

Enlarged Board of Appeal
 European Patent Office
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Attention: Mr Nicolas Michaleczek
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Enlarged Board case G 2/21 (Plausibility)
Amicus brief by the Chartered Institute of Patent Attorneys

The Chartered Institute of Patent Attorneys is the UK's largest intellectual property organisation. We are the professional and examining body for patent attorneys in the UK, representing virtually all the 2,400 registered patent attorneys in the UK, whether employed in industry or private practice. Total membership is over 4,000 and includes trainee patent attorneys, judges, barristers and other professionals with an interest in protecting innovation through the use of intellectual property rights (patents, trade marks, designs and copyright). We represent members' interests to government and a wide range of stakeholders at home and abroad. The profession is one of the UK's most export intensive technical / legal services, generating around £1 billion for the economy in gross value added, and approaching £750 million in exports.

Question 1

*Should an exception to the principle of free evaluation of evidence 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?*

The EPO's approach to inventive step involves formulating a technical problem – based on technical effects achieved vis-à-vis an objectively chosen 'closest prior art', of which the applicant may not have been aware when drafting the application. As a result, it is inevitable that in some (many) cases, the data needed to make the necessary comparison is not in the application as filed. The referring decision T 116/18 recognises this very problem (reasons 13.7.2).

Also, in a huge number of cases, the patent application must be filed relatively early in a research program, before all of the data and evidence relating to the invention has been collected. For example, this may be because of a planned disclosure, not necessarily in the control of the applicant – it could be for regulatory reasons, or in view of known competitor activity.

It has hence been established EPO practice for many, many years to accept post-filing evidence in support of inventive step. It would be unfair on applicants to change that now, and it might have undesirable consequences for already-granted EP patents.

The answer to Question 1 (as referred) must therefore be NO. There must be a free evaluation of the evidence. We also agree with the more general point in the brief filed by *epi*, that there should be no exception to this.

Questions 2 and 3 (*ab initio* plausibility / implausibility)

Given our answer to Question 1, we believe that no answer is required to Questions 2 & 3 of the referral. In case the Enlarged Board disagrees, however, we make the following comments.

Because of the difficulties explained above, it is important that the EPO recognises the reasons why an applicant may need to rely on evidence published after the filing date.

We therefore think that any requirement for information in respect of plausibility (or lack of implausibility) at the filing date should be minimal. For example, it should suffice if the technical effect ultimately relied upon is merely ‘not completely implausible’ – especially bearing in mind that at the date of filing the applicant may not know the closest prior art which must be distinguished. As an example, is the technical effect a reasonable extension from examples given in the application as filed?

Furthermore, the referral deals exclusively with the concept of plausibility in the context of inventive step. However, the issue also arises in other contexts (notably sufficiency of disclosure). The Enlarged Board’s decision needs to take this into account – if a definition of ‘plausibility’ is to be established, it should ideally be a uniform one.

Whatever it decides, the Enlarged Board should avoid making ‘plausibility’ a separate patentability hurdle. There is no plausibility requirement in the EPC. It should not be introduced indirectly.