



## Catalogue on the Use of Grace Period for Industrial Designs

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## INTRODUCTION

ID5 is an industrial design forum that studies and develops industrial design systems and industrial design office practices and brings together in a collaborative manner the European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the National Intellectual Property Administration of the People's Republic of China (CNIPA), and the United States Patent and Trademark Office (USPTO), (hereinafter referred to as the “Partner Offices”).

Recognizing the importance of ensuring applicants are able to effectively protect their industrial design innovation from misappropriation, the Partner Offices at the Inaugural ID5 meeting in 2015 in Alexandria, VA, identified the importance of the study of the use of a grace period by design applicants in ID5 Partner offices and jurisdictions. It is well known that an effective grace period is a critical component in ensuring product designers are able to protect their new designs from misappropriation. Because commercialization of new products is inherently considered in parallel with protection of design rights in new product developed, it is not uncommon for disclosures to take place inadvertently or even despite the best efforts of creators to keep these designs from becoming public. Without an effective grace period, designs will not be able to consider whether their new product designs are worth commercializing and/or worth the investment of pursuing design protection

By better understanding current policies and practices relating to application of grace period/exceptions to lack of novelty to designs, the Partner Offices will better understand how practices converge and diverge, and how to better assist applicants in providing robust design protection for their new designs. The public will also better understand the requirements of the Partner Offices, and may better understand how to effectively file applications consistent with these practices. Finally, in understanding current practices used at counterpart Partner Offices, each of the Partner Offices can assess whether updated practices may prove to be advantageous for their own practices and for applicants seeking design protection.

Enclosed follows the results of the aforementioned study, a result of input directly from each of the Partner Offices to agreed areas and questions of focus on the topic of the effective use of a “grace period.” The JPO and USPTO were honored to serve as lead Offices in preparing this study and the attached catalogue of results from the study and thank the ID5 Partner Offices for their efforts and contributions in this project.

## **A. OVERVIEW OF GRACE PERIODS FOR INDUSTRIAL DESIGNS**

### **A.1 Do you provide for a grace period for industrial designs?**

#### **A.1.1 EUIPO**

Yes.

#### **A.1.2 JPO**

Yes.

#### **A.1.3 KIPO**

Yes.

#### **A.1.4 CNIPA**

Yes.

#### **A.1.5 USPTO**

Yes.

### **A.2 What is the length of time of the grace period for industrial designs?**

#### **A.2.1 EUIPO**

12 Months

#### **A.2.2 JPO**

12 Months<sup>1</sup>

The length of prescribed grace period was amended from 6 months to one year by the Act No.33 of May 30th, 2018. This amendment (one year grace period) is applicable for design applications filed on or after June 9th, 2018 provided that the prior disclosure at issue was made on or after December 9th, 2017 at the earliest.

#### **A.2.3 KIPO**

12 Months

#### **A.2.4 CNIPA**

6 Months

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<sup>1</sup> Article 4 of the Japanese Design Act provides the time period as “one year”.



#### **A.2.5 USPTO**

12 Months<sup>2</sup>

### **A.3 From which date is the term of the grace period computed? (e.g., actual filing date, priority date, disclosure date, etc.)**

#### **A.3.1 EUIPO**

The term of the grace period is the date of filing of the application or, if a priority is claimed, the date of priority.

#### **A.3.2 JPO**

The term of the grace period is calculated from the filing date in Japan (the priority date will not be eligible for calculation of the grace period) to the disclosure date (the date on which the design was first disclosed).

#### **A.3.3 KIPO**

The term of the grace period is calculated from the filing date in Korea (priority date is irrelevant).

#### **A.3.4 CNIPA**

The filling date (or the priority date if priority is claimed).

#### **A.3.5 USPTO**

The grace period is the 1 year time period before the effective filing date of the claimed invention (i.e., the earlier of: (1) the actual filing date of the application for the patent containing the claimed invention; or (2) the filing date of the earliest U.S. or foreign patent application to which the application is entitled to benefit or priority as to the claimed invention). See AIA 35 U.S.C. § 102(b)(1), 35 U.S.C. § 100(i), and MPEP § 2151.

### **A.4 What forms of disclosure are covered under the grace period provisions? (e.g., any public disclosure, including published patent applications, or only certain types of disclosure, such as a disclosure at an academic conference or in printed material)**

#### **A.4.1 EUIPO**

Any public disclosure including published patent or even trade mark applications, irrespective of the means and place of disclosure, provided it concerns the

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<sup>2</sup> 35 U.S.C. 102(b)(1) enumerates the time period as "1 year", however, "12 months" is provided in the response above to facilitate comparison amongst the ID5 Partner Offices in regard to this topic.

“design” (that is, the appearance of a product) for which protection is claimed. There is no restriction as to the form taken by the disclosure.

#### **A.4.2 JPO**

Grace period provisions apply to: (i) Any design that was publicly known in Japan or a foreign country, prior to the filing of the application for design registration. (There is no restriction of means of disclosure. A wide range of disclosures, for example, those for sales, exhibitions, and distribution of samples are included.)

(ii) Any design that was described in a distributed publication, or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration.

However, designs that were disclosed in official gazettes such as Design Gazettes, Patent Gazettes, and foreign gazettes are not eligible for the grace period provision.

*See* (Article 4(2) part written inside parentheses, Design Act).

#### **A.4.3 KIPO**

There are no specific types or entities of disclosure. All designs filed within 12 months of the disclosure date are covered under the grace period provisions.

However, if a design claimed in an application is published, or a registered design is publicly disclosed in the Republic of Korea or in a foreign country under a treaty or the Act (Gazette regarding patent, utility model, design, or trademarks), the exception to lack of novelty shall not be claimed.

#### **A.4.4 CNIPA**

According to Article 24, a design does not lose its novelty when one of the following events occurred:

(1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) where it was first made public at a prescribed academic or technological meeting; or

(3) where it was disclosed by another person without the consent of the applicant.

#### **A.4.5 USPTO**

The grace period provisions cover any form of public disclosure. See AIA 35 U.S.C. § 102(b)(1) and MPEP § 2152.04.

### **A.5 What is the scope of the grace period provisions (type of disclosure)? (e.g., disclosures emanating from the inventor/creator/applicant only, disclosures resulting from breach of confidence, theft or misappropriation of information, third party disclosures based on independent invention, disclosures emulating from Office publications**

**such as the “official gazette,” etc.)**

#### **A.5.1 EUIPO**

The scope of the grace period extends both to disclosures emanating from the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title (Article 7(2) CDR) and to disclosures resulting from a consequence of an abuse in relation to the designer or his successor in title (Article 7(3) CDR).

The grace period does however not cover the disclosure of third parties’ designs that are the result of an independent creation process.

The grace period needs not cover any disclosure made by a third party in breach of a confidentiality agreement because such a disclosure does not produce any legal effect and is not deemed to constitute a “disclosure” (see Art. 7(1) CDR: “The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality”).

#### **A.5.2 JPO**

The scope of the grace period provisions include:

1. A disclosure that was made against the will of the person having the right to obtain a design registration (including disclosures from breach of confidence, theft, or misappropriation of information) (Article 4(1) of the Design Act)
2. Disclosures deriving from an action conducted by the person having the right to obtain a design registration (including disclosures made by the creator or its successor (applicant)) (Article 4(2) of the Design Act).

