

## Grace Periods for Disclosure of an Invention before Applying for a Patent

In general, a patent application for an invention should be filed at the patent office before the invention has been disclosed to the public, because otherwise the disclosure of the invention is “prior art” to the patent application and will be taken into account when considering whether the claimed invention meets the requirements of being new and inventive. However, some countries operate “grace periods” whereby if an applicant files a patent application within a certain time after publicising the invention then the earlier disclosure is not considered to be prior art to the patent application.

This information sheet provides basic information about grace periods operated in some countries, but it is not definitive or exhaustive. Please contact us for more information if applicable.

### Operation of the grace period

The grace period provisions are different in each country and a careful assessment needs to be made in each case to determine whether or not the grace period applies, but general guidance is set out below.

Generally, a grace period allows 6 or 12 months for filing a patent application after a disclosure (see examples of countries with 6 and 12 month grace periods opposite).

Disclosures to which the grace period applies are not taken into account as prior art when assessing novelty or inventive step of the invention in the patent application.

In most countries, grace periods only apply to disclosures by the inventors or the person who is entitled to apply for the patent, not to independent disclosures by third parties. An exception is the US, in which third party disclosures within the grace period can be discounted as prior art if it can be shown that the inventor invented the invention before the third party did.

Normally, a patent application for the relevant country (or an international application designating the relevant country) must be filed within the grace period, i.e. it is the date of filing in that country, not the priority date claimed from a patent application in another country, that determines whether the grace period applies. However, there are exceptions to this, for example the Eurasian patent system allows a grace period of 6 months before the date of priority, if priority is claimed, and Argentina allows a grace period of 12 months before the priority date.

In order to make use of the grace period in some countries (e.g. Japan, South Korea, Mexico, Argentina) it is necessary to tell the patent office about the earlier disclosure when filing the patent application.

### Countries that operate a 12 month grace period (non-exhaustive list):

Argentina (AR)  
Australia (AU)  
Brazil (BR)  
Canada (CA)  
Malaysia (MY)  
Mexico (MX)  
United States of America (US)

### Countries that operate a 6 month grace period (non-exhaustive list):

Japan (JP)  
South Korea (KR)  
Eurasia (EA)  
Russian Federation (RU)  
Taiwan (TW)

### Applying for a patent in countries without a grace period after public disclosure

If an abstract or brief summary of an invention has already been published, it may still be possible to obtain a valid patent, even in countries where there is no grace period. For example, if the disclosure does not contain enough detail to enable a skilled person to carry out the invention, then the invention may still be considered new. Inventive step (obviousness) of the claimed invention compared with the earlier disclosure would also need to be assessed, and this would depend on how much information about the invention had been published.

### Disclosures in breach of confidence and displays at international exhibitions

Most countries have provisions to exempt disclosures from consideration as prior art if the disclosure was an abuse in relation to the applicant or inventor (such as a disclosure made in breach of confidence).

Certain international exhibitions also have a special status so that disclosure of an invention at the exhibition is not considered prior art against a patent application originating from the same inventor. A certificate of disclosure at the exhibition may be required.

In order to benefit from these provisions it is normally necessary to file the patent application within a set period of time after the disclosure. For example, in Europe the grace period for abusive disclosures or disclosures at exhibitions is 6 months, i.e. a European patent application (or an international application designating Europe) must be filed within 6 months of the disclosure.

#### Grace periods for other intellectual property rights

Grace periods apply for other types of intellectual property rights in some countries, including registered designs and utility models. For example, there is a 12 month grace period in respect of Registered Community Designs (European Union).

Therefore, for some types of inventions, other intellectual property rights may still be registrable even if a patent cannot be obtained because of an earlier disclosure.

#### Other countries

In addition to the countries already mentioned, there are many countries in which grace periods are specifically provided for particular types of disclosure, such as disclosures made in breach of confidence, presentations of papers to scientific societies, performance of tests, or display at designated exhibitions.

To find out whether a grace period can be used in a particular country, we recommend contacting a local patent attorneys in the relevant country, which we can do on your behalf.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at [www.mewburn.com](http://www.mewburn.com). Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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