



**Statement Adopted on the Occasion of
a Conference on “Grace Period”
in Kiev, October 10, 2013**

Convened by ALLEA and the National Academy of
Sciences of Ukraine (NAS)

Statement Adopted on the Occasion of ALLEA-NAS of Ukraine Conference on “Grace Period” in Kiev, October 10, 2013

In the Kiev Conference on “Grace Period”, jointly convened by the Federation of European Academies of Sciences and Humanities (ALLEA) and the National Academy of Sciences of Ukraine (NAS), chaired by Professor Joseph Straus, chair of ALLEA Permanent Working Group on Intellectual Property Rights, representatives of ALLEA for the first time met with representatives of the European Patent Office (EPO), the Japanese Patent Office (JPO), the State Intellectual Property Office of the PR China (SIPO), and the State Intellectual Property Service of Ukraine¹, to discuss the instrument of grace period in patent law which immunises inventors against their own disclosures preceding the filing of patent applications. Based on thorough deliberations of most important aspects surrounding the instrument of grace period, the participants wish to:

Recall

1.1 That under the patent laws in force in Europe, including the European Patent Convention (EPC), no grace period exists, which would shield, e.g. immunise inventors and their successors in title against their own disclosures, which occur prior the filing of the respective patent applications.

1.2 That the six months grace period of Article 55 (1) (a) EPC, and the corresponding provisions of national patent laws of the states parties to the EPC, is limited to disclosures of third parties based on „an evident abuse in relation to the applicant or his legal predecessor“, if they occurred no earlier than six months preceding the filing of the European Patent application – not the priority application [Enlarged Board of Appeal Decisions G 3/98, OJ EPO 2001, 62, G 2/99, OJ EPO 2001, 83].

1.3 That the six months grace period of Article 55 (1) (a) EPC strictly applies also in case of the so-called „fictitious prior art“ being based on an evident abuse in relation to the applicant or his legal predecessor. Thus, an inventor whose invention was described in an prior filed patent application based on an evident

abuse in relation to that inventor, has to file his/her patent application with the European Patent Office within six months from the filing of the first (also priority) application in order to benefit from the grace period, although he/she, as a very rule, will have no knowledge of such an application [German Federal Supreme Court, GRUR 1996, 349 = OJ EPO 1998, 263].

1.4 That a number of European States, which after 1991, following the failed WIPO Patent Law Treaty, introduced a grace period into their national laws, such as Bulgaria, Estonia, Lithuania, Romania and Slovenia, abandoned the grace period upon their accession to the European Union.

1.5 That the „Tegernsee Group“, attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO, identified grace period as one of four topics being key to harmonisation.

1.6 That the International Association for the Protection of Intellectual Property (AIPPI), the oldest, largest and non-lobbying international association in the field of IP, which has argued in favour of a grace period over the last 33 years, on September 10, 2013 at its Executive Committee Meeting (governing body) in Helsinki, by a majority of more than 90 % adopted a Resolution (Q 233) in which it resolved 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.

¹ Representatives of the US Patent and Trademark Office, who firmly confirmed their participation, could not participate due to the general shutdown of the US Government.

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.*

1.7 That in patent laws of some thirty countries, among them Argentina, Australia, Belarus, Brazil, Canada, PR China [in case of exhibitions and some other specific cases of disclosures made in academic meetings], Japan, European Patent Convention [EPC - against all disclosures in internationally recognised exhibitions], Rep. of Korea, Mexico, Russian Federation, Ukraine, and the USA, a grace period exists, which immunise inventors against their own pre-filing disclosures, but that the respective provisions vary as regards the length of the grace period, the point in time from which it is calculated [priority date or actual date of filing] and the required formalities.

1.8 That recent empirical data provided by the JPO shows that a need exists for a grace period which covers all disclosures as a result of acts conducted by a person having the right to obtain a patent; this is reflected in the fact that the number of patent applications invoking grace period has increased by about 80 % since the respective broadening of the former rule relating to the grace period was

introduced in the Japanese law in 2012, and that the increase is not only from SMEs or joint applicants, such as universities and their partners, but also from large companies.

Note

2.1 That scientists and researchers especially in publicly funded institutions world-wide are expected and required to generate new knowledge and disseminate it to the public without undue delay. Without a safety-net of a grace period the risk of unintentionally disclosing research results potentially eligible for patent protection and of high economic value leading to an automatic and complete loss of proprietary rights in them, is not acceptable.

