



Question Q233

National group: FRANCE

Title: Grace period for patents

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AIPPI Q233 GRACE PERIOD FOR PATENTS

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1. Does your country or region provide a grace period of any kind for patent applicants?

The French Intellectual Property Code and the European Patent Convention only contain **limited exceptions** to the rule whereby any disclosure destroys the novelty of an invention.

Only disclosures that result from an evident abuse in relation to the patentee or from presentation at certain international exhibitions are considered.

Under national law, Article L. 611-13 of the French Intellectual Property Code (hereinafter CPI) makes the following provision:

“For the application of Article L. 611-11, a disclosure of the invention shall not be taken into consideration in the following two cases:

- *if it occurred within the six months preceding the filing date of the patent application;*
- *if it results from the publication, after this filing date, of an earlier patent application and if, in either case, it was due to, or in consequence of:*

a) an evident abuse in relation to the inventor or his predecessor in law;

b) the fact that the inventor or his legal predecessor has displayed the invention at an official, or officially recognized, exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928.

However, in the latter case, the displaying of the invention must have been declared when filing and supporting evidence provided within the period and under the conditions as determined by the legislation”.

Under European law, Article 55 of the European Patent Convention (hereinafter EPC) provides that:

“(1) For the application of Article 54, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the European patent application and if it was due to, or in consequence of:

a) an evident abuse in relation to the applicant or his predecessor in law, or

b) the fact that the applicant or his predecessor in law has presented the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.”

Article 611-13 CPI therefore expressly considers the case of patent applications that are filed in an abusive manner:

“[a] disclosure of the invention shall not be taken into consideration (...) if it results from the publication, after this filing date, of an earlier patent application”.

Article 55 (1)(a) EPC does not expressly provide for this case, but the Guidelines relating to the examination conducted by the European Patent Office, chapter G-V-3 *“Non-prejudicial disclosures”*, explain that the article also applies to this type of disclosure:

“the disclosure may have taken place in a published document or by any other means. In particular, it may have occurred in a European patent application having an earlier priority date. For example, person B who has become aware, as a result of confidential information, of person A’s invention may himself file a patent application in respect of that invention. In such a case, the disclosure resulting from the publication of B’s application will not affect A’s rights if the latter has already filed an application or does so within a period of six months after this publication”.

It should be noted that if an unauthorized disclosure occurs following the publication of a European patent application that was filed by a third party who has unlawfully appropriated the invention, Article 61 EPC shall apply, which will enable the inventor to assert his rights on the basis of the application.

2. Nature of the grace period

a. What is the duration of the grace period?

The grace period may apply if the disclosure of the invention takes place within the six months preceding the filing date of the patent application (Article L. 611-13 CPI) or six months before the filing of the European patent application (Article 55(1) EPC).

b. From what date is the grace period calculated?

Article L 611-13 CPI and Article 55 EPC are worded in slightly different terms, which may give rise to uncertainty regarding the date from which this period must be calculated: should the filing date of the initial application be taken into account when the application is filed under the benefit of a priority?

- ▶ Article L 611-13 CPI refers to disclosures that occurred *“in the six months preceding the filing date of the patent application”*;
- ▶ Article 55 EPC covers disclosures that occurred *“six months preceding the filing of the European patent application”*.

There is therefore a difference in the way in which this period is calculated under national law and under European law.

Despite this uncertainty, for French patents that claim a priority date, the French Courts seem to consider this date as the date from which the immunity period corresponding to the grace period is calculated.

By a judgment of 29 May 1981 (TGI Paris, 29 May 1981)¹ the Paris Court (TGI) considered that the filing date of the French application (29 March 1963) should be taken into account; in this case, the alleged disclosures (sending of a circular letter on 30 March 1962 and conducting of tests on 29 March 1962) had occurred within the six months preceding the filing in the United States of two patent applications (4 April 1962 and 9 May 1962). The Court held that these disclosures could be cited against the patent and it invalidated the patent:

“Even if it were established, which it is not, that the circular letter of 30 March 1962 did not disclose the embodiment of Figure 1 before 4 April 1962, the US priority date claimed, the defendants are, indisputably, justified in citing a disclosure resulting from the public demonstration on 20 March 1962.

The disclosure being likewise established, patent 1 352 449 must be declared null and void”.

The disclosures originated from the patent applicant, himself the inventor, and the prior art was therefore not opposable to him in the context of the two US patent applications, while they were considered to be prejudicial to the French patent applicant, who was not protected from his own disclosures.²

However, in an order of the Paris Court of Appeal of 16 January 1992, it was held that the grace period of Article L. 611-13 of the French Intellectual Property Code could date back to the six months preceding the priority date:

*“Considering that Article 6 para. 3 of the law of 2 January 1968 states that “by way of derogation to the provisions of this article, the novelty of an invention is not destroyed by the disclosure of said invention in the six months preceding the filing of the patent application if this disclosure was due to, or in consequence of (...) a blatant abuse in relation to the applicant (...); that in any case, by virtue of the provisions of Article 4-b of the Paris Convention, which was ratified by France, and which therefore gives precedence to national law, it is the priority date (28 January 1978 in this case) that should be taken into consideration for assessing whether disclosure has occurred”.*³

This solution was contested by Professor Mousseron.⁴

More recently, on 15 October 2003⁵, the Paris Court of Appeal cancelled the **French part of a European patent** due to lack of novelty on the basis of a disclosure that resulted from the presentation by the inventor, on 29 January 1980, of a report entitled *“Draft study - revegetation of sloped facades”*. The proprietor maintained that the confidential nature of said report precluded any kind of disclosure and that, in any case, this disclosure had taken place within the 6 months preceding the filing date of the patent application (the priority application was a Swiss patent application filed on 8 February 1980 and the patent in suit claiming said Swiss priority had been filed on 6 February 1981) and was due to, or in consequence of, an evident abuse by the architects in relation to the inventor, given the confidentiality obligation to which they were bound. **With reference to Article L.611-13 CPI**, the Court upheld the decision at first instance and considered that as the report had been issued on 29 January 1980, the alleged disclosure had indeed occurred within the six months preceding the filing date of the patent application, **as the date to be taken into consideration was the claimed priority date of the Swiss patent, namely 8 February 1980.**

¹ PIBD 1981, 287.III.204

² Cf. comments Dossier Brevet 1981.VI.n.1

³ CA Paris, 16 January 1992, dossier Brevet 1993. III. 3

⁴ D. 1993, SOMM., p.375

⁵ CA Paris, 4th ch., 15 Oct. 2003 (Propr. Indust. 2004.Com.51)

This decision was fiercely criticized by the doctrine, which noted the absence of grounds in the decision given by the Paris Court of Appeal and emphasized that the solution as ordered was all the more open to criticism because the particular case related to a European patent:

"It is clear that as this is a European patent, the courts of Member States should apply the case-law G3/98 [cf. below] or, if in fact a significant loophole were to be discovered in the reasoning of the Enlarged Board, should issue a decision to the contrary, providing careful grounds therefor (...)

