

"Grace Period" in Japan

- Reflecting revised Article 30 of Patent Act, effective on June 9, 2018 -

SOEI PATENT AND LAW FIRM

June, 2018

Disclaimer

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Basics of "Grace Period" in Japan

2. Exceptions to Loss of Novelty



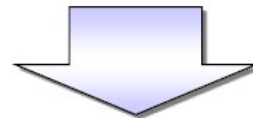
Art. 30: Exceptions to loss of novelty

Principle

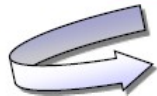
Any subject matter that has been disclosed prior to the filing of an application cannot be patented.

But

In some cases, this may be too strict for inventors. Also, that may be against the purpose of the Patent Act, that is, to contribute to industrial progress.



When an application is filed after being disclosed, under certain conditions, such prior disclosures do not destroy the novelty of the claimed invention.



Exceptions to loss of novelty (Art. 30)

Note: "Exceptions to loss of novelty" is basically synonymous with a "grace period" and may be called "exceptions to lack of novelty" in some references.

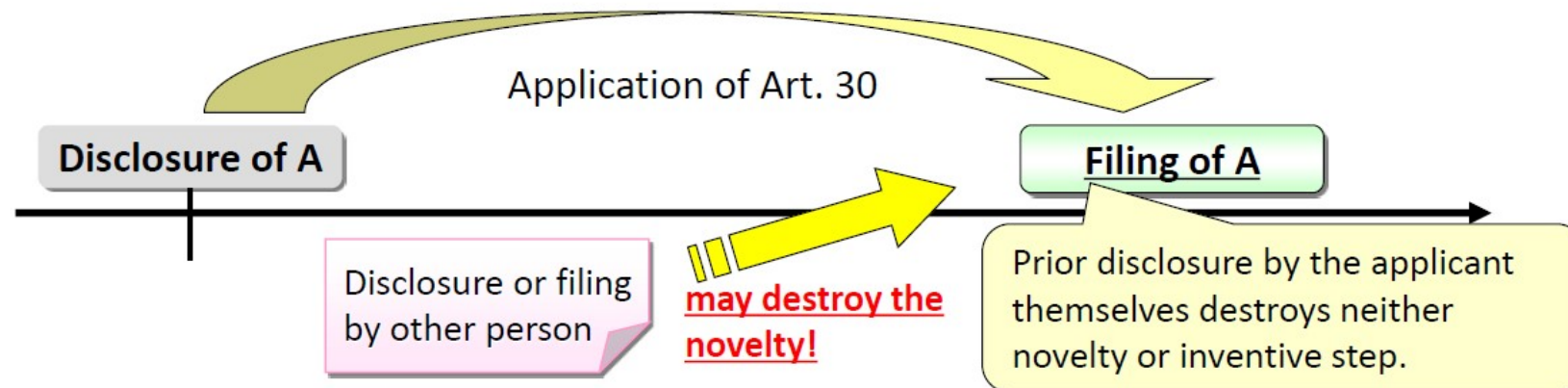
Basics of "Grace Period" in Japan

2. Exceptions to Loss of Novelty



Effect of applying the exception

Whenever the exception is applied, prior disclosures may not constitute the state of the art for the determination of novelty or inventive step of claimed subject matter.



- ✓ This is not the case when the date of prior disclosure is regarded as the filing date. Therefore, the application may be rejected based on disclosing or filing of the same subject matter between them by third person.
- ✓ Note that each jurisdiction has different laws for these exceptions, called "grace period."

Basics of "Grace Period" in Japan

2. Requirements for Exception to Loss of Novelty



Requirement 1 (Art. 30(2))

- ◆ Filed within 1 year of the disclosure
- ◆ Disclosure is the result of any action by the right holder who filed the application

Requirement 2 (Art. 30(1)) *No declaration is required.

- ◆ Filed within 1 year of the disclosure
- ◆ Prior disclosure was made **against the will** of the right holder.

Notes: Due to the revision of Article 30 of the Patent Act (effective on June 9, 2018),
the "grace period" is expanded to one year from six months.

The expanded "grace period" applied to the inventions being **published on or after December 9, 2017** and filed on or after June 9, 2018.

