



Novelty Grace Period in Japan Extended to 1 Year

Applicable to Disclosure on and after Dec. 9, 2017

Seiwa Patent & Law (Tokyo, JAPAN)

June 25, 2018

Abstract

The novelty grace period has been extended from 6 months to 1 year according to the Japanese Patent Law, Utility Model and Design Laws 2018 as partially revised. These revised provisions entered into force as of June 9, 2018, and cover cases where the first disclosure of an invention (a design) was made on and after December 9, 2017, and an application therefor filed on and after June 9, 2018.

This article overviews the grace period system in Japan with the revision.

CONTENTS

1. Applications eligible for the new grace period
2. Applicants eligible for the grace period
3. Disclosure eligible for the grace period
4. Procedural requirements in self-disclosure cases
5. Effects

The novelty grace period is prescribed in the Japanese patent, utility model (UM), and design system, as “exception to loss of novelty” (Japanese Patent Law Art. 30, UM Law Art. 11, Design Law Art. 4). The latest revisions to the Laws, effective as of June 9, 2018, extended the novelty grace period from 6 months to 1 year from the first disclosure. Reference is made to a patent application as follows.

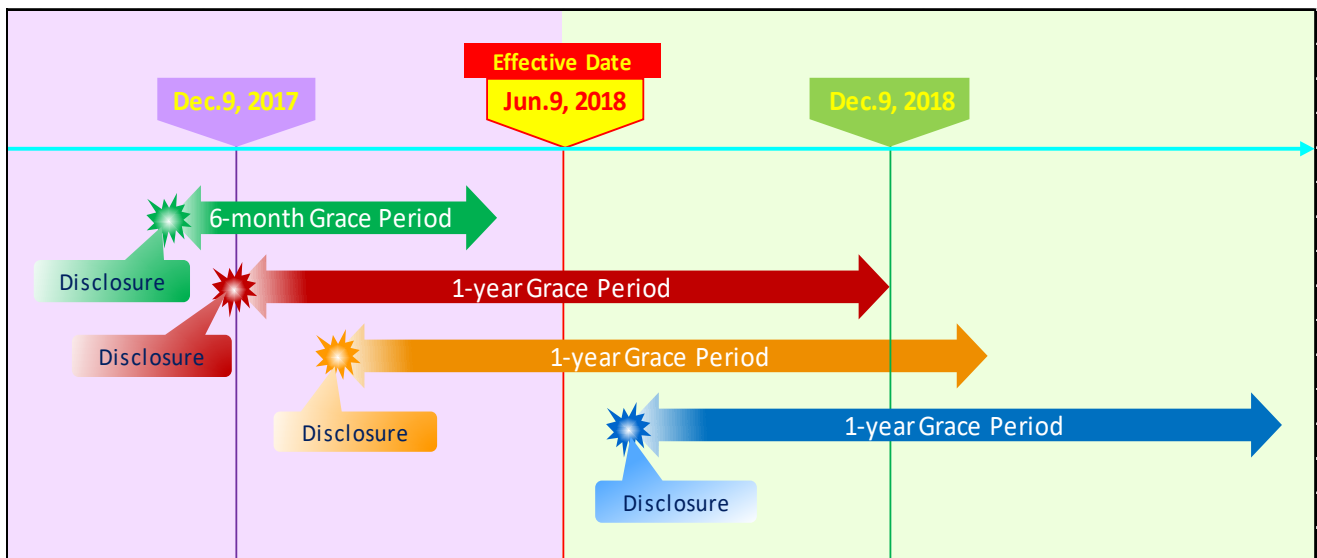
1. Applications eligible for the new grace period

- The extended 1-year grace period is applicable to applications claiming an invention which was first disclosed **on and after December 9, 2017**. It is no longer possible to utilize the grace period for inventions first disclosed before that date.
- In a Japanese patent application, the Japanese filing date must be on or after June 9, 2018.
- In a PCT international application, the international filing date must be on or after June 9, 2018.



The above filing date (Japanese or international) means the actual filing date, NOT including the priority date, if claimed.

- In a divisional application, the filing date of the parent application must be on or after June 9, 2018.
- In an application claiming a domestic priority (priority based on an earlier Japanese application), the filing date of the earlier application must be on or after June 9, 2018, for the original invention.