The Court did not have to go back as far as the intentions of the legislator in 1978, as it was not the French text that was applicable but Article 55 EPC.

In fact, the invalidity of a European patent in France is governed by Article L.614-12, which refers to Article 138(1) EPC, and not by Article L.613-25, which only relates to French patents."

At a European level, it seems to be the date on which the European patent is filed that should be taken into account, even if a priority is claimed.

The Enlarged Board of Appeal of the European Patent Office has clearly affirmed this position in decision G3/98 of 12 July 2000:⁶

"The date which is the determining factor in calculating the period of six months provided for in Article 55(1) of the European Patent Convention is the date on which the European patent application was actually filed; the priority date should not be taken into consideration when calculating this period."

This decision is based on the following arguments:

1. In Article 89 EPC, which governs the effects of the priority right, the priority date shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2; no reference is made to Article 55 EPC. Therefore it cannot be deduced from the wording of Article 89 EPC and Article 55 EPC that the priority date should be a substitute for the filing of the application.⁷
2. The certificate of exhibition as provided for in Article 55(2) EPC must be filed within four months of filing of the application (Rule 25 EPC) and it cannot be supposed that the legislator used the same term for two different dates. Furthermore, if the priority date were to be taken into account, then the acts provided for in Article 55(2) together with Rule 25 EPC would have to be performed before the European application is filed, as the EPC does not provide for formal requirements that must be met before filing an application.
3. The wording of Article 4(4) of the Strasbourg Agreement, which reads as follows: *"A patent shall not be refused or held invalid by virtue only of the fact that the invention was made public, within six months preceding the filing of the application, if the disclosure was due to, or in consequence of:*
an evident abuse in relation to the applicant or his predecessor in law; ..."
4. The competent working group, during preparatory work for the EPC, considered that a longer grace period was only able to safeguard the inventor's legal position at the level of the Paris Convention. The wording of Articles 55 and 89 EPC also corresponds to the legislator's intended meaning of these provisions.

⁶ Case-law of the Courts of Appeal of the European Patent Office, page 58 et seq.; decisions G03/98, G02/99; Lis Dyb Dahl, "European patents", collection of the CEIPI page 74 ; Paul Mathély, "European patent law", page 119

⁷ This confirms the decisions of the Swiss Federal Court in its order of 19 August 1991 (OJ EPO 1993, 170 – Stapelvorrichtung [dispositif d'emplage/stacking device]) and the German Federal Court of Justice in its order of 5 December 1995 (OJ EPO 1998, 263 – Corioliskraft [force de Coriolis/Coriolis force])

5. Although the legislator did not predict the frequency with which European applications would claim priorities, the possibility of an abusive disclosure before the priority date was certainly not perceived by the legislator to be an exceptional case. Moreover, it is indeed true that Article 11(1) of the Paris Convention obliges the countries of the Union to grant temporary protection to inventions featured at official, or officially recognized, exhibitions, a matter governed by Article 55(1)(b) EPC. However, with respect to the arranging of such protection, the provision refers back to the legislation. As for the relationship between the temporary protection and the priority right, the first sentence of Article 11(2) of the Paris Convention establishes that the temporary protection must not extend the priority period, while the second sentence of that article gives the national legislation the option of beginning the period on the date on which the product was introduced at the exhibition. The Paris Convention therefore does not oblige the countries of the Union to combine the period of protection against non-prejudicial disclosures with the priority period.
6. Only the applicant may take the appropriate action to prevent an unauthorized disclosure. It is therefore not unreasonable or inappropriate per se to resolve the conflict of interests in question here to the detriment of the applicant in the interest of legal certainty, rather than to the detriment of the public in the interest of obtaining justice in the particular case. It also does not appear that the legislator was unaware of the above considerations.

This interpretation seems to be consistent with the aforementioned decisions of the Swiss and German Courts but contradictory to a decision of the Dutch Court dated 23 June 1995 (decision of the Dutch Supreme Court, Follicle Stimulation hormone II, OJ EPO 1998, 278). This decision, given in the context of summary proceedings, did not highlight any consideration that could call into question the conclusion of the Enlarged Board of Appeal.

c. What types of intentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

Under both national and European law, only the presentation of the invention at an official, or officially recognized, exhibition, within the meaning of the Convention on international exhibitions of 22 November 1928, is covered by the grace period as an intentional act of disclosure by the applicant:

- ▶ Article L. 611-13 CPI provides that:

“For the application of Article L. 611-11, a disclosure of the invention shall not be taken into consideration in the following two cases:

(...)

b) the fact that the inventor or his predecessor in law has presented the invention at an official, or officially recognized, exhibition falling within the terms of the revised Convention on international exhibitions signed at Paris on 22 November 1928 (...).”

- ▶ Article 55 EPC, for its part, provides that:

« (1) For the application of Article 54, a disclosure of the invention shall not be taken into consideration if it was due to, or in consequence of:

b) the fact that the applicant or his predecessor in law has displayed the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.”

This provision constitutes an application of Article 11 of the Paris Convention of 20 March 1883 providing temporary protection for patentable inventions presented at official international exhibitions.

However, the French and European provisions limit the protection to only those international exhibitions covered by the statute of the Convention on international exhibitions of 22 November 1928.

The scope of this exception is extremely limited, as the number of exhibitions covered by this statute is very small (around forty since 1928).

Some decisions (sometimes earlier decisions) determined that disclosures by the inventor, prior to filing a patent application, would not be prejudicial to the validity of the patent, by citing either an assumption of confidentiality of the disclosure or uncertainty regarding the content of the disclosure, which shows an inclination on the part of certain courts to protect inventors from their own disclosures⁸.

However, other decisions have clearly recalled that, in the absence of a grace period, disclosures of the invention by the inventor, even those prompted by a matter of urgency, are opposable to the patent:

- ▶ in a case where the applicant stated that the disclosure was *"necessitated by the urgent need for intervention"* and that this did not mean that the applicant had *"renounced the intention to claim the invention"*, the Court held that the urgency claimed was not genuine and that as a result this excuse was *"not valid"* (TGI Paris, 3rd Ch. 16 May 1990);
- ▶ in an order of 26 January 2011, Toulouse Court of Appeal (RG 09/00799) recalled that the patent proprietor *"cannot claim a disclosure which deprives him of his rights, where he himself is the source of that disclosure"*.

d. What types of unintentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

Under both national and European laws, the applicant (including the inventor or co-inventor) does not benefit from a grace period covering any unintentional acts of disclosure or exhibition that he may commit.

e. What types of acts, disclosures, or exhibitions by a third party who is not the applicant, inventor, or co-inventor qualify for the grace period?

