

# What options are available if I have already disclosed my invention?

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When you have developed a new product or process you need to consider seeking patent protection before publicly disclosing details of the product or process. One of the main requirements to secure a patent for an invention is that it is novel (i.e. new or not previously known) and disclosure of your invention before filing for patent protection can jeopardise this novelty.

However, some countries, including New Zealand and Australia, provide a 'grace period' which allows an applicant to file a patent application within a certain timeframe after disclosure.

## What is a grace period and how long is it?

A grace period is a provision which allows an invention to be publicly disclosed before a patent application has been filed without that disclosure affecting the validity of the patent application.

Not every country offers a grace period and the length of the grace period and eligibility requirements in those that do can vary significantly. For example, New Zealand, Australia, Canada and the United States all offer a 12 month grace period, whereas the grace period in Japan and South Korea is 6 months and China and Europe have no grace period at all.

## Which countries offer grace periods (and which don't)?

Countries that offer grace periods include:

- Australia
- Argentina
- Brazil
- Canada
- Chile
- Eurasia<sup>1</sup>
- Japan
- Malaysia
- Mexico
- New Zealand
- Russian Federation
- Taiwan
- United States

However, there is no grace period in:

- United Kingdom
- Europe
- China
- India

Grace period provisions are a tool of last resort intended to cover those circumstances where the applicant may have inadvertently disclosed their invention prior to filing a patent application (for example, by way of a non confidential disclosure to a contract designer/engineer during the course of developing an invention you propose to patent).

Because not every country offers or recognises grace periods it is generally not advisable to rely on them as a strategy for publicly disclosing your invention before filing a patent application.

### **Display at an international or industrial exhibition: a type of grace period**

Many countries also have provisions which allow an invention to be displayed (with the applicant's consent) at certain International or industrial exhibitions without affecting the novelty of the invention. In New Zealand an invention is not deemed to have been publicly disclosed if it is displayed at an exhibition that has been gazetted by the Commissioner of Patents at the Intellectual Property Office.

In order to take advantage of this provision, a patent must be filed within 6 months of the opening date of the gazetted exhibition.

The most popular gazetted exhibition in New Zealand is the National Agricultural Fieldays which is held annually at Mystery Creek in Hamilton.

Applications can be made to the Commissioner of Patents to have other international or industrial exhibition gazetted in the New Zealand Patent Office Journal.

It pays to check whether an exhibition has been gazetted before displaying your invention there.

### **Conclusion**

As a prudent inventor you should always keep your invention to yourself/secret/confidential prior to filing a patent application. However, if commercial realities necessitate public disclosure or use of your product prior to filing a patent application, then you may be saved by a grace period provision in some countries, such as New Zealand and those listed above.

However, you should only rely on grace periods as a tool of last resort and it is important that you first obtain advice from an IP professional to minimise your risks and maximise your opportunities.

### **Disclaimer**

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.

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<sup>i</sup> The Eurasian Patent Organisation covers the following countries: Turkmenistan, Republic of Belarus, Republic of Tajikistan, Russian Federation, Republic of Kazakhstan, Republic of Azerbaijan, Kyrgyz Republic, Republic of Moldova and Republic of Armenia.