vol. 55:91, November 2003 at 98-99.

all to use and to build upon," this would mean that any such material could not be the subject of intellectual property or rights. However, this begs the question, "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". In other words, what has been place in the public domain cannot satisfy the novelty requirement laid down in the applicable law.

However, as will be shown, the definition of the novelty requirement is not set in stone. 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 (as modified by compliance with international or regional obligations).

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. The requirement for novelty laid down in the Registered Design Act1949, UK, prior to the drastic changes brought about by the EU Design Directive[8] states as follows:

> 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) registered in respect of the same or any other article in pursuance of a prior application, or
>
> (b) published in the United Kingdom in respect of the same or any other article before the date of application,
>
> Or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

Under this provision the novelty requirement is based on local prior art.

[8] Directive 98/71/EC of the European Parliament and of the Council.

However, to comply with the EU Design Directive, the Registered Design Act 1949 UK was substantially amended. The novelty requirement is now laid down in section 1B(1) which provides:

- Section 1B(1) : A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.
- Section 1B(5) : 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, the 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". 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 intermediate novelty system, depending on the circumstances.

Another example is found in the Patents Act of the United States. 35 USC s. 102 provides that "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, …"

However, with effect from 16 March 2013, the above has been replaced by a new provision which states in 35 USC s 102(a) that "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 …

It will be noted that after the amendments, 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?**

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".

Under the Patents Act 1949, United Kingdom, 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".

Section 101 of the same Act provides that:

> "published", except in relation to a complete specification, means made available to the public; and without prejudice to the generality of the foregoing provision a document shall be deemed for the purposes of this Act to be published if it can be inspected as of right at any place in the United Kingdom by members of the public, whether upon payment of a fee or otherwise;

In *Bristol Myers Co v Beecham Group Ltd*,[9] a case decided under the Patents Act 1949, a patent application relating to the antibiotic ampicillin trihydrate was opposed on grounds including prior user. Prior to the date of the particular claim for the product, the opponents had made several batches of ampicillin trihydrate, sufficient for at least 10,000 medicinal doses, 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. It was not possible to detect by analysis the presence of the trihydrate in the blend. They relied upon this sale to establish prior user. The House of Lords held that there had been prior use of ampicillin trihydrate by the opponents and hence the application for patent should be rejected. The comments of Lord Diplock are relevant for present discussion. His Lordship said:

> "The right of a trader to go on dealing by way of trade in any man-made substance in which he had dealt before, without impediment by a monopoly in that substance granted to any other person, **was not dependent upon his knowledge of its composition or how it could be made.** [Emphasis added] If he had in fact dealt in that substance he had "used" it; his ignorance of these matters was irrelevant to the question of his use.
>
> 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".

The Patents Act 1977 UK provides in section 2 that:

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[9] *Bristol Myers Co v Beecham Group Ltd* [1974] FSR 43, per Lord Diplock at 65-66.

> 2(1) An invention shall be taken to be new if it does not form part of the state of the art.
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> (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.

In *PLG Research Ltd and anor v. Ardon International Ltd and ors*, a case decided under the Patents Act 1977, Aldous J. said,[10]

> "For hundreds of years it had been the law that no monopoly may be granted to prevent the public doing that which had been done in public before the patent was applied for. The 1977 Act changed the law. As Falconer J. pointed out in Quantel Ltd v. Spaceward Microsystems Ltd [1990] RPC 83, 108, the 1949 Act did not require the prior use to make the invention available to the public, as is now the law under section 2 of the 1977 Act. Accordingly, cases decided before the 1977 Act came into force may no longer be good law.
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> Section 2 of the 1977 Act states that an invention shall not be taken to be new of it formed part of the state of the art which comprises inter alia all information made available to the public by use. 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 ..."
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> Mr Thorley submitted that if a product had been made available to the public, it was not possible thereafter to patent the product whether claimed as a product claim or a product-by-process claim.
>
> That submission is too wide. 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**. [Emphasis added] In most cases, prior sale of the product will make available information as to its contents and its method of manufacture, but it is possible to imagine circumstances where that will not happen. In such cases a subsequent patent may be obtained and the only safeguard is section 64 of the Act."

The effect of the new approach to what has been "made available to the public" under the Patents Act 1977 is drastic. 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.

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[10] *PLG Research Ltd and anor v. Ardon International Ltd and ors* [1993] FSR 197, Aldous J. at 225.

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

The question that arises now is whether 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.

