



Registry of the Enlarged Board of Appeal  
European Patent Office  
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*For the attention of: Mr Nicolas Michaleczek ([EBAamicuscuriae@epo.org](mailto:EBAamicuscuriae@epo.org)).*

29 April 2022

Dear Members of the Enlarged Board of Appeal

### **Amicus Curiae Brief – G 2/21**

The IP Federation submits this written statement, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, for the assistance of the Enlarged Board in considering case G 2/21. In summary, the IP Federation's submission is that: post filed evidence should be admissible to support a technical effect that the skilled addressee, having regard to the teachings of the patent application in suit and the common general knowledge available at the patent application filing date, would not have considered implausible.

### **Introduction**

The IP Federation represents the views of UK industry in IP policy and practice matters in the UK, Europe and internationally. Its membership of influential IP intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. Details of the IP Federation membership are given at the end of this letter.

The IP Federation membership invest heavily in IP and are very active users of the European Patent Office (EPO). This submission follows a detailed consideration in the IP Federation Council of the question referred in this case, and the views expressed are based on our members' considerable experience of prosecuting European patent applications and the opposition procedure for European patents, including proceedings before the Boards of Appeal.

### **The Questions**

In decision T 116/18 of 11 October 2021, regarding European patent number 2484209, the following questions are referred to the Enlarged Board of Appeal for decision pursuant to Article 112(1)(a) EPC:

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)?

The IP Federation respectfully submits the following observations as *amicus curiae*.

### **Main Observations**

1. Insofar as the Board reaches an affirmative conclusion in answer to Question 1, in that post-filed data should be excluded when a technical effect is not foreshadowed in the patent application as filed, the IP Federation members believe that it should be permissible to take into account post-filed data if, based on the information in the patent application in suit and/or the common general knowledge, the skilled person at the filing date of the application would have seen no reason to consider the technical effect implausible (including if they considered the technical effect to be plausible based on the information in the patent application and/or the common general knowledge).
2. This is because the role of plausibility should be limited to preventing speculative patenting. It is a pre-condition and not a substitute for the core statutory principles of patentability that a patent must be new, inventive and sufficiently disclosed.
3. If a patent application/patent discloses a technical effect, and the prior art and common general knowledge at the filing date do not suggest that such a technical effect is implausible, then that patent application/patent is not speculative. Therefore, once this low threshold test is satisfied, plausibility should no longer play any further role in the assessment of novelty, inventive step and sufficiency. In particular, once the technical effect of a patent/patent application is shown not to be speculative, it should not be open to third parties to attempt to use the concept of plausibility as a way of disregarding the (non-speculative) disclosure in the patent/patent application. Further, the patent proprietor should be free to file whatever post-filed data is required to support the technical effect it has disclosed in its patent application/patent in the assessment of the patentability of its application/patent (in the face of a challenge that the technical effect is implausible or otherwise).
4. This position flows naturally from the policy considerations underlying the first-to-file system in the EPO. Unlike a first-to-invent system, patent proprietors are

encouraged to disclose their inventions early in the development cycle, which is often before they can explore the full scope of their discovery. It is only fair, therefore, that once they have disclosed a plausible technical effect in their patent application, a patent proprietor can file post-filed data as necessary to support the scope of the claims. The patentability requirements of novelty, inventive steps and sufficient disclosure must of course still be met. Additionally, the admissibility of any such post-filed data must also naturally still remain within the procedural requirements of the EPO which prevents procedural unfairness.

### ***Answering the Questions***

Therefore, insofar as the Board answers question 1 in the affirmative, the IP Federation believes questions 2 and 3 should also be answered in the affirmative. That is it should be permissible to take into account post-filed data if, based on the information in the patent application in suit and/or the common general knowledge, the skilled person at the filing date of the application would have seen no reason to consider the technical effect implausible (including if they considered the technical effect to be plausible based on the information in the patent application and/or the common general knowledge).



## **IP Federation members 2021**

The IP Federation membership comprises the companies listed below. The UK Confederation of British Industry (CBI), although not a member, is represented on the IP Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. The IP Federation is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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