

Question Q233

National Group: Netherlands

Title: Grace period for patents

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Questions

Questions

The Groups are invited to answer the following questions under their national laws. If both national and regional laws apply to a question, please answer the question separately for each set of laws.

Please number your answers with the same numbers used for the corresponding questions.

I. Analysis of current law and case law

- 1) Does your country or region provide a grace period of any kind for patent applicants? As used in these questions, "grace period" includes any situation where a disclosure prior to a patent filing date that would normally qualify as prior art to the patent application is disqualified as or removed from the prior art.

Yes. Article 55(1) EPC and Article 5 of the Dutch Patent Act 1995 ("DPA 1995") identify two types of non-prejudicial disclosures, which aim to protect an inventor from abusive disclosure by a third party and to give an inventor the possibility to display his/her invention at certain exhibitions prior to filing a patent application for the invention.

- 2) If the answer to Question (1) is yes, please answer the following sub-questions

2a) What is the duration of the grace period?

The term is *six months* with respect to both types of non-prejudicial disclosures identified at Q1.

2b) From what date is the grace period calculated? Please indicate the effect, if any, of an international filing date and/or a Paris Convention priority date.

Art. 55(1) EPC provides that certain disclosures of the invention shall not be considered to form part of the state of the art if they occurred no earlier than six months preceding "the filing of the European patent application." Similarly, Art. 5(1) DPA 1995 provides that certain disclosures of the invention shall not be considered to form part of the state of the art if they occurred no earlier than six months preceding "the filing of the patent application."

In 1995 in the case of *Organon vs ARS*, the Dutch Supreme Court (HR 23 June 1995, GRUR Int 1997, 838; IIC 1998, p. 702 *Follicle-Stimulating Hormone II*) held that if a priority right exists, the specified period of six months should be calculated on the basis of the date of priority and not the date of filing of a European patent application:

"As follows from Art. 89 EPC, the effect of a priority right is that for the application of Art. 54(2) EPC inter alia - a provision that determines the applicable state of the art in terms of time, and is hence closely connected with Art. 55(1) EPC - the priority date is to be regarded as the date on which the European patent application is deemed to be submitted. The purpose of Art. 55(1) EPC - the protection of the applicant - would not be effective if this provision was to be construed literally in cases in which there is a priority right. The system underlying the Convention thus justifies a construction according to which the priority date also replaces the date of the application in the calculation of the period specified in Art. 55(1) EPC."

Five years later however, on 12 July 2000, the Enlarged Board of Appeal of the EPO (G 3/98, OJ EPO 2001, 62, [2001] EPOR 33 *Opposition by SmithKline Beecham Biologicals*) held that:

"[f]or the calculation of the six-month period referred to in Article 55(1) EPC, the relevant date is the date of the actual filing of the European patent application; the date of priority is not to be taken account of in calculating this period."

The same rule has been applied by the Swiss Federal Supreme Court in its judgment dated 19 August 1991 (OJ EPO 1993, 170 *Stacker*) and by the German Federal Court of Justice in its judgment dated 5 December 1995 (OJ EPO 1998, 263 *Coriolis force*).

It is arguable that in view of more recent case law, the Dutch Court would no longer follow the ruling of the Dutch Supreme Court in *Follicle-Stimulating Hormone II*, which was decided before G3/98. In *Scimed vs. Medinol* (HR 6 March 2009, NJ 2009, 417) the Dutch Supreme Court held that the ratio of Art. 138 EPC 2000 (which refers to Art. 55 EPC) is harmonization of the revocation of a European patent. In *Bébécar v. Maxi Miliaan* (Court of Appeal of The Hague 30 March 2010, IER 2010, no. 58, p. 397) the Court of Appeal held that Art. 138 EPC also applied to Dutch national patents. Hence, in the context of harmonization of patent law, the Dutch Courts may decide in favor of the European ruling of the Enlarged Board of Appeal.

2c) What types of intentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

Article 55(1)(b) EPC and Article 5(1)(b) DPA 1995 provide for only a limited type of non-prejudicial willful disclosure, i.e. the disclosure due to, or in consequence of the fact that the

applicant or his legal predecessor has displayed the invention at an official, or officially recognized, 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 5(2) Dutch Patent Act provides that the official recognition of exhibitions in The Netherlands shall be accorded by the Dutch Minister of Economic Affairs, and recognition of exhibitions in Curacao and St. Martin shall be accorded by the Government of Curacao or St. Martin. The Dutch Group notes that in practice, these rules are not important. In the Netherlands no decision has been published in which the patentee successfully relied on this rule.

