



Novelty Grace Periods in/under EPC, Germany, Japan and AIA – A Comparative Analysis

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Grace Period under EPC (purely defensive)

- 6 months before effective EPC filing date (Art. 55 EPC)
- Only if publication/disclosure (including public prior use) took place against obvious wish and to the disadvantage of patent applicant
- Exception:
Publication/disclosure on recognized exhibition
 - ◆ In this case, declaration at EP filing necessary, with certificate to be filed within 4 months thereafter
- Not preceding priority date

Grace Period in Germany (purely defensive)

- 6 months before effective German filing date (§3 (5) German Patent Act (GPA)), in case of patent application
- Only if publication/disclosure (including public prior use) took place against obvious wish and against end to the disadvantage of patent applicant
- Exception: Publication/disclosure on recognized exhibition
 - ◆ In this case, declaration at EP-filing necessary, with certificate to be filed within 4 months thereafter
- 6 months before priority date according to §3 (1) Germany Utility Model Act (GUMA)
 - ◆ If by or based on communication of/from inventor
 - ◆ preceding priority date in case of utility model application, but only preceding filing date in case of patent application

Grace Period in Japan (purely defensive)

- New law from April 1, 2012
- 6 months for a person whose invention was disclosed by a third party against his/her will (new §30 (1) of Japanese Patent Act (JPA))
- Provided that disclosure/publication by inventor or based on invention (except for publication of patent, utility model, design, or trademark (new §30 (2) of JPA))
- Grace period not preceding priority date

Grace Period according to AIA – purely defensive or creating priority?

- Defensive grace period of 12 months similar to EPC, DE and JP, if disclosure/publication by inventor or derived from inventor (Section 102 b) of AIA
- First inventor to disclose, in case of two independent/different inventors, is entitled in patent, even if, within grace period of 12 months of disclosure, he/she files patent application later than an earlier application of same (independent) invention by a different inventor
- Question: Factually first-to-disclose and thereby first-to-invent system?
- Or second inventor to publish presumed to be „derivative“ inventor?
- Mini-interference in USPTO necessary in order to determine content of first and second disclosures?
- Grace period not preceding Paris Convention (PC) priority date