

enterprises, particularly in developing countries. It is clear the US patent law was formulated long before the debate on patenting TM existed, but this is cited as one more example of the divide between north and south. In other instances, it appears that US law offers options that are under-exploited by those wishing to protect TM. A good example is the provisions for patenting a joint invention.

### 3. *Joint Invention*

A common refrain is that patent law does not allow TK holder contributions to be recognized. Both statute and case law in the US contradicts this view. 35 U.S.C. §116 states that an invention can be made by two or more persons even if they did not work physically together (or at the same time) and did not make the same type of contribution, and did not make a contribution to every claim. The case law<sup>69</sup> suggests that even if drugs were developed from plants identified in literature surveys, this would be enough to qualify as a joint invention. Some element of reliance appears to be enough, although there is no definitive judicial statement on the minimum standard needed for collaboration.<sup>70</sup>

If the invention simply provided knowledge that was already in the public domain the provider would not qualify as an inventor. There is a need to demonstrate some degree of conceptual connection between the information and invention. Some authors suggest that in recognizing TK, there is a risk:

Legislatures and courts have developed carefully calibrated regimes that effectively balance the competing interests of the inventor in obtaining a patent monopoly and of the general public in preventing the grant of an undeserved monopoly right that diminishes the public domain. Amending patent law to provide rights to traditional knowledge would disturb this balance, risking wide-range disruption of the entire system that would require even more legislative work than creating a narrow, new regime.<sup>71</sup>

The worst case scenario is far from proven. It is difficult to appreciate how applying for a patent held between joint inventors would cause large scale disruption. The examination process remains the same. The passage above seems to suggest that TK is part of the public domain, and in recognizing it as a contribution to the final invention, it would somehow alter the patent granting process. Recognizing a TK holder as a joint inventor does not conflict with international obligations. In the future it is possible that some provision regarding registering a patent as a joint invention could be part of prospection agreements.

68 Curtis M. Horton, *Protecting Biodiversity and Cultural Diversity Under Intellectual Property Law: Toward a New International System*, 10 J. ENVTL. L. & LITIG. 17 (1995).

69 See Michael J. Huft, *Indigenous Peoples and Drug Discovery Research: A Question of Intellectual Property Rights*, 89 NW. U.L. REV. 1712-1722 (1995).

70 See *id.*

71 Jacoby and Weiss, *supra* note 10 at. 99.

#### 4. *Potential Conflict with TRIPS Obligations*

According to critics, a prior art search in the US involves two different standards. According to 35 U.S.C. §102, evidence of foreign public knowledge or use of an invention under consideration for a patent is excluded. This represents a geographic disparity.<sup>72</sup> A central tenant of both the Paris convention and TRIPS is the national treatment principle, whereby: “. . . each Member shall accord to the nationals of other Members treatment no less favorable than that which it accords to its nationals with regard to the protection of intellectual property” as is outlined in Article 3:1 of TRIPS. The large number of foreign patents registered in the US demonstrates that in some regards the USPTO does not discriminate against non-US interests. However, the geographical limitation has been cited as a discriminatory provision.<sup>73</sup> A group based outside of America could have an unprinted and unpublished aspect of their TK appropriated by a US patent.

In contrast, if the same TK was known to an indigenous group living in the US, a patent would be barred on the grounds that it was known as used by others in the US.<sup>74</sup> According to TRIPS, this issue is for the national legislature to decide. According to 35 U.S.C. §104 evidence of unpublished foreign knowledge can be used to challenge priority. The purpose of introducing this evidence would be to support a foreigner’s claim that they introduced the invention into the US before another.<sup>75</sup> Section 104 allows foreigners to obtain US patents on the basis of foreign activity. This is essentially ‘national treatment.’ In contrast, a change to section 102 to recognize foreign anticipation would prevent US inventors from obtaining patents.<sup>76</sup> There seems to be little ground for claiming that the US is in violation of TRIPS, other than some claim that this provision harms TK right holders.

Rule 37 C.F.R. §1.105, titled Requirements for Information, gives USPTO patent examiners the right to require an applicant to provide information that is reasonably necessary to examine the application. C.F.R. §1.56 imposes the duty of disclosure and candor on everyone associated with an application. If a party attacking a patent is able to show that information regarding patentability was intentionally withheld, the patent could be rendered unenforceable due to inequitable conduct. This should encourage applicants to disclose even unpublished information, particularly if requested by an examiner.<sup>77</sup> It is clear that US patent law is flexible enough to accommodate TM (as is the case for joint inventions) but it is up to the right holders to use the law. Two recent cases pitted India against the USPTO in an effort to uphold the rights of TK right holders.

72 See Margo A. Bagley, *Patently Unconstitutional: The Geographical Limitation on Prior Art in a Small World*, 87 MINN. L. REV. 679 (2002).

73 Fecteau, *supra* note 16.

74 See de Carvalho, *supra* note 7, at 54.

75 *Breuer v. De Marinis*, 558 F. 2d 22, 194 U.S.P.Q. (BNA) 308 (C.C.P.A. 1977).

76 Shayana Kadidal, *Subject-Matter Imperialism? Biodiversity, Foreign Prior Art and the Neem Patent Controversy*, 37 IDEA 401 (1997).

77 See Bagley, *supra* note 72, at 740.