



Question Q233

National Group: Canada

Title: Grace period for patents

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Questions

The Groups are invited to answer the following questions under their national laws. If both national and regional laws apply to a question, please answer the question separately for each set of laws.

I. Analysis of current law and case law

- 1) Does your country or region provide a grace period of any kind for patent applicants? As used in these questions, "grace period" includes any situation where a disclosure prior to a patent filing date that would normally qualify as prior art to the patent application is disqualified as or removed from the prior art.

Yes.

2) If the answer to Question (1) is yes, please answer the following sub-questions:

a) What is the duration of the grace period?

One year.

b) From what date is the grace period calculated? Please indicate the effect, if any, of an international filing date and/or a Paris Convention priority date.

In Canada, the grace period is calculated from the Canadian filing date. For national phase entries of PCT applications, the Canadian filing date is deemed to be the PCT international filing date. The Paris Convention priority date is not relevant to the calculation of the grace period.

c) What types of intentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

All public disclosures made by the "applicant", whether intentional or unintentional, qualify for the grace period. "Applicant" is defined in the Canadian *Patent Act* to include inventors and their legal representatives (e.g., assignees).

As the Canadian *Patent Act* does not require such public disclosures to originate with the inventor(s), the grace period may arguably extend to public disclosures made by the "applicant" that originate with individuals other than the inventor(s) when authorized by the applicant.

d) What types of unintentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

See answer to c).

e) What types of acts, disclosures, or exhibitions by a third party who is not the applicant, inventor, or co-inventor qualify for the grace period?

All public disclosures made by a third party who obtained knowledge of the disclosures, directly or indirectly, from the applicant qualify for the grace period. No public disclosures made by a third party who did not obtain knowledge of the disclosures, directly or indirectly, from the applicant qualify for the grace period.

f) To the extent not already answered in Question 2) e) above, is there any situation where a disclosure by a third party who did not learn of or derive the invention from the inventor(s) can be covered by the grace period?

The grace period for any patent application extends to public disclosures by the applicant. As a consequence, disclosures by two unrelated inventors (third parties to each other) that flow through the same applicant may be captured by any grace period afforded this applicant. See answer to c).

g) Is any type of statement or declaration by the applicant required to invoke the grace period?

No.

If yes:

What are the requirements for the statement/declaration? N/A
When must the statement/declaration be filed? N/A

- h) Is the grace period defined by a statute or regulation? If so, please provide a copy of the relevant portion of the statute or regulation.

Yes.

The Canadian *Patent Act* states at paragraph 28.2 (1):

The subject-matter defined by a claim in an application for a patent in Canada ... must not have been disclosed

(a) more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere ...

Section 2 of the Canadian *Patent Act* sets out the following definitions of terms:

“applicant” includes an inventor and the legal representatives of an applicant or inventor;

“legal representatives” includes heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions.

- i) Is there any special situation where only certain types of applicants/inventors are allowed to benefit from graced disclosures? (such applicants/inventors may include SMEs, universities, individuals, etc.)

No.

Policy

- 3) If your country or region provides a grace period for patents, please answer the following sub-questions:

- a) What are the policy reasons behind this grace period?

The policy reasons behind the grace period include:

- (i) providing applicants with limited financial resources time to assess commercial viability of their inventions;
- (ii) protecting unsophisticated applicants from some inadvertent prejudicial disclosures; and

(iii) facilitating early public dissemination of research results by academic applicants.

b) Is the grace period, as it currently exists in your country or region, considered useful?

Yes.

c) Is the grace period considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

The grace period may possibly be more useful for individual inventors and small business applicants as they tend to have fewer financial resources and thus need more time to assess the commercial viability of their inventions. Individual inventors and small business applicants also tend to be less sophisticated and therefore may be more prone to making inadvertent prejudicial disclosures.

Further, the grace period may possibly be more useful for academic applicants as they face more pressure to disclose their inventions early through academic publications.

d) How often is the grace period used? If you are unable to provide a quantitative answer to this question, please indicate one of: often; occasionally; or almost never.

Uncertain. Frequency of use is difficult to quantify since there is no requirement for a statement/declaration to invoke the grace period.

The grace period is likely to be used at least occasionally, especially by applicants who are only interested in filing in the U.S. and Canada.

4) If your country or region does not provide a grace period for patents, please answer the following sub-questions:

N/A

a) What are the policy reasons behind not providing a grace period?

b) Would a grace period be useful for stakeholders in your country or region?

c) Would a grace period be considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

5) What are the positive aspects of the grace period law of your country or region?

There is no requirement for any statement/declaration to invoke the grace period.

There is no requirement to distinguish between intentional and non-intentional public disclosures.

All forms of public disclosures are covered by the grace period.

6) What are the negative aspects of the grace period law of your country or region?

