# 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 (Article 22(3) of the Patent Act)
□ 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: _____).

Since the amendment effective 1 May 2017, Article 22(3) of the Patent Act disregards any disclosure made within 12 months before filing that was made by or against the applicant's will, irrespective of the manner of disclosure, and no declaration is required at filing. The only carve-out is publication in a patent gazette resulting from the applicant's own patent filing (Article 22(4) of the Patent Act). The grace period is statutory relief as an exception to lack of novelty or inventive step saving the applicant's own pre-filing disclosures, which cannot be used against intervening disclosures of a third-party.

III. Duration

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

12 months for invention patents (Article 22(3) of the Patent Act) and utility model patents (Article 120 of the Patent Act applying Article 22); 6 months for design patents (Article 122(3) of the Patent Act).

TIPO published a draft amendment in September 2024 that would extend the design grace period to 12 months to align with the US, Japan, Korea and the EU; it is expected to come into effect soon.

(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.

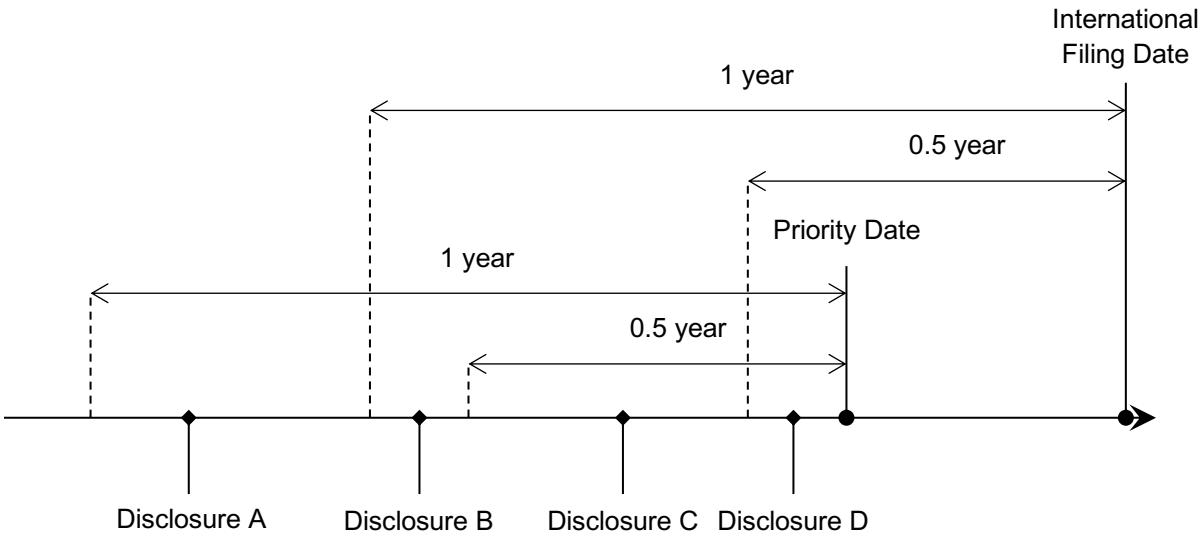
In the case of examination of such a national phase application, which of the disclosures made at time points A to D in the figure below would be excluded from prior art for

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

Taiwan is not a PCT member, so no national phase application derived from an international application exists in Taiwan.




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

Same result as question 2).

(For purposes of this question, if the International Filing Date is regarded as the actual filing date of a Taiwan application claiming Paris Convention priority , the result would be as follows:

Under Taiwan practice, the 12-month grace period is counted back from the actual Taiwan filing date, not from the priority date (Patent Examination Guidelines ("Guidelines"), Part II, Chapter 3, Sections 4.3 and 4.6: the grace period and the priority period have different starting points and are assessed separately, and the grace period does not shift the reference date for patentability). Accordingly Disclosures B, C and D, all made within 12 months before the filing date, are disregarded, provided they were made by or against the applicant's will. Disclosure A, made more than 12 months before the filing date, is not excluded. Where several applicable disclosures exist, the 12 months run from the earliest one. Additional condition: if the examiner relies on a disclosure, the applicant must show that it originated from the applicant; a disclosure of an invention independently created by a third party is never excluded (Section 4.5).

