

ExCo Helsinki
Adopted resolution
10 September 2013

Resolution

Question Q233

Grace period for patents

AIPPI

Noting that:

- 1) AIPPI has studied grace periods for patents on three prior occasions: Q75, Prior disclosure and prior use of the invention by the inventor (Buenos Aires Congress of 1980, Moscow ExCo of 1982); and as part of Q170, Substantive Patent Law Treaty (Lucerne ExCo of 2003).
- 2) Q75, Prior disclosure and prior use of the invention by the inventor, was considered at the Buenos Aires Congress of 1980. A resolution was reached that declared in favour of the principle of a grace period, but referred the question back to the Executive Committee for further consideration of the implementation details:
 - 1) [AIPPI]
 - a) is concerned that an inventor may publicly disclose his invention before filing a patent application, thereby depriving himself of the ability to obtain valid patent protection;
 - b) recognizes that Article 11 of the Paris Convention provides very limited protection for a disclosure made by an inventor at certain international exhibitions;
 - c) considers that it is in the public interest that the inventor should be given greater protection from the consequence of a prior disclosure by himself, and
 - d) therefore considers it desirable that where a public disclosure of an invention originates from an inventor, such public disclosure shall not be taken into consideration in assessing the patentability of the invention, if the first patent application is filed by the inventor or his successor within a certain period beginning from the disclosure, and declares in favour of the principle of introducing such a period of grace under terms and conditions to be determined.
 - 2) refers the question back to the Executive Committee for further consideration.
- 3) Q75 was again considered at the Moscow ExCo of 1982, which resulted in a resolution favouring a 6 month grace period for all disclosures originating or derived from the inventor, without a declaration requirement:

[AIPPI] declares in favour of the principle of introducing such a period of grace under the following terms and conditions:

 - i. A disclosure originating or derived from the inventor shall not by itself establish a right of priority but rather shall not be considered as part of the state of the art as against the inventor or his successor in title if it occurs within the grace period.
 - ii. Such disclosure shall include all acts of disclosure to the public by means of a written or oral description, by use, or in any other way, not withstanding where such disclosure takes place.

- 2) *The grace period shall be six months preceding the filing date of the patent application, or, if a Union priority is claimed, the date of the first filing according to Art. 4 of the Paris Convention.*
 - 3) *The burden of proof shall be on the applicant or patentee to prove that such disclosure originated with the inventor or was derived from the inventor.*
 - 4) *The inventor or his successor in title shall benefit from the grace period without being required to deposit a declaration of such disclosure.*
 - 5) *The grace period shall apply to patents of invention, inventor's certificates and utility models.*
- 4) The question of grace period was taken up again at the Lucerne ExCo of 2003, as part of the study of the Substantive Patent Law Treaty (Q170). The ExCo reached a resolution in favour of a 12 months grace period, including a permissive provision regarding declarations:
[AIPPI] adopts the following Resolution:
the term for the grace period shall be 12 months before the filing date or, if a priority is claimed, the priority date, i.e. the patent application shall be filed no later than 12 months after the public disclosure coming directly or indirectly from the inventor;
a declaration by the applicant confirming that he is entitled to benefit from such grace period may be required.
- 5) The passage of time and changes in relevant national laws make this topic ripe for reconsideration at this time, in particular:
- a) the passage of the AIA in the United States, representing an important move by the US towards global patent harmonization in many respects, including substantial changes to the grace period;
 - b) the revisions to the grace period law in Japan;
 - c) the perceived change of view of national groups on this issue;
 - d) the work of the "Tegernsee Group", attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO, which identified grace period as one of four topics being key to harmonization.