For reference, a “person having the right to obtain a design registration” means the person having the right to obtain a design registration for the disclosed design at the time of the disclosure and indicates the creator or its successor of the design.

It should be noted that designs that were disclosed in official gazettes such as Design Gazettes, Patent Gazettes, and foreign gazettes, are not eligible for the grace period provision.

#### **A.5.3 KIPO**

The scope of grace period provisions include;

- (1) an application shall be filed by a person who has the right to obtain a design registration at the time when a design is publicly disclosed or a person who succeeds the right after public disclosure.

In this case, no matter by whom the design is disclosed, even if it is disclosed by a third person, the design right holder can claim the grace period.

(2) if a design is publicly disclosed by more than one person, one of them shall be an applicant.

*See Article 36 of the Design Protection Act.*

#### **A.5.4 CNIPA**

The following three forms of disclosure are covered under the grace period provisions:

- (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 meeting; or
- (3) it was disclosed by another person without the consent of the applicant.

#### **A.5.5 USPTO**

The grace period provisions pertain to the following types of disclosures:

- (1) disclosures by the inventor or a joint inventor made one year or less before the effective filing date of the claimed invention (“grace period inventor disclosures”);
- (2) disclosures by someone who obtained the subject matter from the inventor or a joint inventor made one year or less before the effective filing date of the claimed invention (“grace period inventor-originated disclosures”); and
- (3) disclosures of subject matter by a third party made one year or less before the effective filing date of the claimed invention that occurred after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor (“intervening grace period third party disclosures”).

See MPEP §§ 2153.01 and 2153.02.

An “inventor” is the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. A “joint inventor” or “coinventor” is any one of the individuals who invented or discovered the subject matter of a joint invention. See AIA 35 U.S.C. 100 and MPEP § 2151. As used in this document and related USPTO resources (see Answer D.2.5), a “third party” is an individual with no direct or indirect connection to the inventor or a joint inventor.

### **A.6 What is the scope of the designs that become the subject of the grace period provisions? (e.g., the same designs only, similar designs only, same and similar designs, or any design emanating from the inventor/creator/applicant as the design that is filed for design registration/patent).**

### **A.6.1 EUIPO**

The grace period is an immunity attached to the filing of the design. Thus, a strict interpretation would require that this period be applicable only where the disclosed design and the design filed for registration are strictly identical. This would be dictated by a literal reading of Article 7(2) CDR, which only refers to the previous disclosure of the « design for which protection is claimed under a registered Community design »

Nonetheless, Article 7(2) CDR expressly refers to Article 6 CDR on individual character. This reference suggests that a registered design is also protected against the disclosure of a similar design, even though not identical, which does not produce a different overall impression. According to EUIPO's interpretation, if the immunity only concerned strictly identical designs (which destroy novelty pursuant to Article 5 CDR), the reference to Article 6 would be unnecessary (EUIPO, Board of Appeal, 2 Mai 2011, Case R 658/2010-3, « Lighting devices », para. 40).

### **A.6.2 JPO**

Under the grace period provision of the Japanese Design Act (Article 4), any design emanating from the creator or its successor (applicant) regardless of the identity, similarity and creativity in relation to the filed design becomes the subject of the grace period provision. This is to avoid undesirable refusal and invalidation in accordance with Article 3(1) and (2) of the Design Act e.g. where two or more similar designs etc. were disclosed at a time and these designs prevent novelty (incl. similarity) and/or creativity one another.

### **A.6.3 KIPO**

When it comes to claiming the grace period, it doesn't matter whether a design in an application is identical with or similar to a publicly disclosed design in an evidentiary document.

### **A.6.4 CNIPA**

Identical designs and substantially identical designs are considered in grace period considerations.

### **A.6.5 USPTO**

Under AIA 35 U.S.C. § 102(b)(1)(A), inventor and inventor-originated disclosures made 1 year or less before the effective filing date of a claimed invention shall not be prior art with respect to the claimed invention. The AIA 35 U.S.C. § 102(b)(1)(A) grace period exception applies to inventor and inventor-originated disclosures of any designs during the grace period. See MPEP § 2151.

**A.7 If two or more similar designs were disclosed by the inventor/creator/applicant and a design application is filed as to one of those designs only, how does your Office handle the application? Does your Office reject the application because of the similarity/non-obviousness based on the disclosure of the other similar design(s) than the filed design? In order to fully enjoy the benefits of the grace period provisions, is the applicant required to take affirmative action as to not only the identical design but also the other disclosed design(s) (e.g. similar designs) that may affect the registration or patentability of the filed design?**

#### **A.7.1 EUIPO**

EUIPO does not carry out an examination of the protection requirements applying to design applications, including novelty and individual character. If a cancellation action filed by a third party is based on the previous designs registered or used by the (contested) design holder, this holder may raise as a defense the grace period, provided the conditions set out in Article 7(2) apply, namely:

- the holder's previous designs were disclosed less than 12 months before the filing date or priority date of the contested design;
- the holder is either the creator of the previously disclosed designs or the successor in title of that creator (General Court UE, 14 June 2011, Case T-68/10, para. 26);
- the holder's previous designs and the holder's contested designs are identical or do not produce a different overall impression.

The Office does not have to examine *ex officio* the reasons that could render a disclosure ineffective that is, covered by the grace period. If the defendant does not prove that the grace period applies and does not deprive the disclosure of the holder's previous designs from novelty-destroying consequences, the Office shall assume that the disclosure is effective.

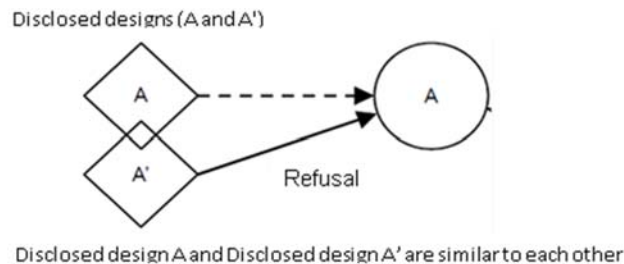
#### **A.7.2 JPO**

In order to fully enjoy the benefits of the grace period provisions, 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.

For example, when design A and design A' that are similar to each other are disclosed prior to filing a design application of the design A (design application A), if only the disclosed design A is stated in the "proving document" seeking for application of the provision of Article 4(2) (grace period provision) of the Design Act for the design application A, only the disclosed design A will be deemed as not falling under a publicly known design due to the application of the grace period provision.

As the disclosed design A' that was not stated in the “proving document” will be deemed as a publicly known design due to no application of the grace period provision, design A in the design application A that is similar to the disclosed design A' will fall under the provision of Article 3(1)(iii) (design similar to a publicly known design) of the Design Act and cannot be registered.

It should be noted that, if both disclosed designs A and A' are stated in the “proving document” for the design application A in the prescribed manner, as both disclosed designs A and A' will not fall under a publicly known design due to the application of the grace period provision, the abovementioned reason for refusal (design similar to a publicly known design) will not be alleged.



### A.7.3 KIPO

If Design A and Design A' which are similar to each other are disclosed, a person who has the right to obtain a design registration is required to claim the grace period for both designs within 12 months from the disclosure to fully enjoy the benefits of the grace period. The applicant needs to provide evidentiary documents against A and A' that show when and where the filed design was disclosed.

