

Substantive patent law harmonization: focus on grace period

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Grace period harmonization

A question regularly studied by the AIPPI

- AIPPI studied grace period for patents on several occasions:
 - ▶ At the Buenos Aires Congress of 1980 (Q75), 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
 - ▶ At the Moscow Executive Committee of 1982 (Q75), a resolution was reached favouring a 6 month grace period for all disclosures originating or derived from the inventor, without a declaration requirement
 - ▶ At the Lucerne Executive Committee of 2003 (Q170), as part of the study of the Substantive Patent Law Treaty, a resolution was reached favouring a 12 month grace period including a permissive provision regarding declarations



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A question revisited at the AIPPI in 2013

- AIPPI decided to revisit this issue in 2013 (Q233, in Helsinki), in particular because:
 - ▶ The revision of the grace period laws in Japan (in 2011) and in the United States (AIA in 2011, effective in 2013)
 - ▶ The perceived change of view of national groups on this issue
 - ▶ The work of the Tegernsee Group, which identified grace period as one of the four topics for harmonization
- The national groups were thus invited to answer a new questionnaire under their national laws



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Three types of grace period

Discussion on the grace period may be considered along three possible directions:

- 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
- 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; 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
- 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, 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




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Grace period harmonization

The position of the French group of AIPPI


- The current French and European (EPC) laws provide for a limited grace period of 6 months, in two limited cases: (1) a third party disclosure resulting from an evident abuse in relation to the applicant, or (2) a disclosure at an international exhibition as defined in the Paris Convention
- The French group was in favour of:
 - ▶ a safety-net grace period
 - ▶ of 12 months
 - ▶ from the priority date of the patent application
 - ▶ without declaration
 - ▶ having the sole effect of making non prejudicial all disclosures by the applicant and those of third parties deriving from the applicant
 - ▶ the applicant is not protected against further disclosures by third parties issuing from independent researches


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Grace period harmonization

The position of the French group of AIPPI

- Reasons of the position of the French group:
 - ▶ for sake of international harmonization, necessary for users
 - ▶ to slightly amend the balance between the interests of the applicants and those of third parties, in favour of the applicants and thus in the global interest of research and innovation
 - ▶ to soften the absolute novelty requirement, considered as too severe in certain cases:
 - ▶ increase of the collaborative research increases the risks
 - ▶ tests cannot always be kept confidential
 - ▶ need of early communication around an invention
 - ▶ non-disclosure agreement sometime difficult to get signed
 - ▶ a breach of a non-disclosure agreement is not "*an evident abuse in relation to the applicant*"


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Replies from the AIPPI national groups

- 38 national groups replied to the questionnaire
- Strong consensus to support the concept of a « safety-net » grace period and in favour of an international harmonization
- Reasons:
 - ▶ to protect the inventor (19 groups)
 - ▶ for sake of international harmonization and conformity with international conventions (11 groups)
 - ▶ protection against evident abuse (9 groups)
 - ▶ encouraging early dissemination of information (5 groups)
 - ▶ protection for academic institutions, individual inventors and SMEs (3 groups)



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Replies from the AIPPI national groups

- 30 national groups suggested a “safety-net” grace period and 7 a “limited” grace period; 1 group suggested a “priority type” grace period
- 30 groups were in favour of the priority date as the starting point of the grace period
- 18 groups suggested a 12 month grace period and 14 groups suggested a 6 month grace period
- 19 groups were in favour of a declaration and 17 against (but this result, weighted by the number of delegates at the AIPPI gave: 98 delegates favourable to a declaration and 135 delegates against a declaration)



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Resolution adopted by AIPPI (Q233) in 2013

- A harmonized grace period should be internationally established
- To exclude from the prior art:
 - ▶ any disclosure by means of a written or oral description, by use or any other way
 - ▶ by the inventor, irrespective of whether such disclosure is intentional or not
 - ▶ by a third party who derived its content from the inventor, irrespective of whether such disclosure results from an abuse in relation to or was made against the will of the inventor (disclosures by a third party which are not derived from the inventor are not covered): safety-net only
- The duration shall be 12 months preceding the priority date
- No declaration requirement



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Prospects of harmonization?

- The Standing Committee on the laws of Patents (SCP) of WIPO stopped working (since 2006) on the adoption of the Substantive Patent Law Treaty (SPLT), which contained provisions on a grace period, because developing countries would like to include other issues that they consider more important
- Some important countries are against grace period: in Germany or The Netherlands, the large industry is against the grace period; as a result, other countries (France) will refrain from taking new initiative (French COMIPI (medef) 1998)



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Prospects of harmonization?

- The European Patent Office is interested in the views of the users and sees itself as a facilitator / mediator trying achieve what the users wish
- The EPO will soon publish a final consolidated report containing the views of the users as gathered during the Tegernsee process: its view could be that there is a demand by the users for an internationally harmonized safety-net type grace period
- The main question for the EPO is whether users prefer:
 - ▶ amending EPC grace period before any change is made in other legal systems (USA, Canada, Japan)
 - ▶ amending EPC grace period only once all countries agreed on an internationally harmonized system



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Thank you

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