§ 580. INTRODUCTION

This book focuses on United States patent law and it is left to the practitioners of Europe, Japan and other key patent areas to educate the practitioners and scientists of the world on their local laws. At the same time, the patent beachhead that a company gains for overseas markets through a well-crafted, global patent position cannot be ignored. More and more, the net profits from overseas markets make the difference between commercial success and mediocrity, whether a company is based in Cleveland, Köln or Kyoto.

This section focuses on key areas where the practitioner familiar with U.S. practice must be alerted to the possible differences in Japan and Europe so that he may craft a strategy consistent with gaining the best protection on a global basis.

For the European or Japanese practitioner, this section provides a comparative guide to permit a better understanding of unique differences in U.S. practice that are dealt with in more detail in other portions of this book.

§ 581. LIMITED OR NON-EXISTENT GRACE PERIODS

Except in the case of an "evident abuse" or derivation, there is no practical grace period in Europe for filing after either the applicant's publication or other bar-creating divulgation. The typical victim is the university professor at a major academic institution. The university or its research foundation is the owner of the work, and each university attempts to do its best to promptly file patent applications before the inventor publishes. But, under a publish or perish mode in academia, coupled with the primary role of a university to profess -- and therefore share information -- it is understandable that many university inventions are published before any patent application is filed, leading to forfeiture of valuable patent rights.

Japan has a six month grace period that is limited in scope both as to the extent of protection that is provided where the grace period applies and the extent of the activities excused; it must be claimed on filing (except in the case of PCT), and is measured from the actual (or PCT) filing date, without regard to Paris Convention priority.

One aspect of the absence of a grace period is that any improvement invention that is "obvious" from the basic case must be filed before publication of the
publication by the inventor of his basic discovery. In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). Under case law from the Tokyo High Court, the six month grace period does not apply to the applicant's own published patent application or patent, so the same zero grace period applies as in Europe insofar as this situation is concerned.

§ 582. VARYING DEFINITIONS OF PRIOR ART

Whereas oral disclosures and sales or sale offers outside the United States (not accompanied by a "printed publication" under 35 USC § 102(b)) are not prior art under American law, Europe includes within the state of the art any oral divulgence of any kind anywhere in the world that is not under an explicit or perhaps implicit obligation of secrecy.

Japan is more liberal than Europe, and like the United States does not count foreign, oral disclosures of an invention as prior art.

In the area of biotechnology, at the time that one considers the possibility of licensing a certain biotechnology process that uses a proprietary biological material that has long been commercialized in a secret process, the invention may be unpatentable under U.S. law. Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 520 (2nd Cir.), cert. denied, 328 U.S. 881 (1946) ("it is a condition upon the inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy or legal monopoly." (L. Hand), quoted in Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 109 S.Ct. 971, 9 USPQ2d 1847 (1989)). Yet, that same invention may still be patentable under Japanese law.

§ 583. ABSENCE OF "SECRET" PRIOR ART

In the United States, it is taken for granted that the state of the art includes various activities that were secret as of the filing date, such as a patent that is granted much later that is given a retroactive prior art effect for obviousness purposes as of the earliest United States filing date. 35 USC §§ 102(e), 103. During prosecution the American applicant comes upon such "secret" prior art, and if he cannot establish a date of invention before the earliest U.S. filing date of the patent or establish that it is non-enabling, the applicant cuts back his United States patent protection down to a scope free from the obviousness impact of this "secret" prior art. It is not necessary to do so in the parallel European and Japanese prosecutions. There is no "secret" prior art in either Europe or Japan for determining obviousness: No patent or patent application has an obviousness effect before its date of publication. Therefore, the American applicant need not cut back his protection in Europe and Japan.