

NON-PREJUDICIAL DISCLOSURES: IN SEARCH OF A HARMONIZED APPROACH*

RICARDO ANDRÉS LÓPEZ SUÁREZ**

ABSTRACT

The purpose of this paper is to study the condition of novelty through the analysis of the current situation of non-prejudicial disclosure provisions in several legislations, namely the America Invents Act, the European Patent Convention, and the Andean Decision 486 of 2000 of the Andean Community. Novelty is one of the pillars for validity of patents. An invention must be new to be protected under patent law. The prior art to the date of patent filing is commonly the framework for novelty examination. However, non-prejudicial disclosure provisions can prevent damaging the novelty of an invention by elements that would have done so otherwise. The development of these provisions is heterogeneous and there are notable gaps among them. Harmonization in this respect will be helpful for applicants and their predecessors in title to assure the protection of their invention at an international level.

Keywords: Patents, novelty, non-prejudicial disclosures, grace period, priority right, intellectual property law, comparative law.

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** Abogado de la Universidad Pontificia Bolivariana, Bucaramanga, Colombia. Especialista en Derecho Internacional de la Universidad Panteón-Assas, París, Francia. Graduado de la Maestría en Derecho de la Propiedad Intelectual y Valorización de Intangibles del Centro de Estudios Internacionales de la Propiedad Intelectual, Estrasburgo, Francia. Bogotá D. C. (Colombia). Correo electrónico: ra.lopezsuarez@gmail.com Fecha de recepción: 21 de agosto del 2018. Fecha de aceptación: 17 de octubre del 2017. Para citar el artículo: LÓPEZ SUÁREZ R. A. "Non-Prejudicial Disclosures: In Search of a Harmonized Approach", *Revista La Propiedad Inmaterial* n.º 26, Universidad Externado de Colombia, julio-diciembre 2018, pp. 47-73. DOI: <https://doi.org/10.18601/16571959.n26.03>

DIVULGACIONES NO PERJUDICIALES: EN BÚSQUEDA DE LA ARMONIZACIÓN

RESUMEN

El presente artículo es un estudio sobre la novedad a través del análisis de la situación actual de la regulación de las divulgaciones no perjudiciales en diferentes legislaciones, principalmente el Convenio de la Patente Europea, la Decisión Andina 486 de 2000 de la Comunidad Andina y la Ley America Inventa. La novedad es uno de los pilares de validez de una patente. Una invención debe ser nueva para que pueda ser protegida a luz del derecho de patentes. El estado de la técnica utilizado para su estudio generalmente abarca las publicaciones anteriores a la fecha de presentación de la solicitud de patente. Sin embargo, varias legislaciones incluyen normas sobre divulgaciones no perjudiciales, las cuales previenen que una invención pierda su novedad a causa de una divulgación que lo hubiera hecho en otro escenario. Las diferencias de esta figura en cada jurisdicción pueden ser considerables. Una armonización al respecto sería favorable para los solicitantes de patentes, y sus antecesores en derecho, en miras a una protección internacional.

Palabras clave: patentes, novedad, divulgaciones no perjudiciales, periodo de gracia, derecho de prioridad, propiedad intelectual, derecho comparado.

INTRODUCTION

We, humans, are neither the quickest nor the strongest of living beings. Yet we have conquered a good portion of our planet. Science and technology have played a key role in our success, furthering our understanding of the universe and providing us with solutions for both new and old problems.

Intellectual Property (hereinafter IP) law has taken part in building this intricate path of evolution. These regulations were born to promote and protect innovation and creativity. They are present in most jurisdictions all around the world, in some degree or another.

In search of an international coordination, the Paris Convention for the Protection of Industrial Property (hereinafter the Paris Convention), signed in Paris, France, on March 20, 1883, established the minimums of harmonization for industrial property rights, including patents. Other international instruments have followed, such as the Patent Cooperation Treaty (hereinafter the PCT), signed in Washington, United States of America (hereinafter U.S.) on June 19, 1970 and the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter the TRIPS Agreement) signed in Marrakech, Morocco, on April 15, 1994. However, there is no unified law.

The development of IP law is independent to each jurisdiction. Moreover, industrial property rights, such as patents, are bound to the territorial principle

established in article 6 of the Paris Convention. In consequence, applying patents in several jurisdictions is not a simple checklist, but rather a strategic game where applicants need to consider the particularities of each legislation.

This paper explores the divergences in non-prejudicial disclosure provisions around the world, namely in connection to the European Patent Convention (hereinafter EPC), signed in Munich, Germany, on October 5, 1973, and revised in November 29, 2000; the Andean Decision 486 of 2000 (hereinafter Andean Decision 486), enacted in Lima, Peru, on September 14, 2000, of the Andean Community (an economic union comprising Bolivia, Colombia, Ecuador and Peru); and the Title 35 of the U.S. Code (hereinafter Title 35 U.S.C.) amended by the American Invents Act, signed on September 16, 2011.

First, it briefly introduces the core concept of novelty, one of the conditions for patent validity, and its importance in patent systems. It will develop on the nature of non-prejudicial disclosures together with a classification into two separate groups: the priority right and the grace period. The latter will be studied through a three-part classification depending of the origin of the disclosure: the inventor or his assignee, a third party, or an Office of Examination. Afterwards, it reviews the impact of each group of non-prejudicial disclosures in the patent system: the priority right as the natural evolution of the first-to-file principle for international protection, and the advantages and challenges of the grace period.

As a result, this exploration highlights the need for greater harmonization in non-prejudicial disclosures. This conclusion is achieved considering that patent applications are independent for each jurisdiction, a user of the patent system may encounter unexpected challenges when applying in different countries.

Thus, the third part of this paper will discuss the options for the harmonization of non-prejudicial disclosures. While the development of the priority right shows a satisfactory level of international coordination, grace period provisions must evolve to provide inventors with a more accommodating environment for international patents.

I. NATURE AND CLASSIFICATION OF NON-PREJUDICIAL DISCLOSURES

Novelty is one of the required conditions for the validity of a patent. An invention is commonly considered new when it is not part of the state-of-the-art. The exact scope of the “state-of-the-art” may differ among legislations but definitions are closely related. For instance, the EPC, the Title 35 U.S.C. and the Andean Decision 486 share two elements: disclosures that were available prior to the filing date, and patent applications of the Office of Examination previously filed but that may not have been published yet.

