GRACE PERIODS FOR DISCLOSURE OF AN INVENTION BEFORE APPLYING FOR A PATENT

In general, a patent application for an invention should be filed at the patent office before the invention has been disclosed to the public, because otherwise the disclosure of the invention is "prior art" to the patent application and will be taken into account when considering whether the claimed invention meets the requirements of being new and inventive. However, some countries operate "grace periods" whereby if an applicant files a patent application within a certain time after publicising the invention then the earlier disclosure is not considered to be prior art to the patent application.

This information sheet provides basic information about grace periods operated in some countries, but it is not definitive or exhaustive. Please contact us for more information if applicable.

COUNTRIES THAT OPERATE A 12 MONTH GRACE PERIOD (NON-EXHAUSTIVE LIST):

- Argentina (AR)
- Australia (AU)
- Brazil (BR)
- Canada (CA)
- Chile (CL)
- Columbia (CO)
- Estonia (EE)
- South Korea (KR)
- Malaysia (MY)
- Mexico (MX)
- Peru (PE)
- Philippines (PH)
- Turkey (TR)
- United States of America (US)

COUNTRIES THAT OPERATE A 6 MONTH GRACE PERIOD (NON-EXHAUSTIVE LIST):

- Eurasia (EA)
- Japan (JP)
- Russian Federation (RU)
- Albania (AL)
- San Marino (SM)

OPERATION OF THE GRACE PERIOD

The grace period provisions are different in each country and a careful assessment needs to be made in each case to determine whether or not the grace period applies, but general guidance is set out below.

Generally, a grace period allows 6 or 12 months for filing a patent application after a disclosure (see examples of countries with 6 and 12 month grace periods above).

Disclosures to which the grace period applies are not taken into account as prior art when assessing novelty or inventive step of the invention in the patent application.

In most countries, grace periods only apply to disclosures by the inventors or the person who is entitled to apply for the patent, not to independent disclosures by third parties.

EUROPEAN PATENT CONVENTION (EPC) MEMBER STATES

A limited number of European Patent Convention (EPC) member states operate a patent grace period. However, more operate grace periods for utility models, which are patent-like rights (see grace periods for utility models and other IP rights, below).

To make use of the grace periods in EPC member states it is usually necessary to file applications in each state either directly or via a PCT application, rather than at the European Patent Office (EPO).

<table>
<thead>
<tr>
<th>EPC Member State</th>
<th>Grace Period (months)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Estonia</td>
<td>12</td>
</tr>
<tr>
<td>Turkey</td>
<td>12</td>
</tr>
<tr>
<td>Albania</td>
<td>6</td>
</tr>
<tr>
<td>San Marino</td>
<td>6</td>
</tr>
</tbody>
</table>

UNITED STATES OF AMERICA

The "first inventor to file" system applies for US patent applications entitled to an effective date (including priority date) on or after 16 March 2013. For these applications, inventors’ disclosures (or disclosures by someone who obtained the disclosed subject matter directly or indirectly from the inventor or a joint inventor) are not prior art if made within a 12 month period before the effective filing date or priority date. In addition, subject matter disclosed by a third party within the same 12 month period is not prior art if the inventor (or someone who obtained the disclosed subject matter directly or indirectly from the inventor or a joint inventor) had already disclosed that subject matter. The grace period is calculated 12 months before the effective priority date, which may be a US or foreign priority date.
The “first to invent” system applies for US patent applications entitled to an effective date (including priority date) before 16 March 2013. For these so-called “pre-AIA” applications, inventors’ disclosures are not prior art if made within a 12 month period before the filing date of the application in the US. Third party disclosures within the 12 month grace period can also be discounted as prior art against “pre-AIA” applications if it can be shown that the inventor invented the invention before the third party did. The grace period for “pre-AIA” applications is calculated 12 months before the earliest US filing date, including an international application designating the US or a priority date of a US provisional application, but not including a foreign priority date.

APPLYING FOR A PATENT IN COUNTRIES WITHOUT A GRACE PERIOD AFTER PUBLIC DISCLOSURE

If an abstract or brief summary of an invention has already been published, it may still be possible to obtain a valid patent, even in countries where there is no grace period. For example, if the disclosure does not contain enough detail to enable a skilled person to carry out the invention, then the invention may still be considered new. Inventive step (obviousness) of the claimed invention compared with the earlier disclosure would also need to be assessed, and this would depend on how much information about the invention had been published.

DISCLOSURES IN BREACH OF CONFIDENCE AND DISPLAYS AT INTERNATIONAL EXHIBITIONS

Most countries have provisions to exempt disclosures from consideration as prior art if the disclosure was an abuse in relation to the applicant or inventor (such as a disclosure made in breach of confidence).

Certain international exhibitions also have a special status so that disclosure of an invention at the exhibition is not considered prior art against a patent application originating from the same inventor. A certificate of disclosure at the exhibition may be required.

In order to benefit from these provisions it is normally necessary to file the patent application within a set period of time after the disclosure. For example, in Europe the grace period for abusive disclosures or disclosures at exhibitions is 6 months, i.e. a European patent application (or an international application designating Europe) must be filed within 6 months of the disclosure.

GRACE PERIODS FOR UTILITY MODELS AND OTHER IP RIGHTS

Grace periods apply for other types of intellectual property rights in some countries, including registered designs and utility models. For example, there is a 12 month grace period in respect of Registered Community Designs (European Union). Therefore, for some types of inventions, other intellectual property rights may still be registrable even if a patent cannot be obtained because of an earlier disclosure.

The European Patent Convention countries in the table below operate a grace period for utility models.

<table>
<thead>
<tr>
<th>EPC Member State</th>
<th>Grace Period (months)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Estonia</td>
<td>12</td>
</tr>
<tr>
<td>Turkey</td>
<td>12</td>
</tr>
<tr>
<td>Albania</td>
<td>6</td>
</tr>
<tr>
<td>Austria</td>
<td>6</td>
</tr>
<tr>
<td>Bulgaria</td>
<td>6</td>
</tr>
<tr>
<td>Cech Republic</td>
<td>6</td>
</tr>
<tr>
<td>Germany</td>
<td>6</td>
</tr>
<tr>
<td>Hungary</td>
<td>6</td>
</tr>
<tr>
<td>Romania</td>
<td>6</td>
</tr>
<tr>
<td>Slovakia</td>
<td>6</td>
</tr>
</tbody>
</table>

Utility models are patent-like rights that differ from patents mainly in that they are often not examined for novelty and inventive step (non-obviousness) on filing, have a lower or non-existent inventive step requirement, and have a shorter duration (10 years for the above states).

It is possible to obtain utility model protection by converting a PCT patent application to a utility model.

In some jurisdictions, utility models are not obtainable for the same types of inventions as patents; process and method inventions are excluded in many jurisdictions. For example, in Germany utility models are not available for process inventions or biotechnological inventions, but are available for pharmaceutical and medical use inventions.

OTHER COUNTRIES

In addition to the countries already mentioned, there are some countries in which grace periods are specifically provided for particular types of disclosure, such as presentations of papers to scientific societies or performance of tests.

To find out whether a grace period can be used in a particular country, we recommend contacting a local patent attorney in the relevant country, which we can do on your behalf.

CONTACT US

For more information on Mewburn Ellis LLP and other intellectual property matters, please visit our website at www.mewburn.com.

If you have the name of a contact email firstname.lastname@mewburn.com or mail@mewburn.com.