2d) What types of unintentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

Unintentional acts do *not* qualify as under the non-prejudicial disclosures.

2e) 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 55(1)(a) EPC and Article 5(1)(a) DPA 1995 provide for only a limited type of non-prejudicial disclosures by *third parties*, wherein the disclosure is due to, or in consequence of an "evident abuse" in relation to the applicant or his legal predecessor. In principle, there is no restriction as to the type of disclosure, which has occurred. It may be an oral presentation, a publication of a document, a prior public use, etc.

In *Organon v ARS*, the Court of Appeal (3 February 1994) found evident abuse within the meaning of Art. 55(1) EPC following the decision of the board of appeal T 173/83 (OJ 1987, 465, [1988] EPOR 133), in which decision the Board held that:

"[w]ithin the meaning of Article 55(1)(a) EPC, there would be evident abuse if it emerged clearly and unquestionably that a third party had not been authorised to communicate to other persons the information received. In the Board's opinion, there would be abuse not only when there is the intention to harm, but also when a third party, knowing full well that it is not permitted to do so, acts in such a way as to risk causing harm to the inventor, or when this third party fails to honour the declaration of mutual trust linking him to the inventor."

wherein unintentional acts are not considered to be "evident abuse":

"evident abuse indicates that mere negligence or breach of confidentiality does not suffice. Deliberate intention to harm the other party would constitute evident abuse, as probably also knowledge of the possibility of harm resulting from a planned breach of this confidentiality."

In a further decision of the Boards of Appeal the bar for finding "evident abuse" within the meaning of Art. 55 EPC was substantially raised. In T 585/92 (par. 6.4-6.5, [1996] EPOR 579, *Unilever/Deodorant Detergent*) regarding a case wherein a patent application was erroneously published early by the Brazilian Patent Office the Board held that the publication of the invention by a government agency as a result of an unintentional (although "lamentable") error was not an evident abuse:

"In the case of an abuse, [...] the state of mind of the "abuser" is of decisive importance. [...] The nature of that state of mind must either be engendered or at least be influenced by his personal and specific relationship with the Applicant. Normally where unauthorised disclosure of information takes place, there exists a legally enforceable obligation of confidence between the giver and the recipient of the confidential information. This confidentiality may arise from the circumstances of the

disclosure or, as is more often the case, be brought about by an express confidentiality or secrecy agreement. In both cases the recipient of the information would know or should know the likely commercial and legal consequences of any unauthorised disclosure. Such a disclosure, made either with actual intent to cause harm (here commercial damage), or with actual knowledge (cf. constructive knowledge) that some such harm would or could reasonably be expected to result from it, would amount to an abuse in relation to the owner of the information. Different criteria apply to a disclosure by a recipient of information who does not stand in any personal or specific contractual relationship to the discloser but merely owes to the public a general duty to prevent disclosure. Such a disclosure made by dint of mere inadvertence or a genuine mistake, however unfortunate and detrimental its results may turn out to be, is not tainted with the necessary amount of actual or constructive knowledge and therefore guilty inadvertence so as to turn it into an evident abuse within terms of Article 55(1)(a) EPC."

Further case law of the Boards of Appeal confirmed this strict requirement for finding "evident abuse" and to our knowledge there have been no decisions of the Boards of Appeal of the EPO or the Dutch courts wherein "evident abuse" was successfully argued and proven, since.

2f) 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?

No. See further at 2e).

2g) 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?**
ii. **When must the statement/declaration be filed?**

With respect to European patents, Article 55(2) EPC provides that if the invention has been displayed in an exhibition falling within the narrow scope of Art. 55(1)(b) EPC, the disclosure will only be non-prejudicial if the applicant states, when filing the European patent application, that the invention has been so displayed and files a *supporting certificate*. Pursuant to Rule 25 EPC, the applicant must file this certificate *within four months of filing* of the European application. The certificate must (a) be issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, (b) state that the invention was in fact displayed there, (c) state the opening date of the exhibition and, where the invention was disclosed later than on that date, the date on which the invention was first disclosed, and (d) must be accompanied by an identification of the invention, duly authenticated by the aforementioned authority. The Examining Division must assess the matter of the identification between the invention displayed and the application under examination (Guidelines for Examination in the EPO, B VI-3, par. 5.5).

