

Not-So-Secret Information

Parties need to be very careful when filing confidential information at the EPO. The EPO will not always agree to a request to keep information confidential.

Board of Appeal decision T2522/10 addressed such a situation. It did not end well for the patentee.

The patentee filed technical declarations with the Board of Appeal, as part of its case. Two of the declarations were supported by "confidential annexes". These confidential annexes were not intended to form part of the main case but, rather, were just evidence of the expertise of the relevant declarant.

The patentee asked the Board of Appeal not to put the confidential annexes on the public record. It argued that the annexes contained confidential trade secrets relating to the patented drug, in particular in-house experimental evidence and manufacturing of formulation tolerances.

The Board of Appeal decided that its hands were tied in deciding whether or not it was in the public interest to publish this "confidential" information.

The Board said that any information filed at the EPO must be placed on the public record, if it is relevant to understanding the patent. The annexes contained actual manufacturing processes and yields relating to the subject drug of the patent, and so the Board decided they contained information useful for understanding the patent.

As a result, the Board held it had no option but to put the annexes on the public record, against the wishes of the patentee.

This should serve as a warning to all parties wanting to file technical information at the EPO. In particular, the EPO will not necessarily respect the wishes of a party to keep certain information confidential but must take its own decision on whether to publish the information, which will be based not on the interests of the party filing the information but on the interests of the "public".

We strongly recommend that, before filing any technical information at the EPO, you carefully consider whether you are content for that information to be made public.

If you want technical information to be kept confidential by the EPO, we recommend that you obtain the EPO's agreement, before you file the information, to

admit the it only if it agrees not to publish it, and to return it if it cannot keep it confidential.

We cannot guarantee that the EPO will agree to such an proposal, but it seems the only way to ensure that confidential information remains confidential when submitted to the EPO.