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Intellectual Property Alert

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Understanding global grace periods to avoid missing patent opportunities

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Inventors and patent applicants should consider the grace periods available in many jurisdictions when making strategic decisions about whether and where to seek patent protection.



What's the Impact?

- / The US provides a one-year grace period for certain inventor-related disclosures; a number of other countries and regions also provide similar six-month or one-year grace periods
- / Many other jurisdictions also provide for grace periods, albeit under more limited circumstances
- / Familiarity with requirements surrounding grace periods in various jurisdictions can be useful and important when building a patent portfolio

Ideally, inventors will not publicly disclose their invention until they have filed a patent application, but this approach is not always practical. Certain jurisdictions, including the United States, provide grace periods that allow an applicant to obtain patent protection even after the invention has been publicly disclosed. The scope and duration of these grace periods varies

across jurisdictions, and it is important to consider a jurisdiction's grace period (or lack thereof) when making strategic decisions about where and when to seek patent protection.

Invention disclosure before patent application filing

When a patent application is examined, the invention will be compared to the "prior art" to determine whether the invention is new and inventive. This prior art can include patents, publications, and products, among other things. In fact, the inventor's prior work (e.g., published papers, offers to sell the invention, presentations) could potentially be prior art, too.

For this reason, patent professionals generally advise filing patent applications as soon as possible to limit the potential universe of prior art. Ideally, the patent application will be filed *before* the inventor publicly discloses (e.g., publishes, presents, or sells) the invention.

However, at least some jurisdictions (including the United States) allow the inventor to publicly disclose the invention for a limited period of time *before* filing for patent protection without creating disqualifying prior art, if certain conditions are met. Several countries afford these so-called "grace periods." The scope and duration of these grace periods depends on the jurisdiction.

Grace periods in the US

The America Invents Act (AIA) provides a one-year grace period for disclosures by an inventor. This grace period applies if:

- / the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- / the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.¹

For example, if an inventor discloses their invention at a trade show before filing a patent application, that disclosure will not qualify as prior art in the US so long as the inventor effectively files a patent application within the one-year grace period.

The AIA grace period provisions also eliminate certain disclosures by *others* from being considered prior art. In the above example, sales of the invention by a third party after the trade show but before the inventor files the patent application within the one-year grace period, would also not be considered prior art in the US.

¹ 35 U.S.C. §102(b)(1)(A)-(B).

Grace periods in foreign jurisdictions

Each country's (or region's) patent office has its own rules about grace periods. For example, many offer no grace period at all, while others offer grace periods for inventor-originated disclosures, similar to the US.

Some jurisdictions have narrow grace periods that only apply to disclosures at certain recognized exhibits or disclosures resulting from an abuse of relation (e.g., a breach of contract). As discussed above, many applicants choose to share their invention with others but maintain secrecy using non-disclosure agreements (NDA). Generally, if someone breaches the NDA and publicly discloses the invention before a patent application is filed, such a disclosure would be disqualified as prior art.

Examples of countries with grace periods based on inventor-originated disclosures include:

- / Australia (12-month)
- / Canada (12-month)
- / Eurasian Patent Organization (6-month)
- / Mexico (12-month)
- / Republic of Korea (12-month)
- / Russian Federation (6-month)
- / United States (12-month, as described above)

Examples of countries with narrower grace periods based on abuses of relation (e.g., breach of contract) and/or disclosures at certain official exhibitions include:

- / Cooperation Council for the Arab States of the Gulf (12-month for abusive actions against applicant; 6-month for official exhibitions)
- / European Patent Office (6-month)
- / Saudi Arabia (6-month for arbitrary acts against applicant; 12-month for official exhibitions)
- / Spain (6-month)
- / Sweden (6-month)
- / Switzerland (6-month)
- / United Kingdom (6-month)

These lists are not exhaustive, additional requirements may need to be met for various jurisdictions, and these grace periods may change over time.

Looking ahead

Knowledge that different types of grace periods exist in different countries can be important when building a patent portfolio, especially when public disclosures or other events have occurred or may occur that might otherwise result in problematic prior art against a later-filed patent application. Even if a grace period is unavailable, a disclosure may not preclude the ability

to obtain a patent if the disclosure does not contain sufficient detail to enable a person skilled in the art to make or use the invention.

Finally, since the rules and requirements surrounding grace periods in various countries can change over time, it is always recommended to consult with your patent counsel when considering patent filings for an invention that has already been disclosed.

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