Article L. 611-13 of the French Intellectual Property Code and Article 55 EPC both provide that the abusive disclosure of the invention by a third party is not prejudicial to the inventor.

According to the doctrine, abuse firstly requires that the invention has been taken from the inventor and secondly that it has been disclosed against the inventor's wishes.⁹ A disclosure of the invention is not taken into consideration if it results from an abuse and if this abuse is evident.

⁸ CA Dijon, 11 December 1916, T1057/09, T1212/97, T1081-1001

⁹ Paul Mathély "European Patent Law", page 118; Paul Mathély, "New French Patent Law", page 76; Jean-Marc Mousseron, "Patent treaty", page 282

Since this rule constitutes an exception to the principle of absolute novelty, it must be interpreted strictly; in this sense, the doctrine considers that the evidence of the abuse involves an awareness on the part of the person responsible for the disclosure that he has committed an abuse in relation to the inventor, even an intention to cause harm to the inventor; the idea of evidence therefore seems to imply that the abuse be obvious and indisputable.

This provision has been applied a number of times in cases where the third party was not bound by a confidentiality obligation.

This provision has been applied a number of times, giving rise to a few noteworthy decisions:

- ▶ Toulouse Court of Appeal recalled, by an order of 26 January 2011, that it is important to consider whether the correspondence between the parties took place under condition of confidentiality, specifying that *"a written document is not necessary to reach a confidentiality agreement"*;
- ▶ In its decision of 16 January 1992, Paris Court of Appeal judged that: *"The residence of such material, without any special precaution, in premises where specialists in the same field, who are not bound to secrecy, freely circulate, creates a disclosure that is perfectly opposable to the patent applicant"*.
- ▶ Bordeaux Court of Appeal heard a case where Mecanic Worker had conducted tests on behalf of Vicard in order to improve machine tools; it had supplied a third party with the modified tool holder in the six months preceding the filing of the patent application by Vicard:
 - Bordeaux Court (1st ch. Civ., 15 April 2008; RG 2002/11072) considered this disclosure non-prejudicial on the following grounds:

"If it was not established in the documents in the case file that Sa Groupe Vicard had informed Sas Mecanic Worker of its intention to patent the self-tightening tongue and groove connection ensuring the leak-tightness of barrel bottoms, the tests conducted by Mecanic Worker, and the novelty of the use of this tongue and groove connection [for leak-tightness purposes] in the field of Cooperage, should have led Sas Mecanic Worker to exercise a minimum degree of caution, such as advising Sa Groupe Vicard of the intended sales of the modified tool holder at the request of the latter, with respect to other cooperage companies.

By disclosing this specific tool holder, unbeknownst to the company which had defined the useful features thereof in the field of cooperage, Sas Mecanic Worker committed a contractual fault, without however committing an infringement by providing means (...)".
 - The Court of Appeal confirmed that this disclosure was not prejudicial to the patent and reiterated the reasoning of the Court (CA Bordeaux, 1st ch. Civ. Sect. A, 1 July 2010 – RG 2008-02432);
 - The Court of Cassation rejected the appeal filed against the order of Bordeaux Court of Appeal, under the following terms:

"However, since, firstly, the order addresses, both on its own grounds and on adopted grounds, that Mecanic Worker disclosed to John Cooper, in the six months preceding the filing of the patent application, unbeknownst to Groupe Vicard, a tool holder that allowed barrels to be produced in accordance with the patented method; since it also points out that Mecanic Worker was responsible, vis-à-vis Groupe Vicard, for failure to comply with the confidentiality requirement in respect of the research conducted by the latter in order to improve a tool that already existed but that now related to cooperage for the purpose of leak-tightness; that in view of these sovereign findings and assessments, from which it can be deduced that the disclosure of the invention by Mecanic Worker was in breach of an undertaking of confidentiality, the Court of Appeal lawfully justified its decision".

In this case, the jurisdictions successively seized emphasized the breach of a contractual obligation and concluded that there was an undertaking of confidentiality due to the situation existing between the parties, but none of them have looked for the existence or identification of an “*evident*” abuse.

Mention may be made of a number of decisions of the Boards of Appeal of the European Patent Office:

- ▶ in decision T585/92, the question addressed was that of deciding whether a publication made in error by an administration could be considered to be an abuse within the meaning of Article 55 EPC; the Board of Appeal considered that it was not an abuse in relation to the applicant within the meaning of Article 55(1)(a) EPC 1973, however regrettable and prejudicial the consequences thereof may be.
- ▶ in decision T 436/92, the Board considered that in order to constitute an evident abuse there had to have been a **deliberate intention to cause prejudice to the other party**, and also it was most likely necessary that the person responsible for the abuse was aware of the prejudice that a deliberate breach of the confidentiality obligation could entail.

The intentions of the person responsible for the disclosure are therefore of crucial importance when qualifying the abuse, which is confirmed by decision T 585/92.

f. To the extent not already answered in Question 2) e) above, is there any situation where a disclosure by a third party who did not learn of or derive the invention from the inventor(s) can be covered by the grace period?

Neither national nor European law provides for situations where the disclosure by a third party who did not learn of or derive the invention from the inventor or inventors can be covered by the grace period.

g. Is any type of statement or declaration by the applicant required to invoke the grace period? If yes:

i. What are the requirements for the statement/declaration?

Pursuant to Article R. 612-22 CPI and Rule 25 of the EPC Implementing Regulations, the benefit of the grace period resulting from disclosure of the invention in the context of an exhibition is conditional upon the filing of a “*certificate issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition and which states that the invention was in fact displayed there.*” (Art. R. 612-22 CPI).

This text adds that “*the certificate states the opening date of the exhibition and, where applicable, the date on which the invention was first disclosed if the two dates are not the same. The certificate is accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.*”

The benefit of the grace period resulting from an abusive disclosure of the invention by a third party is not subject to the presentation of any declaration or certificate.

- ii. When must the statement/declaration be filed?

The certificate stating that the invention has been displayed must be provided within four months of filing the patent application (Art. R. 612-2 para. 1 CPI and Rule 25 of the EPC Implementing Regulations).

h. Is the grace period defined by a statute or regulation? If so, please provide a copy of the relevant portion of the statute or regulation

The reference texts are:

- ▶ Article L. 611-13 of the French Intellectual Property Code (and Article R. 612-22 of the implementing decree) for French patents;
- ▶ Article 55 of the European Patent Convention (and Rule 25 of the Implementing Regulations) for European patents.

i. Is there any special situation where only certain types of applicants/inventors are allowed to benefit from graced disclosures? (such applicants/inventors may include SMEs, universities, individuals, etc.)

