



A Comparative Study of the Grace Period — China, United States and Europe

Dawei Li

Changsha Chuwei Interlectual property agency, Changsha 410205, Hunan, China

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Abstract: Novelty grace period as an exception to the prior art has a significant impact on the determination of the patentability of patent applications in various countries. Because of the variety of provisions on the novelty grace period, it has brought inconvenience to applicants who want to apply Patent in various countries. Therefore, the grace period has become an important topic of international coordination of patent law. This paper analyzes and compares the grace period stipulations in China, the United States and Europe, which leads to the thinking on the development direction of the novel grace period.

Keywords: patent, novelty, grace period

1. Introduction

Novelty is a very important patentability requirement. An invention is not new and therefore not patentable if it was known to the public before the date of filing of the patent application, or before its date of priority if the priority of an earlier patent application is claimed. The purpose of the novelty requirement is to prevent the prior art from being patented again.

Novelty grace period as an exception to the prior art has a significant impact on the determination of the patentability of patent applications in various countries. Because of the variety of provisions on the novelty grace period, it has brought inconvenience to applicants who want to apply Patent in various countries. For example, which I frequently deal with in my work, if a US applicant want to apply for patent in china and claim US priority, we have to check whether invention has been disclosed in the grace period of priority application, which type invention was disclosed in, and how long was disclosed before the priority date. In many cases, such disclosure will make inventions loss of novelty in China.

Therefore, the grace period has become an important topic of international coordination of patent law. This paper analyzes and compares the grace period stipulations in China, the United States and Europe, which leads to the thinking on the development direction of the novel grace period.

2. The basic concept of novelty grace period

2.1 The concept of novelty grace period

The novelty grace period derives from the Paris Convention for the Protection of Industrial Property (hereinafter referred to as "the Paris Convention") and its article 11 provides that the State Party shall treat the goods exhibited at an officially recognized international exhibition organized in any Member State shall be granted temporary protection in respect of patents, inventions, utility models, designs and trademarks. The basic principle of the Paris Convention is the determination of patent rights in accordance with the "first to file principle". The invention disclosed prior to the filing date belongs to the prior art and is not patentable, but there is a prescribed exception, which is the embryonic form of novelty grace period .

A grace period is a period in which the applicant can still apply for a patent without losing its novelty after disclosing his invention-creation period, which makes the disclosure of the invention-creation within a certain time before the application date not constitute the prior art and provides the applicant with a favorable period .

2.2 The Classification of Novelty Grace Period

From the scope of application of the grace period, can be divided into two types: First, the narrow grace period, its scope of application only in the provisions of the international exhibition and the exhibition will be contrary to the wishes of the applicant; the second is a broad grace period, The type of disclosure covered includes, in addition to the narrow grace period, the circumstances in which the applicant publishes or publishes in public publications prior to the filing date of the application, as well as the disclosure of the invention directly from the applicant and is made public by others situation.

From the point of view of the grace period, there are two types: one is based on the actual filing date as the starting point for calculating the grace period, and the other is when the patent application enjoys priority, Calculate the grace period

as the starting point of time.

In terms of the length of the grace period, there are two types: 6 months or 12 months.

3. China's Provisions on the Grace Period for Novelty

Article 24 of the Patent Law of the China stipulates that "a patent-eligible invention or creation shall not lose its novelty within six months prior to the date of filing of the application: (1) at the international exhibition sponsored or recognized by the Chinese Government; (2) the first published in the prescribed academic or technical conference; (3) the disclosure of its contents without the consent of the applicant." As can be seen from this provision, the novelty grace period of China is a narrow grace period, which does not include the applicant's own disclosure of its invention-creation by publication or public use, etc. prior to the filing date, and the disclosure of the invention-creation by other person get from the applicant.

3.1 Types of disclosures that the novelty grace period covers

- (1) the Chinese government sponsored or recognized the international exhibition for the first time on display;
- (2) published in the prescribed academic or technical conference;
- (3) others without the consent of the applicant to disclose its contents.

3.2 Term length of Novelty Grace Period

China's "Patent Law" provides that the period of grace is "within six months before the filing date". And "the filing date" is priority date if the application claim the priority.

4. America's Provisions on the Grace Period for Novelty

On September 16, 2001, the President of the United States formally signed the American Invention Act (AIA), which came into effect on March 16, 2013, so the biggest change in the history of US patents was finally implemented, the international harmonization of the patent system is also a big step forward. The most fundamental change of the Amended Inventive Act is the change from the "first to invent system" to "first-inventor-to-file ". This fundamental change in the patent system has brought about a number of changes to the substantive statute, in which the change in the novelty provision is in particular, the grace period rules, which are closely related to novelty, are modified. The following section will introduce and analyze the provisions concerning the grace period for novelty before and after the American Invention Act.

