

ExCo Helsinki
Adopted resolution
10 September 2013

Resolution

Question Q233

Grace period for patents

AIPPI

Noting that:

- 1) AIPPI has studied grace periods for patents on three prior occasions: Q75, Prior disclosure and prior use of the invention by the inventor (Buenos Aires Congress of 1980, Moscow ExCo of 1982); and as part of Q170, Substantive Patent Law Treaty (Lucerne ExCo of 2003).
- 2) Q75, Prior disclosure and prior use of the invention by the inventor, was considered at the Buenos Aires Congress of 1980. A resolution was reached that declared in favour of the principle of a grace period, but referred the question back to the Executive Committee for further consideration of the implementation details:
 - 1) *[AIPPI]*
 - a) *is concerned that an inventor may publicly disclose his invention before filing a patent application, thereby depriving himself of the ability to obtain valid patent protection;*
 - b) *recognizes that Article 11 of the Paris Convention provides very limited protection for a disclosure made by an inventor at certain international exhibitions;*
 - c) *considers that it is in the public interest that the inventor should be given greater protection from the consequence of a prior disclosure by himself, and*
 - d) *therefore considers it desirable that where a public disclosure of an invention originates from an inventor, such public disclosure shall not be taken into consideration in assessing the patentability of the invention, if the first patent application is filed by the inventor or his successor within a certain period beginning from the disclosure, and declares in favour of the principle of introducing such a period of grace under terms and conditions to be determined.*
 - 2) *refers the question back to the Executive Committee for further consideration.*
- 3) Q75 was again considered at the Moscow ExCo of 1982, which resulted in a resolution favouring a 6 month grace period for all disclosures originating or derived from the inventor, without a declaration requirement:

[AIPPI] declares in favour of the principle of introducing such a period of grace under the following terms and conditions:

 - i. *A disclosure originating or derived from the inventor shall not by itself establish a right of priority but rather shall not be considered as part of the state of the art as against the inventor or his successor in title if it occurs within the grace period.*
 - ii. *Such disclosure shall include all acts of disclosure to the public by means of a written or oral description, by use, or in any other way, not withstanding where such disclosure takes place.*

- 2) *The grace period shall be six months preceding the filing date of the patent application, or, if a Union priority is claimed, the date of the first filing according to Art. 4 of the Paris Convention.*
 - 3) *The burden of proof shall be on the applicant or patentee to prove that such disclosure originated with the inventor or was derived from the inventor.*
 - 4) *The inventor 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 apply to patents of invention, inventor's certificates and utility models.*
- 4) The question of grace period was taken up again at the Lucerne ExCo of 2003, as part of the study of the Substantive Patent Law Treaty (Q170). The ExCo reached a resolution in favour of a 12 months grace period, including a permissive provision regarding declarations:
[AIPPI] adopts the following Resolution:
the term for the grace period shall be 12 months before the filing date or, if a priority is claimed, the priority date, i.e. the patent application shall be filed no later than 12 months after the public disclosure coming directly or indirectly from the inventor;
a declaration by the applicant confirming that he is entitled to benefit from such grace period may be required.
- 5) The passage of time and changes in relevant national laws make this topic ripe for reconsideration at this time, in particular:
- a) the passage of the AIA in the United States, representing an important move by the US towards global patent harmonization in many respects, including substantial changes to the grace period;
 - b) the revisions to the grace period law in Japan;
 - c) the perceived change of view of national groups on this issue;
 - d) the work of the "Tegernsee Group", attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO, which identified grace period as one of four topics being key to harmonization.

Considering that:

- 1) A grace period of some kind is provided in most countries but national and regional laws differ significantly with respect to the scope and duration of such grace period.
- 2) The term "grace period" refers to a length of time before the filing date of a patent application during which certain disclosures of the invention, by the inventor or third parties may not be considered to be prior art to the application. These types of disclosures are hereafter equally referred to as "non-prejudicial" disclosures.
- 3) The differences in the national and regional laws on grace period create difficulties and inefficiencies. Less knowledgeable applicants may either deprive themselves of the ability to obtain valid patent protection in all desired countries or omit to take advantage of existing grace periods in some territories.
- 4) Harmonization of the laws on grace period is considered to be more important in and of itself than any of the particular details of scope and term of the grace period.
- 5) It is appropriate to reiterate some of AIPPI previous resolutions, in particular that:
 - a) it is desirable to establish a grace period for patents;
 - b) a grace period shall not establish a right of priority but rather shall enable to exclude from the state of the art as against the inventor or his successor in title, disclosures which occurred within the grace period;