It is important to highlight that the state-of-the-art review of novelty may include disclosures from foreign territories, even if patent rights are limited to a single jurisdiction. On this respect, W. Cornish and D. Llewelyn expressed that:

No system grants valid patents for inventions that are already known: that would be to encumber industry with constraints upon the use of information without any sufficient return. Accordingly, the present law requires a patented invention to be new in the sense of forming no part of the state-of-the-art, that is it must not be found at the priority date in any 'matter (whether a product, a process, information about either, or anything else) which has at any time been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use, or in any other way.¹

This level of requirement also plays an important role in assuring the protection of a patent, reducing the risk that someone may steal an invention from another jurisdiction. However, neither the TRIPS Agreement nor the Paris Convention establish novelty as an absolute and universal condition.

On the role of novelty in the patent system, E. Rengifo and L. Díaz state: “[novelty] is an essential requirement for the recognition of the invention per se; it would not be possible to speak of invention if it is not new and it is not if the object of the potential exclusive rights is anticipated by the state-of-the-art”².

Novelty is essential because “[it] make[s] certain that a patent is being given in relation to technical information that is not otherwise accessible to the public”³. Moreover, it ensures “that patents are not used to prevent people doing what they did before that patent was granted”⁴. Likewise, it helps balance the exclusivity right sought through a patent application. One of the foundations of the patent system is the retribution of new knowledge. Patents are public, allowing people to know their content and, thus, their contribution to science and technology. In this sense, patents contribute to society in exchange for a temporary economic advantage⁵.

While there is no remedy for the loss of novelty⁶, several legislations include what is called non-prejudicial disclosure provisions, which allow the exclusion of certain elements from the state-of-the-art. To study these provisions, this paper will divide them into two groups: the priority right established by the Paris Convention (A), and the grace period (B).

1 CORNISH, WILLIAM and DAVID LLEWELYN. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (London: Sweet & Maxwell, 2003), 174-175.

2 “[la novedad] constituye un requisito esencial para el reconocimiento de la invención per se; no podría hablarse de invención si esta no es novedosa y no lo es si aquello sobre lo cual se pretenden derechos de exclusiva está anticipado por el estado del arte”. RENGIFO, ERNESTO. *Derecho de patentes* (Bogotá: Universidad Externado de Colombia, 2016). DÍAZ, LINA and ERNESTO RENGIFO. *Novedad*. p. 139. (Translated by the author).

3 APLIN, TANYA and JENNIFER DAVIS. *Intellectual Property Law* (Oxford: Oxford University Press, 2017), 722.

4 *Ibíd.*

5 CABANELLAS DE LAS CUEVAS, GUILLERMO. *Derecho de patentes de invención* (Buenos Aires: Heliasta, 2004), 699; Vivant, Michel. *Droit et Économie de la Propriété Intellectuelle* (Paris: L.G.D.J., 2005). Sueur, Thierry and Jacques Combeau. “Un monument en péril: le système des brevets en Europe”, pp. 99-100.

6 CABANELLAS DE LAS CUEVAS, GUILLERMO, Op. cit., pp. 700-701.

A. THE PRIORITY RIGHT: TRAVELLING BACK IN TIME

Upon fulfilling the requirements of a specific patent legislation, an application will receive a filing date. This is the first element to take into consideration while examining the novelty of a patent application. It is from this date that the prior art will be determined. Everything that was available before it will be included in the state-of-the-art and hence, will potentially jeopardize the novelty of the patent. This condition also applies to previous patent applications from the same applicant in foreign jurisdictions. In this panorama, it may seem difficult for users of the patent system to seek international protection for an invention.

One solution came with the Paris Convention, which established the priority right. It gave applicants the ability to benefit from the filing date of the first application for one single invention, even when made in another country, and for a period limited to twelve months. Consequently, the prior art will be established not from the filing date of the application but from the date of the first filing (the priority application filing date). A “back in time” effect that prevents any damages from previous applications of the same applicant. It also protects the novelty from third parties’ disclosures that may have been available after the priority date but before the filing date. Thus, reducing the risk at the moment of filing.

It is important to note that the priority right is independent from the outcome of the priority application. Indeed, on the grounds of territorial principle of the Paris Convention, each jurisdiction will be competent to examine the patent application according to its own legislation. An Office of Examination is autonomous, and it can disregard other Offices decisions.

B. THE GRACE PERIOD: SEVERAL SOLUTIONS TOWARDS ONE AIM

The grace period can be defined as “the length of time after disclosure of an invention in which the inventor may still file a patent application and not terminate the inventor’s right to a patent”⁷. Some authors may refer to as priority⁸. However, even if related, they are not part of the same institution. Therefore, this paper will refer to this principle as the grace period.

Almost all jurisdictions have established some sort of grace period, but differences are many, and the gap between them can be significant. This is the case for principal jurisdictions, such as the U.S. (large grace period) and the EPC (narrower grace period). This situation can constitute an obstacle for harmonization⁹.

7 METZLER, RENEE. Not all grace periods are created equal: Building grace period from the ground up. *Marquette Intellectual Property Law Review* 13, n.º 2 (2009): 372.

8 MERGES, ROBERT. Priority and novelty under the AIA. *Berkeley Technology Law Journal* 27, n.º 2 (2012): 1023-1046.

9 METZLER, RENEE, Op. cit., pp. 372-373.

The nature and description of grace periods vary. Shared elements nonetheless can be identified. E.g., R. Metzler highlights four:

When drafting a grace period or exception to novelty provision, a legislature or drafting body usually addresses four elements: (1) the type or form of disclosures the grace period will protect; (2) the range of medium in which the disclosures may be made; (3) the party that can make the disclosures; and (4) the time in which the disclosures may occur (which I will refer to as the temporal element). How these elements are defined and restricted will determine the level of protection afforded by the grace period.¹⁰

From these four elements, different grace periods can be described and analyzed. They encompass the scope of a grace period and the conditions claimed by an applicant. The author describes them as follows:

Element One: Type of Disclosures Protected [...]. A grace period may protect disclosure of an invention in the form of an oral or written statement, displaying of the invention, public use of the invention, offering of the invention for sale, or any combination thereof. [...]

