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Grace period for patents (Q 233)

REPORT OF SWISS GROUP*

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, for Swiss national patents (Article 7b Swiss Patent Act) as well as for European patents (Article 55 EPC).

Pursuant to a treaty between Switzerland and the Principality of Liechtenstein, the two countries form a single patent territory with the Swiss Patent Act as the governing substantive law. The following analysis is, therefore, also valid with respect to Liechtenstein.

The following analysis focuses on patents for inventions. Designs follow different rules not addressed in this report.

2. If the answer to question 1 is yes, please answer the following sub-questions:

a) What is the duration of the grace period?

6 months, both for Swiss national patents and for European patents.

b) 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.

For Swiss national patents: From the "filing date" or "the priority date".

For European patents: According to Article 55 EPC, the relevant point in time is "the filing of the European patent application". The Enlarged Board of Appeal clarified this in G 3/98 and G 2/99 as follows: "For 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".

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

For Swiss national patents and European patents: Only the display of the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions of 22 November 1928.

(If the applicant is not the inventor, the latter qualifies as a third party. We refer to our below analysis under e).

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

This does not apply for Swiss national patents and European patents.

e) *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?*

For Swiss national patents and European patents: Any disclosure that constitutes an “evident abuse in relation to the patent applicant or his legal predecessor”. It is discussed controversially and has never been clarified by the Swiss Federal Supreme Court whether “evident abuse” requires bad faith or intent on the part of the third party or whether such abuse is determined based on objective criteria alone. Inadvertent disclosure by a foreign patent office does not constitute an evident abuse in the sense of the EPC (EPO T 585/92).

Under Article 55 EPC, 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.” A prior right in the sense of Article 54(3) EPC (i.e. an earlier European patent application published on or after the filing date) meets this requirement and may therefore qualify as a non-prejudicial disclosure. Under Article 7b of the Swiss Patent Act, a disclosure only qualifies for the grace period if the “invention has been made available to the public in the six months prior to the filing date or priority date.” Per definition, a prior right in the sense of Article 54(3) EPC and the respective Swiss provision (Article 7(3) Swiss Patent Act) is only published and therefore made available to the public after the filing date. Based on the wording alone it would therefore seem that an application in the sense of Article 54(3) EPC and the respective Swiss provision (Article 7(3) Swiss Patent Act) does not qualify for the grace period.

f) *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?*

For Swiss national patents and European patents: No, an evident abuse in relation to the patent applicant or his legal predecessor is required.

g) *Is any type of statement or declaration by the applicant required to invoke the grace period?*

For Swiss national patents and European patents: A statement/declaration is required in the case of the display of the invention at an international exhibition falling within the terms of the Convention on International Exhibitions of 22 November 1928.

If yes:

What are the requirements for the statement/declaration?

When must the statement/declaration be filed?

For Swiss national patents and European patents: The statement must be made with the application and must contain the following information: identification of the exhibition and declaration that the invention was in fact displayed (Article 44 Swiss Patent Ordinance; Rule 25 EPC Implementing Regulations).

Within four months from the filing date, the applicant must submit a certificate of exhibition (Ausweis über die Ausstellungsimmunität) that has been executed during the exhibition by the authority responsible for the protection of intellectual property at the exhibition and that contains the following information: a confirmation that the invention was in fact displayed; the opening date of the exhibition; the date on which the invention was displayed for the first time if this date does not correspond with the opening date; an identification of the invention, authenticated by the competent authority (Article 45 Swiss Patent Ordinance; Rule 25 EPC Implementing Regulations).

h) *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.*

Both with regard to Swiss national patents and European patents, the grace period is defined by statutes.

For Swiss national patents, the relevant provision is Article 7b Swiss Patent Act:

“Where the invention has been made available to the public in the six months prior to the filing date or priority date, this disclosure does not form part of the state of the art when it is due to, or a consequence of:

- a. an evident abuse in relation to the patent applicant or his legal predecessor, or
- b. the fact that the patent 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 of 22 November 1928, and he has declared the fact at the time of filing and has produced sufficient supporting evidence in due time”.

For European patents, Article 55 EPC is pertinent:

“(1) 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:

- (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 time limit and under the conditions laid down in the Implementing Regulations”.

i) 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:

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

The Swiss Patent Act entered into effect in 1956, without grace periods. In the explanatory report, the Federal Council justified this as follows: “A proposal that was occasionally made, to declare a disclosure of the invention during the last six months prior to the patent application as harmless if such disclosure is attributable to the inventor or his legal successor, was not incorporated. In reality, this would not serve the inventor well because in all countries that do not provide for a grace period, and this today still is the large majority, such a disclosure of the inventor, even abroad, destroys novelty. This problem can only be resolved on an international level”.