If the applicant provides evidentiary documents only against A, the filed Design A can be rejected on the ground of A'. To claim the grace period, the applicant needs to submit additional evidentiary documents against A' before determination on whether to accept design registration is made.

### A.7.4 CNIPA

The disclosed similar designs are regarded as prior art to the design application and may be considered in examination to determine patentability.

### A.7.5 USPTO

The AIA 35 U.S.C. § 102(b)(1)(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 under AIA 35 U.S.C. § 102 and/or 103 against a claimed design. See § MPEP 2151.

The applicant does not need to take affirmative action at the time of filing a patent application to identify prior disclosures that would be subject to a grace period

exception. However, it might be necessary for the applicant to provide information during examination to establish that a grace period exception applies, such as when USPTO personnel apply a grace period disclosure as prior art in a rejection under AIA 35 U.S.C. § 102(a)(1).

## **A.8 Does your Office provide separate grace period provisions if a design is created by joint designers? How does your office handle the publication of the design by one joint-designer but not by another joint-designer?**

### **A.8.1 EUIPO**

The Community Design Regulation (CDR) does not provide separate grace period provisions if a design is created by joint designers. The holder of the contested Community design which relies on the grace period must be either the creator of the previously disclosed designs or the successor in title of that creator.

EUIPO considers that 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. 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.

### **A.8.2 JPO**

There is no particular provision for a jointly created design under the grace period provision (Article 4, Design Act). In design examination practices, publication of the design by only one joint-creator will be treated as being eligible for the application of the grace period provision.

### **A.8.3 KIPO**

KIPO does not provide separate grace period provisions for a 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.

### **A.8.4 CNIPA**

It has not been explicitly stipulated in the Guidelines for Patent Examination.

### **A.8.5 USPTO**

No, the USPTO does not provide separate grace period provisions if a design is created by joint designers. USPTO personnel will not apply a grace period disclosure as prior art in a rejection under AIA 35 U.S.C. § 102(a)(1) if it is apparent from the disclosure itself that it is by the inventor or a joint inventor. For



example, where an application names as joint inventors A and B, and a publication one year or less before the effective filing date only names B as the author, it is apparent that the publication is a grace period inventor disclosure, and the publication would not be applied as prior art under AIA 35 U.S.C. § 102(a)(1). See MPEP § 2153.01(a).

## **B. REQUIREMENTS FOR INVOKING THE GRACE PERIOD DURING PROSECUTION OF AN INDUSTRIAL DESIGN APPLICATION BEFORE THE IP OFFICE**

### **B.1 Are applicants required to take affirmative action during the application process with your Office to receive the benefit of the grace period [affirmative action required] or do they receive the benefit of the grace period automatically as a matter of right [no affirmative action required]?**

#### **B.1.1 EUIPO**

No need for affirmative action as EUIPO does not carry out an *ex officio* examination of novelty.

Community design holders may rely on the provisions of Article 7(2) and 7(3) CDR as a defence in invalidity actions (or in the context of counterclaims in infringement actions) where the relevant prior art was disclosed during the grace period.

#### **B.1.2 JPO**

Affirmative action is required.

#### **B.1.3 KIPO**

Affirmative action is required.

#### **B.1.4 CNIPA**

Applicants are required to take affirmative action in order to receive the benefit of the grace period.

#### **B.1.5 USPTO**

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. However, it might be necessary for the applicant to provide information during examination to establish that a grace period exception applies, such as when USPTO personnel apply a grace period disclosure as prior art in a rejection under AIA 35 U.S.C. §102(a)(1).

Applicants also have the option of including a statement designating any grace period inventor disclosures in the specification. *See* 37 CFR 1.77(b)(6). An applicant is not required to use the format specified in 37 CFR 1.77 or identify any prior disclosures by the inventor or a joint inventor (unless necessary to overcome a rejection), but identifying any prior disclosures by the inventor or a joint inventor may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification contains a specific reference to a grace period inventor disclosure, the USPTO will consider it apparent from the specification that the prior disclosure is by the inventor or a joint inventor, provided that the prior disclosure does not name additional authors or joint inventors and there is no other evidence to the contrary. The applicant may also provide a copy of the grace period inventor disclosure (e.g., copy of a printed publication). *See* MPEP § 2153.01(a).

## **B.2 If affirmative action is required, what action must be taken and what are the formal requirements for this action (e.g., declarations, certifications)?**

### **B.2.1 EUIPO**

Not Applicable.

### **B.2.2 JPO**

[Declarations]

Applicants must submit a document stating a request for the application of the provision of Article 4(2) of the Design Act to the Commissioner of the Patent Office upon filing the application for design registration (Article 4(3) of the Design Act).

The submission of the document may be omitted by including a statement to that effect in the application for design registration in lieu of the submission of said document (Article 27-4 of the Ordinance for Enforcement of the Patent Act applied *mutatis mutandis* pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act).

[Certifications]

Applicants must also submit a document proving that the disclosed design is a design that is subject to application of the provision of Article 4(2) of the Design Act to the Commissioner of the Patent Office (Article 4(3) of the Design Act).

### **B.2.3 KIPO**

Before a notice of a determination to reject an application for design registration or a decision to accept the registration of a design is served, applicants shall submit a document stating his/her intention to the Commissioner of the Korean

Intellectual Property Office along with documents evidencing his/her eligibility for such grace period. The documents should be submitted within 30 days from the filing date and/or before the determination on whether to accept design registration is made.

Any person who intends to seek the benefit of the grace period shall submit a document stating his/her intention to the Commissioner of the KIPO or the President of the Intellectual Property Trial and Appeal Board, along with documents evidencing his/her eligibility.

Such documents shall be submitted in accordance with the Enforcement Rule of the Patent Act (Form13). If an applicant indicates the intension in an application when filing a design registration, he/she does not need to submit the documents proving his/her eligibility for the grace period.

#### **B.2.4 CNIPA**

Where an invention-creation for which a patent is applied for was first exhibited at an international exhibition sponsored or recognized by the Chinese Government within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

Where an invention-creation for which a patent is applied for was first made public at a prescribed academic or technological meeting within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

Where an invention-creation for which a patent is applied for is disclosed by another person without the consent of the applicant within six months before the date of filing, if the applicant knows about it before the date of filing, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date. If the applicant knows about the matter after the date of filing, he shall submit a declaration to request for the grace period concerning novelty with certifying materials within two months after he knows about it.

#### **B.2.5 USPTO**

Not Applicable.

### **B.3 If affirmative action is required, when must such action be taken?**

### **B.3.1 EUIPO**

Not Applicable.

### **B.3.2 JPO**

Submission of a document stating a request for the application of the provision of Article 4(2) of the Design Act (grace period) must be made at the same time as filing a design application. (It is possible to include a statement to that effect in the application in lieu of submission of the said document.)

