Questionnaire on Special Topic (Grace Period)

The grace period reconciles an inventor's need to disclose an invention before filing with the requirements for patentability. It serves to protect inventors and promote innovation through early information sharing. At the same time, balancing this protection with predictability and legal certainty for third parties remains a common challenge across jurisdictions.

Grace period rules, such as availability, duration, eligible disclosures, treatment of third-party disclosures, and procedural requirements, differ significantly across countries and regions. A pre-filing disclosure that is permissible in one country may constitute a loss of novelty in another, potentially causing serious disadvantage. An accurate understanding of each jurisdiction's rules and their practical operation is therefore essential.

The APAA Patent Committee has adopted the grace period as this year's Special Topic. The objectives are to compare and analyze each country's system, deepen understanding of the differences among them, and contribute to their improvement. To this end, the Committee is conducting this questionnaire with the cooperation of each regional group.

Please answer the following questions regarding the grace period as defined below.

(Definition)
A grace period refers to a specified period preceding the filing or priority date of a patent application during which certain disclosures of an invention made within that period are disregarded when determining novelty, etc. of the invention claimed in the patent application.

A. Current System

I. Availability of a Grace Period

1) Is a grace period available for patent applications in your country or jurisdiction?
✓ Yes
□ No

II. Legal basis of the Grace Period

1) What is the underlying legal rationale of the Grace Period in your jurisdiction? Please select the option that best describes its primary characterization:

□ Broad protection for inventors (acting as a general safety net against pre-filing disclosures, e.g., the U.S.).
✓ Statutory relief as an exception to lack of novelty (saving the inventor's own disclosures under specific procedural requirements, e.g., Japan).
□ Ensuring legal certainty for third parties (allowing exceptions to the novelty requirement only in strictly limited circumstances, e.g., Europe).
□ Standardization with foreign jurisdictions.
□ Other (please specify: _____).

III. Duration

1) How long is the grace period? (Multiple answers permitted.)
□ 6 months
✓ 1 year (12 months)
□ Other (Please specify the exact period.)

(Where multiple grace periods exist, please indicate the applicable period for each type of act listed in Section IV below.)

2) Assume that a national phase application is derived from an international application claiming priority from a foreign patent application or utility model application.

In the case of examination of such a national phase application, which of the disclosures made at time points A to D in the figure below would be excluded from prior art for determining novelty and the like? In this connection, the disclosure is eligible for the grace period in your country, and if any procedure is required for excluding such disclosures, such procedure shall be deemed to have been duly carried out.

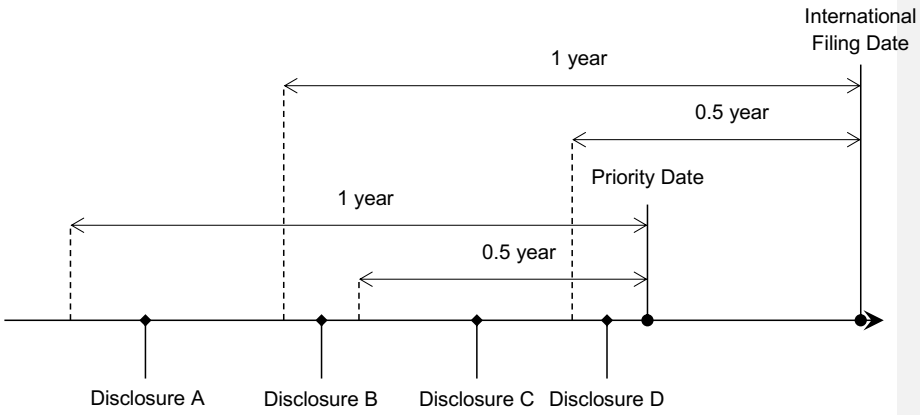
(Multiple answers permitted.)

✓ Disclosure A
✓ Disclosure B
✓ Disclosure C
✓ Disclosure D
□ Additional conditions are required (please explain)
□ All disclosures are considered during examination

Commented [MOU1]: Sec. 25, IP Code. Non-Prejudicial Disclosure. –
25.1. The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:
(a) The inventor;
(b) A patent office and the information was contained (a) in another application filed by the inventor and should not have been disclosed 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 directly or indirectly from the inventor; or
(c) A third party which obtained the information directly or indirectly from the inventor.

Commented [MOU2]: Inventions: 12 months (Sec. 25, IP Code)
Utility Models: 12 months (Sec. 108.1, IP Code)
Industrial Designs: 12 months (Sec. 119.1, IP Code)

Commented [MOU3]: All of the disclosures were made within 12 months from the priority date claimed.



