

Grace Period for Patents

Introduction

A grace period has applied in Australia since 1 April 2002. Grace periods of one form or another apply in many countries, including the United States, Japan and Canada, but there are also many countries that do not have a grace period, such as most European countries.

This fact sheet provides information on how the grace period for patents applies in Australia.

What is a grace period?

The grace period allows for public disclosure of an invention (under certain conditions) without affecting the validity of a subsequent patent application (provided that a complete application is filed within 12 months of the disclosure).

This is to cover those circumstances where the inventor has inadvertently disclosed their invention before applying for a patent, for example when they have discussed it with a contractor without a confidentiality agreement.

Prior to the introduction of the grace period, an invention had to be kept secret before an application for a patent was made. If the inventor showed the invention to another party,

a later patent was invalid unless the disclosure was covered by implied confidentiality or a confidentiality agreement.

The grace period covers disclosures of an invention made by or with the consent of the nominated person or patentee.

The grace period may help a patent application succeed in cases where disclosure of an invention has been made by mistake or is ill timed. However, a grace period should not be used as a general strategy for publishing an invention before filing a patent application.

The lack of a uniform grace period or grace period requirements around the world could mean patent applications that rely on grace period disclosures may be invalid in other countries. In addition, third parties who use an invention in the grace period and before a patent application is made will retain their rights to use the invention.

How does the grace period work?

The grace period may be applied when the validity of your patent or patent application is being considered in examination or revocation proceedings. You do not need to take any action to claim the grace period but if your invention is disclosed you will need to ensure a complete application is filed in time.

Remember:

- The grace period covers disclosures within a period of no more than 12 months before the filing date of a complete application in Australia.
- The grace period will not provide an applicant with an earlier priority date.
- The grace period has no retrospective effect - it only applies in relation to disclosures made on or after 1 April 2002, even if an application was made after 1 April.
- The grace period only applies to your patent or patent application in Australia. Similar arrangements apply in some other countries and you should seek professional advice concerning such matters.

Seek Professional Advice

This sheet provides only basic information. Patent matters can involve complex legal issues and it may be in your best interests to consult a patent attorney, solicitor experienced in intellectual property matters, or your business adviser.

For a list of IP professionals, visit the IP Australia website www.ipaustralia.gov.au or search your local Yellow Pages Directory.

Disclaimer:

This information is intended to help the reader gain a basic understanding of some IP principles. It is not designed to provide legal, business or other relevant professional advice. IP Australia recommends that you seek independent legal, business or other relevant specialist advice.

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