In addition, submission of a proving document must be made within 30 days from the filing date of the design application. *See* (Article 4(3), Design Act)

### **B.3.3 KIPO**

Any person who wishes to seek the benefit of the grace period shall submit a document stating his/her intention to the Commissioner of the KIPO or the President of the Intellectual Property Trial and Appeal Board, along with documents evidencing his/her eligibility, at any of the following times:

1. When a person files an application for design registration under Article 37; in which cases, documents evidencing relevant facts shall be submitted within 30 days from the filing date of the application for design registration;
2. Before a notice of rejection or registration is dispatched for the determinations to reject applications for design registration under Article 62 or determinations of design registration under Article 65 (hereinafter referred to as “determination regarding design registration”); in which cases, documents evidencing relevant facts shall be submitted both within 30 days from the date the documents stating his/her intention are filed and before any determination regarding design registration is made;
3. When a person submits a written reply to a written opposition to registration of a partially-examined design under Article 68 (3);
4. When a person submits a written reply to a petition for an administrative patent trial under Article 134 (1) (limited to an administrative patent trial on the invalidation of registration of a design).

### **B.3.4 CNIPA**

The applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

### **B.3.5 USPTO**

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.

However, if during examination USPTO personnel apply a grace period disclosure as prior art in a rejection under AIA 35 U.S.C. § 102(a)(1), in order to traverse the rejection on the grounds that the disclosure is a grace period disclosure, the applicant would need to file a response within the time period set forth in the Office action providing information to establish that a grace period exception applies.

## **B.4 If affirmative action is required, how does your Office handle a design that has multiple disclosures? Does the Office require the Applicant to identify each disclosure? Does it matter if the multiple disclosures are in different medium?**

### **B.4.1 EUIPO**

Not Applicable.

### **B.4.2 JPO**

Where multiple disclosures resulting from actions conducted by the person having the right to obtain a design registration, as a general rule, in order for the provision of Article 4(2) of the Design Act (grace period) to be applied, all the “facts of disclosure” have to be respectively stated in the “proving document”.

However, when the person having the right to obtain a design registration has, prior to filing the design application, disclosed the design multiple times based on the first disclosure, if the provision of Article 4(2) of the Design Act (grace period) applies to the first disclosure, the design will not be handled as a publicly known design due to the second and subsequent disclosures regardless of the presence of a proof.

Examples

Ex. 1: Where the person having the right to obtain a design registration delivered the same product to the same customer multiple times, the disclosures of the design by the second and subsequent deliveries.

Ex. 2: Where the person having the right to obtain a design registration already disclosed the design by distributing a catalogue that lists the product to the customer, the disclosures of the design as the second time or subsequently by delivering the product upon order by the customer.

*See (Part III 31.1.4.1 (1), Examination Guidelines for Design)*

#### **B.4.3 KIPO**

If a design is disclosed multiple times, applicants are required to identify only the earliest disclosure and can claim the grace period in accordance with procedures. If the subject matter is considered identical with the earliest and the other disclosures, the grace period will be extended to the other disclosed designs (Supreme Court 2014 hu 1341)

An applicant needs to submit a document that states he/she is the owner of the cited disclosed design along with evidentiary information on how, when and by whom the design was disclosed along with drawings that can objectively support the statement. There are no specific types of evidence. (e.g. catalogues or photos of exhibitions, publication dates and photos, and website captures with dates, etc. are acceptable).

#### **B.4.4 CNIPA**

If, within six months from the date on which any of the events described in Article 24 occurred and before the applicant files the application, the invention-creation was disclosed once again, provided that the disclosure does not belong to any of the prescribed events, the later disclosure will not be eligible for grace period and may be considered as prior art in considering novelty of the application. However, if the later disclosure falls into any of the three prescribed grace period eligible disclosures, the application does not lose novelty because of this later disclosure, but the grace period shall be calculated from the date of the first disclosure.

#### **B.4.5 USPTO**

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. The grace period exceptions under AIA 35 U.S.C. § 102(b)(1) apply to any number of grace period disclosures and, as indicated in Answer A.4.5, cover any form of public disclosure.

### **B.5 If one of the multiple disclosures of the design was made by a third party other than the inventor/creator/applicant, can the applicant still enjoy the benefits of the grace period? Is affirmative action required in this case? Are there any requirements for permission? Does it matter whether the third party disclosure is derived from the inventor/creator/applicant or disclosed through independent creation?**

#### **B.5.1 EUIPO**

Contrary to the immunity granted by a priority claim, **Article 7(2)** CDR only covers situations where the designer or his successor in title *consented* to the disclosure of the design. Thus, the grace period applies to acts of disclosure made

“by a third person as a result of information provided or action taken by the designer or his successor in title”.

In this case, the holder of the contested Community design must prove that he had consented to the disclosure by the third party in question (Article 7(2) CDR). Consent does not require that the third party who disclosed the holder’s designs is derived from the inventor/creator/applicant. Existing links between the party may however ease the proof of consent. Proof of permission or consent can be established by any means.

If the third party’s disclosure was not consented by the holder of the contested Community design, the latter may seek defence in proving that the disclosure by this third party reflects an intention to harm or results from a fraudulent conduct (see notion of “abuse” in **Article 7(3)** CDR). A fraudulent conduct may be established where the person who disclosed the design was aware that the designer or his successor would incur damages because of the disclosure (EUIPO, Board of Appeal, 25 October 2013, Case R 1304/2012-3, « Cajas plegables », para. 14-15).

The grace period does however not cover the disclosure of third parties’ designs that are the result of an independent creation process.

### **B.5.2 JPO**

There are cases where an applicant can enjoy the benefits of the grace period provision even when one of the multiple disclosures of the design was made by a third party other than the creator or its successor (applicant).

#### **Examples**

Ex.1: When disclosure by a third party was made based on the prior disclosure by the creator or its successor  
(e.g., Disclosure of the design as exhibition information in a newspaper that is based on the disclosure of the design (display) in a trade fair by the person having the right to obtain a design registration.) See Answer B.7.5.

Ex.2: When disclosure by a third party was made against the will of the person having the right to obtain a design registration.  
(e.g., Disclosure of the design by an exposé article.)

For cases stated in above Ex.1, applicants should take procedures to prove the fact of disclosure by third parties to the extent applicants are aware of.

For cases stated in above Ex. 2, applicants do not have to take procedures to prove the fact at the time of filing. It is possible for applicants to explain and proof the fact subsequently, for example, in responding to the reasons for refusal notified by the examiner that cites the disclosure of the design in question.

If the disclosure by a third party is a disclosure of an independently created design that is not derived from the creator of the design in the design application, such

disclosure will not be eligible for the application of the grace period provision to that design application.

### **B.5.3 KIPO**

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.

### **B.5.4 CNIPA**

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.

### **B.5.5 USPTO**

AIA 35 U.S.C. § 102(b)(1)(B) provides that an intervening third party grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

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. However, if during examination USPTO personnel apply a grace period disclosure as prior art in a rejection under AIA 35 U.S.C. § 102(a)(1), in order to traverse the rejection on the grounds that the disclosure is a grace period disclosure, the applicant would need to file a response within the time period set forth in the Office action providing information to establish that a grace period exception applies.

Whether the disclosure is the third party's<sup>3</sup> own or was obtained from the inventor or a joint inventor affects which grace period exception might apply to the disclosure.

The AIA 35 U.S.C. § 102(b)(1)(B) grace period exception applies to intervening third party grace period disclosures. The AIA 35 U.S.C. § 102(b)(1)(A) grace period exception, on the other hand, applies to disclosures by someone who obtained the subject matter from the inventor or a joint inventor made one year or less before the effective filing date of the claimed invention.

