Patenting research outputs – post-published evidence

As we continue our series on considerations for researchers interested in patenting their research outputs, WP Thompson looks at a recent decision under the European Patent Convention, which offers some much-needed clarity on an issue that can significantly impact the perceived inventiveness of a patent application; namely, the possibility of relying on supporting data published after a patent application's filing date.

Walking the tightrope

Naturally, the more experimental data that a researcher generates in the development of an invention, and the more that they include in a patent application for that invention, the more evidence they can use to support arguments that the invention is plausible. However, as this series discussed back in Autumn 2021, there is a tightrope to be walked between collating enough supporting data to make the description of an invention plausible and filing early enough to beat any competitors to the punch.

Of course, regardless of how long one takes to collect supporting data, the examination process can still throw up unexpected questions and obstacles. For example, an examiner might disagree that a given example plausibly substantiates a claim that an invention has a certain effect. In this case, if explanations and/or amendments fail to move the examiner, the applicant might be tempted to bolster their arguments by submitting a dataset generated after the filing date of the patent application. The allowability of such a move has long been a source of contention before the European Patent Office (EPO), but a recent decision (G2/21) by the Enlarged Board of Appeal (EBA) - the highest and final judicial instance at the EPO – appears to have shed some much-needed light on the matter.

Decision G2/21 of the Enlarged Board of Appeal

In March 2023, the EBA decided on a matter regarding plausibility, with respect to European patent EP2484209. This patent relates to an insecticide composition suitable for pest control, which comprises two compounds already known for their use as insecticides. The patent claims that a mixture of the two has a synergistic effect. The question before the EBA was whether test data filed and published after the filing date of the patent application could be considered when assessing whether there was support for claiming this synergistic effect.

The EBA decided that evidence submitted in defence of an inventive step cannot be disregarded solely because it is made available to the public after the filing date of the patent application in question. This is in accordance with the EPC's principle of free evaluation of evidence. Effectively, this means that late-filed data could, in theory, be used to support arguments in favour of an inventive step.

However, the EBA held that such late-filed data will only be considered if any technical effect shown by the new data would have been known at the patent application's filing date. That is, a person skilled in the art, having access to all relevant prior art and the available common general knowledge, must have been able to understand the technical teaching in the data at the point the application was filed. In other words, late-filed supporting data will only be considered by the European Patent Office if it supports an inventive step already disclosed in the application as filed. One cannot simply file new data and claim that they demonstrate a heretofore unmentioned technical effect that makes the subject of the patent application inventive.

Preparation is key

As ever, a key element of success in acquiring patent protection is preparation, from clearly identifying the inventive feature of an invention to generating sufficient supporting data to substantiate claims to that feature. This decision by the EBA is not a "magic bullet" that allows applicants to fix any and all shortcomings in an application's sufficiency. Rather, it introduces some welcome flexibility to the balancing act of when to file and when to gather more data, whilst avoiding giving applicants a second bite of the cherry. Thus, applicants can reinforce their arguments without being given an unfair advantage over competitors who are keeping a weather eye on the progress of the patent application.

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