[...]

Element Two: Range of Medium. The second element of a grace period is the range of medium in which a disclosure may be made. The range of medium may be definite or indefinite. A grace period having an indefinite range of medium is one that does not restrict the locale of the disclosure, that is, whether the invention enters the state-of-the-art is independent of where the disclosure was made. By contrast, a grace period with a definite range of medium is one that explicitly limits the venues at which applicable disclosures may be made; if the disclosure is not made at an approved venue, it will not be covered by the grace period and the disclosure may be used as prior art against the applicant.

Element Three: Who Can Disclose [...]. A grace period may protect disclosures made only by the applicant or it may protect disclosures made by an individual(s) other than the applicant, for example, an individual who received the information directly or indirectly from the applicant. A grace period may also protect a disclosure made under circumstances of evident abuse, that is, without the consent of the applicant.

Element Four: Temporal Limit. The fourth element of a grace period designates the length of time prior to the filing date in which the inventor may disclose his or her invention without destroying novelty [...].¹¹

¹⁰ *Ibid.*, p. 382.

¹¹ *Ibid.*, pp. 382-384.

Thus, a provision that stipulates a grace period will include, first, the type of disclosure concerned, either specific or broad. Second, the provision will seek to answer the question of how disclosure is made and under what circumstances. Grace periods may either be restrictive or inclusive towards their medium. Later, the rule will identify the party that made the disclosure, which could be the inventor or another party. The final element is the time limit. A provision will establish a period as a perimeter for its application, which is the proper grace period and is commonly limited from 6 to 12 months (or a year)¹².

However, a grace period provision may include a fifth element: formality requirements. This kind of provisions may demand, e.g., a statement or other kind of declaration from the applicant in a specific moment of the procedure. That is the case in Japan, where legislation demands the applicant to file a statement at the moment of filing, and evidence within the 30 days of the filing date, in case of disclosures conducted by the person having the right to obtain a patent¹³.

Given the fact that several grace period provisions are derived from acts by the inventor, one may believe that the applicant, especially if he is the inventor, could be able to provide such statement with enough accuracy. However, formal requirements could eventually create an unnecessary charge for the applicant. For instance, to claim a grace period exception, evidence must be provided to determine whether the disclosure complies with all requirements.

In this respect, K. Heimbach has stated that: “Contrary to the present situation in Japan, the grace period should not be dependent on a statement made by the applicant at the time of filing the patent application since, most of the time, applicants were not aware that an act qualifying as prior disclosure has taken place”¹⁴.

This paper will study the five elements of grace periods while classifying the provision in three groups, starting with the acts committed by the inventor or his assignee (1), then, the circumstances derived from third parties (2) and finally, cases in respect to Offices of Examination (3).

1. Situations derived from the inventor or his assignee

One of the principal objectives of grace period is to protect the inventor from his own acts, as they are not always aware of patent regulations. They may disclose some information with a legitimate purpose, like academic activities or funding search. They may even disclose information without knowing that they have a latent patent right with them.

¹² World Intellectual Property Organization. “Grace period”, 2017. Report on the International Patent System: Certain Aspects of National/Regional Patent Laws, 2015, Retrieved on July 16, 2018 from <http://www.wipo.int>.

¹³ *Ibid.*

¹⁴ HEIMBACH, K. Protection of Biotechnological Inventions: Grace Period and Shift of Burden of Proof. *Symposium on the Protection of Biotechnological Inventions* (1987), 143.

Two hypotheses are included in this group. First, the disclosures made in the frame of exhibitions (1.1). A second group will cover a similar kind of provisions but derived from more varied circumstances (1.2).

1.1 Disclosures made in the frame of exhibitions

A disclosure may occur anywhere. Article 11 of the Paris Convention introduced a temporary protection for inventions exhibited in International Exhibitions. It states:

Article 11

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

The first relevant aspect in this provision is that it only defines the type of disclosure and the range of medium, this is only two of the five elements. Indeed, this provision indicates that the disclosure will take the form of a good exhibited and it mandates that such exhibition may occur in a specific kind of exhibition.

Nonetheless, the article did not provide an answer regarding who the discloser could be and the length of the period of grace. Yet, it states that formal requirements could be demanded. Thus, most of the elements concerning this protection would be determined by the national legislation of the state members, even the type of protection to be provided. Another point to highlight in this provision is paragraph 2, which indicates that such temporary protection may not extend the priority right period.

Even without all the elements defined, this is without a doubt a very narrow grace period. In fact, one of the principal restrictions came from the range of medium element, the condition that the disclosure must take place in an official or officially recognized international exhibitions. These are in fact specific events, which are overseen by the Bureau International des Expositions (hereinafter BIE). The BIE is an intergovernmental organization created by the Convention Relating to International Exhibitions, signed in Paris, France, on November 22, 1928. It was created to manage the calendar, the bidding, the selection, and – in general

– the organization of World Expositions. It is also in charge of establishing the regulatory framework for these events.

The EPC developed this hypothesis in its article 55:

Article 55 Non-prejudicial disclosures

For the application of Article 54, 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:

[...]

(b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, 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 time limit and under the conditions laid down in the Implementing Regulations.

This is the only grace period in connection to disclosures made by the inventor or his assignee included in the EPC. The provision is even more limited, taking into account that the discloser is designated, it needs to be the applicant or his predecessor in title. The period time is only six months and there is also a formality that is required at the time of filing.

1.2 Disclosures made by the applicant or his predecessor in title

Contrary to the approach of the EPC, other jurisdictions have opted for a broader grace period regarding the disclosures made by the applicant or his predecessor in title. The U.S. and the Andean Community are good examples of broad grace period provisions in this category. The Title 35 U.S.C. states as follows:

Title 35 U.S.C. 102 Conditions for patentability; novelty.

[...]

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION. --A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

[...].