With respect to Dutch national patents, Article 15(3) Implementation Decree Dutch Patent Act 1995 provides that the applicant must file a certificate *within four months of filing* of the Dutch application, which meets the same four criteria.

2h) 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.

1) EPC:

Article 55 Non-prejudicial disclosures

- (1) For the application of Article 54 [novelty] 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 legal predecessor, or
 - (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognized, 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.
- (2) In the case of paragraph 1(b), paragraph 1 shall apply only if the applicant states, when filing the European patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions laid down in the Implementing Regulations.

Rule 25 Certificate of exhibition

Within four months of filing the European patent application, the applicant shall file the certificate referred to in Article 55, paragraph 2, which:

- (a) is issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition;
- (b) states that the invention was in fact displayed there;
- (c) states the opening date of the exhibition and, where the invention was disclosed later than on that date, the date on which the invention was first disclosed; and
- (d) is accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

2a) Rijsoctrooiwet 1995

Artikel 5

1. Voor de toepassing van artikel 4 blijft een openbaarmaking van de uitvinding buiten beschouwing, indien deze niet eerder is geschied dan zes maanden voor de dag van indiening van de octrooiaanvraag als direct of indirect gevolg van:
 - a. een kennelijk misbruik ten opzichte van de aanvrager of diens rechtsvoorganger, of
 - b. het feit, dat de aanvrager of diens rechtsvoorganger de uitvinding heeft tentoongesteld op van overheidswege gehouden of erkende tentoonstellingen in de zin van het Verdrag inzake Internationale Tentoonstellingen, ondertekend te Parijs op 22 november 1928, zoals dat is gewijzigd, laatstelijk bij Protocol van 30 november 1972 (Trb. 1973, 100), op voorwaarde dat de aanvrager bij de indiening van zijn aanvraag verklaart dat de uitvinding inderdaad is tentoongesteld en een bewijsstuk daarvoor overlegt binnen een bij algemene maatregel van rijksbestuur vast te stellen termijn en overeenkomstig bij algemene maatregel van rijksbestuur te stellen voorschriften.
2. De erkenning van overheidswege van tentoonstellingen in Nederland geschiedt door Onze Minister en die van tentoonstellingen in Curaçao en Sint Maarten door de regering van Curaçao respectievelijk van Sint Maarten.
3. De tentoonstellingen in Nederland en die in de Nederlandse Antillen die voor de inwerkingtreding van de Rijkswet aanpassing rijkswetten aan de oprichting van de nieuwe landen zijn erkend door Onze Minister van Economische Zaken respectievelijk door de regering van de Nederlandse Antillen gelden na de

inwerkingtreding van die rijkswet als tentoonstellingen als bedoeld in artikel 5, tweede lid.

Artikel 15 Uitvoeringsbesluit

[...]

3. Binnen vier maanden na de indiening van de octrooiaanvraag legt de aanvrager aan het bureau het in artikel 5, eerste lid, onder b, van de wet bedoelde bewijsstuk over dat tijdens de tentoonstelling is afgegeven door de autoriteit, belast met de bescherming van de industriële eigendom op de tentoonstelling, en waaruit blijkt dat de uitvinding inderdaad is tentoongesteld. Deze verklaring vermeldt tevens de datum waarop de tentoonstelling is geopend en eventueel de datum waarop de uitvinding voor het eerst is geopenbaard, indien deze twee data niet samenvallen. Bij deze verklaring worden stukken overgelegd die een nauwkeurige omschrijving geven van de uitvinding en die als authentiek zijn gewaarmerkt door de autoriteit, bedoeld in de eerste volzin.