(Source) Outline of the Examination Guidelines for Patent and Utility Model

https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/outline_guideline_patents.htm

Revision of Examination Guidelines related to Exceptions to Loss of Novelty

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/h3006_kaitei_e.htm

Scope of "Grace Period" in Japan

✓ Old (Before 2011 Revision of Patent Act)

Before April 1, 2012: Old Article 30 Paragraphs (1)-(3)

Limited to inventions made public through:

- the implementation of a test;
- presentation in a printed publication;
- presentation in an electric telecommunication line
(*not including broadcasting*);
- writing presented at an academic conference designated by the Commissioner of the Patent Office; or
- display at a specific exhibition etc., or

Against the will (Old paragraph (2))

Scope of "Grace Period" in Japan

✓ Current (After 2011 Revision of Patent Act)

On or After April 1, 2012: New Article 30 Paragraphs (1)-(2)

- Against the will (Current paragraph (1) = Old paragraph (2))
- "Invention which has fallen under any of the items of Article 29, paragraph (1) as a result of an act of the person having the right to obtain a patent" (Current paragraph (2) > Old paragraphs (1)&(3))

[Note]

Article 29, paragraph (1) = Novelty:

1. Known to public, 2. Worked/Used in public, 3. Publication

(Reference) Patent Act (Tentative translation)

http://www.japaneselawtranslation.go.jp/law/detail_main?re=01&vm=04&id=2828

*As of June 2018, this translation does not reflect the 2018 revision of Patent Act

Scope of "Grace Period" in Japan

✓ Current (After 2011 Revision of Patent Act)

On or After April 1, 2012: New Article 30 Paragraph (2)

<Allowable Examples>

- Inventions made public at meetings and seminars, which are NOT academic conference designated by the Commissioner of the Patent Office
- Inventions made public on TV or radio
- Inventions made public through sales

<Unallowable Examples>

- Inventions contained in a gazette relating to an invention, utility model, design or trademark

Comparison between Japan and the U.S.

	Japan Article 30(2)	U.S. Section 102(b)
Disclosed by:	Person having the right to obtain a patent (ex. inventor etc.)	Inventor; Joint inventor; "Another who obtained the subject matter" etc.
How made public or disclosed?	<u>Inventions made public as a result of an act of the "person having the right to obtain a patent"</u>	As prescribed in Sec. 102(a)(1)&(2)
How long?	1 year* <u>before the JP filing</u> (incl. PCT filing) *See the notes of Slide 5 (i.e. <u>at most, 1 year from disclosure</u>)	1 year <u>before the effective filing date</u> (i.e. <u>max. 2 years from disclosure</u>)
Required Procedures	Submission of Statement and Proof <u>"Due Date for Submission"</u> for Non-PCT: Statement = <u>At the time of filing</u> Proof = Within 30 days from filing for PCT: Within 30 days from the date on which the "national processing standard time (typically, submission of translation)" for a PCT national entry into Japan	Statement, Affidavit or Declaration (37 CFR §1.77(b)(6) and §1.130) <u>"Due Date for Submission"</u> At the time of filing <u>or later</u>

Statement and Proof required in Japan

- ✓ Key elements to prepare the statement and proof
 - How to state the "Facts of Publication" ([Sec. 3.3 of "Operational Guidelines"](#))
 - ex. Displays at shows, trade fairs or exhibitions
 - Sale or distribution
 - Press conferences or performance at a live program on TV or radio
 - How to state the "Facts of Succession to the Right to Obtain a Patent, etc." ([Sec. 3.4 of "Operational Guidelines"](#))
 - How to prove if the invention is disclosed twice or more "by the inventor etc." or "by another" ([Sec. 4 of "Operational Guidelines"](#))
cf. New US Sec. 102 (b)(1)(B) and (b)(2)(B)

(Source) Procedures for Seeking the Application of Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/e_pae_paa30.htm

* This page provides a link to a [provisional English translation of the "Operational Guidelines"](#) for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2018.

Statement and Proof required in Japan

- ✓ Case Example: "Presentation at Conference in the U.S."
 - How to state the "Facts of Publication"
<Example set of required information>
 - (i) Date of the meeting (the date on which the invention was presented)
 - (ii) Name and place of the meeting
 - (iii) Person(s) who published the invention
 - (iv) Contents of the invention published (state in enough detail to specify the subject to be proved)
 - How to state the "Facts of Succession to the Right to Obtain a Patent, etc."
if the inventors did not correspond to the presenters
<Examples>
 - (i) The inventors are obligated to assign all inventions to the company (*i.e.* applicant) as part of their employment agreement; and
 - (ii) One of the inventors requested and authorized the presenters to make the presentation on behalf of the applicant.

