EPO Enlarged Board of Appeal decision G 1/21 (ViCo) and pending referral G 2/21 (plausibility)

Webinar 27 January 2022

Jakob Pade Frederiksen - jpf@*inspicos.com*
European Patent Attorney
Partner

Peter Koefoed - *pko@inspicos.com*
European Patent Attorney
Partner, CEO

G 1/21 – Legality of ViCo oral proceedings - Background

- Since 1998 the EPO has been providing applicants with the opportunity to conduct oral proceedings in examination by way of videoconferencing

- Until March 2020, oral proceedings before opposition divisions and the Boards of Appeal were always held in person at the premises of the EPO in Munich/Haar, The Hague and Berlin

- The breakout of Covid-19 necessitated changes

ViCo oral proceedings

- Pilot project on oral proceedings via ViCo was launched in May 2020; many oral proceedings were, however, cancelled
- As of January 2021, oral proceedings before Opposition Divisions are per default held by way of ViCo
  (Dec. Pres. EPO dated 10.11.2020)
- Pilot project extended (at least) until 31 May 2022
  (Dec. Pres. EPO dated 23.11.2021)
- As of 1 April 2021, the Boards of Appeal have the power to require that oral proceedings to be conducted via ViCo
  (Article 15a RPBA; formally proposed in December 2020)

G 1/21 – referring decision

Interlocutory decision in T 1807/15 dated 8.2.2021

Is the conduct of oral proceedings in the form of a videoconference compatible with the right to oral proceedings as enshrined in Article 116(1) EPC if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference?

G 1/21 – reformulation of the question referred

During a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, is the conduct of oral proceedings before the boards of appeal in the form of a videoconference compatible with the EPC if not all of the parties have given their consent to the conduct of oral proceedings in the form of a videoconference?

G 1/21 – main considerations of the EBA (I/III)

- The meaning of the term “oral proceedings” in Article 116 EPC is not limited to the specific form that was known at the time the Convention was drawn up

  → ViCo oral proceedings are oral proceedings with the meaning of Article 116 EPC

- The question of geographical location does not arise in the question of a videoconference

G 1/21 – main considerations of the EBA (II/III)

- Videoconferences are distinct from telephone conferences, which are clearly not suitable as a format for oral proceedings
- In combination with the written part of the proceedings, videoconferencing is sufficient to comply with the principles of fairness of proceedings and the right to be heard
- Communication by way of videoconferencing is less direct and subject to limitations as a result of technological constraints

  → In-person oral proceedings are the optimum format and should be the default option

G 1/21 – main considerations of the EBA (III/III)

- Parties can be denied this option only for good reasons, such in the case of a pandemic
  - Board's discretion to determine if good reasons exist
- In the case underlying the referral, in–person oral proceedings was not an option because of Covid-19
- During a pandemic delays in finalizing appeals could seriously impair the administration of justice

G 1/21 – the EBA's answer

During a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the boards of appeal in the form of a videoconference is compatible with the EPC even if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference.

Post-pandemic consequences of G 1/21

- Oral proceedings before the Boards of Appeal will per default be held in person, but may at the Board's discretion be held by means of ViCo, subject to the consent of all parties to the proceedings

- What about first-instance oral proceedings?

  – EBA's reasons indicate that it is justifiable to hold ViCo oral proceedings during the pandemic without the parties' consent, but…

  – post-pandemic oral proceedings will probably have to take place at the premises of the EPO unless the parties consent to ViCo

Addendum:
Relocation of the Boards of Appeal back to central Munich

- Subject to approval by the EPO member states at the next meeting of the Administrative Council in March 2022, the Boards of Appeal will move back to the city centre area of Munich (PschorrHöfe Bauteil VII) in 2025/2026

Google Maps, 2022

G 2/21 - plausibility

- Arises from a referral in interlocutory decision T 116/18 (an opposition appeal)
- To be decided to what extent the applicant/patent proprietor can rely on later filed experimental evidence of a technical effect of the claimed invention
- The questions have basis from an inventive step evaluation, but sufficiency of disclosure will also be dealt with
  - Point 13.3.1 in the Referral

