



2018 AIPPI World Congress - Cancún  
Adopted Resolution  
September 26, 2018

## Resolution

### Use of post-filing data in support of inventive step/non-obviousness

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#### Background:

- 1) This Resolution concerns the use of Post-filing data in support of inventive step/non-obviousness.
- 2) For the purpose of this Resolution **Post-filing data** is any evidence, such as data demonstrating a favorable property of the invention, which is submitted to national authorities after the effective filing date of a patent or patent application. Post-filing data does not include any amendment of a claim or specification of a patent or patent application during patent prosecution.
- 3) The Resolution is confined to use of Post-filing data in support of inventive step/non-obviousness.
- 4) Patent practitioners strive to find an appropriate balance between: (i) early filing of a patent application, thereby risking rejection of the application for lack of supporting evidence; and (ii) delaying application filing until the development of additional supporting data, thereby risking a third party's publication of the invention prior to filing. In particular for inventions with long development times and/or many contributing parties, any delay in filing bears considerable risk of a prior publication, which may invalidate potential patent rights. In addition, delayed filing also leads to delayed publication, which may negatively impact the rate of scientific progress. The risk of rejection resulting from filing a patent application relatively early in the inventive process can be mitigated by permitting the applicant to use Post-filing data to support non-obviousness/inventive step.

- 5) Between November 2015 and February 2016 a survey was conducted to assess acceptability of Post-filing data in 27 jurisdictions.<sup>1</sup> The results of this survey have been summarized in an AIPPI Position Paper. The survey results demonstrate considerable divergence in the current practice of the surveyed patent offices in the acceptance of Post-filing data.
- 6) Some jurisdictions allow the use of Post-filing data, although there may be restrictions as to when such data may be used. Other jurisdictions permit all Post-filing data to be considered on the issue of inventive step/non-obviousness. Still other jurisdictions prescribe that only evidence present in the patent or patent application may be taken into account for the assessment of inventive step/non-obviousness.
- 7) Additionally, some jurisdictions permit the use of Post-filing data pre-grant but not post-grant, and other jurisdictions permit the use of Post-filing data equally pre- and post-grant.
- 8) The present divergent practice can lead to inconsistent results. The lack of uniformity in the acceptance of Post-filing data makes striking a proper balance between filing earlier or later in the inventive process difficult. AIPPI observes a consensus among practitioners that harmonization in this area is desirable.
- 9) At the AIPPI World Congress in Cancun in September 2018, the issue of acceptability of Post-filing data was discussed in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

**AIPPI resolves that:**

- 1) Taking into account the ever-growing complexity and duration of inventive processes in various industries, AIPPI supports the use of Post-filing data in support of inventive step/non-obviousness.
- 2) In pre-grant proceedings before a national or regional patent office, patent applicants should be able to support inventive step/non-obviousness of claimed subject-matter by relying on Post-filing data showing at least one property or effect of the claimed invention, in particular in situations where the property or effect is already described in or is apparent from the patent application, either explicitly or implicitly.
- 3) In pre-grant proceedings before a national or regional patent office, patent applicants should be able to (further) support a technical effect or property, in order

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<sup>1</sup> Argentina, Australia, Belgium, Brazil, Canada, Chile, China, Columbia, Costa Rica, Ecuador, France, Germany, Hungary, India, Israel, Italy, Japan, Korea, Mexico, Netherlands, Peru, Spain, Turkey, United Kingdom (UK), United States of America (U.S.) and Venezuela, as well as in the European Patent Office (EPO).

to support inventive step/non-obviousness, by either referring in general terms to prior art or by specifically providing a comparison with the prior art.

- 4) In post-grant proceedings such as post-grant oppositions or post-grant invalidity proceedings, patent owners should be able to rely on Post-filing data analogously to pre-grant proceedings, either before a national or regional patent office or before a national or regional court.

**Links:**

- [Survey results](#)
- [Position Paper](#) prepared by AIPPI's Standing Committee on Pharma and Biotechnology entitled "Recommendations on the use of post-filing data in support of inventive step", 13 April 2017