In France, there are no special situations where only certain types of applicants or inventors are allowed to benefit from graced disclosures.

3. If your country or region provides a grace period for patents, please answer the following sub-questions:

French law recognizes a grace period limited to disclosure resulting from an evident abuse or from the presentation of the invention at an international exhibition. Question 3 has therefore been answered with regard to these provisions. A response will be given to question 4 also bearing in mind the fact that no more general grace period exists.

a. What are the policy reasons behind this grace period?

The applicable grace period due to the presentation of the invention at an international exhibition results:

- ▶ from Article 11 of the Paris Convention of 20 March 1883;
- ▶ taken up in Article 4-4-b of the Strasbourg Convention of 27 November 1963.

The grace period relating to a disclosure constituting an abuse in relation to the inventor originates from the general principle of the law whereby no abuse can be the source of a right and no right can be affected by an abuse.

This is expressly provided for in Article 4-4-a of the Strasbourg Convention of 27 November 1963.

b. Is the grace period, as it currently exists in your country or region, considered useful?

The applicable grace period in the case of presentation of the invention at an international exhibition is considered to be useless. In fact, very few exhibitions fall under the definition of international exhibitions within the meaning of the Convention on international exhibitions of 1928. Furthermore, these kinds of exhibitions are no longer the preferred method of presenting inventions.

This provision could therefore be deleted.

The grace period relating to a disclosure constituting an abuse in relation to the inventor is indispensable and must be maintained, even extended, in order to be more applicable to situations where the invention is disclosed in breach of a confidentiality obligation (whether explicit or implicit), even where there is no intention to harm the inventor.

c. Is the grace period considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

The answer to question b) applies to all classes of stakeholders.

d. How often is the grace period used? If you are unable to provide a quantitative answer to this question, please indicate one of: often; occasionally; or almost never.

The grace period relating to the presentation of the invention at an international exhibition is almost never used.

The grace period concerning a disclosure constituting an abuse in relation to the inventor is used occasionally and is indispensable.

4. If your country or region does not provide a grace period for patents, please answer the following sub-questions:

French law recognizes a grace period limited to disclosure resulting from an evident abuse or from the presentation of the invention at an international exhibition. Question 3 has therefore been answered with regard to these provisions. A response will now be given to question 4 bearing in mind the fact that no general grace period exists.

a. What are the policy reasons behind not providing a grace period?

Many reasons are considered to be behind the lack of an extended grace period in France:

- ▶ a grace period would have the effect of markedly increasing the complexity of the patent system and of creating uncertainty and generating additional costs that are prejudicial to all parties involved, including those whom the grace period is intended to benefit;

- ▶ a grace period would introduce an imbalance between the interests of the applicant and those of third parties as regards the definition of the prior art. In fact, if a prior disclosure by an applicant is covered by the grace period and is therefore excluded from the prior art which is opposable to his application, it does not cease to be a disclosure opposable to the filings of third parties. In the absence of a grace period, the definition of the prior art is neutral from the perspective of striking a balance between the interests of the applicant and those of third parties;
- ▶ a grace period would have the effect of extending the period of uncertainty for third parties as regards the existence and content of a patent application or patent in relation to the content of a disclosure. In view of the secrecy period of 18 months between the first filing and publication of the application, the period of uncertainty becomes 24 months if the grace period is 6 months and 30 months if the grace period is 12 months;
- ▶ the lack of a grace period is a simple rule that educates the responsible staff at research bodies or businesses on the basis of a clear message: no disclosure before filing. This is moreover a requirement that is enshrined in French law (Article L. 611-7 CPI relating to employee inventions). A grace period would blur this message.

On a European level, the absence of a grace period is the result of the negotiations conducted when drafting the Munich Convention on European Patents. This solution has been retained for simplicity's sake, on the basis of the rule of absolute novelty, without exception.

b. Would a grace period be useful for stakeholders in your country or region?

There are three lines of reasoning for thinking that a grace period would be useful:

- ▶ for reasons of international harmonization, and thus of simplification;
- ▶ the need to soften the rule of absolute novelty, which has been deemed to be excessively strict in some cases;
- ▶ to improve the inventors' situation.

Usefulness of a harmonized "grace period"

An essential aim of patent law in the context of a globalized economy is the international harmonization of the applicable rules, as the players, primarily SMEs (small and medium enterprises) and ETIs (intermediate-sized businesses) of whom international development is expected, do not understand the disparity between the rules applicable to such essential questions as the validity of rights. In this regard, the existence of a grace period in the United States and Japan may be experienced by French businesses as an advantage in terms of access to protection granted to the stakeholders in those countries, since French businesses take their priority filings as a basis for obtaining protection abroad. Only the initiated know that they can obtain protection in these countries by direct filing when a disclosure that is prejudicial to novelty in Europe is not so in the United States or in Japan.

In so far as the grace period is inescapable in some countries, it is very useful for French stakeholders to have access to a harmonized system of this "grace period" from which they can also benefit on the basis of their priority filings.

We have noticed a growing trend in the number of countries introducing a grace period (recently South Korea, as well as Australia and Canada in the past few years), which increases the need for harmonization.

Need to soften the criterion of absolute novelty

The second consideration in favour of the introduction of a grace period is the need to soften the current system, which is perceived as being too strict, as inventors are not always able to maintain the necessary secrecy for filing a patent, despite their best efforts to do so.

Indeed, the rigour of the current system prevents the filing of patents relating to prematurely disclosed inventions, and these patents could have been saved if there had been a certain grace period.

The exact number of these prematurely disclosed inventions is not known but some members of the working group estimate it to be approximately 2% of inventions declared to the employer.

Members of the working group have therefore expressed the desire to introduce a grace period that could cover:

- ▶ accidental disclosures;
- ▶ but also the risk of disclosure of an invention during the development period, i.e. the period during which searches must be carried out to validate the existence of a genuine invention.

The risk of early disclosure of an invention, in particular at the development stage, is enhanced because:

- ▶ research is often conducted collaboratively and involves an increasing number of businesses, universities or research institutes; many businesses, in particular SMEs, do not always have the internal competences to produce all aspects of an invention and have to seek aid from external partners; one of the best and most complex examples is that of European research projects in the context of the various European framework programmes (currently FP7);
- ▶ in certain industries, the tests cannot be conducted in a totally secret manner because they have to be performed in an open environment (tests on agricultural engines, aircraft, patient testing);
- ▶ an increase in correspondence, often informally and therefore in a less controlled manner, which is linked to the development of the Internet and email;
- ▶ an increased need for communication prior to taking out a patent, in particular and non-exhaustively:
 - i. for sub-contracting the manufacture of a prototype,
 - ii. for requesting an evaluative consultation of the technical or commercial interest of an invention,
 - iii. for communicating with a potential investor,
 - iv. or for calling upon outside expertise regarding a technology used by the invention.

