

## US Responses to Online Survey on Information Systems

1. No. U.S. law does not specifically require the establishment of information systems on GRs, TK and/or TCEs, however it requires that inventions, to be patentable, must be novel and non-obvious.

As part of the examination of patent applications, it is necessary to obtain the relevant prior art for the application. Thus, there is a need for databases of prior art.

### **35 U.S. Code § 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*

*(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.*

### **35 U.S. Code § 103 - Conditions for patentability; non-obvious subject matter**

*A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.*

The USPTO as well as commercial entities maintain databases containing patent and non-patent literature (NPL) which can be used by USPTO examiners to examine patent applications and by the public to evaluate the patentability of inventions.

Commercial databases may provide proprietary search interfaces and may charge to permit access to the database, but are generally accessible by the public. Non-patent literature references contained in the databases may be subject to the rules of copyright law. The USPTO's position on the role of fair use in using non-patent literature is the subject of a January 19, 2012 memorandum, "USPTO Position on Fair Use of Copies of NPL Made in Patent Examination."

There are no public databases relating to trade secrets, since a principal requirement of trade secrets is that they are subject to reasonable efforts under the circumstances to maintain the secrecy of the trade secret.

2) No

3) Databases that include GRs, TK, and TCEs exist in the United States. These databases are for purposes including preservation, research, defensive protection against the registration of trademarks, and searching patent prior art. For example, the US Department of Agriculture maintains the Plants Database and AGRICOLA and USPTO maintains the Tribal Insignia database.

While there may be works registered with or recorded by the Copyright Office that could be described as TCEs, the Copyright Office's registration and recordation records are not organized or searchable by whether a work is a TCE, so there is no practical relevance of these databases to TCEs.

4) In the United States, the object of databases containing prior art, both patent literature and non-patent literature, is to ensure that patents are issued in compliance with the requirements of U.S. law. In particular, that only novel, non-obvious inventions are granted a patent, under 35 U.S. Code § 102 and 35 U.S. Code § 103.

Another object of prior art databases is to ensure that the public has access to information and references which are relevant to the patentability determination of inventions. It is beneficial for inventors to know what prior art may be relevant to their invention before filing for a patent application. That allows the inventor to evaluate the commercial viability of the invention and the likelihood of obtaining a patent. This knowledge also improves the quality of patent applications that are filed.

5) Only information that is available to the public is typically included in prior art databases, since only patent literature and non-patent literature information that is available to the public can be used to determine whether an invention is novel or non-obvious, thus patentable, during the examination process.

6) n/a

7) Control of the information in the database depends on the database operator, typically the operator controls the information. The owners / providers of the underlying information contained in the database may negotiate with the database operators on the conditions for inclusion of the information in the database.

In the case of publicly accessible USPTO databases, information relating to patent applications that have not yet been published is not included, since non-published applications are confidential by law. USPTO databases which do not contain unpublished applications are accessible by the public.

Databases containing non-patent literature which may be affected by U.S. copyright law are set up with access rules that comply with U.S. copyright rules. The USPTO's position on the role of fair use in using non-patent literature is the subject of a January 19, 2012 memorandum, "USPTO Position on Fair Use of Copies of NPL Made in Patent Examination."

8) n/a

9) Including information in as information does not, in itself, establish patent rights nor deny patent rights of another. Information that is kept as a trade secret, if included in a publicly available database, may lose its protection as a trade secret if it is found that it is no longer subject to efforts that are reasonable under the circumstances to maintain its secrecy.

10) n/a

11) n/a

12) Databases containing prior art used to determine the novelty and non-obviousness of inventions should only contain information that is publicly available and the underlying information they contain should be accessible by the public.

13) We suggest that WIPO undertake the following:

- Assist IP Offices in obtaining access to databases of prior art based on GR, TK and TCE.
- Evaluate whether interoperability standards are an impediment to sharing GR, TK and TCE data contained in databases.