- 6) This question explores issues which had not been examined by the previous AIPPI resolutions, in particular the policy behind the existing laws, the needs of various stakeholders, the acts of third parties that could be covered by the grace period.
- 7) Harmonization on the grace period may be considered mainly along three possible directions:
 - a) a “limited type” grace period, covering disclosures by the inventor or his successor in title only during specific exhibitions and covering disclosures from third parties against the will of the inventor or his successor in title; such grace period is similar to that of several existing laws known to have the most limited grace period;
 - b) a “safety-net type” grace period, covering any disclosures by the inventor or his successor and disclosures from third parties deriving the invention from the inventor or his successor in title; this is considered as a safety-net because it enables to treat said disclosures as non-prejudicial, without excluding the risks for the applicant of third party disclosures; as a result such “safety-net type” grace period still encourages the applicant to file an application as early as possible;
 - c) a “priority type” grace period, covering any disclosures by the inventor or his successor and disclosures from third parties deriving the invention from the inventor or his successor in title; as well as disclosures from third party not deriving from the inventor if they come after a first disclosure by the inventor; this type of grace period is viewed as creating a right of priority to the inventor who is protected from third party disclosures made after his own disclosure, thus possibly creating an incentive to early disclosures by the inventor, rather than an incentive to early filing.
- 8) An internationally harmonized law on grace period should establish a fair balance between the interests of patent applicants and the public.
- 9) In establishing this fair balance, it is necessary to consider changes in the research and development environment which justify reconsidering the balance currently set by the existing national and regional provisions, in particular:
 - a) the increase of collaborative research;
 - b) the increasing need of early disclosure of inventions by all class of stakeholders;
 - c) the practical difficulties in avoiding any effective disclosure.
- 10) In order to focus the question on the “grace period for patents” itself, this study did not consider the related issue of prior user rights. AIPPI could valuably extend the work on the related issue of prior user rights, under the recommended internationally harmonized grace period.

Resolves 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.
- 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.



CongressToronto
Adopted resolution
September 17, 2014

Resolution
Standing Committee – Patents
Prior User Rights

AIPPI

Noting that:

- 1) The use of prior user rights remains an area of patent law where divergent practices exist among various countries and regions.
- 2) This subject has been touched upon in the prior work of AIPPI such as in
 - Q75, Prior disclosure and prior use of the invention by the inventor (Buenos Aires Congress of 1980, Moscow ExCo of 1982),
 - Q89D, Prior Use (Amsterdam ExCo of 1989),
 - Q170, Substantive Patent Law Treaty (Lucerne ExCo of 2003) and
 - Q233, Grace period for patents (Helsinki ExCo of 2013).
- 3) Q89D: At the Amsterdam ExCo of 1989 it was resolved that the Patent Law Treaty then under discussion should contain a mandatory prior use right as set forth in the following provision:

Privilege of prior use

(1) (a) Subject to subparagraph (b), the owner of a patent shall not enjoy, under that patent, rights against activities within the scope of the patent, not authorized by him, of a person (the prior user) who, at the date of the filing of the application, or where priority is claimed, at the priority date of the application on which the patent is granted, and with a view to industrial or commercial exploitation,

(i) was actually engaged in such activities, or

(ii) was engaged in serious preparations, involving, from the viewpoint of the prior user, significant investment, for such activities,

in the territory and any other place or space to which the sovereignty of the Contracting State extends and in or for which State the patent is granted.

It is understood that the expression "industrial or commercial exploitation" comprises every form of exploitation for useful or economic purposes.

(b) Where the prior user engaged in activities or preparations therefore, obtained knowledge of the invention protected by the patent from or in consequence of acts performed by the owner of the patent or his predecessor in title, subparagraph (a) shall not apply in respect of the said activities.

(2) Paragraph (1) shall not apply to a successor in title of the prior user unless that successor in title is the owner of the enterprise or business, or that part of the enterprise or business, in which the prior user engaged in the activities or preparations referred to in paragraph (1) (a).

4) Q233: The Helsinki ExCo in September 2013 adopted a resolution in favour of the grace period as follows:

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.

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.
- 5) The Helsinki resolution on the grace period specifically noted the need for an extension of the work to the related issue of prior user rights:
- “In order to focus the question on the “grace period for patents” itself, this study did not consider the related issue of prior user rights. AIPPI could valuably extend the work on the related issue of prior user rights, under the recommended internationally harmonized grace period.”
- 6) During the second meeting of the “Tegernsee Group,” attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO in April, 2011, prior user rights was one of four topics identified as being key to harmonization (along with the grace period, 18-month publication, and the treatment of conflicting applications).

