

What became of plausibility?

G 2/21 reviewed

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G 2/21

- Early this spring, the Enlarged Board of Appeal published its decision on the questions referred to it by the technical Board of Appeal in decision T 116/18.
- The referral dealt with the admissibility of post-published evidence for support of inventive step in a case where the referring Board came to the conclusion that the question of inventive step hinged entirely on the results reported in the post-published evidence.

T 116/18 in brief

- Patent granted for an insecticide comprising two allegedly synergistically acting classes of compounds
- During opposition, the proprietor filed post-published evidence (D21) that *supported* the synergistic effect.
- Later, in appeal, the opponent filed post-published evidence (D23) that this synergistic effect was not attained over the entire scope of the granted claims
- The referring Board came to the conclusion that reliance on the data in D21 was pivotal for the determination of inventive step
 - And, in this connection identified 3 different lines of case law relating to admissibility of post-published evidence: the *ab initio* plausibility cases, the *ab initio* implausibility cases and the no plausibility requirement cases...

The questions referred

1. 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?
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)?

Free evaluation of evidence

- One firmly established answer in G 2/21 is that question 1 was answered in the *negative*. Free evaluation of evidence is a “universally applicable principle in assessing any means of evidence”.
 - Post-published evidence must not be disregarded, provided that it is filed timely during proceedings and in accordance with the EPC and the RPBA
- So what about questions 2 and 3???

Evaluating post-published evidence

- Some discussions concerning the *order* of the 3 questions
- EBA instead considered an extensive body of TBA case law and national court rulings to determine how admissible post-published evidence can be evaluated in determination of inventive step
- One conclusion was that the "plausibility" concept is a catchword rather than a legal term and the analysis by the EBA concentrated on the legal background for the various uses of the term.

Disclosure vs. technical teaching

- In its analysis, the EBA makes a distinction between "disclosure" and "technical teaching" in a patent document.
- "The Enlarged Board understands from the case law of the boards of appeal as common ground that the core issue rests with the question of what the skilled person, with the common general knowledge in mind, understands at the filing date from the application as originally filed **as the technical teaching of the claimed invention**"
- The detailed analysis of case law namely reveals that the BoAs and national courts in many - if not all – cases have attempted to dig out whether or not the technical effect relied upon "was derivable for the person skilled in the art from the **technical teaching** of the application documents"

The decision...

1. Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.
2. A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

What does it mean?

- The EBA appears to acknowledge in point 95 that the decision is not entirely clear....
- The Enlarged Board is aware of the **abstractness** of some of the aforementioned criteria. However, apart from the fact that the Enlarged Board, in its function assigned to it under Article 112(1) EPC, is not called to decide on a specific case, **it is the pertinent circumstances of each case which provide the basis on which a board of appeal or other deciding body is required to judge**, and the **actual outcome** may well to some extent be **influenced** by the **technical field** of the claimed invention. Irrespective of the actual circumstances of a particular case, the guiding principles set out above should allow the competent board of appeal or other deciding body to take a decision on whether or not post-published evidence may or may not be relied upon in support of an asserted technical effect when assessing whether or not the claimed subject-matter involves an inventive step.

What does it mean? (II)

- One reading of the decision is that there has to be some kind of technical support in the original application which would convince a skilled person in the relevant technical field that the supporting (post-published) evidence is relevant for the claimed invention
- Stated differently: does the application as filed provide a convincing (credible) technical teaching corresponding to the claimed subject matter.
- A patent application lacking technical reasoning or experimental support for a "disclosed" technical effect stands poor chances of being salvaged by post-published evidence.

What does it mean? (III)

- No decisions have been published, which refer to the decision in G 2/21.
- But T 1825/21 gives some hints to application of G 2/21.
- In the case at issue, no experimental evidence of a technical effect (of a crystal form of a substance) was reported, but the Board found it credible (based on common general knowledge) that crystal forms have inherent advantages over amorphous forms of chemical compounds in terms of stability and preparation of dry forms.
- So in T 1825/21, post-published evidence merely “proved a point”, which the Board regarded as credible anyhow.
- T 1499/16 further established (again with reference to pending G 2/21) that post-published evidence not filed in accordance with the RPBA would not be admitted.

What about sufficiency of disclosure?

- The EBA did not decide on this issue, but:
- It is found that for cases where a technical effect is stated in the claims (typically 2nd medical indication cases), the existing case law requires that the skilled person – based on the applicaiton as filed - finds it **credible** that the technical effect is attained.
 - And that post-published evidence cannot reparaire this *ab initio* lack of credibility
- It would hence appear that the threshold for relying on post-published evidence is slightly higher when assessing sufficiency of disclosure than inventive step.

Thank you for your attention

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