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GRACE PERIOD

TMPDF advocates that any grace period should be limited to six months before actual filing date (not priority date)

TMPDF disputes the need for a grace period beyond that already provided, for instance, by Article 55 EPC. Its members are very concerned about the additional uncertainties in the patent system that such a period will create, not only to large companies but also to SMEs. However, they realise that introduction of a grace period in UK and like territories may have to be accepted as part of an international agreement in patent law harmonisation that requires the US to adopt "first-to-file". (The Federation's full position on an acceptable grace period provision in this context is available on request.)

Any law introducing a grace period in UK and like territories increases uncertainty for the following reasons:-

- (1) The period during which innovators do not know whether information in published documents can be used freely is increased from the present 18 months by the length of the grace period. Even a short increase can cause serious disadvantages.
- (2) There will inevitably be uncertainties besides those in (1), inherent in the legal provisions and their application in any given case (e.g., status of other disclosures made in the grace period).
- (3) Unless the advantage to the patentee (increasing the time period of uncertainty for his competitors) is counterbalanced by a disadvantage, the use of the grace will be frequent* and the overall level of uncertainty will be further increased.

The TMPDF concern is to seek a fair balance between the interests of patent applicants and the public in general (including competitors).

By pressing for a 6-month grace period, with the 6 months being before **actual filing date** (not the priority date), the Federation is addressing (3), giving a saving grace to inadvertent or accidental disclosure, whilst discouraging routine use, as patent life will effectively be 6 months shorter than if a priority application is filed just before disclosure. In contrast, a period of 6 months before **priority date** would extend potential patent life, and, **reward** routine use of a grace period provision.

Under the Federation proposal, there is no reason why someone should not file a priority application as soon as possible after the disclosure, and claim priority from that in later applications filed within the 6 months from the disclosure (effectively losing 6 months or so of what would otherwise be the priority year). The most practical thing would probably be to file a PCT application within the grace period. The PCT enables extremely wide geographical protection to be sought in a very straightforward manner via a single patent application. There is thus no hardship, from a practical standpoint, in a grace period of 6 months before the actual filing date.

The TMPDF proposal is technically simple to implement, being an extension of the existing limited grace provision in Article (55) (1) (b) EPC relating to disclosures at international exhibitions, and of the similar provision in Japan.

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* It may be asked why the grace period is relatively little used in the USA at present despite the lack of advantages. The reason is that USA applicants do not want to lose patent protection in other countries. This reason would disappear if the UK and other countries adopted grace periods more generous than the Federation proposes.

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