Some tools do exist for preventing disclosure but they are not always suitable or possible in practice; for example, some large businesses refuse to enter into confidentiality agreements with smaller businesses for fear that this commitment prevents them from conducting research in the field in question. The same goes for certain investors who will require a presentation of the subject of the research to be financed but sometimes refuse to sign confidentiality agreements.

The implementation of a grace period would allow certain inventions that have been prematurely disclosed, despite the precautions taken by the inventor, to be saved.

Need to correct the balance between the interests of inventors and the interests of third parties, to the benefit of inventors

The third consideration is to slightly shift the balance that exists between the interests of inventors and the interests of third parties, in order to further encourage inventors, in the general interest of research and innovation.

An adjustment of the balance of this nature is justified for several reasons.

Firstly, it has been found that much more information is required to file a patent application that is valid from a legal and economic perspective than is required to anticipate a patent; in other words, it is thus not always possible to file a patent application for an invention without having first carried out additional, sometimes lengthy, researches, which increases the risk of disclosure of the invention.

Then, during the further research work, it is sometimes absolutely imperative for inventors to communicate.

This need has long existed and is well known in the field of academic research.

However, it has become more widespread with the advent of the Internet, leading to an acceleration of the global inventive process and to an almost immediate exchange of new knowledge, increasing competition and the need to gain attention.

The introduction of a grace period would make it possible to obtain patents relating to inventions in respect of which the inventor had no other choice, from an economic and communication perspective, than to disclose his researches.

The issue here is of more effectively taking into consideration, in the balance between inventors and third parties, the economic realities that inventors are faced with.

Finally, more pragmatically, a grace period could promote French research system that has already been subject to severe technical and economic constraints, in particular:

- ▶ global development in the volume of and investment in R&D alongside increased competition between innovators;
- ▶ the rise in development in certain countries which have been economically insignificant in the past, some of which are emerging as economic powerhouses with a high potential for research.

On a worldwide scale, all of this means that opportunities to use the grace period are multiplied, diversified and globalized, with it being noted in each country that although the grace period has a limited scope of application, it has a very real protective effect on a local basis.

c. Would a grace period be considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

A grace period would more particularly be useful for certain classes of stakeholders:

i. Researchers and public research bodies

It has always been the case that researchers at research bodies, both in France and abroad, are first and foremost evaluated on the basis of their publications and the presentations that they may give during thematic meetings, which are often global, in order to stimulate research and accelerate technical progress. This evaluation has a direct influence on their career progression and is therefore of paramount importance for them.

Most often, these scientific publications show results, but in order to be credible these results are demonstrated and/or the “inventive” process is at least suggested, and the applications of these results are mentioned: at this stage, the content of the publications is generally insufficient to constitute the material required to file a patent, but unfortunately is often enough to lead to the invalidity of a patent filed later by the researchers or their assignees once the material required to obtain a patent has been established.

The filing of economically and legally valid patents for inventions made by researchers is essential for establishing the development and industrialization necessary for the later creation of economic value in this respect by companies, in the context of licences allowing these companies to gain a competitive edge that justifies the investment that needs to be made for industrialization and ensures that they will see a return on their investment (creation of value from their intellectual property).

In the absence of a “grace period”, when a disclosure by the inventor himself and a publication by a third party are viewed in the same manner, the question of the time at which a patent relating to an innovation resulting from research can be filed is critical: research bodies tend to impose that publications take place after the patent has been filed. Therefore, the publication is “delayed”, with the risk of missing an important date, while at the same time the patent is “precipitated”, that is to say filed as soon as possible in order to allow publication, at the risk of it being filed before the invention in question has matured to an extent that is sufficient for the patent to be relevant and comply with the requirement that the invention be sufficiently disclosed.

Research bodies, and thus even the entire fabric of the economy, have a great deal of interest in ensuring that researchers’ publications are not considered to be prior disclosures that are opposable to patents filed subsequently by those same researchers or their assignees.

The introduction of a grace period would make it possible to more effectively reconcile the obligation to publish incumbent upon researchers with the ability to protect the results of research.

ii. Technical RDI (research, development, industrialization) partners and development partners – Collaborative research

Innovative processes frequently, and increasingly, result from the reconciliation of problems, technologies, adaptations of technical solutions to new usages etc., which involve a number of RDI partners, none of whom possess all of the elements required to master the innovation as a whole.

Moreover, the technical RDI participants also need to involve other partners in the technical field, in order to conduct tests for example, or partners from outside the technical field which are necessary in order to advance the innovation process, so as to produce mature and protectable inventions by filing legally and economically viable patents, i.e. relevant and complete patents.

In principle, all exchanges between partners should be formally covered by confidentiality clauses or agreements signed before any exchange takes place so that said exchange does not constitute a disclosure opposable to subsequent patent filings. However, the patentability of an innovation often only emerges as a result of necessary exchanges which are very difficult to cover in advance by confidentiality. There are a certain number of players that moreover refuse to sign confidentiality agreements like these in order to avoid the risk of potential conflict with their own work.

Without ever calling into question the necessity of setting up confidentiality agreements, the introduction of a grace period would allow patents to be filed in cases where it was not possible to sign such agreements, which would be favourable to the partners in a collaborative innovation process (inventors, employees, shareholders, start-ups, SMEs/PMIs and ETIs, large groups, industries, consortiums, competitiveness cluster, private or public research institutes or laboratories, universities, banks or private or public investment funds, venture capital, etc.), all of which are essential for creating value on the basis of innovations and having a need-to-know when they are developed, that is to say during the process of producing the material necessary for filing concrete patents.

Some decisions already take this situation into account by considering that certain types of exchanges are presumed to be covered by a confidentiality obligation.

Such a grace period would therefore offer a more reliable environment through collaborative partnerships (*"innovation in a network or partnership/collaborative innovation"*, which is of increasing importance, as opposed to *"internal and proprietary innovation"*).

iii. Individual inventors/Start-ups/SMEs/ETIs

A grace period would also facilitate innovative breakthroughs by individual inventors and start-ups/SMEs and ETIs: these contributors to innovation have to make their innovative projects known to potential partners, financial investors or commercial partners, wherever possible by initiating the protection process – and therefore by paying the associated fees, which are always significant for this kind of player for effective international protection – once the prospects of the project have been proven, without the risk that these prior disclosures will subsequently jeopardize the patentability of these potential inventions.

