

Submission by the delegation of Canada to the SCP Electronic Forum

Is there a grace period beyond the minimum provided for in the Paris Convention (i.e. a grace period that only applies to disclosures at official or officially recognized exhibitions)?

Yes

What is the duration of the grace period?

One year

What is the relevant date from which the grace period is calculated?

The filing date of the patent application. If the claim date is more than one year before the filing date, pre-filing disclosures on or after the claim date may be graced¹.

Are pre-filing disclosures by those other than the inventor graced (e.g. disclosures by the applicant and third parties)? If yes, which disclosures are graced and under what conditions?

Yes. Disclosures by the applicant, or a person who obtained knowledge, directly or indirectly, from the applicant, may be graced.

Are disclosures graced if they are made in abuse of the applicant's rights? If yes, under what conditions?

Yes. There is no specific provision related to disclosures made in abuse of the applicant's rights. If the disclosure is made within the grace period by a person who obtained knowledge, directly or indirectly, from the applicant, it may be graced.

Is the publication of a patent application by a patent office a disclosure that can be graced? If yes, under what conditions?

Yes. All publications of patent applications by the patent office during the grace period may be graced.

Are pre-filing disclosures required to be identified in order to be graced? If yes, when must they be identified?

No

When can the grace period be invoked?

The grace period may be invoked at any time, including after grant.

On whom is the burden of proof to show that a disclosure should be graced?

The patent office or a party challenging a patent must establish there is a citable public disclosure. In the absence of evidence to show that the disclosure should be graced, it would be cited as prior art.

Is there any other information you wish to share?

¹ The claim date is defined in section 28.1 of the *Patent Act*.

Yes. Sections 28.2(1) and 28.3 of the Patent Act were amended on October 30, 2019. The grace period as of October 30, 2019 could be longer than 12 months in situations where the claim date is more than 12 months before the filing date (e.g. restoration of the right of priority).