2b) Unofficial translation in English

Article 5 Dutch Patent Act 1995

1. For the purposes of Article 4 the disclosure of an invention shall be disregarded if it occurred no earlier than six months prior to the filing of the patent application as a direct or indirect consequence of:
 - a. an evident abuse in relation to the applicant or his legal predecessor, or
 - b. the fact that the applicant or his legal predecessor displayed the invention at an official, or officially recognized, international exhibition within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928, and last revised by Protocol of 30 November 1972 (Trb. 1973, 100), on condition that the applicant declares, upon filing his application, that the invention has been so displayed and submits proof thereof within a period set by Royal Decree and in accordance with provisions set by Royal Decree.
2. Official recognition of exhibitions in The Netherlands shall be accorded by Our Minister, and recognition of exhibitions in Curacao and St. Martin shall be accorded by the Government of Curacao or St. Martin.
3. The exhibitions in the Netherlands and the Netherlands Antilles which have been recognized by the Minister of Economic Affairs or by the Government of the Netherlands Antilles before the entry into force of the Act on the establishment of the new countries, will be considered exhibitions according to Article 5, second paragraph, after the entry into force of that Act.

Article 15 Implementation Decree Dutch Patent Act 1995

[...]

3. Within four months of filing the patent application, the applicant shall submit with the Patent Office the certificate referred to in Article 5, paragraph 1, sub b, which has been issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, and which shows the invention was in fact displayed there. This statement also states the opening date of the exhibition and, where the invention was disclosed later than on that date, the date on which the invention was first disclosed. With this statement, documents are submitted which provide a precise description of the invention, duly authenticated by the above-mentioned authority.

- 2i) **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.)**

No

Policy

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

3a) What are the policy reasons behind this grace period?

According to Article 8 of the (old) Dutch Patent Act 1910 ("DPA 1910"), a patent application was entitled to an exhibition *priority date* if it was filed within six months from the exhibition of the invention. Article 8 thus provided protection from all disclosures for a timeframe of six months after the disclosure at an exhibition.

The *travaux préparatoires* of the DPA 1910 reveal that there was no real policy reason behind this grace period other than harmonization; Article 8 was intended to fulfill the treaty obligation of Article 11 of the Paris Convention.

In 1977, Article 8 was replaced by Article 2(5) DPA 1910. To bring the DPA 1910 in line with the Strasbourg Convention, "evident abuse" was introduced as type of disclosure which is graced, provided it occurred no longer than six months prior to filing.

Furthermore, the scope of the grace period with respect to disclosures at exhibitions was limited to a significant extent. The old rule, where a patentee was entitled to an exhibition priority date, was abandoned in favor of a more strict regime. Under the new regime, only a disclosure at the exhibition itself is disregarded as prior art (provided that it occurs no longer than six months prior to filing). Other disclosures count fully as prior art. Moreover, contrary to the old rule, only exhibitions at *officially recognized exhibitions* within the meaning of the Convention on International Exhibitions, signed in Paris, France, on 22 November 1928, are graced.

With respect to the latter, the legislator deemed this to be necessary to avoid an inventor being put on the wrong track. The disclosure of an invention at an exhibition recognized by the Dutch State was graced under Article 8 DPA 1910, but often barred the applicant from obtaining a foreign patent as the foreign State would not recognize the exhibition. This was often not considered in practice, and led to damage on the part of inventors exhibiting at Dutch exhibitions.

In the mid 1990's, the DPA 1910 was replaced with the DPA 1995. The current Article 5 DPA 1995 has the same scope as the old Article 2 (5) DPA 1910, with one addition: the patentee must provide proof that his invention was disclosed at an officially recognized exhibition when filing an application. The addition was intended to bring the DPA in line with the EPC, i.e. Article 55 (2) thereof.

In conclusion, the main policy reason behind introducing a grace period in the DPA is harmonization. However, as the Dutch State is party to the abovementioned conventions, the policy reasons behind implementing the graced exceptions in those conventions can be considered to be of relevance for the DPA also.

3b) Is the grace period, as it currently exists in your country or region, considered useful?

The abuse exception of Article 5 (1)(a) DPA 1995 and Article 55 EPC is considered to be useful by practitioners.

The exhibition exception, however, is generally not considered to be very useful. Due to the qualification requirement, the exception is so narrowly defined that it is (almost) never used. The number of exhibitions qualifying for the exception is very limited. Moreover, in this modern time the weight and importance of exhibitions of this kind may have diminished.

3c) Is the grace period considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

Not in particular; the current grace period of Article 5 DPA 1995 and Article 55 EPC does not distinguish between specific groups.

3d) 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.

Occasionally.

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

- a) What are the policy reasons behind not providing a grace period?**
- b) Would a grace period be useful for stakeholders in your country or region?**
- c) Would a grace period be considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?**

Not relevant.