The common practice of drafting confidentiality agreements however remains fully useful when it is implemented in the many cases of collaborative partnerships, so that the stakeholders can precisely define the nature and content of the information exchanged as well as the holder of the information provided, with a view to clearly separating it from future developments.

- iv. Players whose inventions have to be tested in an open environment during development or that are subject to harmonization

Independently of any collaborative research, some inventions can only be validated in open environments, where public accessibility cannot be contained: this is the case for example for medical material tested in hospitals, for large systems that can only be assembled (and the functionality of which can only be tested) outdoors, or for sports articles that have to be tested under the conditions in which they will be used.

Harmonization takes place on a tightly planned schedule which makes it very difficult to file patent applications for inventions that are intended to be disclosed in the context of the work performed by working groups.

Objectively, although it may be difficult to demonstrate, the inventions in question are no longer novel within the meaning of European patent law when applied in all its rigour.

However, beyond these particular classes, a "grace period" would also offer the entire fabric of the economy greater latitude (room for manoeuvre and, as a result, for security), so as to promote and enrich innovation processes.

- v. Players against the grace period

Some large businesses that conduct internal research, sub-contracted research and collaborative research are not in favour of the grace period. These businesses are in favour of international harmonization on this matter but tend to support harmonization without a grace period.

The main reason for this stance is to limit the risk when making investment decisions. Businesses, whether large or of a more modest size, regularly have to make decisions as to whether they should invest early on in the development of a product, whether this investment comes from internal or external sources. In some sectors of industry, this investment may be huge (e.g.: pharmaceutical industry), but whatever the size of the company, investment is always aimed at being profitable. However, for any investor, a financial investment in R&D is a risk, and an investor's main goal is to limit that risk. In this respect, the grace period is perceived as a factor that increases uncertainty and therefore risk. In fact, investment decisions are made on the basis of a product's commercial potential, subject to a low level of risk being determined when making each investment decision. The relevant risks generally relate to the safety of the product, but also to a great extent to the ability to market the product without infringing third-party patent rights. They also consider the ability to adequately protect the product by means of a patent, so as to ensure the necessary financial return, prior to making any investment decision.

However, from this perspective, the grace period is seen as an element that could potentially (i) affect the ability to study the relevance and scope of third-party patents, and (ii) alter the perception of the importance of controlling disclosures by researchers, both within businesses and by means of collaborations.

According to the same principles, businesses listed on the stock exchange are also subject to increasingly high standards, called Legal Compliance, from which intellectual property protection is not immune. In this regard, too, a grace period is perceived as an additional obstacle for complying with these obligations with complete certainty.

5. What are the positive aspects of the grace period law of your country or region?

The positive aspects of French legislation are that it has the advantage of simplicity, by considering novelty in an absolute manner.

In addition to this, the fact that French legislation makes disclosures resulting from an evident abuse in relation to the inventor non prejudicial to the patent is a positive aspect.

6. What are the negative aspects of the grace period law of your country or region?

For the reasons given in answer to question 4, the group believes that French legislation would benefit from recognizing a certain grace period.

The French Group also believes that the conditions defined in Article L. 611-13 of the French Intellectual Property Code and in Article 55 EPC regarding disclosure resulting from an "evident abuse in relation to the inventor" are too strict and should be relaxed.

The case-law and the doctrine in fact interpret this condition of evident abuse very strictly. In some cases, an inventor who may have been careful and who may, for example, have made his partners sign an undertaking of confidentiality, would be unable to make disclosure by one of his partners, in breach of the confidentiality agreement, "non prejudicial", on the grounds that evident abuse also requires the intention to do harm.

7. As a practical matter, are the procedures and strategies of patent applicants in your jurisdiction affected by the grace period laws of other countries or regions? If so, in what way?

The procedures and strategies of patent applicants are indeed affected by the laws of foreign countries.

In fact, if an inventor or applicant has already disclosed his invention when he instigates the patent protection procedure, he generally knows that this earlier disclosure could be cited against a future French or European patent application and he usually decides not to file such a patent application.

Under certain circumstances, the inventor or applicant may decide to file patent applications anyway in countries where a grace period exists and where he would be protected against any disclosures that he made himself before filing in these countries.

These decisions are generally made depending on economic factors, in particular when the protection conferred by the patents filed in just these countries is of sufficient interest.

8. In your view, and assuming a proper balance is struck between the rights of the applicant and the rights of the public at large, is a grace period for patents desirable?

Yes, the French Group of the AIPPI considers that a grace period would be desirable, provided that there is a proper balance between the rights of the applicant and the rights of the general public.

As stated in the responses to questions 4b) and 4c), a grace period would be useful to a number of classes of applicants (public or private research bodies, SMEs, ETIs, collaborative research groups).

It is even considered that in some cases, as detailed in the responses to questions 4b) and 4c), a grace period could benefit the general public, because:

- ▶ the disclosures that could be made in this way, earlier, by researchers from research bodies contribute to stimulating research and to accelerating technical progress, which benefits the entire fabric of the economy;
- ▶ the additional development of the invention that a grace period would sometimes allow could contribute to increasing the quality and quantity of the information disclosed in the patent application.

However, in order to maintain an appropriate balance between the rights of the applicant and the rights of the economic players directly affected by the patents, the French Group of the AIPPI believes that a grace period should be subject to relatively strict legal provisions, as defined in response to question 10. In fact, the application of such legal provisions would enable the economic players directly affected by the patents, for example the applicant's competitors, to simply and reliably ascertain whether a grace period has been validly invoked.

In this context, the French Group is therefore in favour of the implementation of a grace period which is intended to be a "safety net", which would render disclosures made by the inventor within a certain period, and even disclosures by third parties which reproduce or state the inventor's disclosure or which result therefrom, without going beyond its teaching, non prejudicial to the patent. However, the grace period should not cover subsequent disclosures by third parties.

The concept of a safety net is intended in opposition to a grace period conferring rights on the person responsible for the disclosure, in particular a right equivalent to the priority right. It should not allow the person responsible for the disclosure to be protected against later disclosures by third parties resulting from independent research. By independent research, we mean research in which the invention was not obtained from the author of the first disclosure and not resulting from the first disclosure.

A grace period in the manner of a "safety net" would allow the aforementioned advantages to be obtained without calling into question the principle of the right of the first applicant and without changing the logic of the current system, which intends for patent applications to be filed as quickly as possible.

This rigid stance is justified by the desire to maintain the principle according to which any disclosure is potentially prejudicial to the inventor and must be followed by the filing of a patent application as soon as possible.

In such a system, the inventor will always have to file his patent extremely quickly as any disclosure will be potentially prejudicial, since third parties can acquire rights to the invention or can be the source of disclosures that are opposable to the patent.

