



No. 08 - September 15, 2021

CAN EVIDENCE CREATED AFTER THE FILING DATE BE USED TO SHOW INVENTIVE STEP? THE EUROPEAN PATENT OFFICE ADDRESSES THIS QUESTION

One of the European patent system's keystones is the contents of European patent applications at the time of filing. This is true not only for assessing novelty and the admissibility of claim amendments, but also for assessing inventive step. Thus, for the European Patent Office (EPO) to find that an invention meets the inventive step requirement, it is usually essential that the European patent application as filed contains all the necessary information and evidence to support that inventive step.

Exceptionally, the EPO accepts evidence created after the filing date of a European patent application in support of inventive step, especially to show that the technical problem underlying the invention is plausibly solved over the full scope of the claims. Such evidence may be in the form of scientific articles or research papers published by the inventors or their research teams, containing the results of tests performed on the invention and showing that the invention has certain properties, as long as those properties could not be expected before the filing date but are already at least hinted at in the European patent application as filed.

Relying on post-published evidence to support the inventive step of an invention is particularly relevant, and frequent, in the areas of pharmaceuticals, agrochemicals and biotechnological and chemical inventions in general.

However, applicants sometimes have to walk a very fine line when they rely on post-published evidence to support their inventive step arguments, as their reliance on post-published evidence may sometimes also be seen as an implicit admission that at the time of filing of the European patent application the actual inventive step had not yet been understood or shown by the inventors, either at all or at least for a significant part of the claimed scope.

To clarify the circumstances in which an applicant (or a patent owner) can rely on post-published evidence, the EPO Boards of Appeal have announced that they will refer questions to the EPO Enlarged Board of Appeal, i.e. the EPO's highest instance. At present, the questions proposed by the Boards of Appeal read as follows:

"If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted data or other evidence to proof such effect, such data or other evidence having been generated only after the priority or filing date of the patent (post-published data):

- 1. Should an exception to the principle of free evaluation of evidence ... be accepted in that the post-published data must be disregarded on the ground that the proof of the effect rests **exclusively** on such post-published data?*
- 2. If the answer is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would have considered the effect plausible (ab initio plausibility)?*
- 3. If the answer to the first question is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would have seen no reasons to consider the effect implausible (ab initio implausibility)?"*

The exact wording of the questions that will be referred to the EPO Enlarged Board of Appeal is yet to be finalized, but certainly this upcoming referral will be important to watch for all users of the EPO system, at least in the areas of pharmaceuticals, agrochemicals and biotechnological and chemical inventions in general.