4.1 The implementation of the novelty grace period after "The American Invention Act"

In order to accommodate this major change in the first application, the AIA provisions on the grace period were modified accordingly and continue to be specified in Article 102 (b) of the Act.

The AIA still maintains a 12-month grace period compared to the pre-amended US patent law, but has also produced some changes, mainly in the open category of others as an open subject when the limit and calculate the grace period Changes in the starting date.

4.2 Types of disclosures that the novelty grace period covers

AIA modified the original US hybrid novelty standard to absolute novelty standard, that is, any form of public disclosure worldwide may constitute the existing technology. Accordingly, the public form covered by the grace period also provides for any form of disclosure by any country in the world, such as publication, public use or sale, patentability and any other publicly available approach, we can see, AIA is still using the provisions of the broad grace period, the grace period covers a very broad type of disclosure.

However, in order to adapt to the new application system, AIA restricts the disclosure of the subject matter to the original United States Patent Law without any restriction, and restricts the disclosure of inventions to others, either directly or indirectly, from the inventor Or the co-inventor, that is to say, if the invention is invented by another person not from the inventor or co-inventor, but from a third party who independently made the invention, The disclosure of the invention-creation will not fall into the disclosure of the invention after the application has not lost its novelty.

4.3 Term length of Novelty Grace Period

The AIA still provides for a 12-month grace period, but the AIA has changed the starting date for the grace period.

The original United States patent law is based on a prior invention, which has the effect of proving the date of the invention, but under the exception of 35 U.S.C. 119 (a), the grace period set forth in the US patent law The point is the actual filing date or the national priority date, but not the foreign priority date. The effectiveness of a foreign priority is greatly enhanced in the United States after the first filing system has been applied, and the effective date of the United States, as now

affirmed by the IA, also includes the foreign priority date.

5. European novelty grace period

The European Patent Convention (EPC) has undergone four revisions since it was signed in 1973, and only one of the last amendments, in November 2000, covered a number of substantive issues, Amendments to the European Patent Convention, 2000. And the provisions relating to the grace period for novelty have not been addressed in previous revisions, and as such the current EP C section 55, Namely article 55 at the time of the signing in 1973, which provides for the grace period for novelty.

5.1 Types of disclosures that the novelty grace period covers

According to article 5 of the EPC, the European novelty grace period is a narrow grace period, which covers only two types of disclosure.

5.1.1 The apparent misuse of the disclosure resulting from the relationship with the applicant or its lawful prior right holder

Such a situation requires that the content of the disclosed invention-creation must originate from the applicant or its lawful prior right holder and that the apparent misuse is a very serious act and that the standard of proof is also very high and that the apparent misuse must be actual, Presumed abuse cannot be accepted[1], in order to determine apparent misuse, a person who discloses the inventive creation must have actual intent to cause harm, or that his or her actual or presumed public conduct is likely or likely to cause harm. This type may apply where there is an express or implied confidentiality agreement, violation of the applicant's wishes or disclosure resulting from failure to obtain approval. In principle, the manner in which such a situation is disclosed is not limited and may be oral, written, publicly available, or the like.

5.1.2 In the government-sponsored or government-recognized international exhibition of its invention

In this case, the EPC clause stipulates that international exhibitions shall meet the conditions set forth in the Convention on International Exhibitions, which are officially recognized exhibitions, which are regularly published by the European Patent Office in its official journal (official journal) Applicants can make inquiries according to their needs.

5.2 Term length of Novelty Grace Period

The EPC provides a grace period of six months, and any disclosure that does not lose its novelty cannot be earlier than six months prior to the filing date. The counting date for the six-month period is the actual filing date of the European patent application, regardless of the priority date[2].

The EPC and its implementing rules do not prescribe the statutory formalities required for declaration of apparent misuse. Often the examiner will be included in the search report if it is found to be in the public domain of article 55 of the EPC, and the applicant is usually informed of the apparent misuse of the disclosure by a search report or written opinion transmitted by the examiner, The applicant will then need to submit the relevant certification, the review department will review this.

6. A Comparative Analysis of the Provisions of Novelty Grace Period

The novel grace period stipulates the contradiction and the balance of interests. From the international coordinated development process of novelty grace period and the modification process of China, United States and Europe to their own stipulations, Stage to adapt to the development needs of its patent system to promote scientific and technological innovation, at any time in the novelty grace period of the provisions of the adaptation, the following will present the United States, Europe on the novelty grace period to cover the relevant provisions of the comparison analysis.

Table 1 on the novelty grace period of the various factors can be seen, the United States provides the most liberal terms of the new grace conditions, the use of the longest time period, the widest scope of the public, the most favorable starting time to give The most liberal of the applicant's environment; Europe is the most stringent regulations, which provides the narrowest scope of the public and the date of application for six months of the novelty of the grace period; the provisions of China allowing a grace period to be slightly more open than in Europe, can be calculated in accordance with the priority date of the novelty of grace, but still fall within the narrow scope of novelty.

