



FICPI WHITE PAPER

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EXECUTIVE SUMMARY

TITLE: *FICPI White Paper on Grace period*

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At least since 1983 FICPI has expressed, through the approval of more than a dozen resolutions, its support for an internationally widespread and uniform novelty grace period. In most instances, this support has been linked to a desire to achieve substantive patent law harmonization.

Now, because of international developments, notably the study carried out by the Tegernsee Group (2011-2012), patent law reforms in the US (2012), Japan (2012) and Korea (2013), and practical experiences by FICPI members during recent years, FICPI has revisited the grace period issue in order to update its position. The current views on various aspects of the grace period are presented in the attached paper,, following discussions in the Work and Study Commission (CET) of FICPI, and a special Grace Period Working Group within the CET, as well as a workshop in Cartagena.

The current views can be summarized briefly as follows.

Generally, FICPI still favours an internationally widespread and uniform novelty grace period for patent applications, where an applicant's own disclosure is excluded from the prior art for the assessment of both novelty an inventive step.

The general justification for a grace period in the patent system according to FICPI, benefits:

- Society and the public at large;
- Third parties and competitors; and
- Obviously, the inventors (and their assignees or licensees).

Upon study by FICPI, it has become clear that the laws and practice concerning exceptions to the novelty requirements vary widely across the world, causing an undesired imbalance. In spite of the fact that many countries have grace period provisions, these cannot be used by globally active applicants, since a subsequent application in e.g. Europe will be rejected for lack of novelty.

As in many other aspects of patent law and practice, it is desirable, out of fairness and reciprocity, to have uniformity, in particular in terms of:

- the existence of a grace period,
- the duration of a grace period,
- the provisions relating to third party disclosures and activities occurring during a grace period after a pre-filing disclosure, and
- a voluntary or mandatory declaration at the time of filing.

Without such uniformity, there will be severe imbalances in the global patent system, with associated further costs and complications during the prosecution of parallel patent applications in various jurisdictions.

After reviewing a number of factors related to specific manners of implementing a grace period, the paper concludes that an internationally wide-spread and largely uniform grace period is justified, preferably with the following features:

1. Term: 12 months;
2. Counted from: priority date (according to previous resolutions), or filing date only –



FICPI has recognized good arguments for both alternatives;

3. Purpose: safety net;
4. Coverage: any form of prior disclosure caused by or derived from the inventor. Hence, independent disclosures by others are not covered, and a pre-filing disclosure does not constitute a priority right;
5. Declaration: should not be mandatory;
6. Proving entitlement to grace period: procedures may be adopted to determine whether or not a specific disclosure drawn to the attention of an applicant/patentee is derived from the inventor, and the burden of proof should initially be on the applicant/patentee;
7. Prior user rights: third parties may acquire prior user rights irrespective of a disclosure made by the inventor before the filing date under the grace period, provided that all other criteria for obtaining prior user rights are met.

[End of executive summary]