We have all been there. Despite best efforts to minimize public disclosures from the company, you get an email (likely on a Friday at 5 PM) that a company scientist submitted an abstract to a conference without notifying the IP department. And it gets worse: the abstract published in the conference proceedings a week ago. This public disclosure can present a significant hurdle to patentability in most countries because most apply an absolute novelty requirement. However, to soften the draconian application of an absolute novelty requirement, many countries have a grace period for some form of inventor-originated or derived public disclosures. Below we describe the types of grace periods, what type of disclosure is typically excluded by the grace period, and tips for navigating countries’ grace period laws.

**What does a grace period exclude?** Generally, a country’s grace period has two key exclusionary aspects: (1) exclusion type and (2) grace period length. The exclusion type dictates the extent to which the grace period protects inventor-
derived public disclosures or abuse of an inventor's rights by a third party by excluding the public disclosure for novelty purposes only or for both novelty and inventive step purposes. The length of grace period dictates how long the grace period will protect inventor-derived public disclosures or abuse of an inventor's rights by a third party by excluding public disclosures within six months of a patent application's filing date or within one year of the application's filing date.

**Do grace period laws have any uniformity?** Currently, grace period laws around the world lack uniformity, which can lead to patchwork protection for companies seeking worldwide or even regional (e.g., Asia or Europe) product distribution and sales. However, while several countries have their own grace period idiosyncrasies, generally the grace periods fall into one of four categories:

1. public disclosure within six months of application filing excluded from evaluation of novelty;
2. public disclosure within one year of application filing excluded from evaluation of novelty;
3. public disclosure within six months of application filing excluded from evaluation of novelty and inventive step; or
4. public disclosure within one year of application filing excluded from evaluation of novelty and inventive step.[1]

**Are there efforts to harmonize grace period laws?** Most recently, members of the Trans-Pacific Partnership ("TPP") sought to harmonize the grace period laws for its Member States. Ratification of the TPP agreement would have required its Member States (Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States, and Vietnam) to enact the same grace period law. Under the proposed TPP grace period, an inventor (or applicant)-derived public disclosure cannot be used in an evaluation of novelty or inventive step if the disclosure occurred within the 12 months before the filing date of the application.[2]

The proposed TPP grace period is similar to the grace period found in the AIA.[3] However, because the United States has backed away from the TPP agreement, it is unlikely the remaining TPP Member States will ratify the agreement and harmonize their grace period laws.[4] Beyond the TPP agreement, there do not appear to be any grace period harmonization efforts on the horizon.

**How to navigate the different grace period laws?** As stated above, the current patent grace period laws of most countries fall into one of four categories. But despite this categorization, many countries' grace period laws contain idiosyncratic exceptions, e.g., "the inventor displayed the invention at an international exhibition" but there is no corresponding exclusion for a national exhibition.[5] Thus, while harmonization efforts would help reduce the complexity associated with each country's grace period laws, a near-term fix remains to be seen.

To help navigate the existing grace period exceptions, there are several sources of information. Provided with this issue are two quick-reference guides for grace period laws. The first is a world map identifying a country as falling within a specific
category of grace period exclusions. The second is a table with expanded grace period information, including idiosyncratic exceptions. Additional detailed information regarding a country's patent laws, including grace periods, is available through WIPO.[6] However, while the quick-reference guides and WIPO’s repository of patent laws are intended as useful tools to have for ready reference, there is no substitute for seeking the advice of local patent counsel.


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