The referral

- Patent relates to a combination of 1) thiamethoxam and 2) a generic group of insecticides.
- In opposition, the Opponent cited D23 in support of the allegation that a technical effect was not solved over the entire scope of the claims. The Patentee filed D21 in support of the opposite argument.
  - D21 demonstrates synergistic effects *not* demonstrated in the original application.
- The referring Board finds that admittance of D21 is crucial for the inventive step determination.
  - Without D21, inventive step will be denied due to formulation of an unambitious technical problem
  - With D21 admitted, the technical problem is ambitious and inventive step would be acknowledged
- It all hinges on the fact, that the applicaiton text as filed does not provide *plausiblity* of the solution to the ambitious technical problem

Plausibility – background

- The issue has primarily arisen from patent cases in the realm of biotechnology. An example:
- WO 02/094868…

1. A protein comprising an amino acid sequence selected from the group consisting of SEQ IDs 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42, 44, 46, 48, 50, 52, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74, 76, 78, 80, 82, 84, 86, 88, 90, 92, 94, 96, 98, 100, 102, 104, 106, 108, 110, 112, 114, 116, 118, 120, 122, 124, 126, 128, 130, 132, 134, 136, 138, 140, 142, 144, 146, 148, 150, 152, 154, 156, 158, 160, 162, 164, 166, 168, 170, 172, 174, 176, 178, 180, 182, 184, 186, 188, 190, 192, 194, 196, 198, 200, 202, 204, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260, 262, 264, 266, 268, 270, 272, 274, 276, 278, 280, 282, 284, 286, 288, 290, 292, 294, 296, 298, 300, 302, 304, 306, 308, 310, 312, 314, 316, 318, 320, 322, 324, 326, 328, 330, 332, 334, 336, 338, 340, 342, 344, 346, 348, 350, 352, 354, 356, 358, 360, 362, 364, 366, 368, 370, 372, 374, 376, 378, 380, 382, 384, 386, 388, 390, 392, 394, 396, 398, 400, 402, 404, 406, 408, 410, 412, 414, 416, 418, 420, 422, 424, 426, 428, 430, 432, 434, 436, 438, 440, 442, 444, 446, 448, 450, 452, 454, 456, 458, 460, 462, 464, 466, 468, 470, 472, 474, 476, 478, 480, 482, 484, 486, 488, 490, 492, 494, 496, 498, 500, 502, 504, 506, 508, 510, 512, 514, 516, 518, 520, 522, 524, 526, 528, 530, 532, 534, 536, 538, 540, 542, 544, 546, 548, 550, 552, 554, 556, 558, 560, 562, 564, 566, 568, 570, 572, 574, 576, 578, 580, 582, 584, 586,

.....some pages SEQ ID Nos. followed by:

5430, 5432, 5434, 5436, 5438, 5440, 5442, 5444, 5446, 5448, 5450, 5452, 5454, 5456, 5458, 5460, 5462, 5464, 5466, 5468, 5470, 5472, 5474, 5476, 5478, 5480, 5482, 5484, 5486, 5488, 5490, 5492, 5494, 5496, 5498, 5500, 5502, 5504, 5506, 5508, 5510, 5512, 5514, 5516, 5518, 5520, 5522, 5524, 5526, 5528, 5530, 5532, 5534, 5536, 5538, 5540, 5542, 5544, 5546, 5548, 5550, 5552, 5554, 5556, 5558, 5560, 5562, 5564, 5566, 5568, 5570, 5572, 5574, 5576, 5578, 5580, 5582, 5584, 5586, 5588, 5590, 5592, 5594, 5596, 5598, 5600, 5602, 5604, 5606, 5608, 5610, 5612, 5614, 5616, 5618, 5620, 5622, 5624, 5626, 5628, 5630, 5632, 5634, 5636, 5638, 5640, 5642.

2. A protein having 50% or greater sequence identity to a protein according to claim 1.

- WO 02/094868 discloses 2821 proteins from *Staphylococcus aureus* and 2821 corresponding nucleic acids
  - Obtained from full-genome sequencing of *S. aureus*
  - Nothing is disclosed about functionality of the proteins
  - Claim 11 and 12 relates to ”a vaccine composition” comprising any one of these proteins
- No doubt that such a vaccine composition can be readily prepared by a skilled person, *provided the protein is a protective immunogen*
- But: <1/100 proteins in a microorganism are protective immunogens…

Post published evidence
Traditional approach – and its problem…

- An alleged technical effect has traditionally been something that could be evidenced by later filing of convincing experimental data.
- When no technical effect is stated in a claim, such evidence is filed to support inventive step in order to demonstrate that an objective technical problem is solved
- When a technical effect *is* stated in the claim, such evidence is filed to support that the claimed invention is sufficiently dislcosed.
- But what to do about a case like 02/094868?
  - One thing is that post published evidence can demonstrate that a few proteins are useful in a vaccine
  - But would it not constitute a research project to identify the few useful proteins???