The grace period should therefore not cover subsequent disclosures by third parties. In that case, the grace period would disrupt the existing system by encouraging inventors to disclose as soon as possible in order to gain an advantage over their competitors.

The French Group therefore opposes the introduction of a grace period that creates any priority right on the basis of a disclosure.

The French Group also believes that the need to examine whether the content of the disclosure is identical or similar to the subsequently filed invention should be avoided. If the disclosure satisfies the criteria of the grace period, it should be declared to be non prejudicial to the patent, without having to check whether its content is identical or similar to the invention as filed. The non prejudicial nature of a document resulting from the grace period would therefore apply both to novelty and to inventive step.

Within the aforementioned limits, the French Group considers that the grace period must cover not only accidental disclosures but also intentional disclosures by the inventor, for example in scientific publications or disclosures resulting from tests conducted by the applicant, as nothing justifies the exclusion of one type of disclosure from the grace period mechanism.

The French Group is aware that the security afforded by the safety net resulting from the grace period will reduce with the time separating the disclosure from the filing of the patent application:

- ▶ security will be greater in cases of quick filing of a patent application, which will be possible in cases of disclosure (whether accidental or not) of a complete invention;
- ▶ security will be lower if the disclosure relates to an invention that is not yet complete and in respect of which it will take more time to draft a sufficiently complete patent application.

As a result, the grace period will most likely further benefit certain types of disclosures.

The French Group is also aware that it is undesirable for an inventor to voluntarily disclose the invention, even where a grace period exists, especially if the filing of the patent application cannot be effected quickly after this disclosure, because the inventor is exposing himself to the possibility that third parties may acquire rights to the disclosed invention and that third parties may use this disclosure as a starting point for research that may lead to subsequent, opposable, disclosures.

However, the grace period must be able to cover these voluntary disclosures under the same conditions as accidental disclosures.

9. Is harmonization of laws relating to grace periods for patents desirable?

Yes, the French Group of the AIPPI considers that harmonization of the legal provisions governing grace periods is desirable. This harmonization would enable applicants to adopt a single filing strategy after an early disclosure, in order to prevent this early disclosure from causing a refusal or the invalidity of some titles within the same patent family.

The lack of harmonization is a source of confusion; insufficiently informed applicants may believe that foreign laws are identical to those in their own countries and may therefore lose their rights when foreign laws are in fact stricter.

Even for well-informed applicants, the lack of harmonization compels them to adopt a number of filing strategies, as specified in our response to question 7. However, we have seen a trend among applicants to increasingly expand the number of filing countries [OECD, <http://www.oecd.org/sti/inno/44604939.pdf>, Insight into different types of patent families, page 20, figure 2; <http://www.fiveipoffices.org/stats/statisticalreports/chapter3.pdf>, IP5 Statistics Report 2011, Worldwide Patenting Activity, p.46, fig.3.8]. The lack of harmonization of the grace period is therefore a constraint that must be avoided.

Moreover, the absence of harmonization may lead some countries to offer an advantage to their own nationals by offering broader grace period conditions.

It would therefore be very useful for inventors and applicants to be able to protect their inventions in a similar manner in all of the countries in which they are seeking protection.

It is also in the interest of third parties looking to assess the validity of a patent or patent application for the impact of any disclosures which may have occurred prior to filing to be considered in a similar manner from one country to another.

10. Please provide a standard that you consider to be best in each of the following areas relating to grace periods:

a. The duration of the grace period

The issue of the duration of the grace period is not vitally important.

In fact, in the context of the grace period proposed by the French Group, which represents a safety net intended to make disclosures made by the inventor non prejudicial to the patent, the applicant will always have an interest in filing his patent application as quickly as possible after disclosure.

The matter of the duration of the grace period is therefore essentially a matter of policy and depends on the type of disclosure that it is intended to make non prejudicial:

- ▶ if it is only intended to make accidental disclosures of a complete invention non prejudicial, then a short grace period (of three or six months) may suffice;
- ▶ if it is intended to be able to make disclosures occurring in the development stage of an invention (for example during tests for verifying the very existence of an invention) and premature scientific publications non prejudicial, a longer period is desirable, for example 12 months.

The French Group is in favour of the implementation of a grace period with a duration of 12 months, in order to cover all the types of disclosures as described above.

Furthermore, in the majority of countries that have a grace period, said period takes effect over a duration of 12 months. A grace period of 12 months would therefore be heading in the direction of harmonization.

b. The date from which the grace period is calculated

The French Group is in favour of the grace period being calculated with regard to the filing date of the title in question and, in cases where a priority is claimed, from the priority date.

This mechanism is much simpler as it does not depart from the rules and normal filing practice, namely the filing of an extension within the twelve months from filing the priority. Furthermore, it is useful in practice for extensions under priority to be made after the expanded search report or equivalent has been established, or, more generally, after the initial results of the examination procedure.

It would be too restrictive to require filing before the end of the grace period in every country where protection is intended, as this would entail significant and premature expenditure.

c. The types of intentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

The grace period should cover any type of intentional disclosure by the applicant:

- ▶ regardless of its form: oral or written or resulting from the presentation or use of the invention;
- ▶ regardless of its content: total or partial disclosure of the invention;
- ▶ regardless of its cause: accidental or intentional disclosures.

Only the disclosure of the invention resulting from the publication of a patent application by the inventor should not be covered by the grace period. In fact, the application of the grace period in such a case would enable the applicant to extend the protection period of the invention in some countries by deliberately filing his patent application outside of the priority period but within the grace period. In addition, in that case, the grace period would not serve as a "safety net" but more to rectify an error in the selection of extensions when filing the patent, even though the applicant was in possession of a complete invention that could be filed.

d. The types of unintentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

As stated in point c., the French Group believes that all types of unintentional acts or disclosures by the applicant should be covered by the grace period, without any restriction or condition other than the limits defined for the grace period as stated in the present report.

e. The types of acts or disclosures by a third party who learned of or derived the invention from the applicant that should be covered by the grace period

Three types of acts or disclosures by a third party should be covered by the grace period:

- ▶ disclosure resulting from an evident abuse in relation to an applicant or his predecessor in law; this case corresponds to the strict application of the current rule of Article L. 611-13 of the French Intellectual Property Code and Article 55 of the European Patent Convention;
- ▶ disclosure resulting from a third party holding the applicant's invention, made in breach of a legal or contractual obligation with respect to the applicant and without the applicant's consent; this may be the case for example for the disclosure of the invention by the applicant's partner in breach of a confidentiality obligation;

As stated above, the French Group believes that the conditions defined in Article L. 611-13 of the French Intellectual Property Code and Article 55 EPC relating to disclosure resulting from an “evident abuse in relation to the inventor” are too strict and should be relaxed;

- ▶ disclosures by third parties resulting from the prior disclosure of the invention by the applicant or his predecessor in law, the teaching of which does not go beyond that of the initial disclosure; this provision may cover third-party disclosures which reproduce or incorporate all or part of the applicant’s disclosure, such as for example articles in journals or reviews or scientific exposés reproducing the publication made by the applicant; the aim of this provision is to prevent the grace period mechanism from being rendered ineffective merely because a third party has recopied or even reported the disclosure of the invention made by the applicant.