## **B.6 If your Office issues a notice of rejection based on a prior art reference,**

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<sup>3</sup> A "third party" is someone who disclosed subject matter but did not obtain it, directly or indirectly, from a member of the inventive entity.



## **what is an applicant required to provide to the IP Office to show the prior art reference is covered under the grace period provisions?**

### **B.6.1 EUIPO**

EUIPO does not carry out an examination of the protection requirements applying to design applications, including novelty and individual character. If a cancellation action filed by a third party is based on the previous designs registered or used by the (contested) design holder, this holder may raise as a defense the grace period, provided the conditions set out in Article 7(2) or 7(3) apply, namely:

- the holder's previous designs were disclosed less than 12 months before the filing date or priority date of the contested design;
- the holder is either the creator of the previously disclosed designs or the successor in title of that creator (General Court UE, 14 June 2011, Case T-68/10, para. 26);
- if the disclosure was made by a third party, this disclosure is the result of information provided or action taken by the designer or his successor in title (Art. 7(2) CDR) or is the result of an abuse (Article 7(3) CDR);
- the holder's previous designs and the holder's contested designs are identical or do not produce a different overall impression.

The Office does not have to examine *ex officio* the reasons that could render a disclosure ineffective that is, covered by the grace period. If the defendant does not prove that the grace period applies and does not deprive the disclosure of the holder's previous designs from novelty-destroying consequences, the Office shall assume that the disclosure is effective.

### **B.6.2 JPO**

If a "proving document" that includes the published design in question has duly been submitted, the examiner will not notify a reason for refusal that cites the published design, as the provision of Article 4(2) of the Design Act (grace period) will apply to the case.

In cases where the published design cited as a basis for the reason for refusal is not stated in the "proving document" or where the "proving document" itself was not duly submitted, the applicant is not allowed to supplement the "proving document" afterwards (after the reason for refusal was notified).

If the examiner decides that the provision of Article 4(2) of the Design Act (grace period) cannot be applied due to the fact that the content of the "proving document" is uncertain or is insufficient (e.g., uncertainty of whether the person having the right to obtain a design registration disclosed the design or not), the examiner will send a notification of reasons for refusal that cites the published design. The applicant may make a supplementary explanation or submit supplementary materials to prove that the design complies with the prescribed

requirements in arguing against the reason for refusal, provided that such a supplement is within the "facts of disclosure" stated in the "proving document".

If the published design was disclosed against the will of the person having the right to obtain a design registration, it is possible for the applicant to explain and proof the fact subsequently, in responding to the reasons for refusal notified by the examiner that cites the disclosure of the design in question.

Where disclosure was made by a third party against the will of the person having the right to obtain a design registration (e.g., disclosure of the design by an exposé article.), it is possible for the applicant to explain and proof the fact in responding to the reasons for refusal notified by the examiner that cites the disclosure of the design in question.

### **B.6.3 KIPO**

A person who intends to be eligible for the application may claim his/her intention through an 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.

### **B.6.4 CNIPA**

Applicant is required to take affirmative action in order to receive the benefit of the grace period except when the design was disclosed by another person without the consent of the applicant. In this case, the applicant shall certify that the prior art reference is the design disclosed by another person without the consent of the applicant.

### **B.6.5 USPTO**

The USPTO has provided a mechanism for filing an affidavit or declaration under 37 CFR 1.130 to establish that a disclosure is not prior art under AIA 35 U.S.C. § 102(a)(1) due to an exception in AIA 35 U.S.C. § 102(b)(1) as follows:

(1) AIA 35 U.S.C. § 102(b)(1)(A) provides that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the disclosure was made by the inventor or a joint inventor. An applicant may show that a disclosure was made by the inventor or a joint inventor by way of an affidavit or declaration under 37 CFR 1.130(a) ("affidavit or declaration of attribution"). *See* MPEP § 2155.01.

(2) AIA 35 U.S.C. § 102(b)(1)(A) also provides that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the disclosure was made by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An applicant may show that another obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor in an affidavit or declaration under 37 CFR 1.130(a). *See* MPEP § 2155.03.

(3) AIA 35 U.S.C. § 102(b)(1)(B) provides that an intervening third party grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor. An applicant may show that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the intervening third party grace period disclosure of the subject matter on which the rejection was based by way of an affidavit or declaration under 37 CFR 1.130(b) (“affidavit or declaration of prior public disclosure”). See MPEP § 2155.02.

(4) AIA 35 U.S.C. § 102(b)(1)(B) also provides that an intervening third party grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the subject matter disclosed had, before such disclosure, been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An applicant may show that the subject matter disclosed had been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the intervening third party grace period disclosure of the subject matter on which the rejection was based by way of an affidavit or declaration under 37 CFR 1.130(b). See MPEP § 2155.03.

## **B.7 What is the effect of an intervening disclosure that is made by a third party between a properly graced disclosure and the filing date of the industrial design? Does it matter whether the intervening disclosure is the same or similar to the properly graced disclosure? Does it matter whether the third party disclosure is derived from the inventor/creator/applicant or disclosed through independent creation?**

### **B.7.1 EUIPO**

An intervening disclosure that is made by a third party between a properly graced disclosure and the filing date of the industrial design may have novelty-destroying effects if the third parties’ designs are the result of an *independent creation process*. Then, the grace period does not apply, irrespective of whether the third party’s design is identical or only similar to holder’s contested design.

The grace period is not a period of full immunity, contrary to the priority period. Any other interpretation would artificially extend beyond the 6-month period provided for in Article 41 CDR the immunity granted by the priority claim.

If the disclosure that is made by a third party is derived from the holder’s contested design, such a disclosure may be covered by the grace period if it is the result of “information provided or action taken by the designer or his successor in title” (Article 7(2) CDR) or if it is the result of an “abuse in relation to the designer or his successor in title” (Article 7(3) CDR).

### **B.7.2 JPO**

In cases where a third party disclosed the same design as or similar design to the design disclosed by the act of the creator or its successor between the time when the design was first disclosed and the design application was filed, the design will

be deemed as having lost its novelty by the third party's intervening disclosure, as a general rule.

However, in the case where it was clear that the disclosure by the third party was based on the first disclosure of the design, in spite of the disclosure by the third party, the design will not be deemed as having lost its novelty.

"The case where it was clear that the disclosure by the third party was based on the first disclosure of the design" refers to the following, for example;

Ex.1: Disclosure of the design on a website by a third party that is based on the disclosure of the design (selling of a product bearing the design) by the person having the right to obtain a design registration.

Ex.2: Disclosure of the design as exhibition information in a newspaper that is based on the disclosure of the design (display) in a trade fair by the person having the right to obtain a design registration.

*See* (Part III 31.1.4.1 (2), Examination Guidelines for Design)

If the disclosure by a third party is a disclosure of an independently created design that is not derived from the creator of the design in the design application, such disclosure will not be eligible for the application of the grace period provision to that design application.

### **B.7.3 KIPO**

If the disclosed design is owned by the applicant (a creator), even if it was disclosed by a third person, the applicant can claim the grace period for the design. However, if an independently created design is disclosed by a third party, the applicant cannot claim the grace period for it.

### **B.7.4 CNIPA**

The design is lack of novelty because of the intervening disclosure, unless the disclosure can be certified that it is disclosed by another person without the consent of the designer.