3)In the above question (2), if the application forming the basis of the priority claim were a patent application or utility model application filed in your country, which of the disclosures would be excluded from prior art for determining novelty and the like?

(Multiple answers permitted.)

- ✓ Disclosure A
- ✓ Disclosure B
- ✓ Disclosure C
- ✓ Disclosure D
- □ Additional conditions are required (please explain)
- □ All disclosures are considered during examination

Commented [MOU4]: The IP Code does not qualify the rule on non-prejudicial disclosure in terms of where the disclosure was made or where the application was filed.

IV. Disclosures Eligible for Grace Period

1) Does the grace period apply irrespective of the manner of disclosure of the invention?

✓ Yes
□ No

Commented [MOU5]: The qualification to the non-prejudicial disclosure rule pertains to the person who disclosed the information and not on the manner of disclosure.

2) If the form or manner of disclosure is relevant, which of the following are covered? (Multiple answers permitted.)

2-1) Disclosure by a person having the right to obtain a patent
✓ Publication in academic journals or conference proceedings
✓ Publication in books or pamphlets
✓ Publication on websites containing academic papers or conference abstracts
✓ Publication on the applicant's own website
✓ Publication on e-commerce websites
✓ Publication on social networking services (SNS)
✓ Presentation at meetings (e.g., academic conferences, seminars, presentations for investors or customers)
✓ Disclosure through public trial or testing

✓ Disclosure at an official or officially recognized international exhibition (Art. 11 of the Paris Convention)

✓ Disclosure through public display (e.g., other exhibitions, trade fairs, expositions)
✓ Disclosure through advertising, sale or distribution of products embodying the invention
✓ Disclosure through press conferences or appearances on live television or radio programs

2-2) Disclosure by Patent Office

✓ Publication in the laid-open patent publication or patent gazette of the applicant's own patent application.

2-3) If a third party acting with the authority of and at the request of a person having the right to obtain a patent makes any of the disclosures listed in 2-1 and/or 2-2 above, is the grace period applicable?

✓ Yes
□ No

2-4) If a third party makes any of the disclosures listed in 2-1 and/or 2-2 above against the will or without the authority of the person having the right to obtain a patent, is the grace period applicable?

✓ Yes
□ No

V. Procedures

1) Are any procedures required in order for the grace period to apply?

□ Yes, to enjoy all of the available forms of grace period
□ Yes, to enjoy some but not all of the available forms of grace period
✓ No

2) If any procedures are required, is it necessary to submit documents proving the fact of disclosure?

□ Yes
□ No

3) If yes, what is required and for which forms of grace period?
□ A written statement/declaration indicating that the grace period requirements are satisfied
□ Evidence specifically showing that the requirements for application are satisfied

4) By when must the statement/declaration, and/or evidence referred to in 3) above be submitted?

□ At the time of filing the patent application
□ Other (Please specify the deadline.)

VI. Other

1) In what circumstances can a grace period be applied based on the relationship between the prior disclosure and the invention under examination?

✓ when the disclosed invention and the invention under examination are completely identical

□ when the disclosed invention and the invention under examination are substantially identical

□ Other (Please briefly explain.)

2) Where "Declaration as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty" has been made in a PCT application and the application enter

Commented [RP6]: Sec. 25 of the IP Code explicitly provides that, "the prior disclosure shall not prejudice the applicant **on the ground of lack of novelty**".

Rule 204.1 of the RIRR further provides that a strict identity test is required to be applied when assessing novelty, and that a single prior art reference must disclose each and every element of a claimed invention (i.e. completely identical).

s the national phase in your country, can the applicant benefit from the grace period without any additional procedure?

✓ Yes
□ No

Commented [MOU7]: There are no formality requirements that must be complied with before the non-prejudicial disclosure rule applies

3) If an international application enters the national phase in your country without "Declaration as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty" having been made in the PCT application, can the applicant still benefit from a grace period?

✓ Yes, for all forms of available grace period
□ Yes, for some forms of available grace period
□ No

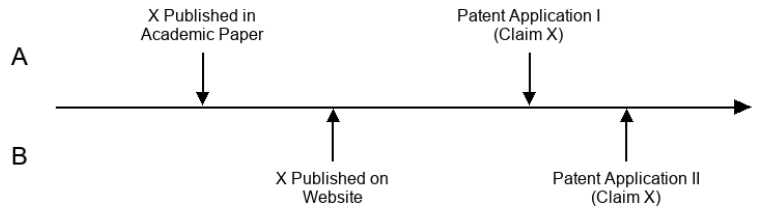
Commented [MOU8]: Since there are no requirements that must be complied with before the non-prejudicial disclosure rule applies, then the absence of "Declaration as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty" in the international phase will not prejudice the applicant.