Before addressing the question, a quick comparison is made of the western perception of property ownership as opposed to traditional communities'. The western type property based system is centered on individual creation and private individual ownership. In contrast, the emphasis in traditional communities is on communal ownership with community obligations. There are also elements of spirituality involved.[11] The collective traditional knowledge of traditional communities is the very foundation of their culture.[12] 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."[13] As Otto Kahn-Freund noted, legal transplants are not mechanical processes and there is a chance of rejection.[14]

Despite these differences, this paper suggests that 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. But 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,[15] 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. It is here pertinent to refer to the definition in section 101 of the Patents Act 1949 which defines "published" to mean "made available to the public", and that a document shall be deemed to be published if it can be inspected as of right at any place in the

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11 Preston Hardison, policy analyst for the Tulalip Tribes of Washington state (US), http://www.ip-watch.org/2014/03/25/indigenous-peoples-present-their-perspectives-on-traditional-knowledge-at-wipo/.

12 For a more detailed discussion of the complexities of traditional communities relationships, see Graham Dutfield, Protecting Traditional Knowledge and Folklore, UNCTAD-ICTSD Project on IPRS and Sustainable Development, Issue Paper No. 1, 2003, pages 19 – 25. See also "Joint Statement from the Indigenous World Association and Indigenous Media Network, Doc. E/CN.4/Sub.2/AC.4/2005/CRP.3, 13 July 2005.

13 Preston Hardison, policy analyst for the Tulalip Tribes of Washington state (US), http://www.ip-watch.org/2014/03/25/indigenous-peoples-present-their-perspectives-on-traditional-knowledge-at-wipo/.

14 Otto Kahn-Freund, "On Uses and Misuses of Comparative Law", 37 Mod. L Rev 1 at 6.

15 See Humpherson v. Syer (1887) 4 RPC 407, per Bowen L.J., at 413.

United Kingdom by members of the public, whether upon payment of a fee or otherwise. Hence it is arguable that even though some traditional property had been known and used by members of the public (excluding member from the relevant traditional communities), the traditional property cannot be regarded to have fallen into the public domain unless members of the public can use or gain access to it "as of right".

The various aspects and understanding of the "public domain" in western intellectual property rights system presuppose an existing "bargain" between the conferring authority and the IP owner. In the case of a patent, in return for certain exclusive rights which will end after a certain duration, the rights owner must disclose fully information about his invention. After the expiry of the patent, information about the invention goes into the public domain as there is deemed to be a dedication of the invention to the public.[16] In the case of traditional property, there is no such a bargain. In many cases, traditional property has been used and disseminated without the consent, or possibly even without the knowledge of the traditional communities. In such a situation, the traditional communities cannot be deemed to have dedicated their traditional property to the public. 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. 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.

A fine balance will thus have to be drawn to demarcate what traditional property is still deemed to be the property of the traditional community and what is not. This can be done by defining the term 'publicly available" in such a way that justice is done to the traditional community. 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.

An example of a definition is found in the Draft Legal Framework for the Protection of Traditional Knowledge in Sri Lanka.[17] 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

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16 See National Biscuit Co. v. Kellogg Co., 91 F.2d 150 (3d Cir. 1937), per Davis, Circuit Judge at 152.

17 Draft Legal Framework for the Protection of Traditional Knowledge in Sri Lanka (Working Document - Version 01 – January 2009). Note that while the term "public domain" is used in Senate Bill 669 of the Philippines, "Traditional Property Rights of Indigenous Peoples Act [9 July 2013], there is no definition of what is meant by this term. See sections 5 and 9 of the Senate Bill.

linked to, and commonly available in, Sri Lanka by the date which this Act becomes effective."

Some possible variations to the definitions of what is deemed to be "available to the public" could be follows:

- "not widely known or used by people outside the relevant traditional community"
- "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"

In addition, it might be desirable to have in place a Register of Traditional Property.[18] 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:

> "But romantic discourses of the public domain thwart the new claims for property emerging in the developing world and in Western indigenous communities. Focused more on form than function, the increasingly binary rhetoric of "intellectual property versus the public domain" deafens us to new claims by individuals who seek to restructure social and economic relations through property-like rights. 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

[18] There is provision for such a Register in the Draft Legal Framework for the Protection of Traditional Knowledge in Sri Lanka. It is not, however, mandatory, and non registration will not affect the rights of traditional knowledge holders – see section ((4) and (5) of the Draft Framework.

as subjects of property - that is, as autonomous with constitutive personhood interests in property - rather than as mere objects, or someone else's property."[19]

The western intellectual property rights system has constantly redefined the scope of the public domain to suit various needs. It is not unreasonable to ask that in any discussion on traditional property, the scope of the public domain should be fine-tuned to suit the needs and expectations of the traditional communities. 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.

[19] Anupam Chander and Madhavi Sunder, "The Romance of the Public Domain", California Law Review , (2004) Vol. 92:1331 at 1335.