Considering that:

- 1) A grace period of some kind is provided in most countries but national and regional laws differ significantly with respect to the scope and duration of such grace period.
- 2) The term "grace period" refers to a length of time before the filing date of a patent application during which certain disclosures of the invention, by the inventor or third parties may not be considered to be prior art to the application. These types of disclosures are hereafter equally referred to as "non-prejudicial" disclosures.
- 3) The differences in the national and regional laws on grace period create difficulties and inefficiencies. Less knowledgeable applicants may either deprive themselves of the ability to obtain valid patent protection in all desired countries or omit to take advantage of existing grace periods in some territories.
- 4) Harmonization of the laws on grace period is considered to be more important in and of itself than any of the particular details of scope and term of the grace period.
- 5) It is appropriate to reiterate some of AIPPI previous resolutions, in particular that:
 - a) it is desirable to establish a grace period for patents;
 - b) a grace period shall not establish a right of priority but rather shall enable to exclude from the state of the art as against the inventor or his successor in title, disclosures which occurred within the grace period;

- 6) This question explores issues which had not been examined by the previous AIPPI resolutions, in particular the policy behind the existing laws, the needs of various stakeholders, the acts of third parties that could be covered by the grace period.
- 7) Harmonization on the grace period may be considered mainly along three possible directions:
 - a) a “limited type” grace period, covering disclosures by the inventor or his successor in title only during specific exhibitions and covering disclosures from third parties against the will of the inventor or his successor in title; such grace period is similar to that of several existing laws known to have the most limited grace period;
 - b) a “safety-net type” grace period, covering any disclosures by the inventor or his successor and disclosures from third parties deriving the invention from the inventor or his successor in title; this is considered as a safety-net because it enables to treat said disclosures as non-prejudicial, without excluding the risks for the applicant of third party disclosures; as a result such “safety-net type” grace period still encourages the applicant to file an application as early as possible;
 - c) a “priority type” grace period, covering any disclosures by the inventor or his successor and disclosures from third parties deriving the invention from the inventor or his successor in title; as well as disclosures from third party not deriving from the inventor if they come after a first disclosure by the inventor; this type of grace period is viewed as creating a right of priority to the inventor who is protected from third party disclosures made after his own disclosure, thus possibly creating an incentive to early disclosures by the inventor, rather than an incentive to early filing.
- 8) An internationally harmonized law on grace period should establish a fair balance between the interests of patent applicants and the public.
- 9) In establishing this fair balance, it is necessary to consider changes in the research and development environment which justify reconsidering the balance currently set by the existing national and regional provisions, in particular:
 - a) the increase of collaborative research;
 - b) the increasing need of early disclosure of inventions by all class of stakeholders;
 - c) the practical difficulties in avoiding any effective disclosure.
- 10) In order to focus the question on the “grace period for patents” itself, this study did not consider the related issue of prior user rights. AIPPI could valuably extend the work on the related issue of prior user rights, under the recommended internationally harmonized grace period.

Resolves that:

- 1) Internationally, a grace period should be established in order to exclude from the prior art against the inventor or his successor in title, any disclosure to the public by means of a written or oral description, by use, or in any other way, made:
 - a) by the inventor or his successor in title, irrespective of whether such disclosure is intentional or not;
 - b) by a third party who derived the content of the disclosure from the inventor or his successor in title, irrespective of whether such disclosure results from an abuse in relation to or was made against the will of the inventor or his successor in title.
- 2) The grace period shall not exclude from the prior art:
 - a) disclosures from a third party which are not derived from the inventor or his successor in title, even if said disclosures occur after a non-prejudicial disclosure;
 - b) disclosures resulting from the proper publication by an Intellectual Property Office of an application for or the grant of an intellectual property right filed by the applicant or his successor in title.

- 3) The duration of the grace period shall be twelve months preceding the filing date of the patent application or if priority is claimed, the earliest relevant priority date.
- 4) The applicant or his successor in title shall benefit from the grace period without being required to deposit a declaration of such disclosure.
- 5) The grace period shall have no effect on the date of publication of the patent application.
- 6) When a disclosure is cited the burden shall be on the party claiming benefit of the grace period to prove that the disclosure shall be excluded from the prior art.