Article 7b Swiss Patent Act was introduced in 1976 in the course of aligning the Swiss Patent Act with the EPC and the Strasbourg Convention on the Harmonization of Certain Points of Substantive Patent Law. The explanatory report of the Federal Council does not explain why Article 7b Swiss Patent Act differs from Article 55 EPC in so far as (i) under Article 55 EPC the grace period begins with the actual filing of the European application while under Article 7b Swiss Patent Act the filing date or the priority date is relevant and (ii) filing a patent application that will qualify as prior right in the sense of Article 54(3) EPC and the respective Swiss provision (Article 7(3) Swiss Patent Act) is only covered by Article 55 EPC but not by Article 7b Swiss Patent Act (at least according to the wording of the latter provision).

For the policy reasons behind Article 55 EPC, see G3/98 and G2/99, reason for the decision number 2.

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

The grace period for exhibitions is practically meaningless. Statistical data is, however, not available in Switzerland.

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

No.

d) 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.

Almost never. To the knowledge of the Swiss Group, there is only one Swiss Federal Supreme Court decision on this topic (BGE 117 II 480).

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)?

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

It is transparent and attractive from the point of view of legal certainty. Also, it is considered positive that under Swiss law the priority date is relevant for calculating the grace period.

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

It is confusing that the rules for Swiss national and for European patents are different, and this may lead to arbitrary results. Also, the Swiss group deems it a disadvantage that under Swiss law a patent application in the sense of Article 54(3) EPC and the respective Swiss provision (Article 7(3) Swiss Patent Act) does not seem to qualify for the grace period.

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?

From a European perspective, clients are advised not to disclose their inventions before having secured a priority. If a disclosure has occurred within the past six months, clients are recommended to consider filing utility models in Germany and/or Austria. German and Austrian utility model laws provide for a grace period of six months.

II. 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.

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

Yes.

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

6 months

b) The date from which the grace period is calculated

The filing date or, if a priority is claimed, the priority date.

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

Either no intentional acts or disclosures by the applicant at all or any such act or disclosure. To the Swiss group, only these two extremes seem to be justifiable with regard to the principle of legal certainty.

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

See above answer to c).

e) 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

Any act or disclosure by a third party not acting with the consent of the applicant.

f) 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.

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

Should it be decided that intentional acts or disclosures by the applicant should be covered by the grace period, the Swiss group considers it appropriate to require the applicant to identify the respective act or disclosure, without however being obliged to disclose the content of the act or disclosure. Such information should be published together with the application.

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

The Swiss Patent Act and the EPC provide a grace period of six months for the display of the invention at an exhibition according to the Convention on International Exhibits and for disclosures by third parties that constitute an evident abuse in relation to the applicant. The provisions in the Swiss Patent Act and the EPC differ in so far as (i) under the EPC the grace period begins with the actual filing of the European application while under the Swiss Patent Act the filing date or the priority date is relevant and (ii) filing a patent application in the sense of Article 54(3) EPC and the respective Swiss provision (Article 7(3) Swiss Patent Act) is only covered by the EPC but, according to its wording, not by the Swiss Patent Act.

Zusammenfassung

Das schweizerische PatG und das EPÜ bezeichnen Offenbarungen innerhalb einer Schonfrist von sechs Monaten als unschädlich, wenn sie an einer internationalen Ausstellung im Sinne des Übereinkommens über die internationalen Ausstellungen erfolgen oder auf einen offensichtlichen Missbrauch zum Nachteil des Patentbewerbers zurückgehen. Die Bestimmungen des PatG und des EPÜ unterscheiden sich insofern, als (i) unter dem EPÜ die Schonfrist vom Zeitpunkt des Einreichens der europäischen Anmeldung an berechnet wird, während unter dem PatG das Anmelde- oder das Prioritätsdatum massgebend ist, und (ii) eine Patentanmeldung i.S.v. Art. 54 Abs. 3 EPÜ respektive Art. 7 Abs. 3 PatG (älteres Recht) nur unter dem EPÜ, seinem Wortlaut zufolge aber nicht unter dem PatG eine unschädliche Offenbarung darstellen kann.

Résumé

La loi suisse sur les brevets et la CBE prévoient une période de grâce de six mois pour montrer l'invention à une exposition selon la Convention concernant les expositions internationales et pour des divulgations de la part de tiers constituant un abus évident relativement au Demandeur. Les dispositions de la Loi suisse sur les brevets et de la CBE diffèrent car (i) selon la CBE la période de grâce commence avec le dépôt réel de la demande européenne tandis que selon la Loi suisse sur les brevets la date de dépôt ou la date de priorité est pertinente et (ii) le dépôt d'une demande de brevet aux termes de l'Article 54(3) CBE et de la disposition suisse correspondante (Article 7(3) de la Loi suisse sur les brevets) est protégé seulement par la CBE mais non, selon son énonciation, par la Loi suisse sur les brevets.