2. Applicants eligible for the grace period (no change)

- A person having a right to obtain a patent may enjoy the benefit of the novelty grace period, including an inventor and his/her successor, but is not limited to the person who actually disclosed the invention.

3. Disclosure eligible for the grace period (no change)

- The eligible disclosure includes two types, i.e.,
 - A. self-disclosure, i.e., disclosure by the act of the right holder (inventor, etc.), and
 - B. undesired disclosure, i.e., disclosure (by a third party) against the intention of the right holder.
- Eligible acts in the above Item A are basically not limited, i.e., including the following acts of publication through:
 - a test, an experiment,
 - a presentation in a printed publication, e.g. books, magazines, etc.
 - the Internet website,
 - a presentation at a meeting, e.g. academic conference, seminar, briefing session for investors or customers, etc.,
 - displays at shows, trade fairs, exhibitions, etc.
 - sale, and
 - press conferences, live broadcasting on TV or radio.



- However, it is not possible to enjoy the benefit of the grace period based on an invention disclosed in an official gazette published in Japan or other countries, in relation to a patent, utility model, design and trademark.
- The invention claimed in the application is not necessarily identical to the disclosed invention.

4. Procedural requirements in self-disclosure cases (No change)

- The applicant must assert the grace period **at the time of filing**. Later assertion is not possible.
- Also, the applicant must submit evidence legitimating the grace period within **30 days** from the filing date. It is practically impossible to submit it later.



The length of 30 days for submitting evidence for the grace period has not been extended by the latest revision.

- The evidence must include the fact of disclosure, e.g., a) who disclosed the invention, b) when, where and how the invention was disclosed, c) summary of the disclosed invention, etc.
- In a PCT application entering Japan, the applicant may assert the grace period and submit evidence within 30 days from the national entry due date (if a request for examination is filed earlier, 30 days from that date), unless so asserted in the international phase (Patent Law Art. 184-14). If the 2- month deferment of the Japanese translation submission is requested, the above 30 days starts from the time limit of such a deferment (Patent Law Art. 184-14).
- The above procedural requirements are not applicable to the cases of undesired disclosure. In this case, the applicant may assert the grace period, e.g., in an argument in response to a possible Office Action.

5. Effects (No change)

- If the grace period is accepted by the JPO Examiner, the disclosed invention will not be cited as a publicly-known invention in the examination of novelty and inventive step.
- It is not possible to overcome the disclosure and patent application in relation to a third party's own invention during the grace period, unlike the Paris Convention priority claim.



Although the novelty grace period has been extended to 1 year, it is still strongly recommended that the applicant file an application at the earliest opportunity, in order to avoid intervention by a third party's possible disclosure or application during the grace period.

END



<Appendix>

Grace Periods in IP5

<June 9, 2018>

	Grace Period	Base date	Eligible disclosure	Procedures
JP	1 year	Filing date	<ul style="list-style-type: none"> Any act of self-disclosure Not applicable to publication on official IP gazettes 	<ul style="list-style-type: none"> Assertion at the time of filing (except PCT national entry) Evidence
			<ul style="list-style-type: none"> Disclosure against applicant's intention 	<ul style="list-style-type: none"> Unneeded (to be proved in examination)
US	1 year	Effective filing date	<ul style="list-style-type: none"> Any act of disclosure 	<ul style="list-style-type: none"> Unneeded (to be proved in examination)
EU	6 months	Filing date	<ul style="list-style-type: none"> Display at official or officially recognized international exhibition 	<ul style="list-style-type: none"> Assertion at the time of filing Evidence
			<ul style="list-style-type: none"> Evident abuse 	<ul style="list-style-type: none"> Unneeded (to be proved in examination)
CN	6 months	Filing date or Priority date	<ul style="list-style-type: none"> Display at international exhibition sponsored or recognized by Chinese Government Disclosure at prescribed academic or technological meeting 	<ul style="list-style-type: none"> Assertion at the time of filing Evidence
			<ul style="list-style-type: none"> Divulgence by others without applicant's consent 	<ul style="list-style-type: none"> Unneeded (to be proved in examination)
KR	1 year	Filing date	<ul style="list-style-type: none"> Any act of self-disclosure Not applicable to publication on official IP gazettes 	<ul style="list-style-type: none"> Assertion at the time of filing or later Evidence
			<ul style="list-style-type: none"> Disclosure against applicant's intention 	<ul style="list-style-type: none"> Unneeded (to be proved in examination)