B. Hypothetical Cases

Please answer the following hypothetical cases on the assumption that all procedures required to obtain the benefit of the grace period have been duly completed.

Hypothetical 1

1) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. Inventor B independently invented X and published X on a website between the publication of the academic paper and the filing of Patent Application I. Inventor B filed Patent Application II within the applicable grace period after Inventor B's publication and after the filing of Patent Application I.



Will either patent application be rejected?

1-1) Will Patent Application I be rejected?

✓ Yes

□ No

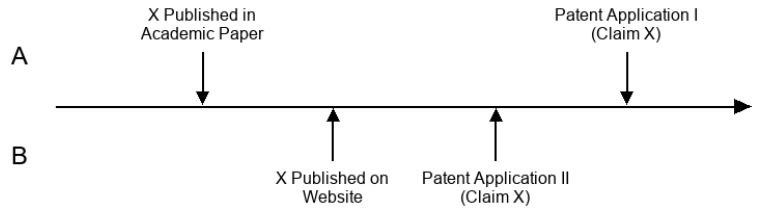
1-2) Will Patent Application II be rejected?

✓ Yes

□ No

Hypothetical 2

2) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. After the publication of Inventor A's academic paper, Inventor B independently invented X, published X on a website before the filing of Patent Application I, and filed Patent Application II within the applicable grace period from Inventor B's publication and before the filing of Patent Application I.



Will either patent application be rejected?

2-1) Will Patent Application I be rejected?

✓ Yes

□ No

2-2) Will Patent Application II be rejected?

✓ Yes

□ No

Patent Application I will be rejected pursuant to the first-to-file rule.

Hypothetical 3

Commented [MOU10]: B's publication is prejudicial to A's Application I even if within the grace period. B's publication does not qualify as a non-prejudicial disclosure with respect to A's Application I because the information disclosed was not obtained directly or indirectly from A.

Commented [MOU11]: A's publication is prejudicial to B's Application II.

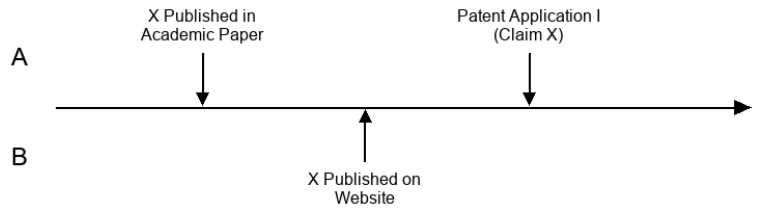
Commented [RP11R2]: Rejection based on First-to-File rule may likewise apply here (See Sec. 29, IP Code).

Commented [MOU12]: B's publication is prejudicial to A's Application I even if within the grace period. B's publication does not qualify as a non-prejudicial disclosure with respect to A's Application I because the information disclosed was not obtained directly or indirectly from A.

Commented [MOU13]: A's publication is prejudicial to B's Application II even if within the grace period. A's publication does not qualify as a non-prejudicial disclosure with respect to B's Application II because the information disclosed was not obtained directly or indirectly from B.

Commented [RP14]: Rejection due to the prejudicial disclosure of publication of Inventor B may also apply.

3) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. Mr. B saw Inventor A's publication, produced X, and published X on a website before the filing of Patent Application I.



3-1) If B's disclosure is regarded as being derived from A's disclosure, will Patent Application I be rejected?

□ Yes
✓ No
□ Other

Commented [MOU15]: B's publication is a non-prejudicial disclosure with respect to A's Application I because the information disclosed was obtained directly or indirectly from A.

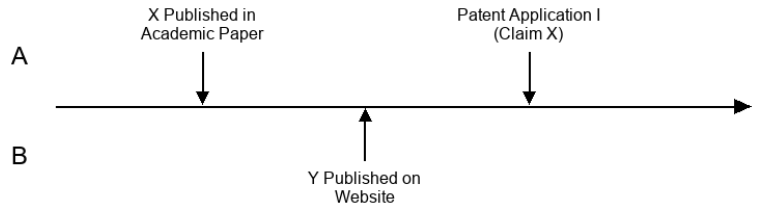
3-2) If B's disclosure is not regarded as being derived from A's disclosure, will Patent Application I be rejected?

