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EVIDENCE CREATED AFTER THE FILING DATE AND INVENTIVE STEP: HERE ARE THE QUESTIONS REFERRED TO THE EPO'S ENLARGED BOARD OF APPEAL

The European Patent Office (EPO) is a first-to-file system. Often times, this means that applicants have to file their European patent applications with little or no experimental data to support the inventive property of the invention. This is particularly true in the biotech, pharmaceutical and agrochemical fields. In these fields and in the chemical field in more general, the well-known 'publish-or-perish' drive causes some applicants to rush to file their patent applications; for others, the time it takes to put together the experimental data for filing in the first place cannot always be reconciled with the need to file the patent application as soon as possible. Indeed, there are certain inventions, e.g., the new use of a known active ingredient to treat or prevent a certain condition, or an unexpectedly synergistic combination of active compounds, that may require some experimental data to support the inventive property.

In these situations, applicants may try to use experimental evidence created after the filing date of the European patent application or European patent (e.g., such as in an opposition) to show the inventive property, and/or to complete the data relating to the inventive property that is already contained in the European patent application as filed. The evidence may be in the form of scientific articles or research papers published by the inventors or their research teams, which contain the results of tests performed on the invention and show that the invention has a certain property, as long as that property is unexpected in view of the prior art but is already at least hinted at in the European patent application as filed.

The EPO's authority of highest instance, i.e. the Enlarged Board of Appeal, has now received a referral on precisely this issue - whether and when evidence created after the filing date of a European patent application or European patent can be used to show inventive step.

The case that generated the referral relates to an opposition filed against EP2484209B1 relating to a synergistic insecticidal combination. In that case, the patent owner (Sumitomo Chemical Company Ltd.) submitted experimental evidence generated after the patent's filing date to show that the asserted synergy did arise from the claimed combinations. The opponent (Syngenta Ltd.) argued that that particular synergy had not been made plausible in the European application as filed, and thus the experimental evidence could not be taken into consideration.

The EPO Board of Appeal observed that at present there seem to be three lines of case law at the EPO tying the concept of "plausibility" to inventive step (i.e. non-obviousness):

- A first line of case law, on *ab initio* plausibility, whereby evidence created after the filing date can only be used to show inventive step if the property conferring inventive step to the claimed subject-matter was already plausible from the content of the European patent application as filed and/or from common general knowledge at the filing date;
- A second line of case law, on *ab initio implausibility*, whereby evidence created after the filing date can always be used to show inventive step unless the property conferring inventive step to the claimed subject-matter is *implausible* based on the content of the European patent application as filed and/or on common general knowledge at the filing date;
- A third line of case law, on *no plausibility*, whereby evidence created after the filing date can be used to show inventive step irrespective of whether the property conferring inventive step to the claimed subject-matter was already plausible from the content of the European patent application as filed and/or from common general knowledge at the filing date.



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The Board of Appeal noted that each of these lines of case law leads to different and even opposing results, and it is therefore essential for the EPO's authority of highest instance, i.e. the Enlarged Board of Appeal, to provide guidance. The Board of Appeal also noted that there has been some discussion, in the EPO and UK case law and in certain scholarly writings, on whether a requirement of plausibility is actually enshrined in the European Patent Convention or whether it is instead "court-invented".

Therefore, the Board of Appeal referred the following questions to the EPO Enlarged Board of Appeal:

"If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted evidence, such as experimental data, to prove such an effect, this evidence not having been public before the filing date of the patent in suit and having been filed after that date (post-published evidence):

1. Should an exception to the principle of free evaluation of evidence ... be accepted in that post-published evidence must be disregarded on the ground that the proof of the effect rests exclusively on the post-published evidence?

2. If the answer is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have considered the effect plausible (ab initio plausibility)?

3. If the answer to the first question is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have seen no reason to consider the effect implausible (ab initio implausibility)?"

The Enlarged Board of Appeal will now have to decide whether the referral is admissible in the first place. If it is, we should expect a multitude of amicus curiae briefs trying to persuade the Enlarged Board of Appeal one way or another, as the referred questions clearly relate to a high-stakes issue in many fields of technology. If the referral is admissible a decision may take anywhere from about 6 months to two years or more.

This article was written by Micaela Modiano (Modiano & Partners) and Lisa Mueller (Casimir Jones) and was also published in the Brics and Beyond blog.