Conclusion

✓ Key points of the "grace period" system in Japan

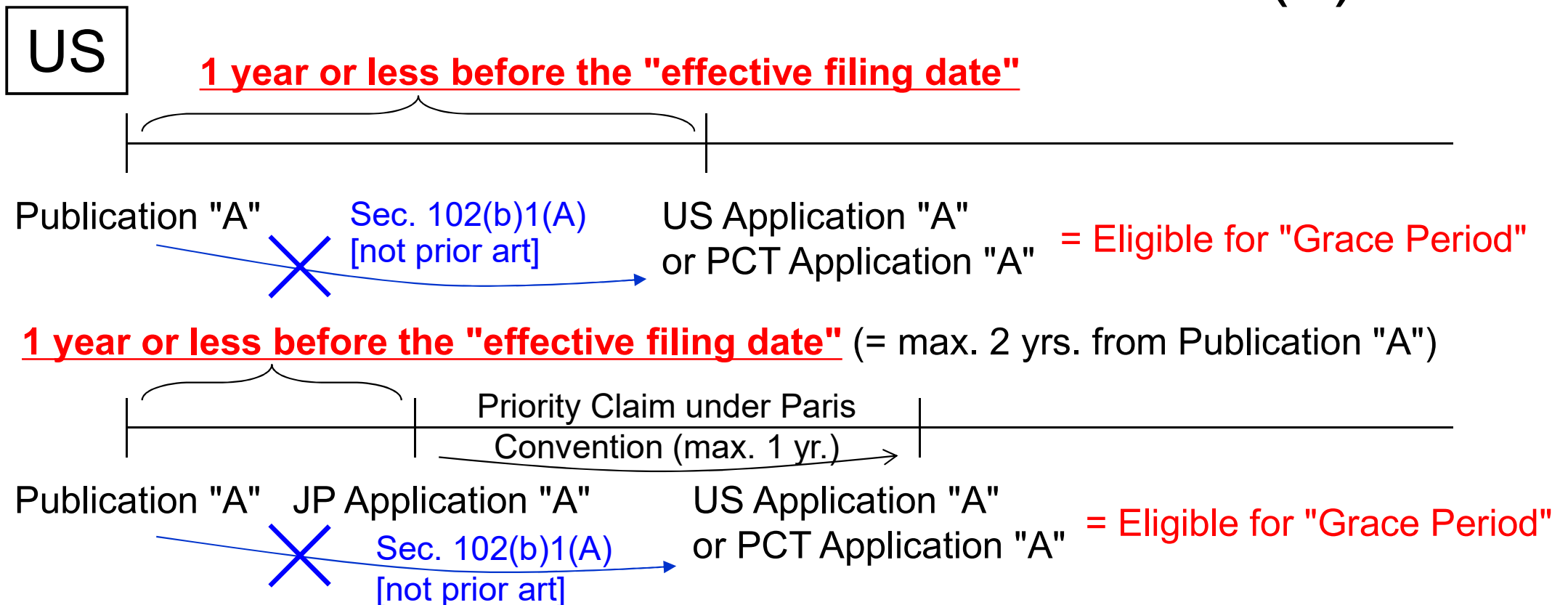
- 1) The "grace period" is available in Japan and called "exceptions to loss of novelty."
- 2) The "grace period" in Japan is limited to 1 year before an actual filing date in Japan or a PCT filing date (not a priority date).
- 3) In Japan, the "statement" is required at the time of filing, and the "proof" *with sufficient information* is required within 30 days* from the date of filing.

*Exception: Within 30 days from the date on which the "national processing standard time (typically, submission of translation)" for a PCT national entry into Japan

Appendix:

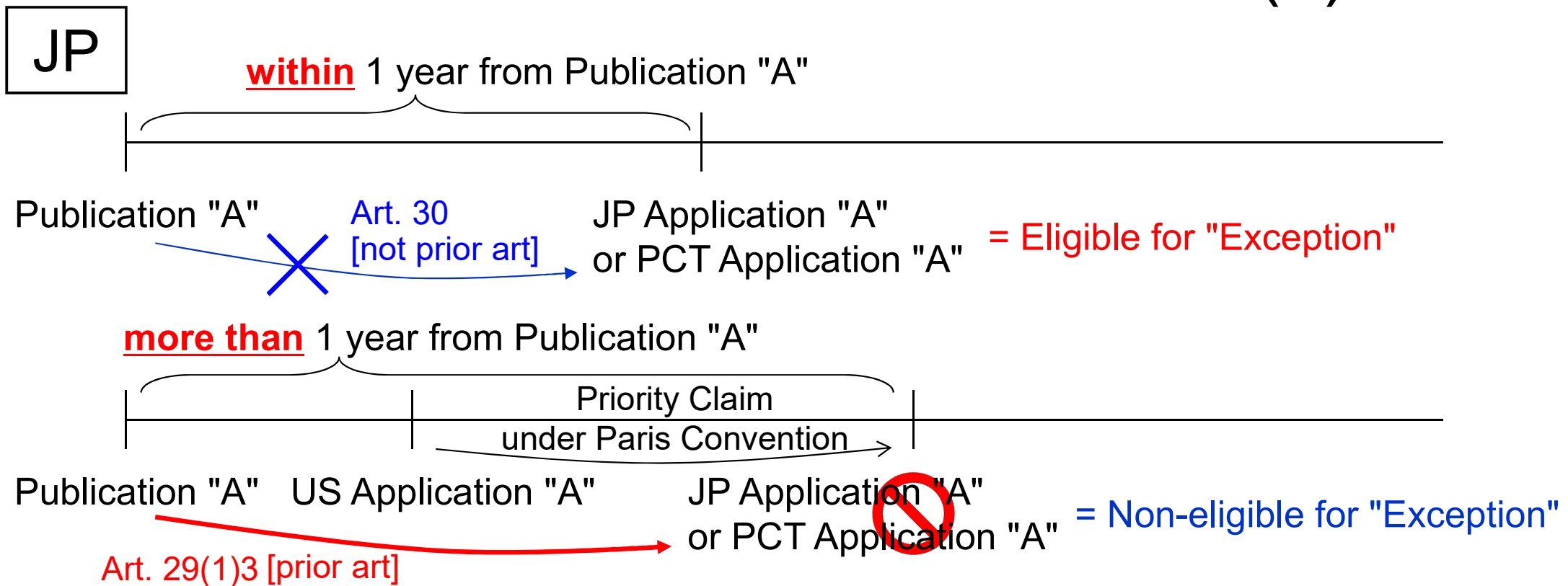
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S.

Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (1)



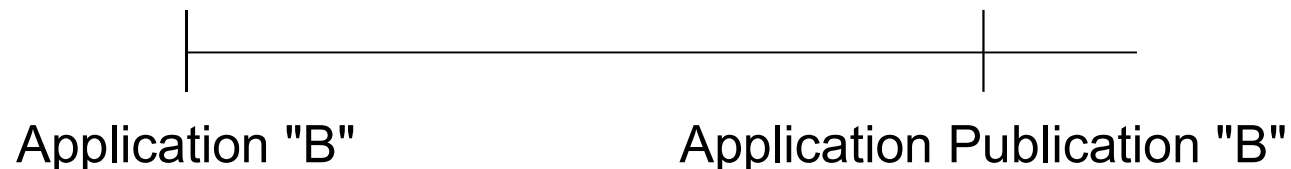
**Application "A" may be filed in the U.S.
within maximum 2 years from the publication
if a priority is validly claimed.**

Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (1)



Application "A" must be filed in Japan
within 1 year from the publication
irrespective of priority claim

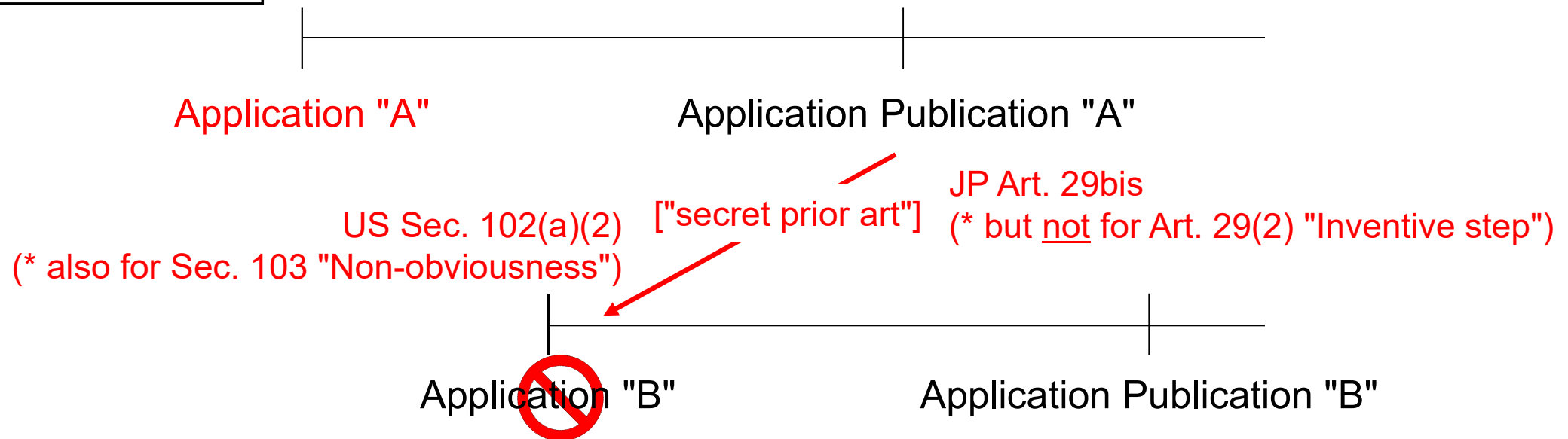
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (2)



Who may obtain a patent for the same and original invention ("A"="B") in JP and US?

