

PRESENTATION:

**THE GRACE PERIOD:
A JAPANESE PERSPECTIVE**

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To begin with, I would like to introduce our system: the Japanese system for the grace period. The Japanese grace period is situated between America's and Europe's. Why? We have a six-month grace period accorded to the applicant (the range of applications for the publication is as wide as the United States). To help you understand this concept I would like to read a portion of Japanese patent law (Section 30). Obviously, the Japanese law is in Japanese, so what I am about to read is a translation into English. AIPPI Japan publishes this Japanese law relating to industrial property and this is a bestseller. Section 30 states:

In the case of an invention which has fallen under any of the paragraphs of Section 29(1), (that is to say a lack of novelty), by reason of the fact that the person having the right to obtain a patent has conducted an experiment, has made a presentation in a printed publication, has made a presentation through electric telecommunication lines (that is to say the Internet) or has made a presentation in writing at a study meeting held by a scientific body designated by the Commissioner of the Patent Office, such an invention shall be deemed not to have fallen under any of the paragraph of Section 29(1), (that is to say, the lack of novelty) for the purpose of Section 29(1) and (2) to the invention claimed in the patent application which has been filed by such person within 6 months from the date on which the invention first fell under those paragraphs.

Yes, it is a little long. Second, it also concerns an important thing. "In the case of an invention which has fallen under any of the paragraphs of Section 29(1), against the will of the person having the right to obtain a patent, the preceding sub-section shall also apply for the purpose of section 29(1) and (2) to the invention claimed in the patent application which has been filed by such person within 6 months from the date on which the

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invention first fell under any of those paragraphs." You should read paragraphs 3 and 4, which describe the publication or exhibition. Those are similar to the United States and Europe.

AIPPI Japan has conducted a survey concerning the grace period. AIPPI Japan carried out a questionnaire with 2,000 companies, regarding the influence on domestic users of differences between each country's intellectual property systems. From that questionnaire we received 714 answers for the questions concerning grace period. Within the past 5 years, 42% answered yes, they had used a grace period for an application; on the other hand, 58% replied no. More specifically, Japanese users used grace period quite frequently. The use-ratio is much higher than the graph for companies with the most number of patent applications.

In the area where the grace period is used, 71% of the answers were "only in Japan;" 23% indicated they used the grace period "in Japan and abroad;" and the remaining 6% used the grace period "only abroad." The reasons given for grace-period use within Japan were "use for experimental purpose," which amounted to less than 1%; but for "disclosure by inventor through published matters" it was about 23%. The "disclosure at a scientific or academic party" was about 68%. That is the majority. The "disclosure at an exhibition" was the remaining 9%. Those were the reasons that Japanese companies used the grace period for their applications.

Next, let us look at how the grace period was used abroad. The grace period was used 62% of the time in the U.S.A. The EPO represents 13%, 6% in Korea, 6% in Canada, 4% in China, 3% in Australia, and 2% in Taiwan and the remaining others.

Besides these statistical results, we also received free descriptions from the inquiries. Let me share some of them. From the viewpoint of international harmonization, the general opinion is that they desired unification of the reason for lack of novelty. For the European systems, the Japanese users desired that the absolute novelty shall be changed or be taken off so they could have easier access. These were the opinions of the Japanese users. For the United States, they desired the change from the first-to-invent system to the first-to-file, because the Japanese users considered that the system of grace period should be linked with the first-to-invent system. The Japanese users have some difficulty in understanding that notion. They believe that the introduction of a grace period all over the world will be the best choice in the future.

Next, I will try to explain a recent amendment of the Japanese patent law concerning publication. Since I have already mentioned the newest Japanese patent law concerning the grace period, you should already know about disclosure through the Internet, which is also regarded as publication. The next thing that is very important for us is that, even when an invention is filed in an application which is not identical with the invention presented in a printed publication, the exception in lack of novelty is applicable. This is the newest amendment; we did it last year.

To conclude my presentation I would like to share my personal opinion on the desired harmonization of patent laws concerning the grace period in the future. First, as an advocate of the Japanese users in favor of the international grace period, I think that introduction of an international grace period prior to the priority date is absolutely necessary. Second, broadening the scope and modality of disclosures is also very important when looking at the will of an inventor. In this context, I hope the international grace period will be introduced in the near future. Thank you.