



European Patent Office
Registry of the Enlarged Board of Appeal
Mr. Nicolas Michaleczek
80298 Munich

EBAamicuscuriae@epo.org

April 29, 2022

Referral to the Enlarged Board of Appeal - G 2/21

Amicus Curiae Brief by the Patentankammer according to Art. 10 (1) RPEBA

EXECUTIVE SUMMARY

The position of the Patentankammer regarding the referral questions can be summarized as follows:

Question 1 referred to the Enlarged Board of Appeal should be answered with NO. Any kind of a priori disregarding of evidence violates the right to be heard according to Article 113 EPC and, thus, is not acceptable.

As the answer to question 1 is NO, answers to questions 2 and 3 are not required.

If question 1 is answered with YES, questions 2 and 3 should be answered with YES.

I. Interlocutory decision and referred questions

According to Art. 112(1)(a) EPC, the technical Board of Appeal 3.3.02 of the European Patent Office has - by its interlocutory decision T 116/18 - referred legal questions to the Enlarged Board of Appeal. The referral is pending under G 2/21.

The referred questions are the following:

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)?

II. Regarding the referred questions in more detail

1. Construction of the referred questions

The referred questions, in particular the way in which they use certain terms, are construed in the following way:

a. Question 1 emphasises the prerequisite for disregarding evidence that the proof of the effect rests exclusively on the post-published evidence.

b. Question 1 suggests that a substantive examination of the meaning of “proof of the effect rests exclusively” has to be conducted prior to evaluation of the evidence.

c. The Patentanwaltskammer doubts that the definition of “post-published evidence” is clear. Although the term seems to be used in the decision under appeal only for “post-published evidence” filed by a proprietor, it is common practice to use it for all “post-published evidence” which is published after the filing date of a patent application to achieve a well-balanced situation for all parties participating in the proceedings.

d. The terms “proof of the effect rests exclusively” and “information in the patent application” may encompass the following abstract situations:

i) “A priori objections”: The original application documents assert an effect obtainable by the claimed invention without any or with incomplete data in support thereof (G 1/19).

ii) “A posteriori objections”: The original application documents disclose data in support of an effect, but this data is later contested.

Cases i) and ii) can appear in one patent application independently from one another for different embodiments.

2. Means of evidence and free evaluation of evidence

In accordance with generally accepted legal principles and the established case law of the Boards of Appeal, a „Failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 117(1) and Art. 113(1) EPC, see T 1098/07, point 8.2 of the Reasons. In T 135/96, point 3 of the Reasons, ignoring documents (and arguments) relevant to inventive step was found to violate the party's right to be heard“. In T 1110/03 (OJ EPO 2005, 302), point 2.4 of the Reasons, it is declared: “[...] viz. the right to give evidence in appropriate form, specifically by the production of documents, Art. 117(1)(c) EPC, and the right to have that evidence heard“ (Case Law of the Boards of Appeal, chapter III.G.3.3).

Art. 117 EPC relates to the means of giving evidence before the EPO and allows, inter alia, the production of documents (Art. 117(1)(c) EPC) and sworn statements in writing (Art. 117(1)(g) EPC).

The EPC does not contain any definition for the requirements on the production of documents in general or for the production of documents for different procedural issues or certain types, e.g. for post-published technical documents.

Before we comment on this in more detail, we would first like to refer to the principles laid down in case law as mentioned below and cited in the referral.

G 3/97, point 5 of the Reasons, paragraph 2 reads: "Regarding the issues of evidence raised in the referrals, it must be emphasised that proceedings before the EPO follow the principle of the free evaluation of evidence. This also applies to the problems under consideration here. The principle of free evaluation would be contradicted by laying down firm rules of evidence defining the extent to which certain types of evidence were, or were not, convincing. Instead, the question whether a fact can be regarded as proven has to be assessed on the basis of all the relevant evidence."

G 1/12, point 31 of the Reasons reads: "'If the answer is yes, what kind of evidence is to be considered to establish the true intention?' The referred question concerns what kind of evidence is needed to establish true intention. In general terms, it must be emphasised that proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence. This also applies to the problems under consideration here. As the Enlarged Board of Appeal pointed out in G 3/97 (OJ EPO 1999, 245, No. 5 of the Reasons) and G 4/97 (OJ EPO 1999, 270, Reasons No. 5), '(t)he principle of free evaluation would be contradicted by laying down firm rules of evidence defining the extent to which certain types of evidence were, or were not, convincing'. The Enlarged Board of Appeal sees no reason not to apply this principle in the present case and to provide guidance on its application."

The Patentanwaltskammer is of the firm opinion that the principle of free evaluation of any type of evidence may not be compromised in order to grant the right to be heard guaranteed by Art. 113 EPC. Therefore, the principle of

free evaluation of evidence must not be contradicted by a firm ruling for considering post-published technical information.

3. Proposal

The Patentanwaltskammer considers that post-published evidence must be freely evaluated for its probative value. However, free evaluation of evidence can only apply in so far as the decision depends on the probative value of evidence. Where a fact is not pertinent to a decision, evidence in support of this specific fact does not need to be evaluated. Thus, evidence of post-published facts is open for evaluation only if consideration of such facts is not precluded by law.