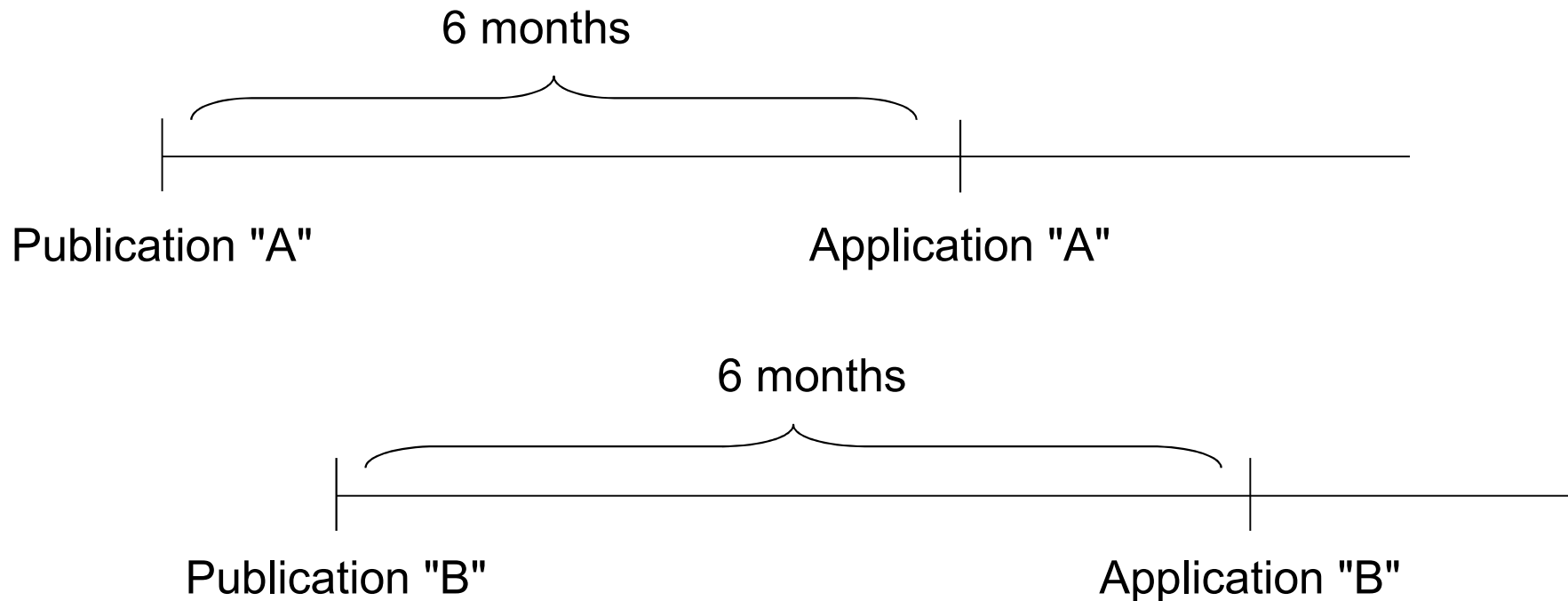
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (2)