2.2 That, whereas inventors and their employers from European countries can secure proprietary rights in their pre-disclosed inventions due to existing grace periods in patent laws of countries representing a population, i.e. markets, of close to two billion, inventors of pre-disclosed inventions from those countries are deprived of any patent protection in Europe, thus their inventions can be used free of charge in a market of more than 500 million inhabitants.

2.3 That patent laws providing for a grace period have not caused any particular problems to applicants, also to those from the European Union. In the course of patent law harmonization deliberations in the World Intellectual Property Organization (WIPO) no court cases have become known which could be used as evidence of an increased legal uncertainty due to existence of a grace period in comparison with the legal situation in Europe, where such a grace period does not exist.

2.4 That, whereas grace period has correctly been identified by the „Tegernsee Group“ as one of four key topics of patent harmonisation, the complete lack of a grace period in an area covering a market of more than 500 million inhabitants (Europe Union) in a globalised world can no longer be reduced to a „key topic“ of patent law harmonisation, but in fact constitutes a severe imbalance in terms of international relations in the area of science and technology and economy, and should also be treated as such.

2.5 That in order to provide for a safety-net for inventor's own pre-filing disclosures, which due to their mission is of particular importance for scientists and researchers working in publicly funded research

institutions and universities, and due to specific circumstances of small and medium-sized enterprises (SMEs) for their inventors, and in order to remove the obvious disadvantage for inventors from countries providing for a grace period, a proper balance of interests in the field is to be established by introducing a minimum standard for a grace period of a general type, i.e. excluding from relevant prior art pre-filing disclosures of inventors and their successors in title, which occurred within a certain period of time preceding the filing of application.

2.6 That, whereas a minimum standard for a grace period of general type is to be regarded as a necessity for removing the existing imbalance in international relations, which results in one sided opportunities for the free-of-charge use of third parties' inventions, the necessity also exists to further harmonise rules related to grace period in regional and national patent laws, which vary to a remarkable extent.

Consider^{2,3}

3.1.1 Based on empirical evidence offered at the Conference, that a grace period of general type shielding the inventor or his successor in title, against any disclosure to the public by means of a written or oral description, by use, or in any other way, no matter where the disclosure occurred, and irrespective whether such disclosure is intentional or not, should be viewed as a minimum standard to be found in all national patent laws or regional patent law treaties.

3.1.2 That such a grace period should be one of at least six-months preceding the national or regional filing.

3.1.3 That notwithstanding the consideration above [3.1.2], a six-months grace period preceding the priority filing would be a preferred alternative for the minimum standard.

3.2 That for reasons of legal certainty, and having regard to objections continuously raised against a grace period of general type, the grace period should be invoked by the applicant formally at the filing date and should be complemented with a declaration indicating pre-filing disclosures, which should be submitted to the patent office within a reasonable period of time following the filing of the patent application.

3.3 That such a grace period would adequately take into account the interests of the inventor as well as those of competitors and the public at large, and would also provide for a balance of interests in the international context addressed above [2.2 - 2.6] and be in line with the general principles underlying the patent system.

3.4 That the adoption of the proposed minimum standard related to grace period of a general type would in no way affect the provisions related to such a grace period already in force in a number of Member States of the World Trade Organisation.

3.5 That the adoption of the proposed minimum standard should in no way interfere with the ongoing efforts to internationally harmonise the rules related to the grace period which at present vary to a large extent [above 1.7] and therefore should be viewed as a final goal of international efforts aimed at a broader harmonisation of substantive patent law.

Kiev, 10 October 2013

Professor Günter Stock, President of ALLEA
Professor Joseph Straus, Chair of the ALLEA Permanent Working Group on Intellectual Property Rights
Professor Carlo D'Adda, Member of the ALLEA Board
Professor Boris E. Paton, President of the National Academy of Sciences of Ukraine
Professor Yuriy Kapitsa, Fellow of NAS and member of the ALLEA Permanent Working Group on Intellectual Property Rights

Contact

ALLEA Secretariat
c/o Berlin Brandenburg Academy of
Sciences and Humanities
Jaegerstr. 22/23
10117 Berlin
Germany
Phone: +49 (0)30-3259873-72
Fax: +49 (0)30-3259873-73
Email: secretariat@allea.org
www.allea.org

² The representative of the EPO took no position as regards the considerations.

³ The representative of SIPO explicitly declared that for the time being the considerations could not be shared.