One noteworthy characteristic of the US provision is the broadness of the first element. All types of disclosures are included and the range of medium is not limited. The limitation is provided in connection to the third element, the discloser. In this provision, the discloser could be the inventor, but also “another”. It is important that such another, however, had gained access to the information somehow from the inventor, e.g., an assignee. Then, the grace period is one year, from the date of filing or claimed priority, which is twice the length of the EPC provision. Moreover, no formalities are required.

On the other hand, Andean Decision 486 reads as follows:

Article 17. For the purposes of determining patentability, no account shall be taken of any disclosure that occurs during the year prior to the filing date of the application in the member country, or during the year before the priority date if priority has been claimed, provided that such disclosure is attributable to:

(a) the inventor or his successor in title.¹⁵

As it can be appreciated, the construction of the provision differs from the one of the US. The model of the Andean Community centers around the third element: the discloser.

Here, the type and the range of medium are not restricted. Nevertheless, the discloser is clearly identified and limited to two cases, the inventor or his successor in title, i.e., an assignee. Thus, more restricted than the US provision which includes the word “another”.

Andean Community legislation also states a period of grace of one year, from the date of filing or claimed priority, and no formalities are required. This kind of provision grants an opportunity for inventors for overcoming their own mistakes or allows them to conduct some activities before filing, which may otherwise jeopardize the patent application. Besides, some inventors may need to disclose information. Such is the case, e.g., for inventors in academic environments.

¹⁵ Translated by the author.

In such context, researchers will aim to discuss their discoveries with colleagues, sometimes in private, but eventually in public, e.g., in conferences or symposiums. Furthermore, some researchers are even compelled to publish the fruits of their scientific effort. In fact, we cannot deny that these public displays are the main strategy for a scholar to obtain funding or even a promotion¹⁶. Hence, this type of provision constitutes an advantage for the development of research and academics.

2. Situations derived from a third party

Third parties could eventually be in contact, directly or indirectly, with inventions, even with the most precautionary measures. Therefore, it is necessary to protect the applicants from disclosures originating from third parties. In fact, third parties could get access to information from several paths and in this regard, it is possible to classify this kind of grace period in two groups, the first one in connection to an abusive access (2.1) and a second when the access came from the inventor or the assignee, without further considerations (2.2).

2.1 Disclosures made by a third party who had access to the information abusively

The EPC is a clear example of this kind of provisions. Article 55 of the EPC states:

Article 55 Non-prejudicial disclosures

For the application of Article 54, 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 an evident abuse in relation to the applicant or his legal predecessor.

Contrary to the previous provision of grace period in connection to international exhibitions, this second hypothesis has a broader first element: It includes all kind of disclosures.

The range of medium is however limited. It states that such disclosure must fall in a case of “evident abuse”. This abuse must also be connected to specific parties, in this case, the applicant or his predecessor in title. This is a subjective element related to the state of mind of an individual¹⁷ that could be difficult to prove in a procedure.

In contrast, the third element is flexible. The provision does not stipulate precisely from whom the disclosure can originate. For an evident abuse to occur, a

¹⁶ TESSENHORN, JOHN and YAMAMOTO, SHUSAKU. Japan's Novelty Grace Period Solves the Dilemma of “Publish and Perish”. *Nature Biotechnology* 25, n.º 1 (2007): 55.

¹⁷ METZLER, RENEE, Op. cit., pp. 397-398.

direct or indirect relationship between the applicant or his predecessor in title and the discloser must exist. Then, the duration of the grace period is only six months. This short period becomes harder to follow given the fact that the disclosure is made by a third party, an action that could be outside the sphere of influence or vigilance of the applicant.

Thus, the applicant should pay close attention to third party disclosures as to not overlook the six-month grace period. No specific formalities are requested. However, the applicant shoulders a great burden of proof, as the second elements must nonetheless be demonstrated.

2.2. Disclosures made by a third party who had access to the information through the inventor or his assignee

In an analogue way to the previous group of provisions, other legislations have opted for a broader scope in case of third parties' disclosures. In the U.S. jurisdiction, the Title 35 U.S.C. indicates:

Title 35 u.s.c. 102 Conditions for patentability; novelty.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Once again, the approach in the US system give us a broad first element, as all kinds of disclosures are included.

In respect to the range of medium, the exception states that prior to the disclosure, a previous publication of the inventor or “another” must have occurred. In fact, the construction of the rule makes it clear that if an inventor does not publicly disclose before a third-party disclosure occurs, there would not be grace period for the inventor¹⁸. But, a degree of flexibility comes to play an important role in this hypothesis thanks to the inclusion of the word “another” in connection to the previous publication necessary to claim this grace period. This “another”

¹⁸ MERGES, ROBERT, *Op. cit.*, p. 1031.

could be, e.g., the assignee of the inventor or any other party that obtained the information of the invention somehow from the inventor himself.

In connection to the discloser – the third element – nothing is restricted. Moreover, the period of grace remains one year, and no formalities are required.

There is some contrast in the Andean Decision 486 as it indicates:

Article 17. For the purposes of determining patentability, no account shall be taken of any disclosure that occurs during the year prior to the filing date of the application in the member country, or during the year before the priority date if priority has been claimed, provided that such disclosure is attributable to:

[...]

(c) third party who has obtained the information directly or indirectly from the inventor or his successor in title.

As previously observed, the first and second elements are broader in the Andean Community legislation, the emphasis is made on the third element: the qualification of the discloser. In this provision, the discloser could be a third party, but not any third party. It is required for this person to obtain the information somehow from the inventor or his successor in title.

The Andean Decision 486 continues the same characteristics of the fourth and fifth element: a period of grace of one year before the date of filing or claimed priority, and no formalities are requested.

3. Situations derived from an Office of Examination

Publications from Offices of Examination may also endanger novelty. However, some legislations have included an additional period of grace for this kind of situations. In the U.S. jurisdiction, a complex provision was put in place. It reads:

Title 35 U.S.C. 102 Conditions for patentability; novelty.