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

Positive aspects are considered to be the fact that it potentially provides the patentee with some protection against disclosures which are clearly abusive in relation to the patentee.

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

Negative aspect for the position of the patentee is the fact that the protection against abusive disclosures is so narrow that it is often not applicable for the patentee. The current rule does not protect against disclosure by a third party which obtained the information directly or indirectly from the inventor if this does not constitute an evident abuse. In practice, it may be difficult to prove that a disclosure qualifies as evident abuse related to the applicant.

A further negative aspect is that the grace period may be too short in cases earlier than 6 months before the filing date.

Another negative aspect is that the "grace period" of Article 5 DPA 1995, even though very narrow, may lead to legal uncertainty for parties. Abusive disclosure before the patent filing date may cause parties, not being the patentee or the party responsible for the abusive disclosure, to believe that the disclosed subject matter cannot be protected by the later-filed patent.

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?

Yes, patent filing strategies are influenced both by the availability of a grace period in some foreign countries/regions and by the non-availability in other countries.

If a grace period is available:

Applicants sometimes file patent applications only in countries where there is a grace period available when they have (mostly inadvertently) disclosed their invention before filing the application.

Example: a product has been presented to customers directly or on the Internet. Or a paper has been published or presented at a conference. Some applicants choose to file a PCT application directly as a first filing, in order to be able to rely on a grace period, should an earlier "publication" surface later in the proceedings.

Example: applicants are cooperating in a project and it is unclear what any one of the parties has made public prior to a filing. Or it is clear that some prior use has occurred but it is unclear whether this could be understood as "experimental use" or whether in specific countries this will be considered confidential or not, or when there is doubt about a specific date of publication at the time of filing the application. In all of these cases later there may be discussions about the prior art and whether or not one should rely on a grace period in one, some or all of these countries.

Some applicants may consider filing their application only in countries in which there is no obligation for an Information Disclosure Statement (IDS) and/or a requirement for a declaration in order to rely on a grace period, for example when they are not sure about whether or not they have made prior publications which might be considered as prior art or could be considered as such in other jurisdiction, even if it were not in the relevant country asking for such IDS and/or declaration.

Example: In some jurisdictions "experimental use" may be excluded from the prior art, whereas in others this may not be. In order not to have to litigate about whether or not some experiments could have been considered public, applicants may consider not disclosing such use voluntarily.

If a grace period is not available:

Obviously non availability or very limited availability of a grace period (including The Netherlands and other EPO jurisdictions) has the most impact on applicants' filing strategies, because of the requirement of "file first, publish later". By filing an application prior to publication in any form, anywhere on the world, the applicant does not have to rely on any grace period and is in time also in countries where a prior publication cannot be graced. As discussed before, the non-availability will also sometimes have the impact that only in a limited number of countries an application will be filed, or a PCT application such that later on national/regional phases can be entered which do have a sufficient grace period.

PROPOSALS FOR HARMONIZATION

The Groups are invited to put forward proposals for the adoption of harmonized laws in relation to grace periods for patents. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws.

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, if the right balance is found between the different interests at stake. See further at Q 9-11.

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

Yes, most certainly, even if such would mean no grace period anywhere, this would be better than different laws on grace periods in different countries, because of legal certainty for both applicants and third parties.

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

Please note that our answers at question 10 must be read in the light of our *additional remarks* made below at question 11.

10a) The duration of the grace period

In our view the duration of the grace period should provide for a fair balance between the interests of inventors/applicants and third parties. Obviously a shorter period would provide more legal certainty to third parties, whereas a longer period would provide a more useful safety net to applicants. Especially for publications to be graced which were made inadvertently by the applicant/inventor (for publications made knowingly by the applicant he should be able to file an application quickly and thus a shorter period should be sufficient). A 6-month period would sooner provide third parties with an insight in whether or not a publication is prior art to an application. Moreover the period over which applicants may be treated differently in view of available prior art will be relatively short. At the other hand, the Dutch Group recognizes that if the grace period is too short, inadvertent publications originating from the applicant/inventor early on in product development may not be graced in cases where such development takes more time. In this context it was also considered that when a third party becomes aware of a publication within 18 months from its publication date, he would not be able to find out whether or not a patent application has been filed for the invention disclosed therein. This means that there is “legal uncertainty” for the third party anyhow during said 18 months. See further our remarks at Question 11, fifth consideration, with respect to prior user rights. Balancing the pros and cons, the Dutch Group has not yet been able to decide whether the grace period should be 6 or 12 and therefore has decided to simply use the term [6-12] months.

