

Appendix

Summary Table <ID5 Study Report on Grace Period for Industrial Designs>					
A. Overview of Grace Periods for Industrial Designs					
Question	EUIPO	JPO	KIPO	CNIPA	USPTO
A.1 Grace period available for design applications?	Yes	Yes	Yes	Yes	Yes
A.2 Length of the grace period.	12 months	12 months ¹	12 months	6 months	12 months ²
A.3 Date from which the grace period is measured.	Priority Date	Filing Date	Filing Date	Priority Date	The effective filing date (i.e., the actual filing date or the benefit/priority date)
A.4 Form of disclosures that are covered	Any public disclosure including published patent and trademark applications	Any public disclosure but not including official gazettes	Any public disclosure	Exhibits at international exhibitions sponsored or recognized by the Chinese Government or disclosures at prescribed academic or technological meetings	Any public disclosure
A.5 Type of disclosures that are covered	Disclosure made by the designer, his successor, or a third person as a result of actions taken by the designer or successor; result of abuse	Disclosure made by the designer or his successor; result of abuse	No specific provisions	Disclosure when: (1) it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government; (2) it was first made public at a prescribed academic or technological	1) Grace period inventor disclosures (2) Grace period inventor-originated disclosures (3) Intervening grace period third party disclosure

¹Article 4 of the Japanese Design Act provides the time period as “one year”. The length of prescribed grace period has been amended from 6 months to one year by the Act No.33 of May 30th, 2018.

²35 U.S.C. 102(b)(1) enumerates the time period as “1 year”, however, “12 months” is provided in the chart above to facilitate comparison amongst the ID5 Partner Offices in regard to this topic.

				meeting; or (3) it was disclosed by another person without the consent of the applicant.	
A.6 Scope of designs that are subject of the grace period	Similar disclosed designs are covered provided they do not produce a different overall impression	Any design disclosed by the creator or successor (applicant)	Any design disclosed by the inventor/creator/ applicant	Any design disclosed at a prescribed event	Any inventor or inventor-originated disclosure
A.7 Office handling when there was disclosure of two or more similar designs but an application is filed to only of the designs. In order to fully enjoy the benefits of the grace period provisions, is the applicant required to take affirmative action. If so, is it required to do so not only with respect to the identical design but also the other disclosed design(s) (e.g. similar designs) that may affect the registrability/patentability of the filed design?	There is no substantive examination of the application, however if a cancellation action is filed then the holder may raise the grace period as a defense and must demonstrate the required conditions are met. The applicant is not required to take any affirmative action at the time of filing.	Applicants are required to take the prescribed procedures not only for the identical design but also for other disclosed designs that may affect the registrability of the filed design. Applicant must include relevant information in the “proving document”.	Applicant must provide evidentiary documents including both disclosures otherwise the second similar design can be used as prior art against the claimed design.	Disclosed similar designs are regarded as the prior art of the design application.	A grace period exception applies to inventor and inventor-originated disclosures of any designs during the grace period. Inventor and inventor-originated disclosures made outside the grace period might be used in a prior art rejection against a claimed design. The applicant is not required to take any affirmative action at the time of filing; however, it may be necessary to provide information during examination.
A.8 Grace period provisions for designs by joint designers (e.g., handling of publication of design by one designer but not by another	The CDR has no specific provision. EUIPO considers that	There is no specific provision. In design	KIPO does not provide separate grace period provisions for a	There is no specific provision.	There is no specific provision. The USPTO will not

joint inventor.)	<p>the grace period equally applies if the previously disclosed designs were registered or created by joint designers, provided one of these designers is the holder of the contested Community design.</p> <p>Likewise, the grace period will apply if the previously disclosed designs were registered or created by a single designer provided this designer is one of the joint holders of the contested Community design</p>	examination practices, publication of the design by only one joint-creator will be treated as being eligible for application of the grace period.	design created by joint designers. In case the design is disclosed by one of joint designers, the grace period will be applied to protect the other joint-designers		apply a grace period disclosure as prior art if it is apparent from the disclosure itself that it is by the inventor or joint inventor.
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B. Requirements for Invoking the Grace Period During Prosecution of an Industrial Design Application before the IP Office