✓ Yes
□ No
□ Other

Commented [MOU16]: B's publication will be prejudicial to A's Application I even if within the grace period, since
B's publication does not qualify as a non-prejudicial disclosure with respect to A's Application I because the information disclosed was not regarded as being obtained directly or indirectly from A.

Hypothetical 4

4) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. Mr. B saw Inventor A's publication, developed Y as an improvement of X, and published Y on a website before the filing of Patent Application I. Note that Y is substantially different from X, but does not have sufficient differences from X to establish an inventive step over X.



4-1) If B's disclosure of invention Y is regarded as being derived from A's disclosure of invention X, will Patent Application I be rejected?

□ Yes
✓ No
□ Other

Commented [MOU17]: B's publication is a non-prejudicial disclosure with respect to A's Application I because the information disclosed was obtained directly or indirectly from A. Furthermore, although invention Y was derived from A's disclosure, invention Y is substantially different from X but short of being inventive on its own. Since novelty in the Philippines is assessed based on strict identity test, the presence of dissimilarities already removes Y from novelty-destroying prior art with respect to Application I.

4-2) If B's disclosure of invention Y is not regarded as being derived from A's disclosure of invention X, will Patent Application I be rejected?

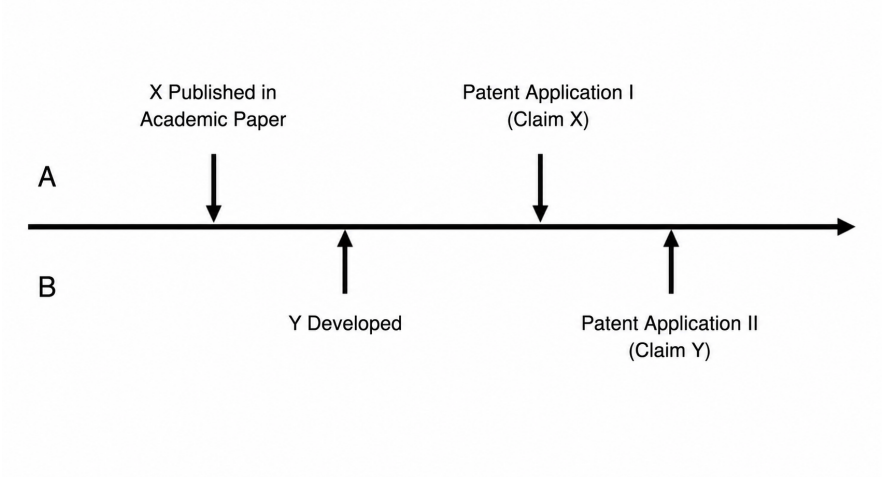
□ Yes
✓ No
□ Other

Commented [MOU18]: Although Y can be considered as a prejudicial disclosure because it was not derived from A, the presence of dissimilarities already removes Y from novelty-destroying prior art with respect to Application I.

Hypothetical 5

5) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. Mr. B saw Inventor A's publication, developed Y as an improvement of X, and filed Patent Application II for Y after the filing of Patent Application I. Note that Y is substantially different from X, but does not have sufficient differences from X to establish an inventive step over X.

Y was not disclosed before the filing of Patent Application II.



Will either patent application be rejected?

5-1) Will Patent Application I be rejected?
□ Yes
✓ No
□ Other

5-2) Will Patent Application II be rejected?
✓ Yes

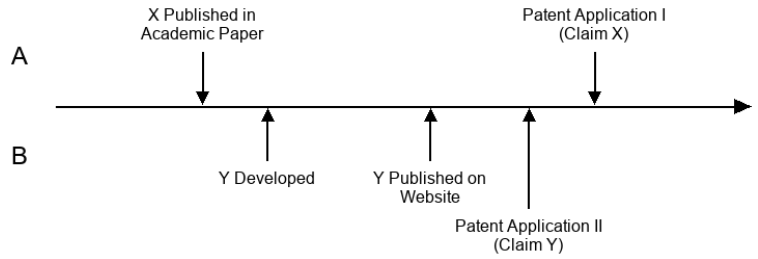
□ No
□ Other

Commented [MOU19]: No prior disclosure of Y. In any case, since Y contains dissimilarities from X but short of being inventive on its own, it cannot be considered novelty-destroying for Application I pursuant to the strict identity test.

Commented [MOU20]: Y is an improvement of X. Although X's disclosure will not be sufficient to destroy the novelty of Application II, Y is obvious from X, thus it lacks inventiveness.