10b) The date from which the grace period is calculated

In our view a grace period should be counted from the priority date, i.e. from the date of the first filing according to art. 4 Paris Convention (PC).

If the grace period is calculated from the actual filing date instead of the priority date, an applicant who has filed patent applications claiming priority of a first filing at the end of the priority year could lose all of his patent rights, except for a patent granted based on the first filing, due to a publication (even if inadvertently) made prior to the priority date. Even if the later applications are for “the same invention” and thus validly claim priority of the first filing (see further at Question 11, seventh remark).

This becomes especially relevant for applicants who are not aware of the prior publication (inadvertent publications) and therefore have to rely on the grace period, which may come up during a later stage of prosecution or even in opposition or court proceedings, after having incurred high costs. Whereas an applicant who was aware of the prior publication would be able to directly file applications for all relevant jurisdictions, for example by filing a PCT application, and thus still obtain valid patent rights relying on the grace period. This therefore was considered contrary to the idea of the grace period providing for a safety net, especially for applicants who are not very familiar with the patent system and/or are not aware of their prior publication.

By providing for the grace period counted from the priority date at least later filings validly claiming priority from the first filing will benefit from the same “grace” as the priority and therefore all applicants will be treated equally, and the grace period would especially (also) provide for a safety net for applicants not being aware of their prior publications.

10c) The types of intentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

All acts.

10d) The types of unintentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

In our view there should be *no difference* between intentional and unintentional acts. The Dutch Group does not see any need to limit the grace period rule to unintentional publications only. In practice, it may be difficult, if not impossible, to prove whether a publication was "not intentional", e.g. in a case where parties cooperate and the publication is done by one unknown to the other(s).

10e) 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

The Dutch Group considers that in the present time of fast and worldwide digital means of publications, any restriction on this point would make the grace period rule almost a dead letter. We would favor that disclosures by a third party, which obtained the information contained in the disclosure directly or indirectly from the inventor can be graced, even though we realize that this may introduce an uncertainty since then it will be open for debate whether or not the information has been obtained "directly or indirectly" from the inventor. In our view, it would undermine the rationale of the grace period rule if certain third party disclosures would be excluded from the grace period, such as a "republication" or link to a website by a third party, putting a product in a shop window, public use of the relevant product, etc.

10f) 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

None. If the third party has made the publication independently from the applicant(s)/inventor(s), it should form part of the prior art and should not be graced.

10g) The requirement for and content of any statement/declaration by the applicant to invoke the grace period

The Dutch Group would favor a rule which includes a possibility of a *voluntary* statement/declaration. We do not favor a mandatory statement/declaration since we consider that this may harm the effect of a grace period rule in practice. In many cases, the applicant may not have been aware of the disclosure before he filed his invention.

However, in our view, the burden of proof could be higher in cases where the applicant has not voluntarily made a statement/declaration and wishes to invoke the grace period, e.g. by requiring that the applicability of the grace period rule is proved close to absolute conviction, a degree of high certainty which is beyond any reasonable doubt ("up to the hilt").

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

Before providing a proposal for a new grace period rule the Dutch Group would like to make seven introductory remarks.

First, our proposal is based on the assumption that *all major patent countries* will harmonize their patent system by adopting the *same grace period rule*. As stated before, the aspect of harmonization is important and in our view it does not make sense if the Netherlands or some EPO countries only change their system. Preferably, the grace period should also be harmonized with the same provisions for utility models.

Second, with respect to the *experience/policies* behind a grace period rule, the Dutch Group notes that

- a) the application of the existing provisions (Article 55 EPC and Article 5 DPA 1995) in practice is rare;
- b) historically, European countries which have had a grace period rule before harmonizing their patent system in accordance with Art. 4(4) Strasbourg Convention, seem to have had no negative experiences with such a rule;
- c) in practice, inventions made by public research institutions, such as universities, SMEs and independent inventors, can sometimes not be patented in Europe due to the very limited scope of the existing provisions, while such inventions can be patented in countries which are more generous with respect to grace periods, which leads to patents – and related businesses – for European entities outside of Europe;
- d) in practice, some products, such as agricultural machines, may need testing at places, which may be publicly accessible, before the filing of the technology as a patent;
- d) a more generous grace period may facilitate early publication of academic research results and promote sharing of knowledge and improvements in technologies more than a patent system without grace period, and
- e) a more generous grace period may result in less applications filed for incomplete inventions.