B.1 Affirmative action required during application process	No	Yes	Yes	Yes	<p>No requirement that the applicant take affirmative action at the time of filing a patent application</p> <p>However applicant may have to provide information during examination to establish that a grace period exception applies, such as when</p>
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B.2 Actions required	Not Applicable	Submission of a document requesting application of Article 4(2) or a statement to that effect in the application; and the submission of proving documents	Submission of documents evidencing eligibility	Submission of a declaration and certifying materials	Not Applicable There is no requirement that the applicant take affirmative action at the time of filing a patent application to identify prior disclosures that would be subject to a grace period exception.
B.3 Timing requirements	Not Applicable	Request must be made at filing; evidentiary proving documents must be filed 30 days from filing date.	Request must be made at filing; evidentiary documents must be filed 30 days from filing date.	Request must be made at filing; evidentiary documents must be filed two months from filing date.	No requirement at filing, but if raised during examination, the applicant needs to respond within the time period set forth in Office Action providing information to establish that a grace period exception applies.
B.4 Actions required for multiple disclosures	Not Applicable	In principle, all “facts of disclosure” must be stated in proving documents.	Only identification of earliest disclosure is required	Provided the disclosure occurs at a prescribed event, only identification of earliest disclosure is required	There is no requirement that the applicant take affirmative action at the time of filing a patent application to identify prior disclosures that would be subject to a grace period exception.

<p>B.5 Office handling of disclosures by a third party.</p>	<p>The grace period of Article 7(2) only covers situations where the designer or his successor consented to the disclosure by the third party.</p> <p>If the third party's disclosure was not consented by the holder of the Community design, the latter may seek defense in proving that the disclosure by the third party reflects an intention to harm or results from a fraudulent conduct.</p> <p>If the disclosure by a third party is of an independently created design, the disclosure will not be eligible for the grace period</p>	<p>The grace period applies to third party disclosures when they were made based on the prior disclosure by the creator or successor or when they were made against the will of the person having the right to obtain a design registration.</p> <p>If the disclosure by a third party is of an independently created design, the disclosure will not be eligible for the grace period.</p>	<p>Only the person who has the right to obtain a design registration (a creator or a legitimate successor) can claim the grace period for his/her design disclosed by a third person. In case a design is disclosed multiple times by a third person, the applicant is required to claim the grace period only for the earliest disclosure as long as the designs disclosed multiple times are deemed to be identical.</p>	<p>The application can enjoy the benefits of the grace period as long as the applicant can prove that the third party disclosed the design without the consent of the applicant.</p>	<p>A grace period exception may apply to intervening third party grace period disclosures. Whether the disclosure is the third party's own or was obtained from the inventor or a joint inventor affects which specific grace period exception might apply to the disclosure.</p>
<p>B.6 Documentation or evidence required of applicant to demonstrate the disclosure is covered under the grace period if a notice of rejection is issued based</p>	<p>Not Applicable.</p> <p>There is no substantive examination of the</p>	<p>The applicant was required to submit proving documents along with the application.</p>	<p>A person who intends to be eligible for the application may claim his/her intention through an</p>	<p>The applicant is required to certify that the prior art reference is the applicant's design</p>	<p>The applicant may file an affidavit or declaration under 37 CFR 1.130 to establish that a</p>

on the disclosure as prior art.	application, however if a cancellation action is filed then the holder may raise the grace period as a defense and must demonstrate the required conditions are met.	If a rejection issues because the examiner determines the proving document was uncertain or insufficient, applicant may provide a supplementary explanation or materials to prove the design complies with the prescribed requirements. In case of the disclosure against the will of the creator or its successor, submission of proving documents in responding to the examiner's notice will be allowed.	opinion form corresponds to the notification of rejection that states a publicly disclosed design as the ground for rejection. In such case, documents evidencing relevant facts shall be submitted within 30 days from the date the documents stating his/her intention are filed, before any decision regarding design registration is made	and that is was disclosed by another person without the consent of the applicant.	disclosure is not prior art due to a grace period exception
B.7 Effect of intervening disclosure	Intervening disclosure is prior art provided it is a result of independent creation and not derived from the holder's design.	Intervening disclosure is prior art unless it is clear the disclosure was based on the first disclosure of the design	Intervening disclosure is prior art unless it was derived from the owner of the design.	Intervening disclosure is prior art unless it is disclosed by another without the consent of the designer.	Intervening third party grace period disclosure is not prior art if the subject matter disclosed was previously publicly disclosed by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor.
C. Requirements and Ability for Invoking the Grace Period During the Life of the Industrial Design Rights					
C.1 Effect that later discovered	None	If not identified in	If a design was	If a disclosure is	A patentee can show