(b) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

R. Merges explains it as follows:

Section § 102(b)(2) parallels the general structure of § 102(b)(1), but for the special case of disclosures in patents and applications. Section 102(b)(2) sets out a grace period in three situations: (1) when an applicant or patent owner is faced with an earlier-filed patent that was derived from that applicant-i.e., with a disclosure that originated with the inventor him or herself; (2) when an applicant is faced with a prior-filed patent, but that applicant had made a public disclosure of the material before the filing of the prior-filed patent; and (3) when an applicant is faced with a prior-filed patent that is owned by the same owner who owns the applicant's invention.¹⁹

The first relevant aspect of this stipulation is the description of the time element. There is an undefined length for the period of grace for the first case. In the second and third cases, the limit is the filing date or claimed priority of the disclosure in one case (Title 35 U.S.C. Section § 102(b)(2)(b)) and the filing date or claimed priority of the application of the claimed invention (Title 35 U.S.C. Section § 102(b)(1)(c)). The type of disclosures is limited to patents and applications. Consequently, the discloser will always be an Office of Examination.

The range of medium is special. First case indicates that the matter of the disclosure should be obtained somehow from the inventor. It could be considered an extension of provision Title 35 U.S.C. Section § 102(b)(1)(a), in connection to the disclosure made by "another" but with the absence of the element time, yet limited to a patent or an application.

The second hypothesis follows a similar path as it is an extension of provision Title 35 U.S.C. Section § 102(b)(1)(b). It will clearly prevent a conflict between disclosures of previous applications and the ones from the application of the claimed invention.

A third hypothesis prevents the conflict between applications from the same applicant or holder, according to the specific case. It also encompasses the issue of an assignment yet to be recorded, when it states that items in conflict could be "subject to an obligation of assignment to the same person". In any case, there are no formal requirements for any of the three hypotheses.

In the Andean Community, Andean Decision 486 establishes the following:

¹⁹ MERGES, ROBERT, Op. cit, p. 1033.

Article 17. For the purposes of determining patentability, no account shall be taken of any disclosure that occurs during the year prior to the filing date of the application in the member country, or during the year before the priority date if priority has been claimed, provided that such disclosure is attributable to:

[...]

(b) the competent national office which, in violation of the provisions applicable, publishes the contents of the patent application filed by the inventor or his successor in title. Cita

In contrast with Title 35 U.S.C., Andean Decision 486 incorporates a time element of one year before the filing date or claimed priority. The discloser is limited to an Office of Examination, as all other hypotheses in this category.

The range of medium is very specific, too. The disclosure must be the result of an error of an Office of Examination. The goal of this provision is clear, it protects applicants from formal errors in connection to procedures that are out of their control. Finally, the rule is still the absence of formal requirements in this jurisdiction.

This exposition of the different kind of grace period provisions shows the variety in the development of this institution. The five elements have been developed to a different extend, even in the case of provision derived from similar acts. But, how do non-prejudicial disclosures impact the patent system and why are they important? This question will be approached in the next chapter.

II. IMPACT OF NON-PREJUDICIAL DISCLOSURES IN THE PATENT SYSTEM

The approach of novelty as an absolute and universal condition is a remarkable tool for balancing the economic advantages in the patent system and preventing conflicts at international levels. However, complications can arise in dynamic societies such as ours, where information flows quicker than ever and innovation is constant. For some authors, such as M. Meller for example, absolute and universal novelty is a big obstacle for inventors. He strongly criticizes the EPC concept of novelty and urges to look for a more-inventor-friendly approach. He argues that grace periods are not enough to achieve this goal²⁰.

In this respect, it is relevant to point out that systems do not merely constitute a group of stipulations. On the contrary, they are meant to be built as a correlation of rights and obligations, limitations and permissions, rules and exceptions. In this context, it can be said that the rule of novelty as an absolute and universal condition could be bent through exceptions to prevent abuse of the rule and to

²⁰ MELLER, M. Principles of patentability and some other basics for global patent system. *Journal of the Patent and Trademark Office Society* 83, n.º 5 (2001): 364.

bring dynamics to it, never to destroy it. Those exceptions could take the form of non-prejudicial disclosure provisions.

Indeed, grace period and priority right are keys for inventors in their strategy to protect and profit as much as possible from their inventions. Through these institutions, inventors and assignees, and other successors in title, may find better ways to make the most of an invention. A balance between the concepts of absolute and universal novelty and protection of inventors can be achieved in this way. How these two institutions impact the patent system will be studied in the next paragraphs, starting with the priority right (A) to arrive then to the grace period (B).

A. THE PRIORITY RIGHT: A WAY FOR INTERNATIONAL PROTECTION

The priority right is essential for applicants willing to seek international protection. Its scope of application is larger than the PCT system. In this sense, it is a crucial element to consider for applicants interested in a jurisdiction where PCT is not available. However, it also serves applicants who are looking for protection in a small number of jurisdictions. In those cases, it could happen that the costs to consider may be lower than in the PCT system. Besides, the priority right also allows an applicant to enter the PCT system later, claiming priority of a previous national application.

A combination of these two strategies allows for a level of flexibility needed in some industries, especially where there is not a clear view of the economic potential of an invention. Thus, the priority right is crucial in the patent system and has become one of the most important institutions. J. Straus has mentioned that:

For nationals of the countries of the Union for the Protection of Industrial Property and for persons enjoying same status for long the national treatment under Articles 2 and 3 and the Union priority right under Article 4 of the [Paris Convention] have been the key principles securing the functioning of patent protection at an international level.²¹

Moreover, the priority right seems the natural evolution of the first-to-file principle at the international level. Indeed, first-to-file patent systems relays in the filing date to examine patent applications and to solve a conflict between application and patents. It is natural that such system developed the priority right to take the essential filing date beyond borders.

In this respect, O. Cairo has expressed that:

There is no need of saying that there may exist concurrent inventors, who have made, at different times, the same invention and who may come into conflict with respect to

21 STRAUS, JOSEPH. Priority right, 35 U.S.C. 102(d) bar and the trips obligations of the USA: last chance to analyze the issue. *Journal of the Patent and Trademark Office Society* 91, n.º 6 (2009): 378.

patent claims. The laws, take into account the possibility of said conflicts and provide that, if the legal novelty exists, the first applicant should be considered as first inventor or author of the invention. We are thus confronted with a question of legal presumption which, is not necessarily in accordance with real facts. Said question is settled by the laws, except in the United States where it remains open to interferences. It may now be stated that in the European patent laws, some provisions settle a question of priority right, by way of legal presumption, that is to say, a question of preference with respect to patent rights, between concurrent inventors, independently of priority of conception. The above statement gives implicitly a definition of “priority right” as affirmed in Art. 4 of the Convention in favour of the first applicant in one of the union countries.²²

In short, the priority right is a development of the presumption established in the first-to-file systems. It creates an essential opportunity to expand the effects of the filing date but also to balance the need of a filing date together with a condition of absolute and universal novelty for obtaining a patent in several jurisdictions. In this way, a previous application on behalf of the same applicant or predecessor in title will jeopardize further applications.