Domestic priority under Article 30 of the Patent Act is treated differently. Where the later application claims domestic priority from an earlier Taiwan application, the later application has the substantive effect of inheriting the benefit of the grace period applicable to the same invention disclosed in the earlier application. Accordingly, a disclosure disregarded under the grace period for the earlier application does not constitute prior art against the same invention in the later application. The earlier Taiwan application is deemed withdrawn 15 months after its filing date (Article 30 (2) of the Patent Act) and is therefore normally never laid open.)

## IV. Disclosures Eligible for Grace Period

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

□ Yes
☑ No

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

All of the listed forms are covered because the statute is generally not form-specific. The principal exception is publication in a patent gazette resulting from the applicant's own patent filing, as addressed in 2-2) below. Taiwan has not adopted the exhibition-related rule under Article 11 of the Paris Convention: an exhibition disclosure is handled under the ordinary 12-month grace period, and the priority period cannot be back-dated to the exhibition (Guidelines Section 4.3).

2-2) Disclosure by Patent Office

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

Publication of the applicant's own application in a patent gazette (Taiwan or foreign) as a consequence of the applicant's own filing is expressly excluded from the grace period (Article 22 (4) of the Patent Act). There are two exceptions to this rule (Guidelines Section 4.4): (i) a gazette publication resulting from an error of the Patent Office, and (ii) a gazette publication resulting from an application filed by a third party who directly or indirectly obtained the invention from the applicant without consent. In both cases the applicant must file within 12 months of that publication and prove the facts. The TIPO Commentary explains that gazette publication serves a different purpose from the grace period: it informs the public and avoids duplicated research, whereas the grace period shields applicants from their own pre-filing disclosures.

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

A disclosure by a person entrusted, authorized or instructed by the person entitled to apply is a disclosure made by the applicant's will (Guidelines Section 4.5). The TIPO Commentary on Article 22 adds that the applicant includes its legal predecessor, following EPC Article 55 and Section 3(4) of the German Patent Act, so disclosures by an assignor, a decedent, or an employee or commissioned inventor also qualify.

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

A disclosure made against the applicant's will, for example by a person acting without authority, in breach of confidentiality, or who obtained the invention by coercion, fraud or theft, is covered (Article 22(3) of the Patent Act; Guidelines Sections 4.2 and 4.5). The 12-month period runs from that unauthorized disclosure (Section 4.8(3)).

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

The 2017 amendment also deleted former Article 22(4), which had required applicants relying on experiments, publications or exhibitions to state the disclosure at filing and submit evidence within a designated period. Since the 2017 amendment no declaration or filing-time formality is required for any form of grace period (Guidelines Section 4.8(2)). Article 16 of the Enforcement Rules lists the matters that must be stated at filing, and the grace period is not among them.

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

□ Yes
☑ No

No document is required at filing. If the examiner cites the disclosure as prior art, typically where the publication names persons other than the applicant, or where only the year or

quarter of publication is known and the presumed date falls more than 12 months before filing, the applicant must then explain the fact and date of disclosure and submit supporting evidence (Guidelines Sections 4.3, 4.5 and 4.7). The applicant may also submit this voluntarily at any time before the decision, and the examiner must consider it (Section 4.8(2)). The same applies in invalidation proceedings.

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

When required, the applicant must state the fact of disclosure and its date and attach evidence, for example the dated publication, proof of authorship or derivation, or proof that an unauthorized disclosure originated from the applicant. Where several disclosures are inseparably linked (e.g., a conference presentation and the later proceedings, an online pre-publication and the later print issue, a thesis defence and its later library deposit), evidence of the earliest disclosure suffices (Guidelines Section 4.7).

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.)

There is no filing-date deadline. Evidence is submitted when the examiner raises the issue, within the response period set in the office action (extendable), or voluntarily at any time before the decision; in invalidation proceedings it is submitted with the response to the invalidation brief.

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.)

Taiwan does not limit the grace period to disclosures that are completely or substantially identical to the claimed invention. The grace period may apply where the prior disclosure would otherwise destroy the novelty or inventive step of the claimed invention, including

disclosures of identical or substantially identical inventions or disclosures relevant to inventive step.

2) Where "Declaration as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty" has been made in a PCT application and the application enters the national phase in your country, can the applicant benefit from the grace period without any additional procedure?

