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ON SALE BAR - DOES IT EXIST AT THE EPO?

In a very recent decision (Helsinn vs. Teva) the US Supreme Court had to interpret the US patent law provision which bars a person from receiving a patent on an invention that was on sale before the effective filing date of the claimed invention, in view of the public information regarding the existence of certain commercial agreements prior to the effective filing date. In that case, the US Supreme Court cited a precedent which had held that an invention was on sale if (i) it was subject to a commercial offer for sale and (ii) it was ready for patenting.

How would a similar case fare at the EPO?

According to the European Patent Convention (EPC), the state of the art shall be held to comprise "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application."

Thus, the question to be answered under the EPC is whether the invention has been made available to the public. In the Helsinn vs. Teva case, the existence of the commercial agreements between Helsinn and another party had indeed been made available to the public before the effective filing date, but the contents of those commercial agreements, and specifically the features of the invention forming the subject-matter of the patent as contained in those commercial agreements, had not been made available to the public.

Under the EPO case law, an act can be prejudicial to the validity of a patent only if it represents an enabling disclosure of the invention to the public. Thus, if a commercial offer for sale was made confidentially to one party only, that party does not qualify as the public. In addition, the fact that in the Helsinn vs. Teva case the invention was ready for patenting does not mean that it was ready for patenting for the public at large, but rather that Helsinn and the third party, and only they, knew enough about the invention that they could have patented it. This should not amount to an enabling disclosure of the invention to the public at large under the EPO case law.

The most authoritative EPO decision on this matter, decision G 1/92, states that the features of a product are part of the state of the art when "the product as such is [i] available to the public and [ii] can be analysed and [iii] reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition."

Thus, for an invention to be part of the state of the art under G 1/92:
i) the invention itself must be available to the public. This means that the public disclosure of the existence of a commercial agreement relating to that invention does not amount to making the invention itself available to the public if the parts of the agreement disclosing the invention are not made available to the public;
ii) the invention must be analysable, which of course is not possible if the invention is not disclosed to the public in the first place;
and
iii) the invention must be reproducible, which of course is also not possible if the invention is not disclosed to the public in the first place.

As a result, if a situation like the one before the US Supreme Court in Helsinn vs. Teva were to be decided by the EPO, the patent would likely be held to be valid. There are of course good reasons why each of the US and EPO approaches are the way they are, despite their differences. It seems however that in the above situation the EPO approach would, unlike the US approach, allow to obtain a valid patent.

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