The Patentanwaltskammer proposes that any effect made plausible in the original application documents can be challenged or defended by evidence created or made public after the priority date of the patent application according to established case law (see T 2371/13 and T 31/18 where experimental evidence was filed during opposition proceedings but was found not to support the alleged effect vis-à-vis the closest prior art).

It is not incumbent upon the applicant to provide, in the original application documents, all means of defence against a posteriori material objections, i.e. objections based on a comparison of the contents of the original application documents against prior art or against conflicting evidence. The applicant must be accorded all means to defend his patent application or patent against later challenges, in particular against objections under Artt. 54 and 56 EPC. This includes the means to challenge the probative value of evidence relied upon in any a posteriori objection, e.g. by proving that a later allegation is incorrect. It does not include, however, the liberty to make the invention after the date of filing by relying on arguments that have no basis in the original application documents, be it that these documents do not at all contain a supportive expression of thought of the inventor, be it that the expression would be open to an a priori objection. Thus, in case of an a posteriori objection, it is at first necessary to evaluate if the defence of the claimed subject matter is supported by the description in its entirety (T 1024/18, point 3.1.8 of the Reasons), i.e. if the person skilled in the art would recognise that an alleged technical effect is reliably achieved.

If the skilled person is found to be convinced that the alleged technical effect is associated with the claimed invention (in particular its characterising feature) and not merely an unsubstantiated speculation, i.e. that it is credible, then, in a second step, it must be examined whether the evidence on which the defending party relies on with reference to the technical effect has sufficient probative value. Thus, the free evaluation of evidence is applied in two regards, namely to the assessment of the content of the original application documents and to the additional evidence brought forward in defence of the patent.

Also, as the principle of free evaluation of evidence must not be contradicted by a firm ruling for considering post-published technical information: Free evaluation of evidence may be supported, for example, by a very general guidance on credibility of e.g. the conduction of experiments and post-published evidence, if inventive step is to be proven for disclosed effects, in particular for synergistic effects in the patent or if sufficiency of disclosure is questionable.

4. Reformulation of the technical problem in view of the closest prior art

Decades of case law required the reformulation of the technical problem in view of the closest prior art and acknowledged post-published evidence as support for the objective problem to be solved in view of new prior art. As mentioned in the decision under appeal, T 116/18, point 13.7.2 of the Reasons: “In fact, the only hurdle applied in this case law has been that the newly formulated problem must lie within the spirit of the invention as originally disclosed. See for instance, T 1397/08, where it is stated in the catchword [...] that: ‘[...] Nothing prevents, even at the appeal stage, the modification of the problem initially posed, provided that the spirit of the original statement of the invention is preserved ...’”. Also, G 1/03, point 2.3.3 of the Reasons, refers to the common practise of the EPO requiring that the technical problem can be deduced from the application as filed (T 13/84; OJ EPO 1986, 253, point 11 of the Reasons).

Also, the UK Supreme Court has opined that “plausibility” is a court invented pre-condition to validity: „Sufficiency or plausibility, in the sense presently relevant, is a court-invented pre-condition to validity. It has been constructed by courts, principally to attach some limit to the Swiss-form claims for

manufacture of compounds for uses which could otherwise be presented on a purely speculative basis. In the circumstances, there is every reason why the pre-condition should be narrowly understood, and should represent a low threshold to overcome." (see point 192 of the Reasons of the decision, 14 November 2018, Generics (UK) (trading as Mylan) v. Warner-Lambert Company Ltd.).

No secondary requirements should be established which are not compatible with Art. 56 or 83 EPC. At most, Art. 52 EPC may be relevant here. According to Art. 52(1) EPC, European patents shall be granted for inventions in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

In this context, the hurdle for inventions in any specific field, in particular the field of chemistry, biotechnology, pharmacy or life science, must not be higher than in any other technical field, such as mechanics, physics or information technology. This is, in particular, true as many inventions involve at least two of the mentioned fields. In all these fields, inventions can equally be made by joint inventors from different fields of technology.

The standard for a patentable invention is that the invention is sufficiently disclosed to be carried out by the skilled person and involves an inventive step, both in view of the skilled person's common general knowledge, on the filing date. If, due to later circumstances, further data supporting the executability and/or inventive step are furnished by the proprietor, the proprietor may offer the proof with a higher standard of proof, e.g., convincing proof of general technical knowledge and private documents as post-published documents, if necessary comprising photos/video of the particular experiments. Such supporting data or material then has to be considered under the principle of free evaluation of evidence if it supports the sufficient disclosure and the inventive step involved in the claimed invention.

Furthermore, based on the above considerations, the Patentanwaltsskammer proposes to abandon the "plausibility" case law and to return to the established case law according to T 31/18 and T 2371/13.

III. Conclusion

Question 1 should therefore be answered with NO.

As the answer to question 1 is NO, answers to questions 2 and 3 are not required.

In the event that question 1 is answered with YES, question 2 should be answered with YES.

In the event that question 1 is answered with YES, question 3 should be answered with YES.

The Patentanwaltskammer is available for further discussion.



Richard Bennett, LL.M.
Chairman of Division V and of
the Committee on Digital Technology



Dr. Tanja Bendele, LL.M.
Chairwoman of the Committee
on Patent and Utility Model Law



Dr. Hendrik Wichmann
Chairman of the Committee
on Biotechnology