Considering that:

- 1) Nearly all legal systems contain statutory provisions, case law and/or legal doctrines that provide prior user rights as an exception to the exclusive right of a patent holder.
- 2) The conditions for obtaining prior user rights and their scope diverge from one jurisdiction to another.

- 3) Harmonization of prior user rights would enhance legal certainty and clarity.
- 4) Prior user rights are rarely invoked, but are nevertheless considered an important part of a balanced patent law system.
- 5) The three main justifications for prior user rights are balance, economic aspects, and freedom of choice. Freedom of choice in this context means the freedom between obtaining patent protection publishing the development or simply using it without disclosing it to the public. Economic aspects refer to the goal of providing incentive for innovation and dissemination of information without unduly restricting investment. Balance means the balance between the effects of the first-to-file system principle and a lawfully continued activity that had been carried out in good faith.
- 6) Because the current resolution does not fully address the extent or magnitude of prior user rights and whether there should be specific limits based on the extent or magnitude of such rights, this issue merits further study. The territorial scope of prior user rights of regional patents without unitary effect also merits further study.

Resolves that:

- 1) A prior user right should be recognized when a party has used an embodiment falling within the scope of a patent before the filing date or, if earlier, the applicable priority date of the patent. A prior user right should also be recognized, at a minimum, when serious and effective preparations for the use of an embodiment within the scope of protection of a patent have been made.
- 2) The prior user right should be recognized as an exception to the exclusive rights of the patent holder afforded by the patent.
- 3) The prior user right should lapse upon the abandonment of the use and/or abandonment of the preparation of the use by the prior user.
- 4) A prior user right should in principle be limited to the country where the prior use took place. Thus, the use of the invention in one country should not give rise to a prior user right in another country. In case of a regional patent with unitary effect, the prior user right should apply, as an exception to the patentee's rights, on all the territories covered by the patent.

- 5) A prior user right should only arise if the prior user has acted in good faith.
- 6) A prior user right should be limited to embodiments within the scope of the patent which were used prior to the filing date or, if applicable, the applicable priority date of the patent or to substantially similar embodiments; prior user rights should not by definition extend to the entire scope of the patent.
- 7) A prior user right should be transferable, but only if it is transferred together with substantially all of the related enterprise or business.
- 8) The prior user right should not be licensable to another legal entity.
- 9) Prior user rights should be available in any field of technology and for any type of entity.



2018 AIPPI World Congress - Cancún
Adopted Resolution
September 26, 2018

Resolution

2018 – Study Question (Patents)

Conflicting patent applications

Background:

- 1) This Resolution concerns patent applications that conflict with earlier-filed but later published patent applications by the same or a different applicant (***conflicting applications***).
- 2) For the purpose of this Resolution:
 - A first patent application that is filed prior to a later-filed patent application falls within a standard definition of publicly available prior art if it is published prior to the effective filing date of the later-filed patent application. In most jurisdictions, patent applications are published at a publication date after the filing date, meaning that there is a window during which later filed applications may be filed prior to publication of the first application. If the later-filed patent application is filed before the first patent application is published, the examining patent office must determine if and to what extent the first patent application may preclude patentability of the claims in the later-filed patent application. The first patent application in this situation will be referred to herein as ***secret prior art***.
 - ***Self-collision*** refers to the situation where secret prior art “collides” with a later-filed application by the same (or partially the same) applicant(s) and/or inventor(s).

- 3) Due to different approaches to treatment of conflicting applications in different jurisdictions, it is a common occurrence that a claim considered patentable in one jurisdiction is unpatentable in another. This leads to situations where multiple patents may be amassed in one country while the same or similar protection cannot be obtained in another. Multinational inventorship, joint industry and university-industry research collaborations, and globalization in general all further complicate this situation.
- 4) 44 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 5) At the AIPPI World Congress in Cancun in September 2018, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) As a matter of principle, it would be beneficial to harmonize the treatment of conflicting patent applications.
- 2) Secret prior art should be available against the claims of a later-filed application, after the secret prior art is published, for examining novelty only. With respect to this secret prior art, its entire contents other than the abstract, should be considered.
- 3) The applicable standard for the examination of novelty in the case of secret prior art should be identical to the standard for the examination of novelty in the case of non-secret prior art.
- 4) Secret prior art should not be available against the claims of the later-filed application for examining inventive step/obviousness.
- 5) There should not be provisions to avoid self-collision for examining novelty, but only provided that there is full recognition of multiple and partial priority rights for individual claims.
- 6) International applications should be treated as secret prior art as of the earlier of the international filing date or the effective priority date of the relevant disclosure.

- 7) An international application should be considered as secret prior art only in jurisdictions where the national/regional phase has been entered.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Reports of National and Regional Groups and Independent Members](#)