□ Yes
□ No

Not applicable. Taiwan is not a PCT member.

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

Not applicable. Taiwan is not a PCT member.

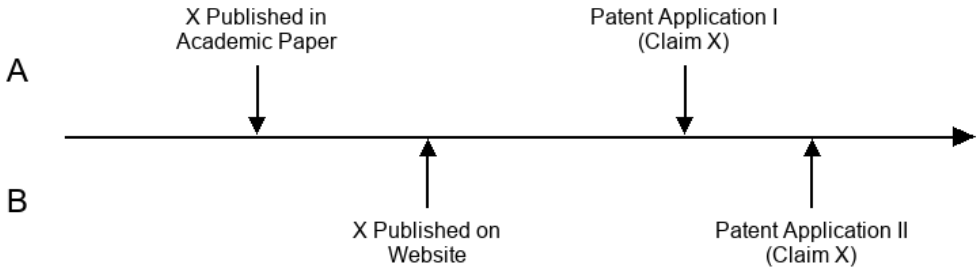
Also as above: no declaration of any kind is needed at filing in Taiwan.

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

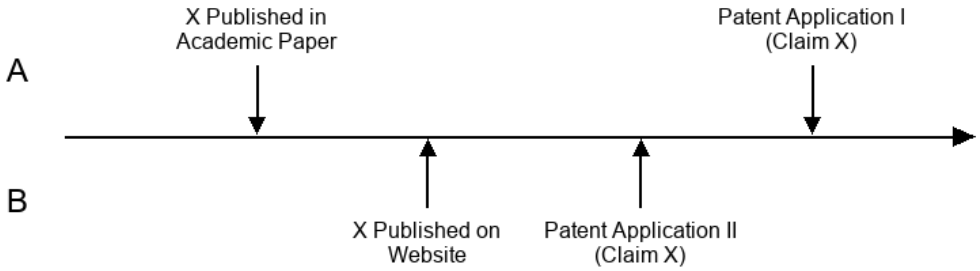
1-2) Will Patent Application II be rejected?

☑ 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

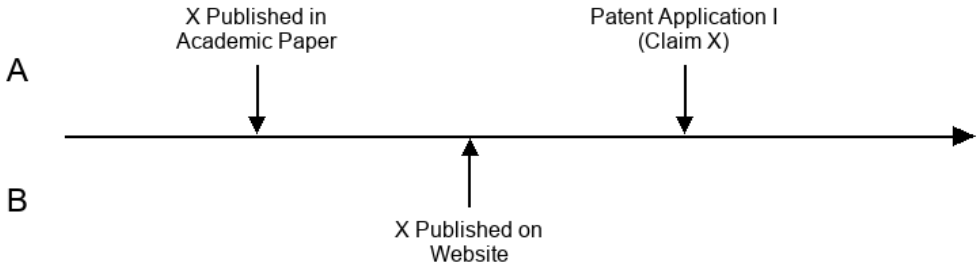
2-2) Will Patent Application II be rejected?

☑ Yes

□ No

Hypothetical 3

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?

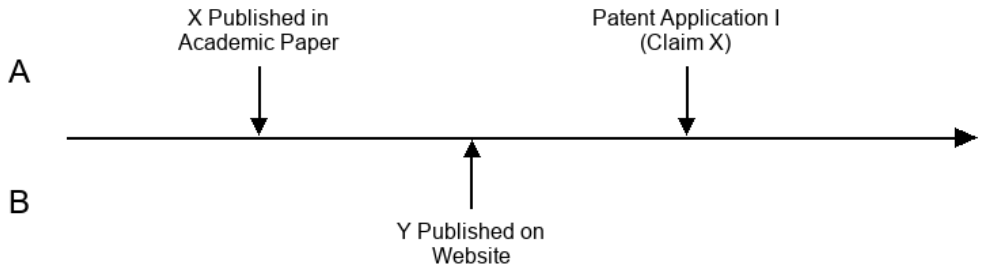
□ Yes
☑ No
□ Other

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

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

Taiwan has no express rule on a third-party publication that combines content derived from

the applicant with the third party's own contribution. In our opinion, the part of B's publication that reproduces X as derived from A's paper should be disregarded, and B's own modification is an independent disclosure and should serve as prior art (Section 4.5). Once the derived content is set aside, what remains of B's publication as prior art is only B's own modification, which does not contain the features of X. It cannot anticipate X or make it obvious, so Application I should not be rejected.

