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 is represents a geographic disparity.[72] 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has been cited as a discriminatory provision.[73] A group based outside of America could have an unprinted and unpublished aspect of their TK appropriated by a US patent.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.[74] 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 According to 35 U.S.C. §104 evidence of unpublished foreign knowledge can be used to challenge priority.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.[75] 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.[76] 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 This should encourage applicants to disclose even unpublished information, particularly if requested by an examiner.[77] It is clear that US patent law is flexible enough to accommodate TM (as is the case for joint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 Imperialsim? Biodiversity, Foreign Prior Art and the Neem Patent Controversy*, 37 IDEA 401 (1997).
77 *See* Bagley, *supra* note 72, at 740.