

**THIRD-PARTY OBSERVATION FILED ON BEHALF OF AIPPI:
G 2/21 PENDING BEFORE THE ENLARGED BOARD OF APPEAL OF
THE EUROPEAN PATENT OFFICE**

**WRITTEN STATEMENT IN ACCORDANCE WITH ARTICLE 10 OF
THE RULES OF PROCEDURE OF THE ENLARGED BOARD OF
APPEAL**

I. INTRODUCTION

The EPO has called for third-party observations in case G 2/21, pending before the Enlarged Board of Appeal.

AIPPI herewith files our observations regarding the above referenced case.

Technical Board of Appeal 3.3.02 has by interlocutory decision T 116/18 referred the following questions to the Enlarged Board of Appeal (referral pending under G 2/21):

If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted evidence, such as experimental data, to prove such an effect, this evidence not having been public before the filing date of the patent in suit and having been filed after that date (post-published evidence):

- 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)?

In the case at hand, a synergistic effect was argued to exist between a combination of thiamethoxam with anthranilic diamides (represented by a Markush formula Ia) with respect to insecticidal activity. The evidence for the synergistic effect was provided after the filing date of the patent application.

Board of Appeal 3.3.02 concluded that “... questions need to be referred to the Enlarged Board of Appeal on whether evidence not public before the filing date of the patent in suit and filed after that date (“post-published evidence”) can be taken into consideration in view of the plausibility case law of the boards.” (T 0116/18, point 11.1 of the Reasons for the Decision).

II. AIPPI’s POSITION

At the AIPPI Annual World Congress in London in 2019, the National and Regional Group Members voted on a Resolution regarding Plausibility with reference to Patents (hereafter referred to as “the Resolution” https://www.aippi.dk/wp-content/uploads/2019/11/Resolution_Patents_Plausibility_English.pdf).

In the Resolution, AIPPI took the position that there should be no stand-alone, independent ground of patentability or validity based on plausibility alone (Paragraph 1).

Paragraphs 1 and 2 of the Resolution read as follows:

- 1) *There should be no stand-alone ground of patentability or validity based on plausibility. The already existing patentability (novelty, inventive step, industrial application and/or utility) and validity (e.g. sufficiency, right to priority, added matter) requirements are sufficient to ensure that the invention protected by the claims is commensurate with the technical contribution made by the specification to the state of the art. The introduction of a separate plausibility requirement would create legal uncertainty without a commensurate benefit.*
- 2) *If plausibility is to be examined (in any of its possible aspects, notably as a requirement of credibility of the technical effect, as a prohibition of speculative patent or as condition of use of prophetic examples), it should be considered as one of many elements of the examination of the already existing patentability and validity requirements.*

It should be noted that paragraph 4 of the Background section of the Resolution specifically excludes “*the general sufficiency of disclosure and inventive step requirements, the general utility requirement or the use of post-filing data*” from the scope of the Resolution.

Nevertheless, the contents of the Resolution are pertinent with respect to the questions put to the Enlarged Board of Appeal in the present case.

AIPPI further submits that if a plausibility criterion is indeed considered, the threshold for credibility should be narrowly understood. (Paragraph 3 of the Resolution)

Paragraphs 8 to 10 of the Resolution indicate AIPPI's position on how the plausibility criterion should be assessed in the case that it is in fact applied, contrary to the position expressed in Paragraph 1:

- 8) *If plausibility is considered, it should be assessed, in consideration of the claimed subject matter, in particular by taking into account whether the claimed invention is characterized (i) only by structural features or (ii) also by functional features or a use. Under (i), it should not be critical for the purpose of assessing plausibility to disclose its technical effect or use. Under (ii), it should be plausible that the technical effect of this use or function can be obtained.*
- 9) *It should not be presumed that if an effect is found plausible to the skilled person at the priority date based in part on the common general knowledge, then the invention would necessarily lack inventive step. In the assessment of plausibility the teaching of the patent is taken into account.*
- 10) *Plausibility considerations should not prohibit the presence of prophetic examples in the specification.*

III. OTHER REMARKS

It is noted that the consideration of “post-published evidence” as the “proof” of an effect (question 1) may involve factually complex enquiries as to whether evidence has in fact been “published” and whether the document in question decisively “proves” anything.

For example, if the document in question briefly states that there is a synergistic effect and does not provide any detailed scientific/technical explanations of why that might be the case, can such a document objectively and sufficiently support a finding that there is a synergistic technical effect?

The desirability of a complex enquiry of this type – given that it may not result in an absolute and clear answer and could usually be expected to yield an uncertain answer – is questionable. It is, effectively, a second plausibility question: is it plausible that the document in question correctly states the technical position, the answer to which is subsequently factored into the ‘actual’ plausibility question as part of the consideration of validity.

IV. CONCLUSION

In conclusion, AIPPI's position as clearly indicated in the Resolution on plausibility is that there should be no stand-alone validity or patentability requirement for plausibility. If plausibility is considered, it should form part of the consideration of an independent ground of validity.

With regard to post-filing data, AIPPI does not provide further specific responses to the questions addressed to the Enlarged Board of Appeal in G 2/21.