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?

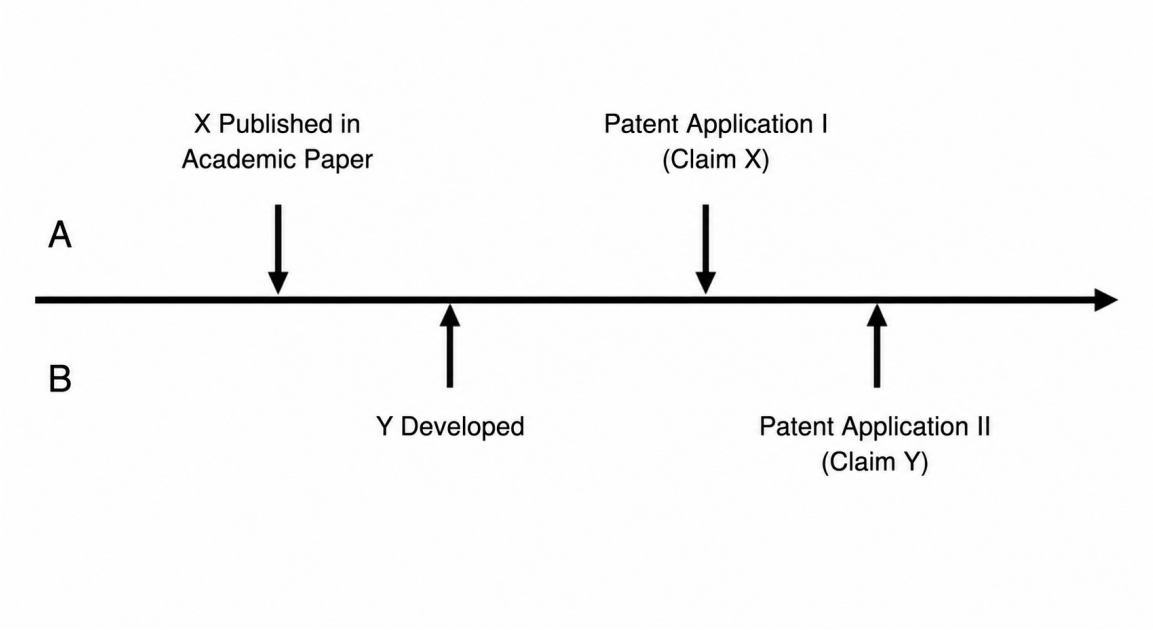
☑ Yes
□ No
□ Other

B's publication is then not attributable to A, and its whole content is prior art. Y differs from X only by changes that involve no inventive step, and going back from Y to X may normally be deemed a simple change. Application I is therefore likely to be rejected for lacking an inventive step, or for lack of novelty if B's publication also describes X.

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.



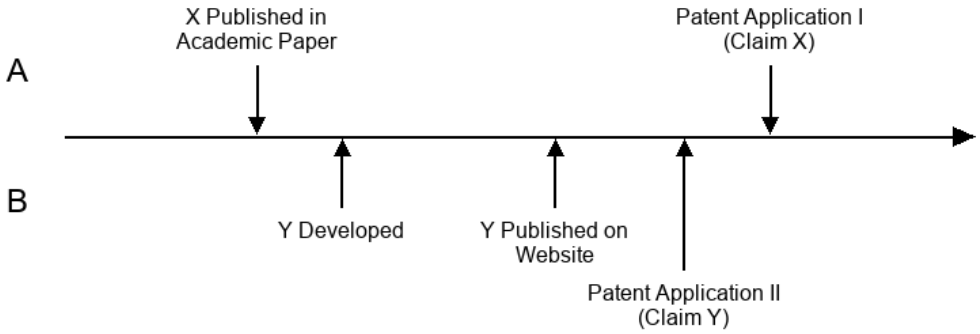

Will either patent application be rejected?

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

5-2) Will Patent Application II be rejected?
☑ Yes
□ No
□ Other

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

Similar to 4-1), B's website publication does not bar Application I. Specifically, the X content derived from A's paper is disregarded, and B's own modification does not anticipate X or make it obvious.