B. THE GRACE PERIOD: A SAFETY NET TO SAVE AN APPLICATION

Grace period provisions are not mean to denaturalize a first-to-file system. On the contrary, it creates a necessary dynamic inside the absolute and universal novelty condition to be more inventor-friendly and in consequence, to promote innovation, which is the final goal of patents. For these reasons, their advantages are numerous: from allowing inventors to share their knowledge without fear to helping them fix their mistakes in patent management, grace period forms a group of hypotheses that help the patent system in keeping pace with human development. However, it must be admitted that grace period is not an almighty panacea. Like other legal institutions, it cannot rest and needs to evolve to face challenges. These two aspects, advantages (1) and challenges (2) will be studied in the following paragraphs.

1. *Advantages of grace period*

Grace period provisions aim to protect inventors. It encourages both innovation and dissemination of information²³. It allows the inventor, e.g., to disclose information to evaluate the economic potential of his invention. Furthermore, it helps prevent an avalanche of patent applications without sense and planning. In this regard, M. Shinall says:

²² CAIRO, ORESTE. Priority right and legal novelty rights of third parties. *Journal of the Patent Office Society* 14, n.º 5 (1932): 392.

²³ SHINALL, MICHAEL. Priority and disclosure: Challenges and protections to small inventors in first-to-file world. *Journal of the Patent and Trademark Office Society* 94, n.º 4 (2012): 364

Further, the ease with which inventors gain preliminary patent protection may prevent a large influx of patent applications in the patent office. The priority grant triggered by a disclosure of the invention provides inventors with a simple, cheap, and quick method to gain preliminary protection against third parties. Under the AIA, inventors will have one year to decide whether they wish to pursue a patent after they publish their work. If the inventor finds her invention lacks commercial potential, she will not waste her time filing a patent.²⁴

Thus, a grace period could work as a preventive protection. In this sense, one of the possible outcomes could be a patent application, which would be the realization of the grace period, proving once again its role as a builder rather than a destroyer in the patent system. The idea is to rethink disclosures not as destroyers of novelty, but “as a marker to establish an inventor’s patent rights”²⁵. Hence, “disclosure will thus incentivize inventors to engage in open and public discussions regarding their inventions”²⁶.

It is common that inventors may disclose their invention partially or in full due to ignorance or mistake. Sometimes without even realizing the implication for a potential industrial exploitation. Patent law must address this situation and consider that “patent law was not aimed at penalizing inventors but, on the contrary, to protect them against the pitfall”²⁷. In fact, the opportunity to disclose information before filing is also beneficial and almost needed in some context where inventors are pushed to make publications²⁸. That is the case in some scholarly contexts.

On this respect, the thoughts of R. Metzler allow to illustrate clearly this situation:

[...] the success of a professor in a research-based field seems to stem from the professor’s ability to publish, as publications lead to grants, grants sustain additional research, and more research leads to further publications, all guiding the professor down the path to tenure. Due to the pressure of publishing and the likelihood that the professor is unfamiliar with patent law, a publication may forfeit the right to a patent. Therefore, it is important for a grace period to protect printed publications and written disclosures of all forms.²⁹

24 *Ibid.*, p. 382.

25 SHINALL, MICHAEL, *Op. cit.*, p. 383.

26 CARRIER, MICHAEL. Unraveling the Patent-Antitrust Paradox. *University of Pennsylvania Law Review* 150, n.º 3 (2002): 823-824.

27 MATHÉLY, P. Affording a Period of Grace for Disclosure of an Invention by the Inventor Prior to Filing a Patent Application. *Industrial Property*, n.º 10 (1982): 286.

28 HÜNI, ALBRECHT. Comments on the Introduction of an International Period of Grace. *International Review of Industrial Property and Copyright Law* 16, n.º 5 (1985): 580-583 (As cited by Straus, Joseph. *Grace Period and the European and International Patent Law. Analysis of Key Legal and Socio-Economic Aspects*, 2001, p. 59)

29 METZLER, RENEE, *Op. cit.*, pp. 376-377.

This situation has been also highlighted by C. Everitt in the area of biotechnology. For him, in respect to a narrower approach of grace period:

[...] the loss of right as consequence of early publication under the present rules of absolute novelty was a punishment which is out of proportion to the error or omission. In practice, a grace period serves as a safety net which enables protection of meritorious inventions when, because of a prior disclosure, that would not be so at present.³⁰

Furthermore, in connection to academic patenting, it has been found that “academic researchers are forced [...] to postpone publication in scientific journals even beyond the date of first publication of the patent”³¹. However, it seems that “the average delay of publication is relatively shorter in those patent systems that allow for a grace period”³². Besides, during the developing and later valuation of an invention, information is disclosed to third parties. In such scenarios, inventors must be protected in case not all confidential measures are met.

In fact, in the absence of a grace period, inventors could be deterred from seeking funding from potential investing firms, who may not be willing to sign a confidentiality agreement due to its implications³³. Moreover, an inventor may also need to carry utility tests of the invention in full view of the public³⁴. Patent law cannot be alien to these situations. It is evident that a grace period is not the enemy or a demolisher that should be feared. It is a tool, a companion of the absolute and universal novelty condition aiming for the interest of progress and innovation³⁵.

2. Challenges of grace period

Grace period provisions still have room for improvement. Some efforts have been made towards a more coordinated and harmonized approach, yet without a clear consensus to date. Three challenges will be exposed in this paper. First, the balance and coexistence of grace period and novelty (2.1). Then, the risk of despoilment (2.2). And finally, legal uncertainty (2.3.).

