



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Roberto Pistolesi
Secretary General

19 April 2022

Registry of the Enlarged Board of Appeal
European Patent Office

Attention: Mr Nicolas Michaleczek

via email: EBAamicuscuriae@epo.org

RE // Case number G 2/21

Dear sirs,

Please find attached FICPI's written statement in response to the communication from the Enlarged Board of Appeal concerning case G 2/21, issued 10 December 2121.

Yours faithfully,

Roberto Pistolesi
Secretary General

Enc.

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Written statement for case G 2/21 before the Enlarged Board of Appeal

19 April 2022

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have the opportunity to provide this written statement for case G 2/21 in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

I. Case G 2/21

The following questions have been referred to the Enlarged Board of Appeal in case T 0116/18:

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)?*



II. FICPI's comments

FICPI believes that the specific questions put to the Enlarged Board do not adequately deal with the issues at stake, and simple “yes” / “no” answers would be unsatisfactory. In particular, **FICPI** believes that Question 1 conflates the issue of “proof” with “plausibility”. It is logical to answer “no” to Question 1 on the basis that there should be no exceptions to the principle of free evaluation of evidence, or on the basis that post-published evidence should be evaluated even when it is the exclusive proof for the existence of an effect that is rendered plausible, but unproven by the application as filed. As currently framed, Question 1 does not allow for the different situations of, for example, an application that is wholly speculative and an application that discloses subject-matter for which an effect is plausible, but still does not contain proof of the effect. Question 1 might be better formulated as:

“May post-published evidence be disregarded solely on the ground that the proof of an effect rests exclusively on the post-published evidence?”.

Further, **FICPI** believes that Questions 2 and 3 should be answered regardless of the answer to Question 1.

Article 52 EPC sets out that “*patents shall be granted for any inventions, in all fields of technology*”. **FICPI** believes that a patent should only be granted when the applicant was in possession of the invention at the time of filing and not on an application that consists solely of speculation, even if some speculative subject-matter turns out to be a “lucky guess”. It is clearly not practical for a third party such as an examiner or opponent to determine whether an applicant or proprietor was actually in possession of the invention at the time of filing, and an objective test is therefore needed to deter and safeguard against purely speculative applications, but **FICPI** doubts whether a “plausibility test” linked to a technical effect is the correct mechanism to deny patentability to such purely speculative inventions.

The subject matter of an invention is generally a device, a substance or a method in an area of technology and not a technical effect, except in special circumstances. A new, non-obvious and industrially applicable invention exists independently of evidence that the subject matter of the invention is associated with a technical effect. Furthermore, an invention can be purely theoretical: it should be possible to obtain protection for an invention made in a “eureka” moment made in an armchair (or bathtub), which an application as filed enables, but for which the proof of an effect is only demonstrated later.

A test which, if met, gives confidence that the existence of an invention will be acknowledged may be helpful in maintaining the principle of legal certainty. However, it is important for there to be flexibility in the criteria used, for example, to enable an inventor to demonstrate that they were in possession of an invention in a new field that does not conform to previous



expectations. When considering whether an inventor was in possession of an invention, the wider circumstances of the invention and the disclosure need to be considered. For example, it might be appropriate to treat an application directed to a specific concept differently from an application consisting of wide ranging and contradictory guesses as to how a desired result might be achieved.

An objective test for the possession of an invention should set a low bar. It is often necessary to file an application at an early stage in the development of a product or process which incorporates the invention, *e.g.* before full trials to demonstrate efficacy can be carried out for budgetary or confidentiality reasons. Setting a high bar would adversely hinder universities, start-ups and SMEs that cannot invest the resources necessary to collect extensive evidence of efficacy prior to filing.

FICPI is of the view that a requirement for an effect to be made plausible by an application as filed before post-published evidence will be considered in all cases, is too strict. To the contrary, **FICPI** believes that when an inventor was in possession of an invention at the time of filing, effects associated with the subject matter of the invention that are disclosed in an application should be considered ***prima facie* plausible** and may be further supported by post-published evidence under the principle of free evaluation of evidence. Only when the contents of the patent application in suit or the common general knowledge positively render an effect implausible, *i.e.* when the person skilled in the art has serious reasons to doubt that the effect could be obtained in practice, may the post-published evidence be disregarded.

In addition, the way the EPO assesses inventive step under the problem-solution approach, while often being helpful in assessing obviousness, is ultimately artificial and often necessitates the reformulation of the objective technical problem in view of newly cited prior art. **FICPI** believes that the ability of an applicant to adduce additional evidence to support a technical effect associated with the subject-matter of the invention that, although not explicitly disclosed in the application as filed, preserves the spirit and character of the disclosed invention and is **not implausible**, must be preserved.

In special circumstances when the attainment of a particular technical effect is treated as an integer of a claim and thus part of the subject matter of the invention, such as a second medical use or a purpose-limited process claim, then it is appropriate to consider whether the claimed effect was rendered plausible in the application as filed. If the claimed effect was not rendered plausible, it might be appropriate to conclude that the inventor was not in possession of the invention at the time of filing. However, it is important to keep in mind that even a claimed technical effect can be rendered plausible without having been proved, *e.g.* by means of extrapolation, analogy or a theoretical rationale, and the principle of free evaluation



of evidence should be preserved in order to allow later proof, if needed, of a claimed effect that is rendered plausible by the application.

III. Suggested answer to the referred questions

In view of the above, **FICPI** suggests answering the questions referred to the Enlarged Board of Appeal (with Question 1 reformulated as above) as follows:

- 1. Post-published evidence may not be disregarded solely on the ground that the proof of an effect rests exclusively on the post-published evidence.**
- 2. Post-published evidence should 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. Post-published evidence should also 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 no serious reason to consider it implausible that the claimed subject-matter is associated with the effect (*ab initio* implausibility). Only in the special case where the novelty of claimed subject-matter resides solely in attainment of a technical effect should there be discretion to apply an *ab initio* plausibility test on a case-by-case basis.**

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade



Industrial (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, ~~Russia~~,* Singapore, South Korea, Spain, Turkey and the United States of America, a regional section covering for the Andean States (Bolivia, Colombia, Ecuador, Perú and Venezuela), a provisional national section in Poland and individual members in a further 41 countries and regions.

* Membership of the Russian Section in FICPI was suspended on 9 March 2022 by Resolution EXCO/EB22/RES/001 of FICPI's Executive Committee in response to Russia's invasion of Ukraine.

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