On the other hand, a disclosure by a third party who has substantially supplemented, improved, perfected or modified the applicant's initial disclosure would be opposable.

The burden of proving the non prejudicial nature of a disclosure must be incumbent upon the party invoking said grace period.

f. The types of acts or disclosures by a third party who did not learn of or derive the invention from the applicant that should be covered by the grace period

No act or disclosure by a third party who did not learn of or derive the invention from the applicant should be covered by the grace period.

As previously stated, the French Group’s proposal for harmonization is to create a grace period that is solely a safety net protecting the inventor from his own disclosures but that does not create total immunity to the benefit of the inventor who has disclosed his own invention.

Any disclosure must therefore remain potentially prejudicial so that the inventor remains encouraged to file his patent application as soon as possible after a disclosure.

Any grace period mechanism that would cover acts or disclosures by third parties who did not learn of the invention from the applicant would create a priority right to the benefit of the applicant having made the disclosure and would therefore strongly encourage inventors to disclose the results of their research as soon as possible in order to try to set a date and steal a march in relation to their competitors.

A system like this would call into question the principle of the first applicant, which is not desirable.

g. The requirement for and content of any statement/declaration by the applicant to invoke the grace period

In the opinion of the French Group, it is not useful to require that the applicant provide any kind of statement or declaration in order to invoke the grace period.

The main reason for this is that, in some cases, the applicant may be unaware of the disclosure:

- ▶ an employer may be unaware that one of his employees has disclosed the invention;
- ▶ a business may be unaware that one of its partners has disclosed the invention, in breach of a confidentiality obligation;

- ▶ a business may be unaware that tests conducted in some circumstances supposedly protective of the confidentiality of the invention have nonetheless led to that invention being disclosed.

Then, any declaration obligation would pose the question of the extent of the disclosure and the question of monitoring compliance with this obligation. If the disclosure had to consist of specifying the content of the disclosure, then the obligation and monitoring thereof could prove to be complicated, in particular when the disclosure was made orally or related to the product or method under development, in the content of which could be difficult to document.

Such a declaration obligation would increase the workload of the Offices and would complicate the assessment of the validity of the title by creating an additional condition of validity.

However, a declaration must be possible, if the applicant deems it useful; in some cases, a voluntary effort on the part of the applicant, aimed at declaring the prior disclosure at the time of filing, may be useful, for example in order to indicate to the examiner and to third parties that an apparently opposable disclosure is in fact covered by the grace period.

11. The Groups are invited to comment on any additional issue concerning grace periods for patents that they deem relevant

The French Group considers that the question of rights acquired by third parties, aware of the invention, during the grace period may be very significant and could be the subject of future AIPPI work.

SUMMARY

French law only recognizes a grace period that is limited to cases where disclosures occurred as an evident abuse in relation to the applicant, or during official international exhibitions. This grace period, lasting 6 months, is calculated for European patent in force in France from the actual filing of the European patent application, and for a national applications from the priority date the application claims the benefit. The number of practical cases where this grace period has been recognized is very low, due to the need to show the intention to cause harm which is linked to the concept of evident abuse.

The French Group is in favour of the principle of a limited grace period, considered as a "safety net", having the sole effect of making all disclosures by the applicant (or its predecessors in law, such as the inventor) non prejudicial to a patent having a priority date that is less than 12 months later than said disclosure. On the contrary, the grace period shall not allow the applicant who has disclosed the invention to be protected against further disclosures by third parties, issuing from independent researches.

This stance is substantiated by three kinds of reasons:

- for sake of international harmonization, and thus of simplification;
- a need to soften the absolute novelty requirement, considered as too severe in certain cases, namely when the inventors are not able to keep their inventions secret, necessary for filing a patent application, in spite of their continued efforts in this sense;
- the need to slightly correct the balance between the interests of the applicants, and the interests of third parties, in favour of the applicants, in the global interest of research and innovation.

This grace period shall not challenge the principle of the "first to file" right, and shall not change the logic of the current system, which urge patent applications to be filed as soon as possible, since the applicants are still exposed to public acts committed by third parties between the first disclosure and actual filing.

RÉSUMÉ

Le droit français reconnaît un délai de grâce uniquement limité aux divulgations résultant d'un abus évident à l'égard du demandeur ou de la présentation de l'invention lors de certaines expositions internationales officielle. Ce délai de grâce d'une durée de 6 mois se calcule, pour les brevets européens en vigueur en France, à compter du dépôt effectif de la demande de brevet européen, et pour les brevets nationaux, à compter de la date de priorité dont bénéficie la demande nationale. Le nombre de cas pratiques où ce délai de grâce a été reconnu est très faible, à cause de la nécessité de démontrer l'intention de nuire liée à la notion d'abus évident.

Le Groupe Français est favorable au principe d'un délai de grâce limité, conçu comme un « filet de sécurité », ayant pour seul effet de rendre inopposable les divulgations réalisées par le demandeur (ou ses prédécesseurs en droits tels que l'inventeur), à l'encontre d'un brevet dont la date de priorité serait postérieure de moins de 12 mois à ladite divulgation. En revanche, le délai de grâce ne doit pas permettre au déposant ayant divulgué l'invention de se protéger contre des divulgations postérieures de tiers issues de recherches indépendantes.

Cette position est motivée par trois séries de raisons :

- ▶ un souci d'harmonisation internationale et donc de simplification ;

- ▶ un besoin d'assouplir la règle de la nouveauté absolue jugée trop sévère dans certains cas, notamment en ce que les inventeurs ne sont pas toujours en mesure de conserver à l'invention le caractère secret, nécessaire au dépôt du brevet, malgré leurs efforts en ce sens ;
- ▶ le besoin de corriger légèrement l'équilibre entre l'intérêt des déposants et l'intérêt des tiers, au bénéfice des déposants, dans l'intérêt général de la recherche et de l'innovation.

Un tel délai de grâce ne remet pas en cause le principe du droit au premier déposant et ne changera pas la logique du système actuel qui veut que les demandes de brevet soient déposées aussi vite que possible puisque les déposants restent exposés aux actes publics opérés par des tiers entre la première divulgation et le dépôt effectif.