disclosure has on validity or enforceability		proving document during the application process, validity or enforceability may be affected unless such a disclosure was of a result of abuse (i.e. disclosure made against the will of the person having the right to obtain a design registration)	disclosed by the design owner and an application for is filed within 12 months of the disclosure, he/she can claim the grace period but if the registration was determined without identifying that a disclosure was made by the defendant, the design registered can be invalidated..	identified during the enforcement of the industrial design and there is no evidence could prove that the disclosure is made by another person without the consent of the industrial design owner, this design patent will be invalid	that an allegedly invalidating disclosure is not prior art because a grace period exception applies to the disclosure.
C.2 Grace period benefits can be invoked after issuance	Yes	No. Only in the case of abuse (i.e. disclosure made against the will of the person having the right to obtain a design registration)	Yes	No. Except when the design owner learns that the design was disclosure by another without the consent of the owner before the date of filing. A declaration requesting the grace period with certification materials must be filed within two months of the owner learning about the disclosure.	Yes
D. Legal Provisions Relating to Grace Period For Industrial Design Rights					
D.1 Relevant Legal Provisions	CDR Article 7	Design Act Article 4	Design Protection Act Articles 33	Article 24; Rule 30; Guidelines for Patent Examination Part I Chapter 1 (6.3), (6.3.1), (6.3.2), (6.3.3);	35 U.S.C. 100 Definitions; 35 U.S.C. 102 Conditions for patentability; novelty; 37 CFR 1.77 Arrangement of

				Guidelines For Patent Examination (2010) Part II Chapter III (5)	application elements; 37 CFR 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy Smith America Invents Act; 37 CFR 1.151 Rules applicable
D.2 Reference Links	https://euipo.europa.eu/tunnel-web/secure/webdav/quest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_design_invalidity_applications_en.pdf See Section 5.5.1.9.	Design Act (English) http://www.japaneseelawtranslation.go.jp/law/detail/?id=2846&vm=04&re=02&new=1 Ordinance for Enforcement of the Design Act (Japanese) http://law.e-gov.go.jp/htmldata/S35/S35F03801000012.html Appended Table 1 and 2 of the Ordinance for Enforcement of the Design Act (English) https://www.ipa.go.jp/tetuzuki_e/t_tokkyo_e/appended-table1_2.htm Forms of the Ordinance for Enforcement of the Design Act (Japanese) https://www.ipa.go.jp/	Design Act (English) http://elaw.klri.re.kr/ko_service/lawView.do?hseq=38408&lang=ENG Enforcement Decree of Design Protection Act (English) http://elaw.klri.re.kr/ko_service/lawView.do?hseq=39952&lang=ENG Examination Guidelines for Design (Korean) http://www.kipo.go.kr/kpo/user.tdf?sessionid=9863ca6b30d51a82eb1aeb6c4fc4a521f1ba182c0c19.e34RahyTbxmRb40LaxyPaHaRahqLe0?a=user.html.HtmlApp&c=30732&catmenu=m04_01_07 Design Map (Korean) https://www.designm	Chinese version: www.CNIPA.gov.cn/zcfg/ English version: english.CNIPA.gov.cn/laws/	“First Inventor to File (FITF) Resources” available at https://www.uspto.gov/patent/first-inventor-file-fitf-resources Manual of Patent Examining Procedure (9th ed) (Rev. 8. 2017, January 2018) available at https://www.uspto.gov/web/offices/pac/mp/ep/index.html “Consolidated Patent Laws” available at https://www.uspto.gov/web/offices/pac/mp/ep/consolidated_laws.pdf “Consolidated Patent Rules” available at https://www.uspto.gov/web/offices/pac/mp/ep/consolidated_rules.pdf

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