Table 1. The current China, US, and Europe novelty grace periods comparison table

	CN	US	EU
The scope of coverage	1. Exhibited at an international exhibition 2. Presented at an academic or technical conference 3. Disclosure by others without consent	Any disclosure	1. Abuse of the relationship with the rights of others caused by public 2. International exhibition on display
Term length	6 months	12 months	6 months
Starting point	An application date or a priority date	An application date or a priority date	Filing date
Declaration requirements	Apply for a statement within 2 months to submit supporting documents	No requirement	Apply for a statement within 4 months to submit supporting documents

6.1 Broad and narrow Grace Period

Both China and Europe adopt a narrow grace period, which makes their role in promoting technological exchange extremely limited, and cannot fully meet the various needs of the main body of innovation. The United States, the use of a broad grace period, which can make the inventors in the process of innovation and freedom to communicate, for the public, but also to keep abreast of the development of related industries.

In fact, the original intention of the novelty grace period system is more for the innovation of the main services, from the interests of the main body of innovation, the broad grace period has its advantages. First of all, the provisions of the broad grace period can enable the inventor in a relaxed environment for inventions and technological exchanges, without their deliberate or unintentional disclosure will lead to loss of novelty of its invention and too nervous, get rid of a certain bondage, broad grace periods provide more opportunities for independent inventors and SMEs to communicate without strong financial support to allow them to fully assess and predict the commercial potential and patentability of their inventions in a variety of ways, or fully publicize their own technology, in order to obtain adequate financial support. Finally, it satisfies the inventor's need to publish his research results as early as possible due to some objective reasons.

At present, a growing number of countries have adopted a broad grace period, and it is expected that countries adopting a narrow grace period will face in the coming years the question of whether to widen the openness type without losing the novelty, especially in Europe and the patent system Rapid development of China, stepping up pace to develop strategies to cope with international development trend is imminent.

6.2 Term length and Starting Point of Novelty Grace Period

The length of the grace period is in fact similar to the scope of the disclosure covered by the grace period, the length of which reflects the range of time. At present, Europe and China are using a 6-month grace period, while the United States used a 12-month grace period. The longer the grace period is set, the more benefits and disadvantages it will bring.

In addition, the different starting points for the novelty grace period directly affect the validity period of the grace period. At present, China and the United States is based on the date of application or priority date as the starting point of the provisions of the priority of the priority date to calculate the grace period, whether national priority or foreign priority; and Europe adopted the novelty grace period is still calculated at the point in time of the actual filing date, regardless of the priority date. The patent law, which is usually formed under the earlier filing system, is recognized as the priority date for most of the provisions in accordance with the requirements of the Paris Convention, and has been accepted by the United States as the first filing system. However, Applicable countries Europe only stipulate a grace period on the actual filing date, and the European regulations are more stringent at the grace period. It also shows that the US decision-making considerations, the United States provides the most relaxed conditions for the applicant, so the timing of the starting point also adopted a liberal policy; the provisions of the most conservative in Europe, for the time of the starting point only accept the actual application, so in the time period on relatively stringent requirements, to achieve a balance.

6.3 Grace period declaration and formalities

When a grace period is required, the certainty of the legal status of the known technology brought about by the grace period can be reduced to some extent by requiring certain declarations and formalities as required. China and Europe are limited in their ability to enjoy the novelty grace period, and the grace period for applicants requires that a declaration be made at the time of filing an application so that the legal uncertainty brought about by the grace period can be as much as possible To be controlled. But for the applicant, it increases the burden of proof, especially in the United States, the broad grace period of the applicant, the burden of proof is heavier.

7. Conclusion

As countries have been different for the provisions of the novelty grace period, the WIPO in recent decades to promote the harmonization of the practice of novelty grace, which attempted to recommend a 12-month generalized grace period for all Member States, but not always accepted by all States.

But from the major countries in the world in recent years, the modification of the provisions of the novelty of the grace period of change has a convergence trend. In March 2003, the United States implemented the AIA, which maintained the original 12 months of the broad grace period, and revised the starting point provision that consider the foreign priority date.

In recent years, countries with more developed patent systems, such as the United States, have further liberalized the provisions on the basis of the original provisions and moved closer to the “Substantive Patent Law Treaty” put forward by WIPO in 2001 . At the same time, with the advancement of the European single patent system, the EPO system integration process will be further improved, although the most stringent narrow grace period provisions, but at the world patent system harmonization background, the EPO is also facing the relaxation of the provisions of the grace period to adapt to the adjustment of the world trend of development needs. In this context, China’s existing novelty grace period system needs to be relaxed sooner or later.

In my opinion, China should consider the new grace period countermeasure under the world development trend at the earliest time, put forward more scientific and reasonable suggestion to adapt to the social legal environment of China, conform to the international development trend, guarantee the balance between innovation subject and social public interest, and promote the development of the patent system and science and technology.

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