The remaining possible ground for rejecting Application I may be based on Article 23. That is, if the specification, claims and drawings of Application II discloses the same invention as claimed in Application I, Application I may be therefore rejected for lacking novelty by legal fiction.

6-2) Will Patent Application II be rejected?

☑ Yes

□ No

□ Other

B's own website disclosure of Y is within B's grace period and disregarded, but A's academic paper disclosing X is prior art against B, and Y lacks an inventive step over X.

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.)

Taiwan's experience since 2017 supports a broad grace period that facilitates earlier disclosure and protects applicants against unauthorized disclosures. Third parties remain protected by the prior-user right (The Patent Act, Article 59(1)(3) of the Patent Act) and by the fact that the grace period does not move the filing date.

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.)

The 12-month, form-neutral, declaration-free regime is simple to administer and rarely gives rise to disputes. The remaining uncertainty concerns third-party disclosures that mix derived and independent content (Hypotheticals 4 and 6).

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

Balance is maintained because:

(i) the grace period does not shift the reference date, so independent third-party disclosures and earlier third-party filings still defeat the application;
(ii) the prior-user right Article 59(1)(3) of the Patent Act protects good-faith implementers, except persons who learned of the invention from the applicant less than 12 months before filing where the applicant has reserved its rights; and
(iii) the gazette-publication carve-out prevents applicants from using their own earlier filings to extend protection.

The prior-user right follows Section 12 of the German Patent Act, and in 2017 its reservation window was extended from 6 to 12 months to match the grace period.

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

Academic and conference disclosure before filing is common in Taiwan, and the grace period makes such early publication possible without loss of rights.

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

This is the main practical risk. We routinely advise clients that a disclosure that is safe in Taiwan may be fatal in Europe or China. The reference date also differs: Taiwan, Europe and Japan count the grace period back from the actual filing date in each country. In the United States, the one-year grace period is measured from the effective filing date of the claimed invention. If the claim is entitled to priority to, or the benefit of, an earlier application, that date may precede the actual U.S. filing date. Hence, filing timing for the whole family must therefore be planned around the strictest jurisdiction.

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.)

Greater consistency would reduce the risk of unintended loss of patent rights in multi-jurisdictional filings. However, sufficient flexibility should be preserved for each jurisdiction to balance the interests of applicants and third parties in accordance with its patent system and policy considerations.

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.)

Form-specific lists, such as only recognized exhibitions or academic journals, are arbitrary in the age of preprints, social media and crowdfunding, and invite disputes over categorization. The only exclusion that should remain is gazette publication resulting from the applicant's own filing.

8) What duration of grace period do you consider appropriate?
□ 6 months
☑ 12 months
□ More than 12 months
□ Other
(Please provide reasons if any.)

12 months matches the Paris Convention priority year and the practice of the US, Japan, Korea and Taiwan; 6 months is too short for academic publication cycles. The TIPO draft amendment of September 2024 would likewise extend the design grace period from 6 to 12 months to harmonize with the US, Japan, Korea and the EU.

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.)

Procedures should be harmonized towards no declaration at filing, with explanation and evidence required only when the office or an opponent relies on the disclosure. Mandatory filing-time declarations with short deadlines turn a substantive safeguard into a formality trap, especially for applicants whose first filing was made abroad without awareness of the requirement.

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)

A single statement filed with the first application or in the PCT request and recognized in all designated jurisdictions would be welcome. Concerns: (i) it must not become a mandatory

precondition whose omission defeats the grace period; (ii) evidentiary standards and the treatment of derived third-party disclosures would still differ unless the substantive rules are harmonized; and (iii) jurisdictions outside the PCT, such as Taiwan, would need a parallel mechanism.

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.)

Evidence should be required where necessary to establish entitlement to the grace period, but should not be a mandatory filing requirement in every case.

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)

Measuring from the filing date gives third parties a clear and early cut-off: once 12 months have passed after a disclosure without a filing in a given country, the disclosure is prior art there. Measuring from the earliest priority date, which produces the two-year international grace period described above, is more favorable to applicants and gives one reference date for the whole family, but it extends to up to 24 months the period during which third parties cannot know whether a publication will become prior art. We consider the filing-date approach, combined with a harmonized 12-month period, to strike the better balance.