2.1. Grace period and novelty

One of the first challenges of the grace period is its compatibility with the concept of absolute and universal novelty. A grace period must not denaturalize this approach but bring it to reality according to practice and behaviors of society, and

³⁰ EVERITT, C. *Grace Period: Effects of Disclosures* (Patent World, 1999) (As cited by STRAUS, JOSEPH, Op. cit., p. 62).

³¹ FRANZONI, CHIARA and GIUSEPPE SCELLATO. Academic Patenting and the Consequences for Scientific Research. *Australian Economic Review* 44, n.º 1 (2011): 98.

³² *Ibid.*

³³ HÜNI, ALBRECHT, Op. cit. (As cited by STRAUS, JOSEPH, Op. cit., p. 58).

³⁴ *Ibid.*

³⁵ *Ibid.*

most precisely, inventors³⁶. The absolute and universal novelty condition is important in the patent system, as previously stated. But its application must be done in consonance with the principle goal of patents: encourage research, innovation and creation. When this condition starts raising issues and becomes an obstacle for inventors and the development of the industry, the grace period will play a key role in helping to find a balance in the system.

2.2. The risk of despoilment

Another point to consider in connection to grace period is the risk of despoilment. The grace period allows inventors to disclose information and this behavior will communicate the invention to third parties, or at least, keep it available. But not all third parties connecting with said information share the interests of the inventor. Thus, disclosing information may also put in jeopardy a patent application due to a risk of being despoiled.

This risk, however, is not specific to grace period disclosures. In fact, considering that for creating an invention and seeking funding it is necessary to communicate with third parties, there is an inherent risk of despoilment³⁷. This may generate complex situations, with challenges relating to the evidence that must be used. Proving who was the first-to-invent is not proper to a first-to-file system, which intend to use filing date as the mechanism to declare the beginning of a potential patent right.

A judicial action for claiming ownership of a patent could be available to address this kind of problems. Grace period gives, in this regard, an additional tool in case of despoilment. Indeed, it could be argued, e.g., that the third party received the information from a previous disclosure of the inventor, who should also file a patent application to assure his right over the despoilment attempt. Hence, grace period could work together with these other actions. As it does recognize them, the risk of despoilment would be in control. The absence of a grace period – on the contrary – will not prevent all despoilment.

2.3. Legal uncertainty

Legal uncertainty is another challenge of grace period. There is a fear that a broader grace period could make it difficult to identify what is protected and what is in the public domain. In this respect, M. Koktvedgaard and L. Osterborg have pointed out that:

It may be argued that any access to make one's own publication and use—even within a narrow time-limit— creates legal uncertainty on the part of the competitors. The

³⁶ *Ibid.*, p. 287.

³⁷ *Ibid.*

general principle is as mentioned that anybody may exploit known technology but if a novelty grace period exists nobody knows where he stands. Is a patent applied for later, or has the inventor given up to acquire an exclusive right?

In this case, too, even a short time-limit may be of great importance if competition is keen. To give competitor a lead or e.g. 6 months may be fatal and without any reason at all if the inventor in spite of everything does not apply for a patent.³⁸

Thus, third parties may believe that, in the absence of a patent application, disclosure can be freely performed. The grace period in fact ensures that a valid patent application can still be made. Nevertheless, this is a radical position in connection to this challenge, given the fact that the limitation in time would be enough to balance the situation³⁹.

In addition, some authors state that – in any case – legal uncertainty may happen even without connection to a grace period. For A. Hüni, an absolute approach to novelty as in EPC is not a guarantee of legal certainty. Given the fact that it is impossible for an Office of Examination to have access to all prior art, there will always be a risk⁴⁰.

Furthermore, it is not sure that a patent application will be granted as filed or published, some modifications are commonly allowed and even sometimes they are imposed by an Office of Examination. Therefore, there is no an absolute legal certainty but a dynamic reality: grace period gives more advantages than obstacles.

In fact, A. Hüni states that:

[...] no serious difficulties as regards legal uncertainty have arisen as a consequence of the period of grace existing e.g. in the United States, Canada, Japan and, until recently, Germany. It is significant that in Germany, where the period of grace was sacrificed in the interests of harmonization, the reintroduction of the period of grace is now desired.⁴¹

Thus, even previous experiences from around the world have proven that grace period is not an issue for legal uncertainty. In this sense, it cannot be pointed out that the inclusion of a grace period will create a dangerous situation. Moreover, as previously stated, it is in fact a common situation that cannot be totally prevented by legislation. The different cases of non-prejudicial disclosures and their impact and importance in the patent system have already been studied and this exercise has shown that the panorama includes all kind of case. In the next lines, these institutions will be analyzed from the angle of a possible harmonization.

38 KOKTVEDGAARD, M. and OSTERBORG, L. A novelty grace period for patent applications: its legal and practical consequences (*EU Commission - Working Document*, 1984), 4-5.

39 *Ibid.*

40 HÜNI, ALBRECHT, *Op. cit.*, (As cited by Straus, Joseph, *Op. cit.*, p. 58).

41 *Ibid.*, p. 583.

III. HARMONIZATION OF NON-PREJUDICIAL DISCLOSURES

Harmonization is a key element for international trading and globalization. It helps applicants and right holders to understand the scope of their rights, or potential rights, and to comprehend other systems. It also reassures the users of the systems and encourages them to seek an international protection, promoting the values of intellectual property globally.

In this paper, several provisions of non-prejudicial disclosures have been studied. It is clear that the differences in conditions and developments call for a harmonization. In this sense, harmonization must be made in search of the promotion of innovation, research, and creation, which is one of the goals of the patent system. The necessity of a harmonization is more evident when a parallel is made between the priority right (A) and the grace period (B).

A. THE PRIORITY RIGHT: A FOLLOWED PAVED WAY

Between the priority right and the grace period there is a clear difference in their development. It is possible to state that international harmonization of priority right is adequate. The rule applies in several jurisdictions with some minor differences. This gives users a level of certainty to plan the expansion of patent protection at international level.