JP & US



**Applicant of Application "A" may obtain
a patent for the invention**

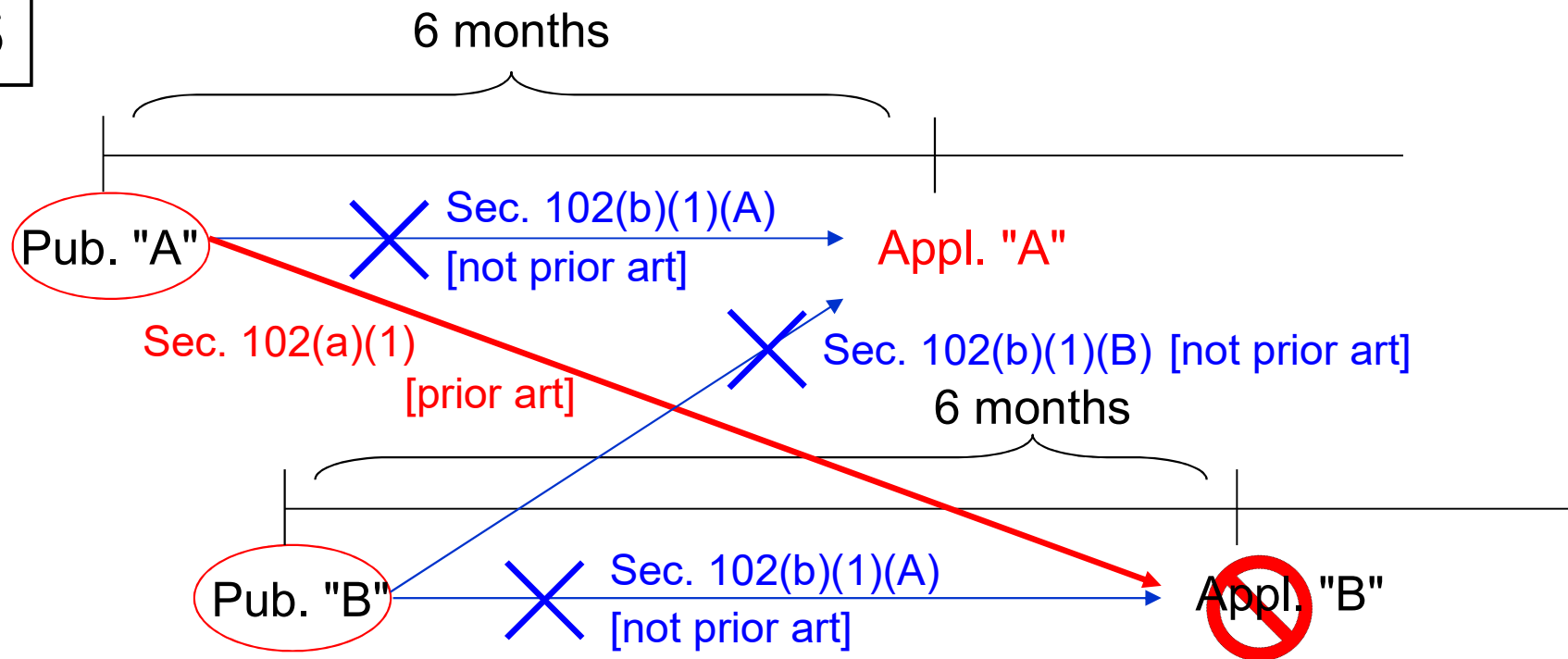
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (3)



Who may obtain a patent if the same and original invention ("A"="B") is disclosed by the original inventors who independently invented it

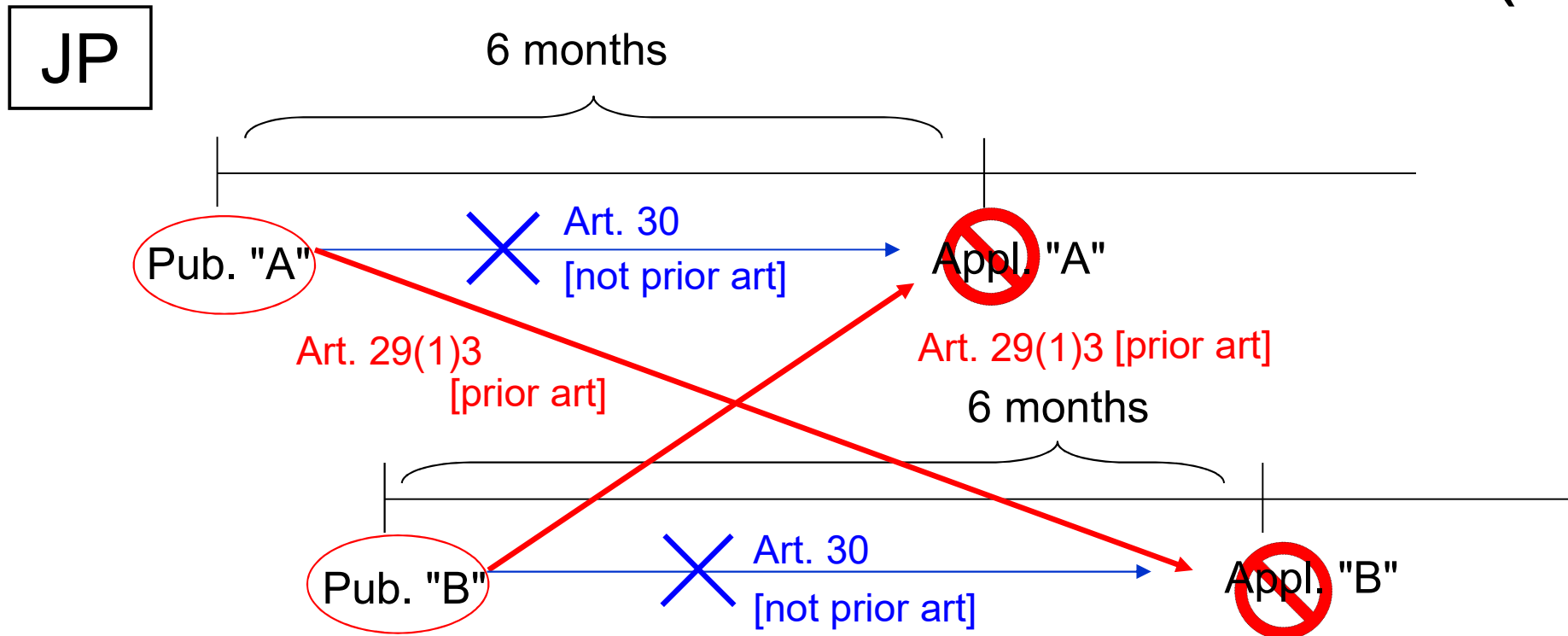
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (3)

