CONSEQUENCES IN CANADA OF PUBLIC DISCLOSURE OF INVENTIONS

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That's it! Eureka! After a lot of hard work in investments, you have finally found a solution that will give you a competitive advantage over your competitors. One might be tempted to communicate the good news. Beware! Silence is golden, at least until the filing of a first patent application.

In Canada, in order to be patentable, an invention must be described in a patent application and satisfy several criteria defined in the Patent Act and Rules, more specifically with respect to what is already part of public knowledge. An invention already known by the public will not be patentable.

Public Knowledge

In order to be considered to be already known by the public, an invention must have been publicly disclosed in a manner that is sufficient to allow a person of skilled in the art to reproduce the invention. This disclosure can have taken place in Canada or elsewhere in the world, in front of one or several people. The disclosure can be a communication under any written, printed, electronic or oral form. A disclosure could also be a public use or sale of the invention. For example, re-engineering of a chemical product, without exercising any inventive experimentation, can result in that the sale or public use of the product constitutes a public disclosure.

Grace Period

Canada like a few rare countries (for example the United States), is somewhat flexible with respect to the rules on novelty and obviousness. Under these rules, an invention can be made accessible to the public as long as it is made by the inventor or applicant of the patent application or any third party that received information directly or otherwise from the inventor/applicant, during the year preceding the filing

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date of the patent application in Canada. One cannot rely on the conventional priority date of a previous patent application in order to calculate the grace period.

The following scenario illustrates how the grace period works:

- Inventor A discloses and sells a new ecological soap for the cleaning of the exterior of boats on February 1, 2010 at a boat show in Montréal. It is the first public disclosure of the invention.
- Following the commercial success of the product, the inventor files a patent application in the United States (where the most important market for such cleaning products is located).
- The US patent application is filed on February 15, 2010, and the patent agent of the inventor informs him that:
  a) Although the Paris Convention would normally give the inventor until February 15, 2011 to file a Canadian patent application and claim priority of the original filing date of February 15, 2010 of the US patent application, the sale of the soap on February 1st, 2010 results in that the final date for filing a Canadian patent application is now moved up to February 1, 2011.
  b) Public disclosure of the invention on February 1, 2010 also prevents the inventor from filing patent applications in other countries that require absolute novelty, which is the case of most industrialized countries.
  c) There still remains a possibility of filing the patent application in certain countries which, like Canada and the United States, have a grace period between the public disclosure of an invention by the inventor and the filing date of the patent application.

<u>Consequences</u>

Canada:
The filing of a patent application in Canada after the one-year (1) grace period will constitute a legal reason for invalidating any patent application made after that date.

Canada functions as a first-to-file country. Therefore, if in the preceding example, a visitor at the boat show files before inventor A in his own name a patent application in Canada related to the soap, this other patent application can be cited against the patent application filed by inventor A within the one-year grace period. In such a situation, inventor A would have to incur costly legal proceedings in order to correct the situation in order to obtain his patent.

Other Countries:
A large majority of industrialized countries apply rigorously an "absolute novelty" criteria in the evaluation of patent applications. Consequently, any public disclosure of the invention prior to the filing of a patent application is a reason for invalidation of the patent. Very few countries have a grace period as is the case in Canada.

Conclusion

Before lifting the veil of secrecy surrounding an invention, it is important to evaluate and to plan the filing of patent applications that will have to be completed in order to avoid involuntary and irremediably loss of patent rights.

A qualified patent agent can help you prepare and coordinate such patent filings.

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