

Grace Periods

Patents can be considered a bargain - in exchange for a monopoly to use your invention, you must tell the world what your invention is. The proviso is that your invention must be new - the Patent Office won't grant a monopoly for something which the world knew how to do before.

In most European countries this requirement for novelty is absolute - even an applicant's own sales or publications can be cited against his patent application, if they were made before the application was filed. The general rule then, is file your patent application first.

What if it's too late? I've already disclosed my invention!

Not all European countries are quite so strict. Some offer a grace period prior to filing, during which an applicant can disclose his invention without needing to worry that the disclosure will prejudice his patent application later on.

The table below outlines which EPO countries offer grace periods (unfortunately there aren't many), as well as the length of the grace period prior to filing, and the types of protection to which they apply.

| Country | Length of grace period PP - preceding priority date PF - preceding filing date | Types of Protection |
|----------------|--|--------------------------|
| Albania | 6 months PP | Patent and Utility Model |
| Bulgaria | 6 months PP | Utility Model only |
| Czech Republic | 6 months PF | Utility Model only |
| Estonia | 12 months PP | Patent and Utility Model |
| Germany | 6 months PF | Utility Model only |
| Romania | 6 months PF (patent) 6 months PP (utility) | Patent and Utility Model |
| San Marino | 6 months PP | Patent only |
| Turkey | 12 months PP | Patent and Utility Model |

Some non-EPO countries also offer grace periods, including Australia, Canada, USA, South Korea, Armenia, Belarus, Georgia and Ukraine (12 months PP), Kazakhstan (six months PP), and Russia and Japan (six months PF). New Zealand also offers a 12 month grace period in certain limited circumstances.

The terms and scope of grace periods tend to vary from country to country, and even between the different types of protection offered by a single Office. It is therefore wise to check the local rules of each country prior to filing to determine whether their specific grace period applies to your circumstances.

What if someone else disclosed my invention?

In the event that someone disclosed your invention without your permission (e.g. through a breach of confidentiality), most European countries allow a six month grace period during which you can still validly file a patent application. However, it varies from country to country whether this grace period precedes the local filing date (PF) or the priority date (PP). It is therefore worth considering if and where foreign applications might be required as soon as a breach of confidence is discovered.

The key words here are “without your permission” - if you agreed to allow someone else to publish details of your invention this grace period will not apply. It is also worth noting that this applies to only most, but not all, European countries. There are a few, including Cyprus, Poland, Portugal and Monaco, which do not offer any grace period of this type at all.

I heard it was OK to disclose my invention at an International exhibition?

That’s true, as far as it goes. The majority of European countries allow a six month grace period for disclosures made at an International exhibition. However, this doesn’t mean any exhibition - only exhibitions falling within the terms of the Convention on International Exhibitions 1928 qualify, and there are very few of these. It is always better to check whether your exhibition is a qualifying one prior to making a disclosure, and if in doubt, file a patent application first.

Are there any other options?

It is always worth looking at what, exactly, was disclosed. Depending on the level of detail included in the disclosure, a patent application may still be possible even in countries without a grace period. For instance, if only a short summary or a photo of a product was disclosed (e.g. in marketing literature), it may still be possible to validly file a patent application for the product, if it is not possible to tell from the disclosure how the product works. Similarly, the sale of a product does not necessarily rule out obtaining patent protection for a process for making the product, if there is a clever step in the manufacturing process that can’t be worked out by looking at the product alone.

Other types of IP could also be an option - most European countries, including the UK and the EU IPO, offer a 12 month grace period for filing registered design applications. If the shape and appearance of your product are important, it may still be possible to protect those even if it’s too late for patent protection.

If you would like more specific advice on any of the options above, please contact your usual Barker Brettell attorney.