Third, in view of the Dutch Group, it is important to understand the *legal effect* of the proposed grace period rule. The grace period is a specified period of time preceding the filing of a patent application, during which a disclosure of the invention for which the patent application is filed by the inventor or his successor in title does not constitute prior art in respect of the patent application. This so-called "non-prejudicial" disclosure does *not establish any priority date*. The proposed grace period rule does not provide for any immunity for the inventor/applicant against *independent disclosures*, such as patent applications of third parties, which are disclosed in the interval period, i.e. the period between the date of disclosure and any later filing date. Such interval publications do form part of the state of the art for the party which has invoked the grace period rule. Therefore, in the Dutch Group's view, the proposed grace period rule does not negatively affect the principle that one must file first. It is important to understand the proposed grace period rule as a rule which protects the inventor *against own disclosures* and disclosures by third parties, who *obtained* the disclosed information directly or indirectly *from the inventor, only*.

Fourth, the Dutch Group notes that Article 55 EPC only refers to Article 54 EPC, which deals with novelty, which may raise the question whether any graced publication may still be prior art for inventive step (Article 56 EPC). In our view it should be made clear that the grace period is relevant for all criteria of patentability. Prior publications are very often not "complete" and might show, for example, only some embodiment or part thereof of the later claimed invention, or not disclose each and every aspect thereof. Should the grace period only have effect with respect to novelty, it would seriously limit the possibilities to make use of this "safety net" due to a finding of lack of inventive step.

Fifth, while the Working Guidelines indicated that *prior user rights* are outside the scope of Q233, the Dutch Group would nevertheless point out that the grace period rule is proposed *on the condition that a prior use right is recognized*: a third party, which has used a disclosed invention in good faith for the purpose of his business (or has started effective and serious preparations for such use), shall have the right to continue his use of this invention if it is subsequently patented under the grace period rule. Good faith means that the third party did not know or should not have known that disclosed invention would be graced. Since this condition is considered essential, the Dutch Group has added paragraph (3) into its proposal for a new grace period rule.

Sixth, the *onus of proof* relating to facts which would support the application of the grace period rule must be on the side of the inventor/applicant which invokes this rule.

Seventh, if a new grace period rule will be introduced, it is important to also provide for a transitory rule. The Dutch Group would favor an ex-nunc introduction of the new grace period rule: only applications filed after the date that the new grace period rule comes into force, shall be eligible to the grace period. The new rule should *not* be applicable to pending applications (and granted patents).

Taking into account the aforementioned points, the Dutch Group proposes the following grace period rule:

Art. 55 EPC. Non-prejudicial disclosures

- (1) For the application of Article 54 and Article 56, a disclosure shall not be taken into consideration if it was disclosed no earlier than [six or twelve] months preceding the date of filing of the European patent application or, if priority has been validly claimed, from the date of priority, and if it was disclosed:
 - (a) by the inventor, applicant or his legal predecessor
 - (b) by a patent office and the disclosure was contained:
 - (i) in another application filed by the inventor, applicant, or his legal predecessor and should not have been made available to the public by the patent office, or
 - (ii) in an application filed without the knowledge and consent of the inventor, applicant or his legal predecessor by a third party which obtained the information contained in the disclosure directly or indirectly from the applicant or his legal predecessor, or
 - (c) by a third party which obtained the information contained in the disclosure directly or indirectly from the inventor, applicant or his legal predecessor.
- (2) The effects of paragraph (1) may be invoked at any time.
- (3) Any person who, prior to the date of filing of the European patent application, or, if priority has been validly claimed, prior to the date of priority, has in good faith used or made effective and serious preparations for using the information contained in the disclosure mentioned in paragraph 1 may without payment continue such use in the course of his business or for the needs thereof, in spite of the issuance of any European patent based on such application.

Note: this proposal is inspired by the wording of Article 9 SPLT (SCP/10/2 dated September 30, 2003) and Article 55 EPC.