Some obstacles must be faced. Mainly, the formality of filing a certified copy of an application, despite the fact that several Offices of Examination count with a digital data bases that can be accessed online. PCT, e.g. has paved the way for a possible future generation of priority right. The system brings a platform that reduces the necessity of filing documents in some jurisdictions. Moreover, applicants have 30 to 31 months to enter the national phase in the countries of their interest from the priority right.

What are the next characteristics of a priority right going to be? It will depend of the challenges to be faced in the present and the future for the patent system, and the strategies that will be put in place. On the other hand, there is still a long road before a grace period harmonization.

B. THE GRACE PERIOD: A COORDINATION TO BE MADE

As discussed previously, grace period comprises a heterogeneous group of provisions. To this day, there is no consensus beyond the protection of international exhibitions and, even in such case, some significant differences can be appreciated in each jurisdiction as the Paris Convention does not specify all elements of this provision.

Several attempts have been made. For the Paris Convention itself, there was a failed suggestion to include a provision for protecting inventors from their own

disclosure in the revisions of London, in 1934, and Lisbon, in 1958⁴². In 1982, the International Association for Protection of Industrial Property (AIPPI) issued a resolution making some recommendation regarding a possible harmonization of grace period. It proposed a provision to prevent that novelty may be affected by any type of disclosure made by the applicant in a period of six months without limitations in respect to the range of medium and with no formalities required⁴³. This resolution inspired the Paris Convention Union to propose that the International Bureau of the World Intellectual Property Organization (hereinafter the International Bureau) should prepare a study on the grace period in connection to disclosures made by the inventor⁴⁴. As a result, the International Bureau proposed the following solution to be considered in a meeting of a Committee of Experts on the grace period for public disclosure of an invention before filing an application, in 1984:

(a) The contracting States agree to provide that any disclosure relevant for the invention shall not be taken into consideration when determining the state-of-the-art relevant for that invention, provided that the disclosure was made

(i) by the inventor; or

(ii) by a third party based on the information acquired from, or in consequence of acts performed by, the inventor

And provided furthermore that the said disclosure occurred not more than [six] [12] months before the filing date or, where priority is claimed, the priority date of the application.

[...]

(d) For the purpose of paragraphs (a) and (d), “inventor” also means the original owner of the invention other than the inventor and any successor in title of the inventor or such original owner.

(e) For the purpose of paragraph (a), “third party” means any person other than the inventor.⁴⁵

⁴² STRAUS, JOSEPH. *Op. cit.*, 2001, pp. 5-6.

⁴³ International Association for Protection of Industrial Property, Yearbook, 1982, 3, pp. 109-110.

⁴⁴ STRAUS, JOSEPH, *Op. cit.*, pp. 7-8.

⁴⁵ World Intellectual Property Organization. Committee of Experts on the grace period for public disclosure of an invention before filing an application, Document GP/CE/1/2, 1984 (As cited by STRAUS, JOSEPH, *Op. cit.*, p. 9). Two options of length for the period of grace were included, one of six months and a second one of twelve.

This first proposition received mixed support, and, in the end, the proposition was dismissed.⁴⁶

Subsequent meetings of the Committee were held in 1987, 1988, 1989 and 1990. The provision was revised several times, but it did not pass. Other attempts have been made in other spheres, such as the Diplomatic Conference in The Hague, in 1991, but it has not been possible to arrive to an agreement.⁴⁷

Most recent discussions have been made in the framework of Substantive Patent Law Treaty. A draft published in 2003 proposes the following grace period:

An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art on a date during the [12] [six] months preceding the priority date of the claimed invention,

(i) by the inventor,

(ii) by an Office and the item of prior art was contained (a) in another application filed by the inventor [and should not have been made available to the public by the Office], or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor, or

(iii) by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor.⁴⁸

The absence of harmonization brings a discussion about the unbalance of national treatment in case of a jurisdiction where the gap is considerable. In fact, the Standing Committee on the Law of Patents of the WIPO has indicated that:

[...] unless a uniform grace period at the international level is established, an applicant cannot fully enjoy the benefits of the grace period at the national level, since the disclosure made under certain conditions in one place might affect patentability in other countries.⁴⁹

46 STRAUS, JOSEPH, Op. cit., pp. 9-11.

47 STRAUS, JOSEPH, Op. cit., pp. 12-14.

48 World Intellectual Property Organization, *Draft Substantive Patent Law Treaty, Document SCP/10/2*, 2003, p. 23. Two options of length for the period of grace were included, one of six months and a second one of twelve.

49 World Intellectual Property Organization, *Report on the International Patent System, Document SCP/12/3*, 2008, pp. 62-63.

For instance, on one hand, a national of a country member of the EPC may benefit from both the grace period of the US and/or the Andean Community. On the other hand, a national of the US or a country member of the Andean Community, is only protected under the grace period in that jurisdiction.

Several provisions have been exposed through this paper. At this stage, a harmonization of grace period seems complicated. It is difficult to determine when and how this harmonization will be achieved. There are several hypotheses around the world and a harmonization of a minimal grace period would be desirable. But the gap between restricted to broader system is relevant. This may put in jeopardy an international strategy of protection of an invention whereas a disclosure could be considered as non-prejudicial in one country but not in another.

A harmonization of a grace period should take into consideration that the patent system exists for the promotion of research, innovation and creation and for protecting and serving the inventors. Hence, a minimal provision could include academic and research related disclosures made by the applicant, or any of his predecessor in title, in the form of written or printed documents, but also exhibitions. Likewise, certain official disclosures, such as exhibitions, could be taken into consideration for being included.

It seems, however, that at least the length of the duration of a grace period is near to a harmonization. Jurisdiction commonly limits this period to 6 to 12 months, or a year. In any case, this period should take into account the date of the filing or the claimed priority, to have a more effective impact in an international level.

No formalities should be demanded to the application, in consonance to the advances of patent law and other intellectual property categories, which search for simplified procedures. The non-prejudicial disclosures are in continue development and they help to bring dynamics to the patent system. They are necessary to allow exceptions that will prevent an abuse from the application of the absolute and universal novelty condition. It is necessary to see them as allies for novelty. This way, they help the patent system fulfill its goals and help inventors to obtain the protection for their inventions. There is no doubt that the patent system will continue to evolve to face the new challenges in the present and in the future.

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