### **B.7.5 USPTO**

AIA 35 U.S.C. § 102(b)(1)(B) provides that an intervening third party grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. § 102(a)(1) if the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor ("inventor-originated prior public disclosure").

What is required for subject matter in an intervening third party grace period disclosure to be excepted under AIA 35 U.S.C. § 102(b)(1)(B) is that the subject matter of the disclosure to be disqualified as prior art must have been previously publicly disclosed by the inventor or a joint inventor or by another who obtained

the subject matter therefrom. Even if an intervening grace period disclosure by a third party is obvious over an inventor-originated prior public disclosure, this is not a disclosure of the same subject matter and the AIA 35 U.S.C. § 102(b)(1)(B) exception does not apply. Although the same "subject matter" must be disclosed, there is no requirement that the inventor-originated prior public disclosure and the third party's intervening grace period disclosure be made in the same manner or that the two disclosures be identical.

Whether the disclosure is the third party's own or was obtained from the inventor or a joint inventor affects which grace period exception might apply to the disclosure. The AIA 35 U.S.C. § 102(b)(1)(B) grace period exception applies to intervening third party grace period disclosures. The AIA 35 U.S.C. § 102(b)(1)(A) grace period exception, on the other hand, applies to disclosures by someone who obtained the subject matter from the inventor or a joint inventor made one year or less before the effective filing date of the claimed invention.

## **C. REQUIREMENTS AND ABILITY FOR INVOKING THE GRACE PERIOD DURING THE LIFE OF THE INDUSTRIAL DESIGN RIGHTS**

### **C.1 During the enforcement of the industrial design, if a disclosure that occurred during the grace period is identified (and which is entitled to have been “graced”), what effect will that disclosure have on the validity or enforceability of the industrial design rights? Can the design rights holder invoke the grace period during enforcement proceedings for the first time, if a new novelty defeating disclosure is identified by the defendant in those proceedings?**

#### **C.1.1 EUIPO**

No consequence on the validity and enforceability as the disclosure of an earlier design which is “graced” does not produce any legal effect. The design rights holder invokes the grace period during enforcement proceedings. Since EUIPO does not examine novelty during the registration process, the issue of the novelty of a Community design will only be raised in the course of infringement proceedings before a national court, or in the course of requests for invalidity before EUIPO.

#### **C.1.2 JPO**

When a disclosure during the grace period is identified during enforcement of a design right, if the identified disclosure was not stated in the “proving document” or the “proving document” itself was not duly submitted in accordance with the provision of Article 4(3) of the Design Act in the filing procedure before the Office, there is a possibility that the validity or the enforceability of the design right will be affected, as it is not allowed to supplement them afterwards.

However, if the identified disclosure was a disclosure made against the will of the person having the right to obtain a design registration, it is possible for the right owner to explain and prove the fact subsequently. In this case, the validity or the enforceability of the design right will not be affected.

### **C.1.3 KIPO**

If a design was disclosed by the design owner and an application for the registration of the design 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.

### **C.1.4 CNIPA**

If a disclosure is 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.

### **C.1.5 USPTO**

A patentee can show that an allegedly invalidating disclosure is not prior art under AIA 35 U.S.C. § 102(a)(1) because an AIA 35 U.S.C. § 102(b)(1) grace period exception applies to the disclosure.

## **C.2 Can the benefits of the grace period provisions be invoked after the design rights have issued? Does the industrial design owner have to take any affirmative actions?**

### **C.2.1 EUIPO**

Since EUIPO does not carry out an *ex officio* examination of novelty, Community design holders may only rely on the provisions of Article 7(2) and 7(3) CDR as a defence in invalidity actions (or in the context of counterclaims in infringement actions) where the relevant prior art was disclosed during the grace period.

The burden of proof that the disclosure was ineffective and covered by Article 7(2) or 7(3) CDR rests on the defendant that is, the Community design holder the validity of which is challenged.

This holder may raise as a defense the grace period, and submit proof that the conditions set out in Article 7(2) or 7(3) apply, namely:

- the holder's previous designs were disclosed less than 12 months before the filing date or priority date of the contested design;

- the holder is either the creator of the previously disclosed designs or the successor in title of that creator (General Court UE, 14 June 2011, Case T-68/10, para. 26);
- if the disclosure was made by a third party, this disclosure is the result of information provided or action taken by the designer or his successor in title (Art. 7(2) CDR) or is the result of an abuse (Article 7(3) CDR);

the holder's previous designs and the holder's contested designs are identical or do not produce a different overall impression.

### **C.2.2 JPO**

In order to receive the benefit of the provision of Article 4(2) of the Design Act (grace period), it is necessary to request the application of the provision at the same time as filing the design application and submit a "proving document" to the Commissioner of the JPO within 30 days from the filing date of the design application (Article 4(3), Design Act). These are the procedures that have to be taken at the stage of filing an application. It is not allowed to request the application of the provision of Article 4(2) of the Design Act (grace period), submit a "proving document", or add "facts of disclosure" after the design rights have been established.

If the disclosure was made against the will of the person having the right to obtain a design right (Article 4(1), Design Act), it is possible for the right owner to explain and prove the fact subsequently.

### **C.2.3 KIPO**

Even after the design rights are issued, if the grace period is claimed when a person submits a written reply to an opposition appeal to registration of a partially-examined; and when a person submits a written reply to a petition for an administrative patent trial (limited to an administrative patent trial on the invalidation of registration of a design), it can be accepted, no matter how and by who the design was disclosed if the design is owned by the applicant (a creator). (e.g. regardless of whether or not the design was disclosed by an applicant or a third party, or against his/her will).

*See Design Protection Act, Article 36 (Exception to Lack of Novelty) (2) 3~4.*

### **C.2.4 CNIPA**

If the industrial design owner finds that the design was disclosed by another person without the consent of the industrial design owner before the date of filing, he shall submit a declaration to request the grace period concerning novelty with certifying materials within two months after he knows about it. Otherwise, the grace period benefits cannot be invoked after issuance.

### **C.2.5 USPTO**

During litigation to enforce a design patent, a patentee can show that an allegedly invalidating disclosure is not prior art under AIA 35 U.S.C. § 102(a)(1) because an AIA 35 U.S.C. § 102(b)(1) grace period exception applies to the disclosure.

## **D. LEGAL PROVISIONS RELATING TO GRACE PERIOD FOR INDUSTRIAL DESIGN RIGHTS**

### **D.1 Please provide the text and citation of the relevant legal provisions that govern grace period with respect to industrial design rights.**

#### **D.1.1 EUIPO**

Article 7 ('Disclosure') CDR provides the following:

1. For the purpose of applying Articles 5 [novelty] and 6 [individual character], a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

2. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:

(a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and

(b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

3. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

#### **D.1.2 JPO**

Design Act

(Exception to lack of novelty of design)

Article 4



(1) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) against the will of the person having the right to obtain a design registration, such a design shall be deemed not to have fallen under item (i) or (ii) of Article 3(1) for the purposes of Article 3(1) and (2) for any design in an application for design registration which has been filed by the said person within one year<sup>(\*)</sup> from the date on which the design first fell under either of those items.

(2) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) as a result of an act of the person having the right to obtain a design registration (excluding those which have fallen under item (i) or (ii) of Article 3(1) by being published in a gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 3(1) and (2) to any design in an application for design registration which has been filed by the said person within one year<sup>(\*)</sup> from the date on which the design first fell under either of those items.