US



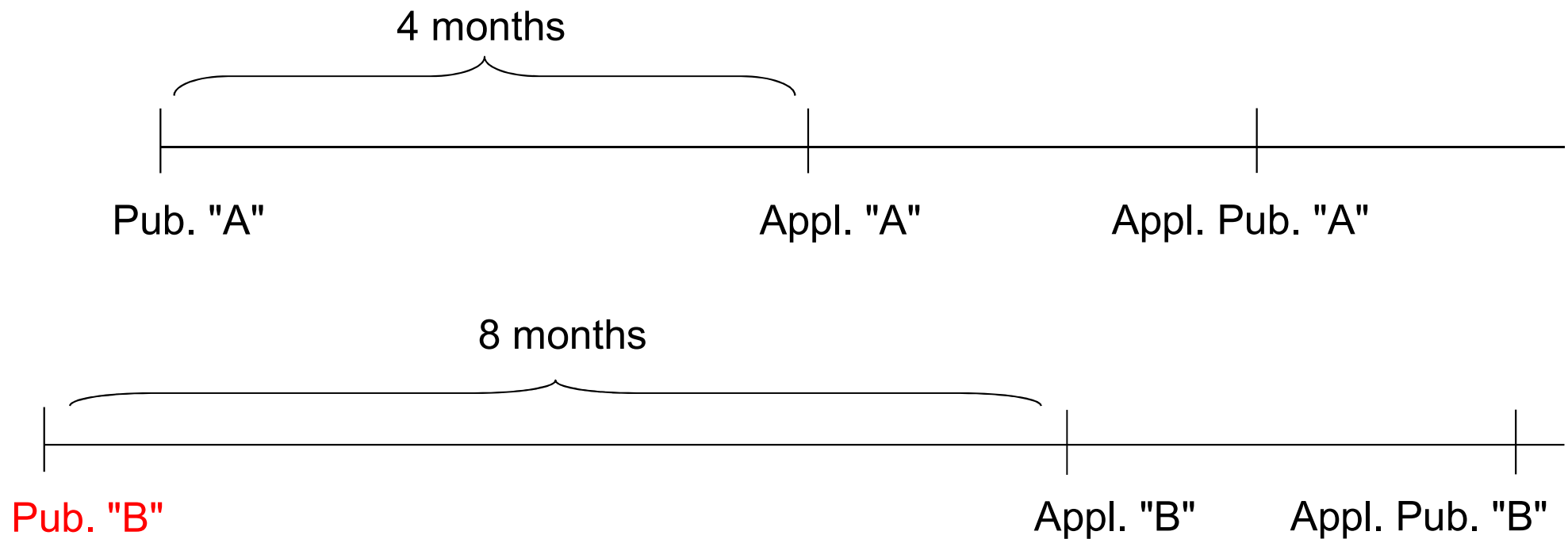
In the U.S., Applicant (earlier disclosure) of Application "A" may obtain a patent for the invention.

Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (3)