Hence: plausibility...

- In a number of cases from the Technical Boards of Appeal, post published evidence has been considered in light of the application as filed
- If a skilled reader would not find it plausible - when studying the application text originally filed – that the technical effect can be attained, then the later demonstration in the post published evidence cannot repair this defect of the original application text and is not taken into consideration

Back to G2/21

- The referral has identified 3 divergent lines of case law:

- 1: If the skilled person does not consider the technical effect to be plausibly disclosed in the application text, then post published evidence is not considered (*ab initio* plausibility)
- 2: If the skilled person does not consider the technical effect to be implausible based on the original disclosure and the common general knowledge, then post published evidence must be considered (*ab initio* implausibility)
- 3: Allowability of post published evidence is not influenced by plausibility considerations (no plausibilty)

1st view: *ab initio* plausibility

- For instance T 1329/04
  - a new polypeptide (denoted growth differentiation factor-9 (GDF-9)) was stated it to be a new member of the transforming growth factor-β (TGF-β) superfamily
    - Which has certain uses linked to the technical problem solved
  - Board found no evidence that GDF-9 was indeed a TGF-β superfamily member because there was no disclosure "…*to make at least plausible that a solution was found to the problem which was purportedly solved*…"
  - And Board did not take post published evidence into consideration…
- Other cases: T 609/02, T 488/16, T 415/11, and T 1791/11

Ab initio implausibility

- For instance T 919/15:
  - Very much like the situation in the referring decision: two groups of herbicides are combined, only a few combinations are exemplified, but proof was later submitted.
- Board admitted the evidence: "...in the absence of evidence to the contrary in the common general knowledge for herbicide combinations containing herbicide (A), it cannot simply be assumed that a synergistic interaction would be *per se* implausible for the combinations not tested in the application as filed.
- Other cases: T 578/06, T 536/07, T 1437/07, T 266/10, T 863/12, T 184/16, and T 2015/20

Ab initio plausibility or implausibility?

- Illustrated by UK Supreme Court decision of 14 November 2018, Generics (UK) (trading as Mylan) v. Warner-Lambert Company Ltd ("the UK Supreme Court decision") and the follow-up on this judgment by C. Floyd, "Plausibility: where from and where to", GRUR, 2021, 185.
  - Majority of judges applied the plausibility approach and revoked the patent, whereas the minority applied an implausibility approach and would have maintained the patent in suit.

No plausibility

- Example is T 31/18
  - Claims directed to a tablet comprising imatinib and cross-linked polyvinylpyrrolidone in certain amounts
    - Problem solved: disintegration time of <20 minutes, evidenced by post published evidence
  - Board *admitted* the evidence: "...it can indeed not be expected from a patent applicant to include an extensive number of experimental evidences corresponding to all technical features which can possibly be claimed in the application as filed and which can possibly constitute a future distinguishing feature over the closest prior art, since said closest prior art and its technical disclosure may not be known to the applicant at the filing date of the application..."
- Other case: T 2371/13

Consequences/thoughts

- Would the ab initio plausibility approach render patenting of non-exemplified subject matter impossible?
- Is the (im)plausibility considerations in conflict with the principle of free evaluation of evidence?
- Would no plausibility open the door for (too many) armchair inventions
- What about the need to distinguish from prior art not considered in the drafting phase?

Questions referred

- Should an exception to the principle of free evaluation of evidence (see e.g. G 3/97, Reasons 5, and G 1/12, Reasons 31) 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?
- 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)?
- 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)?

Link to situation in the USA

- In the US, the same type of considerations are applied under 35 U.S.C. §112(a) (the written description requirement):
  - Would the skilled person acknowledge – when studying the application text as filed – that the inventors *had possession* of the claimed invention at the filing date?
    - Separate from the enablement requirement, where post published experimental evidence can overcome a rejection. Post published experimental evidence *cannot* overcome a written description rejection.
- Written description was originally introduced in §112 in the 1960ies in order to prevent applicants from filing continuation applications with claims with no basis in the parent application – and thus was an equivalent to Art. 76(1) EPC.
  - But today a favorite Examiner's tool for rejections in many biotech cases