The grace period is measured from the Canadian filing date, and not the priority date under the Paris Convention, which may create a potential pitfall for applicants who rely on Paris Convention priority.

- 7) As a practical matter, are the procedures and strategies of patent applicants in your jurisdiction affected by the grace period laws of other countries or regions? If so, in what way?

Given the first-to-file priority rules in Canada and elsewhere, and the lack of a grace period in some jurisdictions, best practice in Canada generally calls for use of the grace period not as a filing strategy, but rather to protect applicants from inadvertent prejudicial disclosures.

II. Proposals for harmonisation

The Groups are invited to put forward proposals for the adoption of harmonized laws in relation to grace periods for patents. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws.

- 8) In your view, and assuming a proper balance is struck between the rights of the applicant and the rights of the public at large, is a grace period for patents desirable?

Yes.

- 9) Is harmonization of laws relating to grace periods for patents desirable?

Yes.

- 10) Please provide a standard that you consider to be best in each of the following areas relating to grace periods:

- a) The duration of the grace period

One year.

A duration matching the one year period for claiming priority under the Paris Convention ensures that the grace period covers public disclosures made after filing of a priority application, but before filing of a subsequent application within the priority year. Thus, public disclosures covered by the grace period are not prejudicial to the subsequently-filed application even if a priority claim is not made or is unavailable.

- b) The date from which the grace period is calculated

The grace period should be calculated from the priority date under the Paris Convention, as this date is common across jurisdictions and thus facilitates ready harmonization.

- c) The types of intentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

All public disclosures by the applicant or third parties that originate with the inventor(s) should be covered by the grace period, regardless of the type of acts or disclosures, and regardless of whether the disclosures were intentional or unintentional. This scope of coverage for the grace period provides for a clear and consistent standard that facilitates ready harmonization.

- d) The types of unintentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

See answer to c).

- e) The types of acts or disclosures by a third party who learned of or derived the invention from the applicant that should be covered by the grace period

See answer to c).

- f) The types of acts or disclosures by a third party who did not learn of or derive the invention from the applicant that should be covered by the grace period

No acts or disclosures by a third party who did not learn of or derive the disclosure from the inventor should be covered by the grace period. Excluding such acts and disclosures from being covered by the grace period maintains an incentive to file early during the grace period.

- g) The requirement for and content of any statement/declaration by the applicant to invoke the grace period

There should be no requirement for any statement/declaration by the applicant to invoke the grace period. Any such requirement would place an undue burden on the applicant to determine whether or not the grace period needs to be invoked, by, for example, determining the scope and timing of potential public disclosures, which may be onerous. Further, the applicant may be unable to identify all public disclosures necessitating the grace period such as, for example, disclosures made by a third party without the applicant's knowledge.

- 11) The Groups are invited to comment on any additional issue concerning grace periods for patents that they deem relevant.

Harmonization of "Prior User Rights" and the interplay with grace periods may be an appropriate follow-up study for AIPPI.

SUMMARY

The Canadian Patent Act provides a grace period of one year for all public disclosures that are made by the applicant or by a third party who obtained knowledge of the disclosures directly or indirectly from the applicant. The grace period applies whether the public disclosure was intentional or unintentional. No statement or declaration is required by the applicant. The grace period is calculated from the Canadian filing date. It is proposed that a harmonized grace period should be calculated from the priority date under the Paris Convention.

RÉSUMÉ

La *Loi sur les brevets* canadienne prévoit un délai de grâce d'un an pour toutes les divulgations publiques qui sont faites par le demandeur ou par un tiers ayant obtenu de lui les divulgations de façon directe ou autrement. Le délai de grâce s'applique que la divulgation publique ait été volontaire ou involontaire. Aucune déclaration n'est exigée du demandeur. Le délai de grâce est calculé à partir de la date de dépôt canadienne. Il est proposé qu'un délai de grâce harmonisé soit calculé à partir de la date d'antériorité aux termes de la Convention de Paris.

ZUSAMMENFASSUNG

Das kanadische Patentgesetz bestimmt eine Neuheitsschonfrist von einem Jahr für alle öffentlichen Offenlegungen, die durch den Anmelder oder einen Dritten, der das Wissen von den Offenlegungen direkt oder indirekt von dem Anmelder erlangte, vorgenommen werden. Die Neuheitsschonfrist greift unabhängig davon, ob die öffentliche Offenlegung absichtlich oder unabsichtlich erfolgte. Seitens des Anmelders ist keine Erklärung oder Bekanntgabe erforderlich. Die Neuheitsschonfrist wird ab dem kanadischen Anmeldungsdatum berechnet. Es wird vorgeschlagen, dass eine angegliche Neuheitsschonfrist nach der Pariser Verbandsübereinkunft (PVÜ) ab dem Prioritätsdatum berechnet werden sollte.