**In Japan, both applications shall be rejected
even if "Exceptions to Loss of Novelty" are sought.**

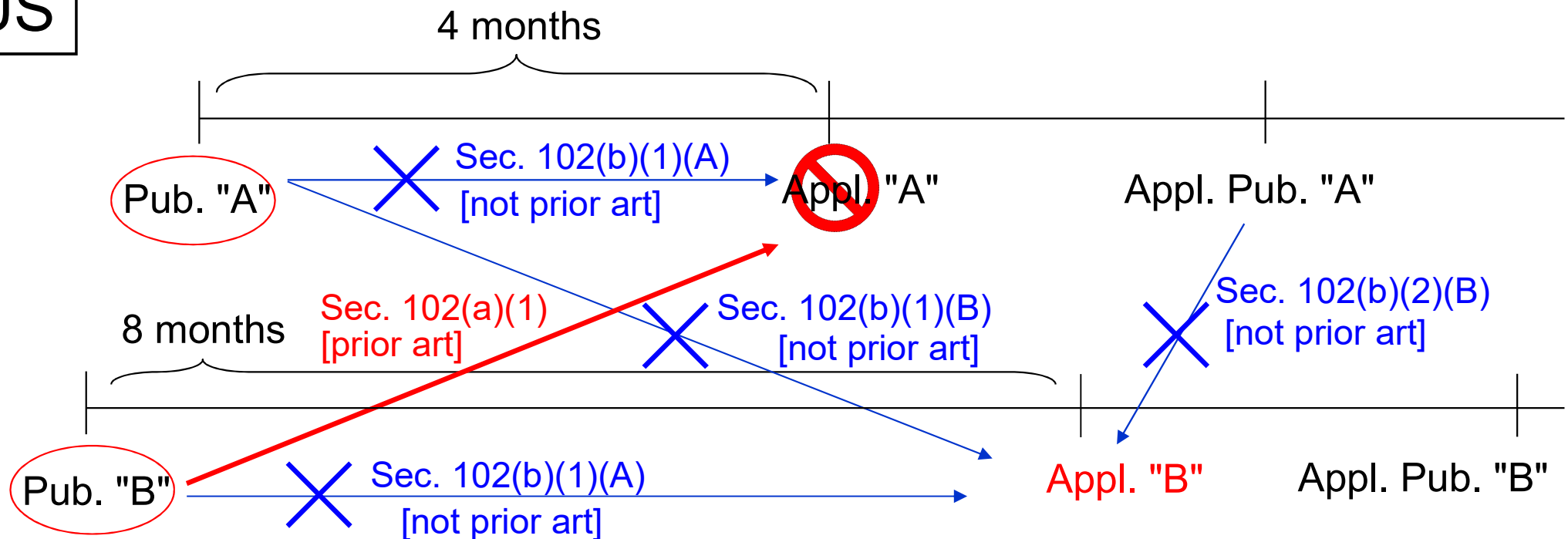
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (4)



Who may obtain a patent if the same and original invention ("A"="B") is disclosed by the original inventors who independently invented it and the earlier disclosure ("B") is filed later?

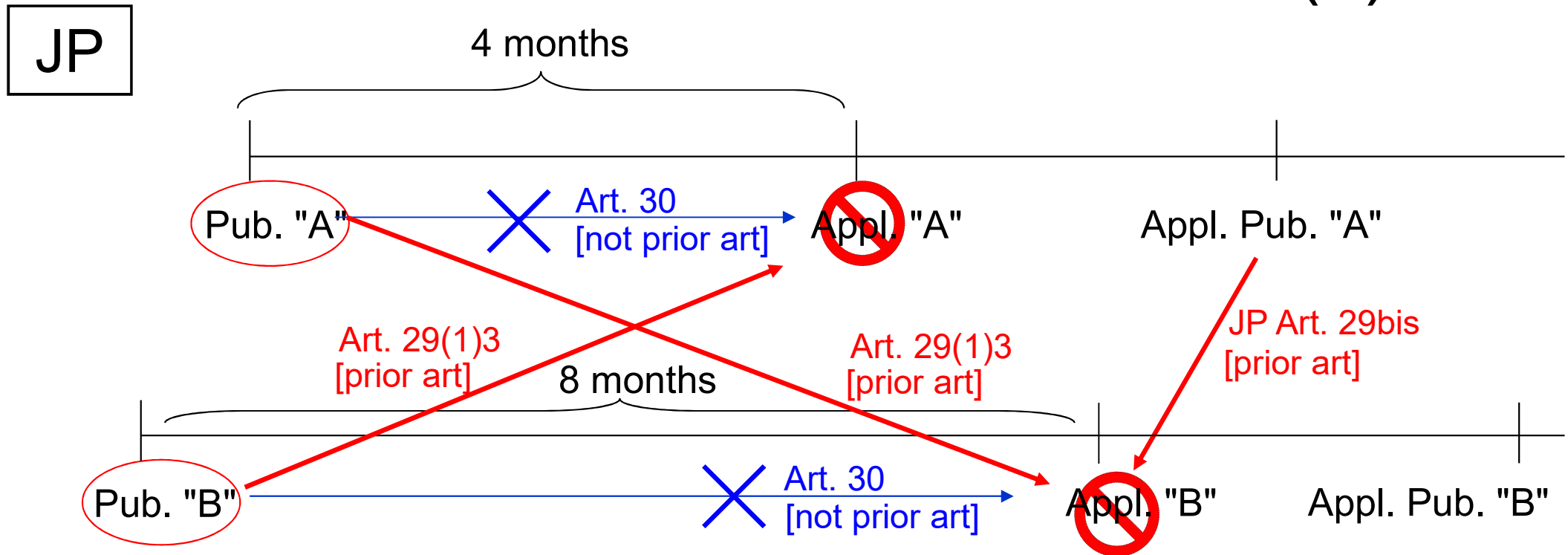
Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (4)

US



In the U.S., Applicant (earlier disclosure) of Application "B" may obtain a patent for the invention.

Detailed Comparison between "Exceptions to Loss of Novelty" in Japan and "Grace Period" in the U.S. (4)



**In Japan, both applications shall be rejected
even if "Exceptions to Loss of Novelty" are sought.**

THANK YOU

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