

EPO releases findings of survey on grace period for patents

Author: Kerem Halil Shah

On 17 June 2022, the EPO reported the results of a survey conducted last winter to understand the impact of the novelty requirements of the European Patent Convention (EPC) on its users. In particular, the survey focused on the lack of a "grace period" under the EPC. The study draws on empirical evidence collected from a random sample of applicants who filed patent applications with the EPO in 2018, 2019 and 2020, seeking to focus on evidence of the respondents' actual behaviour rather than their opinions or preferences.

Under the EPC, an applicant is only entitled to protection for an invention based on matter not previously disclosed, including by the applicant, except in certain circumstances such as where the disclosure is made public as a result of a breach of confidence. However, other jurisdictions allow for a period of time, a grace period, where an inventor can disclose their invention before the filing or priority date of a patent application without destroying the novelty of their invention with regard to the application. The EPO report notes that grace periods prolong the period of legal uncertainty from 18 months up to 30 months, during which time the public may be unable to establish whether a disclosure is prior art or not – increasing the risk of unintentional infringement. This negative consequence balances the benefit of increased flexibility for applicants regarding when to publish and when to file patent applications.

The EPO's newsletter, reporting the publishing of the findings, led with the finding that the vast majority of European users are content with the status quo, and that only an estimated 6% would use a grace period were one to be available. However, the EPO newsletter did point to the exception among US applicants, saying that amongst US applicants just over 7% reported that pre-filing disclosures have caused their application to the EPO to fail in the past. The report itself says that just over 7% of EP applications are prevented by a pre-filing disclosure but 46% of US respondents have been prevented from filing a European patent application.

The US, Japan and South Korea notably all provide a grace period for their national filings and perhaps unsurprisingly, US, Japanese, and Korean companies show a higher share of applications prevented by pre-filing disclosures than of applications that were filed following the postponement of disclosures.

However, the EPO noted the particular needs of the university research sector and the impact on academic disclosure on subsequent potential patent filings. Indeed, the estimated impact of the strict novelty requirement under the EPC was estimated to be greater on European universities than US companies, with a larger share of EP applications prevented by a pre-filing disclosure and above 12% of EP applications from European universities requiring the postponement of a disclosure. From the survey, university applicants appeared to be more affected by the postponement of a disclosure than their business counterparts, and are a significant contributor to grace period requests in other jurisdictions.

The EPO's report on the release of the study can be found [here](#). The full report and a summary of the key findings can be found [here](#).