(3) Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration, a document stating thereof and, within thirty days from the date of filing of the application for design registration, a document proving the fact that the design which has otherwise fallen under item (i) or (ii) of Article 3(1) is a design that is subject to application of the provision of the preceding paragraph (referred to as a "certificate" in the following paragraph).

(4) Notwithstanding the preceding paragraph, where, due to reasons beyond the control of a person who submits a certificate, the person is unable to submit the certificate within the time limit as provided in the said paragraph, the person may submit to the Commissioner of the Patent Office the certificate within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the said time limit.

\* The length of prescribed grace period has been amended from 6 months to one year by the Act No.33 of May 30th, 2018. This amendment (one year grace period) will be applicable for design applications filed on or after June 9th, 2018 provided that the prior disclosure at issue was made on or after December 9th, 2017 at the earliest.

#### (Conditions for Design Registration)

##### Article 3

(1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the said design, except for the following:

(i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;

- (ii) Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration; or
  - (iii) Designs similar to those prescribed in the preceding two items.
- (2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

### **D.1.3 KIPO**

#### **Related Acts and Subordinate Statutes**

##### **Design Protection Act**

##### **Article 33 (Requirements for Design Registration)**

(1) A design that may be used for an industrial purpose is eligible for design registration, except in any of the following cases:

1. A design publicly known or worked in the Republic of Korea or a foreign country before an application for design registration is filed;
2. A design described in a printed publication distributed in the Republic of Korea or a foreign country or made available for public use via telecommunications lines before an application for design registration is filed;
3. A design similar to any of the designs specified in subparagraph 1 or 2.

**Article 36 (Exception to Lack of Novelty)** (1) If a design of the person who has the right to register the design falls under Article 33 (1) 1 or 2 on a certain date, it shall be deemed that the design does not fall under paragraph (1) 1 or 2 of the aforesaid Article in applying paragraph (1) 1 or 2 of the aforesaid Article to the design claimed in an application filed by him/her for design registration within 12 months from the date: Provided, That the foregoing shall not apply to a design of which an application or a registration is published in the Republic of Korea or in a foreign country under a treaty or an Act.

(2) In any of the following cases, a person who intends seek the benefit of the main sentence of paragraph (1) shall submit a document stating his/her intention to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board, along with documents evidencing his/her eligibility:

1. When a person files an application for design registration under Article 37. In such cases, documents evidencing relevant facts shall be submitted within 30 days from the filing date of the application for design registration;

2. Before a notice of a determination to reject an application for design registration under Article 62 or a decision to accept the registration of a design under Article 65 (hereinafter referred to as “determination on whether to accept design registration”) is served, applicants shall submit a document stating his/her intention along with documents evidencing his/her eligibility. The latter documents should be submitted within 30 days from the filing date of the former documents and before determination on whether to accept design registration is made.

3. When a person submits a written reply to a written opposition to registration of a partially-examined design under Article 68 (3);

4. When a person submits a written reply to a petition for an administrative patent trial under Article 134 (1) (limited to an administrative patent trial on the invalidation of registration of a design).

#### **D.1.4 CNIPA**

**Article 24.** An invention-creation for which a patent is applied for does not lose its novelty where, within six months before the date of filing, one of the following events occurred:

- (1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;
- (2) where it was first made public at a prescribed academic or technological meeting;
- (3) where it was disclosed by another person without the consent of the applicant.

**Rule 30.** The international exhibition recognized by the Chinese Government referred to in Article 24, subparagraph (1) of Patent Law means the international exhibition that is registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention.

The academic or technological meeting referred to in Article 24, subparagraph (2) of the Patent Law means any academic or technological meeting organized by a competent department concerned of the State Council or by a national academic or technological association.

Where any invention-creation for which a patent is applied falls under the provisions of Article 24, subparagraph (1) or (2) of the Patent Law, the applicant shall, when filling the application, make a declaration and, within a time limit of two months from the date of filing, submit certifying documents issued by the entity which organized the international exhibition or academic or technological meeting, stating the fact that the invention-creation was exhibited or published and with the date of its exhibition or publication.

Where any invention-creation for which a patent is applied falls under the provisions of Article 24, subparagraph (3) of the Patent Law, the patent administration department under the State Council may, when it deems necessary,

require the applicant to submit the relevant certifying documents within the specified time limit.

Where the applicant fails to make a declaration and submit certifying documents as required in paragraph three of this Rule, or fails to submit certifying documents within the specified time limit as required in paragraph four of this Rule, the provisions of Article 24 of the Patent Law shall not apply to the application.

## **Guidelines for Patent Examination (2010) Part I Chapter I**

### **6.3 Non-Prejudicial Disclosures**

Article 24 provides that an invention-creation for which a patent is applied for does not lose its novelty if, within six months before the date of filing (or the priority date where priority is claimed), one of the following events occurred:

- (1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;
- (2) where it was first made public at a prescribed academic or technological meeting; or
- (3) where it was disclosed by another person without the consent of the applicant.

#### **6.3.1 First Exhibited at an International Exhibition Sponsored or Recognized by the Chinese Government**

The international exhibitions sponsored by the Chinese Government include those sponsored by the State Council or its departments, or by other institutions or local governments approved by the State Council. The international exhibitions recognized by the Chinese Government refer to the international exhibitions that are registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention. The international exhibitions refer to those at which exhibits shall be from foreign countries as well as from the organizing country.

Where an invention-creation for which a patent is applied for was first exhibited at an international exhibition sponsored or recognized by the Chinese Government within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

The certifying materials of the international exhibition shall be provided by the organizer of the exhibition. In the certifying materials shall be indicated the date, venue, and name of the exhibition, and the exhibition date, form and contents of the invention-creation with the official seal of the organizer affixed

#### **6.3.2 First Made Public at a Prescribed Academic or Technological Meeting**

Prescribed academic or technological meetings refer to those organized or held by the competent authorities under the State Council or national academic organizations, excluding those held below the provincial level or with the

entrustment or in the name of the departments under the State Council or national academic organizations. Disclosure at a meeting of the latter nature is prejudicial to the novelty of the content, unless there is an agreement on confidentiality being concluded on such a meeting.

Where an invention-creation for which a patent is applied for was first made public at a prescribed academic or technological meeting within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

The certifying materials of the academic or technological meetings shall be provided by the competent authority under the State Council or national academic organizations organizing the meeting. In the certifying materials shall be indicated the date, venue and name of the meeting, and the publication date, form, and contents of the invention-creation with the official seal of the organizer affixed.

### 6.3. 3 Disclosed by Another Person Without the Consent of the Applicant

The disclosure made by any other person without the consent of the applicant includes the disclosure of the contents of an invention-creation by another person for his failure to comply with the explicit or implicit confidentiality agreement, and disclosure caused after another person gets to know the contents of an invention-creation from the inventor or applicant by means of coercion, fraud or espionage.

Where an invention-creation for which a patent is applied for is disclosed by another person without the consent of the applicant within six months before the date of filing, if the applicant knows about it before the date of filing, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within for the grace period concerning novelty with certifying materials within two months after he knows about it. The examiner may, when necessary, require the applicant to submit the relevant certifying materials within the specified time limit.