Hypothetical 6

6) Inventor A invented X, published an academic paper disclosing X, and filed Patent Application I within the applicable grace period after the publication of the academic paper. After the publication of Inventor A's academic paper, Mr. B saw Inventor A's publication, developed Y as an improvement of X, published Y on a website, and filed Patent Application II for Y before the filing of Patent Application I. Note that Y is substantially different from X, but does not have sufficient differences from X to establish an inventive step over X.



Will either patent application be rejected?

6-1) Will Patent Application I be rejected?

□ Yes

✓ No

□ Other

6-2) Will Patent Application II be rejected?

✓ Yes

□ No

□ Other

Commented [MOU21]: Since Y contains dissimilarities from X but short of being inventive on its own, it cannot be considered novelty-destroying for Application I pursuant to the strict identity test.

Commented [MOU22]: Although X's disclosure will not be sufficient to destroy the novelty of Application II, Y is obvious from X, thus it lacks inventiveness.

C. Opinion Survey for the Preparation of an APAA Resolution on Grace Periods

Please answer the following questions based on your views and experience as a patent practitioner in your jurisdiction. The results of this survey will be used as a basis for discussing and formulating an APAA Resolution on grace period systems.

1) Do you think it is appropriate to allow a patent to be obtained under the grace period system for an invention that was disclosed by the inventor before filing, or disclosed against the inventor's will before filing?

✓ Yes

□ No

□ Conditionally Yes

(Please provide reasons.)

2) Are you satisfied with the current grace period system as it applies to patents in your jurisdiction?

✓ Yes
□ No
□ Cannot say either way
(Please provide reasons if any.)

3) Do you think that the grace period system currently maintains an appropriate balance between the rights of applicants and the interests of the public?
✓ Yes
□ No
☐ Cannot determine

4)Do you think that the grace period system promotes the early use of technical information by others in the same field by allowing inventors to disclose research results before filing a patent application?
✓ Yes
□ No
□ Cannot say either way

5) Do you have any concern that differences in grace period systems between jurisdictions may create risks, such as the loss of novelty in foreign patent applications, even where a grace period is available for a domestic application?
✓ Yes
□ No
□ Depending on the situation

6) Do you think it is desirable for jurisdictions to adopt common standards regarding the availability of grace period systems, the types of disclosures covered, and the duration of the grace period(s)?

✓ Yes
□ No
□ Cannot determine
(Please provide reasons.)

7) What types of pre-filing disclosures do you think should be covered by the grace period system?
✓ It is preferable to broadly cover disclosures regardless of the manner of disclosure
□ It is preferable to limit coverage to certain types of disclosures
□ Cannot determine
(Please describe the types of disclosures you consider appropriate, or the criteria for limitation if coverage should be limited.)

8) What duration of grace period do you consider appropriate?
□ 6 months
✓ 12 months

Commented [RP23]: YES, but there's room for improvement.

Current PH application of non-prejudicial disclosure only focuses on novelty. Expanding its applicability to inventive step/non-obviousness may afford the applicant greater protection.

Consider the scenario:
- Inventor A publicly discloses invention X.
- Within the grace period, A files an application claiming an improvement Y.
- Y is not identical to X, so X does not anticipate Y. But Y does not have sufficient differences from X to establish an inventive step.
- X may possibly then be cited to argue that the improvements of Y would have been obvious to a person skilled in the art.

However, there are not much references applications in the PH that can help assess if current grace period system is adequate.

In addition, exclusions applicable to foreign patent offices/WIPO may create complexities not currently apparent.

□ More than 12 months
□ Other
(Please provide reasons if any.)

9) Do you think it is necessary to promote consistency in the procedures for securing grace periods across jurisdictions?
✓ Yes
□ No
□ Cannot determine
(If applicable, please describe the procedures that you consider should or should not be made consistent, and provide reasons.)

10) Do you think it is desirable to establish a system whereby a single procedure for claiming the benefit of the grace period can have effects in as many countries and jurisdictions as possible?
✓ Yes
□ No
□ Cannot determine
(Please describe any expectations or concerns regarding such a system if any)

11) Do you think it reasonable to require applicants to submit evidence of the circumstances of the disclosure in order to benefit from a grace period?

✓ Yes
□ No
□ Conditionally Yes
(Please describe the procedures you consider appropriate.)

12) In view of International grace period, which approach do you consider the most preferable starting point for measuring the grace period?

The "international grace period" provides a maximum two-year period, consisting of one year under your country's patent law (e.g., where a one-year grace period applies) and an additional one year through the Paris Convention priority system.

✓ A grace period measured from the earliest priority date
□ A grace period measured from the filing date of the patent application
□ Other (please explain)