In the certifying materials submitted by the applicant on the disclosure of the application contents by another person shall be indicated the date, manner and contents of the disclosure, which shall be signed or sealed by an attester.

Where the request for the grace period concerning novelty by the applicant is not in conformity with the above provisions, the examiner shall issue *the Notification that Grace Periods Concerning Novelty Deemed Not to Have Been Claimed*.

## **Guidelines For Patent Examination (2010) Part II Chapter III**

### **5. Grace Period for Non-Prejudicial Disclosures**

Article 24 provides that an invention-creation for which a patent application is applied does not lose its novelty where, within six months before the date of filing, one of the following events occurred:

- (1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;
- (2) where it was first made public at a prescribed academic or technological meeting;
- (3) where it was disclosed by any person without the consent of the applicant.

For examination regarding the above three circumstances, Chapter 1, Section 6.3 of Part I shall apply.

An invention-creation for which a patent application is applied does not lose its novelty where, within six months before the date of filing, any of the events prescribed in Article 24 occurred. In other words, even if any of these events occurred, the relevant invention creation does not form part of the prior art to said application. That period of six months is called the "grace period".

The effect of grace period is different from the effect of priority. The grace period means that some kinds of disclosure are merely regarded as non-prejudicial to the novelty and inventive step of the application, including some disclosure by the applicant (including inventor) and some disclosure by a third person who got knowledge of the invention-creation from the applicant or inventor by legal or illegal means. Actually, an invention-creation will form part of the prior art once it was disclosed, but the above kinds of disclosure in a certain period are regarded as non-prejudicial to the application, that is, not forming part of the prior art that may affect the novelty and inventive step of the application. Nevertheless, it does not mean the date of disclosure of the invention-creation is regarded as the filing date of the application. Therefore, if any third person makes an identical invention-creation independently during the period from the date of disclosure to the date of filing and files a patent application earlier than the application by the applicant, then, according to the principle of first-to-file, the applicant cannot get the patent right. On the other hand, the application by the third person does not have novelty and cannot be granted patent right, due to the disclosure of the invention-creation by the applicant (including inventor) which makes the invention-creation form part of the prior art to the application by the third person.

If, within six months from the date on which any of the events described in Article 24 occurred and before the applicant files the application, the invention-creation was disclosed once again, provided that the disclosure does not belong to any of the prescribed events, the later disclosure will take away the novelty of the application. If the later disclosure also falls into any of the three prescribed events, the application does not lose novelty because of this later disclosure, but the grace period shall be calculated from the date of the first disclosure.

Where a patent application falls into the circumstance as prescribed in Article 24(3), the Patent Office may, when it deems necessary, require the applicant to submit relevant certifying documents to prove the date on which the event occurs and the substantial contents of the disclosure.

Where the applicant fails to make a declaration and submit certifying documents as required in Rule 30.3 (*see also* Chapter 1, Section 6.3 of Part I ), or fails to

submit certifying documents within the specified time limit as required in Rule 30. 4, the application cannot enjoy the grace period of novelty as provided for in Article 24. When a dispute arises as to the application of Article 24, the party claiming for its applicability shall bear the burden of proof or make a convincing explanation.

#### **D.1.5 USPTO**

Note that answers to all questions pertain to laws, rules and procedures under the Leahy-Smith America Invents Act (AIA).

##### **35 U.S.C. 100 Definitions.**

When used in this title unless the context otherwise indicates –

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(d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

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(f) The term "inventor" means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(g) The terms "joint inventor" and "coinventor" mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

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(i)(1) The term "effective filing date" for a claimed invention in a patent or application for patent means—

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

(j) The term "claimed invention" means the subject matter defined by a claim in a patent or an application for a patent.

##### **35 U.S.C. 102 Conditions for patentability; novelty.**

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

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### **37 CFR 1.77 Arrangement of application elements.**

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(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see § 1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) "Sequence Listing," if on paper (*see* §§ 1.821 through 1.825 ).



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**37 CFR 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy Smith America Invents Act.**

(a) *Affidavit or declaration of attribution.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

(b) *Affidavit or declaration of prior public disclosure.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.

(2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed on that date by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

\*\*\*\*

**37 CFR 1.151 Rules applicable.**

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

**D.2 Please provide website links and/or reference to any guidance documentation, including examination guidelines, currently available for applicants relating to grace period for industrial design rights.**

### D.2.1 EUIPO

[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/designs\\_practice\\_manual/WP\\_LR\\_2016/examination\\_of\\_design\\_invalidity\\_applications\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/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.

### D.2.2 JPO

Design Act (English)

<http://www.japaneselawtranslation.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.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/appended-table1\\_2.htm](https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/appended-table1_2.htm)

Forms of the Ordinance for Enforcement of the Design Act (Japanese)

[https://www.jpo.go.jp/torikumi/kaisei/kaisei2/pdf/isyoyou\\_17.pdf](https://www.jpo.go.jp/torikumi/kaisei/kaisei2/pdf/isyoyou_17.pdf)

Examination Guidelines for Design (English)

[https://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/design\\_es.htm](https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/design_es.htm)

### D.2.3 KIPO

Design Act (English)

[http://elaw.klri.re.kr/kor\\_service/lawView.do?hseq=38408&lang=ENG](http://elaw.klri.re.kr/kor_service/lawView.do?hseq=38408&lang=ENG)

Enforcement Decree of Design Protection Act (English)

[http://elaw.klri.re.kr/kor\\_service/lawView.do?hseq=39952&lang=ENG](http://elaw.klri.re.kr/kor_service/lawView.do?hseq=39952&lang=ENG)

~~Enforcement Rule of Design Protection Act (Korean)~~

~~<http://www.law.go.kr/법령/디자인보호법시행규칙>~~

Examination Guidelines for Design (Korean)

[http://www.kipo.go.kr/kpo/user.tdf;jsessionid=9863ca6b30d51a82eb1aeb6c4fc4a521f1ba182c0c19.e34RahyTbxmRb40LaxyPahaRahqLe0?a=user.html.HtmlApp&c=30732&catmenu=m04\\_01\\_07](http://www.kipo.go.kr/kpo/user.tdf;jsessionid=9863ca6b30d51a82eb1aeb6c4fc4a521f1ba182c0c19.e34RahyTbxmRb40LaxyPahaRahqLe0?a=user.html.HtmlApp&c=30732&catmenu=m04_01_07)

Design Map (Korean)

<https://www.designmap.or.kr:10443/dr/DrinfoFrM.jsp>

Kipris (English/Korean)

<http://eng.kipris.or.kr/enghome/main.jsp>

#### **D.2.4 CNIPA**

Chinese version: [www.CNIPA.gov.cn/zcfg/](http://www.CNIPA.gov.cn/zcfg/)

English version: [english.CNIPA.gov.cn/laws/](http://english.CNIPA.gov.cn/laws/)

#### **D.2.5 USPTO**

“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, Jan 2018)  
available at <https://www.uspto.gov/web/offices/pac/mpep/index.html>

“Consolidated Patent Laws” available at  
[https://www.uspto.gov/web/offices/pac/mpep/consolidated\\_laws.pdf](https://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf)

“Consolidated Patent Rules” available at  
[https://www.uspto.gov/web/offices/pac/mpep/consolidated\\_rules.pdf](https://www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf)