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Decision G 2/21 on plausibility: Enlarged Board of Appeal acknowledges different thresholds for inventive step and enablement with regard to post-filing data

First findings on the opt-out

M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A T T O R N E Y S

Decision [G 2/21](#) on plausibility: Enlarged Board of Appeal acknowledges different thresholds for inventive step and enablement with regard to post-filing data

In a landmark decision, the Enlarged Board of Appeal of the European Patent Office has distanced itself from the term “plausibility” and clarified that different thresholds apply for taking account of post-filed data for inventive step and enablement. One may be inclined to welcome this for putting a stop to developments in case law which have rendered it increasingly difficult for applicants/patentees to submit post-filed data to show an inventive step. However, such a result seems doubtful, as the Enlarged Board of Appeal confirms that, according to established case law, post-filed data cannot be the sole basis for establishing a technical effect. Such reasoning has so far been put forward by every board that has disregarded post-filed data.

The established inventive step analysis at the European Patent Office includes identifying the difference between the subject-matter of the claim and the closest prior art. The technical effect caused by this difference is then determined. On the basis of this technical effect, the objective problem which the underlying invention solves is phrased. It must be plausible that this problem is solved over the entire scope of the claim. If this is not the case, the problem needs to be reformulated in such a way that the problem is plausibly solved over the entire scope of the claim¹.

The requirement of plausibility was first established - without using the word “plausibility” - in decision [T 939/92](#)², known as the “AgrEvo” decision. In this case, the board did not consider it credible that compounds with a wide ranging variety of different substituents, falling under a generic structural formula, should all show herbicidal activity. As the patentee did not submit additional data, the alleged technical problem was regarded as not having been solved.

At that time, this decision raised eyebrows among patent attorneys. Could a board regard itself as being in a position of creating a new patentability criterion in the form of plausibility? An aspect that got a bit out of sight was that since the founding days of the European Patent Office it has been undisputed case law that the problem to be solved must be derivable from the application documents³ and that the applicant cannot subsequently invoke an advantage that he had presented as undesirable in the application as filed⁴.

Accordingly, in the proceedings of decision [T 939/92](#) submitting post-filing data proving the alleged technical effect would have been unproblematic.



In Our Own Affairs

After a “Corona break” of three years, our traditional patent seminar will take place again this year. Eight speakers await you at the Industrie-Club in Düsseldorf, who will not only bring you up to date with regard to current patent case law in Germany and Europe, but will also shed light on other interesting topics, such as the limits of D&O insurance protection in the event of patent infringement and the judicial enforcement of patent law claims with the help of litigation financiers. The patent seminar is aimed at patent department staff as well as lawyers working in the field of intellectual property. If you are interested, we look forward to receiving your registration. You can download the registration form from www.mhpatent.de.

¹ However, compare decision T 500/20

² Point 82 of the reasons

³ T 13/84, point 11 of the reasons

⁴ T 155/85, head note

A somewhat stricter view has become widely accepted worldwide: in most countries (meanwhile also in China), post-filing data on inventive step can be submitted if it supports information already contained in the application. This is also the practice in Australia, for example, where incidentally plausibility is understood as an aspect of enablement.

At the EPO, the spectrum ranges from decisions which merely require that post-filing data must not be implausible in the light of the application⁵, to decisions which require that the application as filed already needs to provide data and which do not accept unsubstantiated statements⁶. This gave rise to the impression that possession of the invention, similar to the U.S. "Written Description Requirement", has found its way into EPO case law via a requirement of plausibility⁷.

At first glance, the Enlarged Board of Appeal has now rejected such an approach: It clarifies that plausibility does not amount to a distinctive legal concept or a specific patent law requirement under the EPC⁸. However, no Board of Appeal has stated to the contrary. At second glance, it would be illogical for the Enlarged Board of Appeal to deny a requirement of possession of the invention, at least altogether, if post-filed data cannot be the sole basis for establishing a technical effect, see above.

At the latest in decision [G 1/19](#)⁹, the assessment whether a claimed objective problem is solved over the entire claim scope had received official confirmation by the Enlarged Board of Appeal. However, in G 2/21 the Enlarged Board of Appeal is silent on such an approach. Instead it exclusively refers to the technical effect.

Indeed, the aspects of the problem/solution approach mentioned at the beginning above show a degree of laxness: before I set out phrasing a problem solved by the invention, I should actually be convinced that the technical effect is more than an allegation asserted by the patent application. The technical effect, not the problem based thereon, should already be plausible vis-a-vis the claim scope. This may seem hair-splitting, but the additional detour via re-phrasing the problem to be solved may have contributed to the fact that plausibility has begun to take on a life of its own over time. Thus, in its review of the case law, the Enlarged Board of Appeal found that the boards of appeal ultimately all examined whether or not the technical effect relied upon by the applicant or patentee was derivable for the skilled person from the technical teaching of the application documents¹⁰. The downstream question of whether a phrased problem is solved or not, is not mentioned by the Enlarged Board of Appeal at all in this context.

In its review of the case law of the last two decades, the Enlarged Board of Appeal found as common ground that the Boards constantly apply two criteria when assessing plausibility: (1) the common general knowledge of the person skilled in the art at the filing date, and (2) the technical teaching of the claimed invention which can be understood by the person skilled in the art from the application as originally filed¹¹. According to the Enlarged Board of Appeal, these criteria are also used by courts of the EPC contract-

In Our Own Affairs

For the 15th time, our office is offering two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE) in 2023. The courses will take place on Monday/Tuesday, November 20/21, and Saturday/Sunday, December 9/10, 2023. Both courses are identical in content, so attendance at one course is sufficient.

The course content is mainly focused on appropriate exam techniques as well as strategies to avoid mistakes in order to successfully approach the C and D part of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Kai-strasse 16A and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Prof. Dr. Alloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

⁵ e.g. T 1760/11, point 10.5.1 of the reasons

⁶ e.g. T 488/16

⁷ T. Exner/A. Hüttermann, GRUR 2018, 97, cited in G 2/21 at point 80 of the reasons

⁸ G 2/21, point 92 of the reasons

⁹ G 1/19, point 82 of the reasons

¹⁰ G 2/21, point 72 of the reasons

¹¹ G 2/21, point 71 of the reasons

ing states when deciding on whether post-filing data can be taken into account in the assessment of a technical effect¹². According to the Enlarged Board of Appeal, these criteria are also the relevant standard for assessing whether an inventive step is involved, on the basis of the presence (or absence) of a technical effect¹³. This is almost literally repeated in the second headword of decision G 2/21.

On the question to what extent at the European Patent Office a case can turn upon post-filing data, the Enlarged Board of Appeal fortunately drew a line between inventive step and enablement. It came to the conclusion that case law on the assessment of inventive step applied clearly different standards than the assessment of enablement: for data on inventive step, the “scope of reliance” on post-filing data is much larger than for post-filing data that are filed to support enablement¹⁴. A lack of enablement cannot be cured by post-filing data.

This statement will hopefully prevent a mix-up of the requirements in terms of inventive step and enablement.

For submitting post-filing data, the first headword of G 2/21 applies: Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.

First findings on the opt-out

Now that the “sunrise period” has begun, the first figures are available on who is using the early opt-out.

We analyzed the use of the opt-out within the time window from March 1, 2023 to March 15, 2023, i.e., the first two weeks of the sunrise period. Some surprising and some less surprising numbers emerged, which we will discuss below.

Figure 1 shows the most frequent Main IPC classes of opted-out patents:

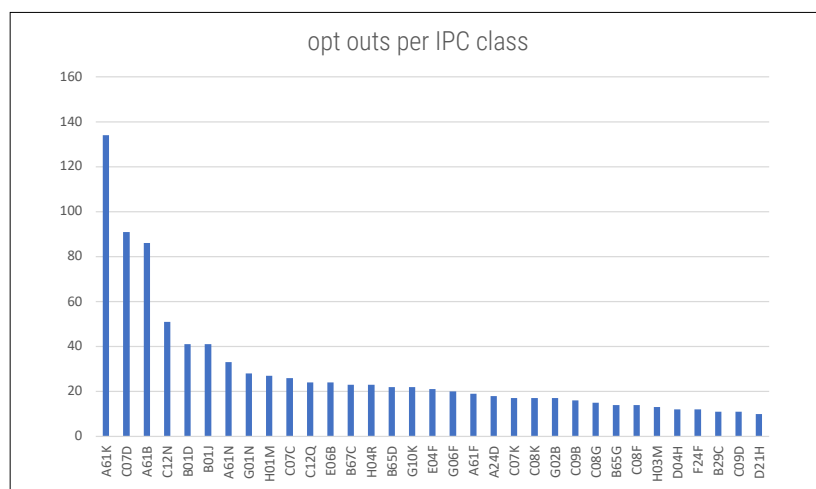


fig. 1: opt outs per IPC class

¹² G 2/21, point 87 of the reasons

¹³ G 2/21, point 93 of the reasons

¹⁴ G 2/21, point 77 of the reasons

Frankly, it is not surprising that the major part of opted-out patents and patent applications has its main IPC class in the medical, biotech or chemistry field. In these technical disciplines, the patent:product ratio is smaller than e.g. in telecommunications, meaning that a loss of a patent due to central invalidation has the potential to open the market directly for generic products. For that reason, applicants seem to be more cautious to lay their crown jewels into the hands of a court which they do not really know yet.

Figure 2 shows opted-out patents and patent applications plotted against the nationality of the applicant or patent owner.

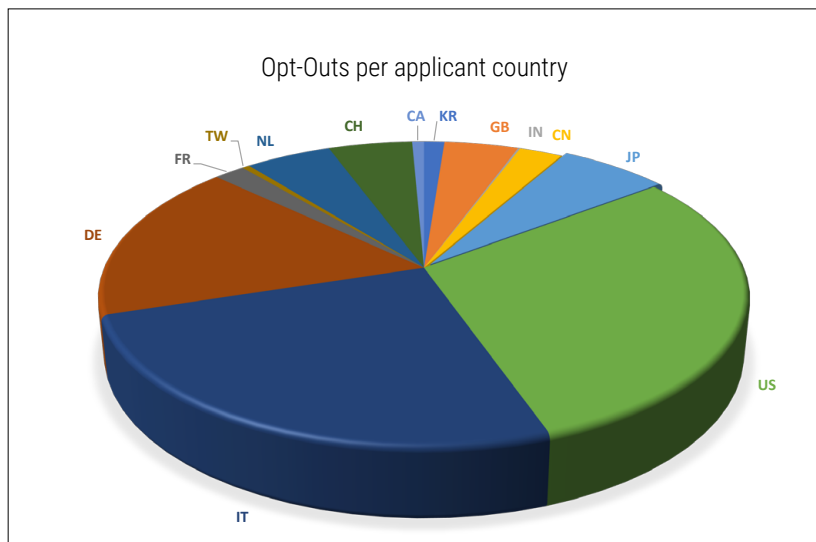


fig. 2: Opt-Outs per applicant country

Well, relative to its share in total filing numbers, who would have thought that Italian applicants and patent owner are so doubtful about the Unitary Patent Court ?

Figure 3 shows opted-out patents and patent applications plotted against the applicant. Not surprising if you compare with Figure 1. The only notice is that quite a few big pharma companies have not yet filed their requests.

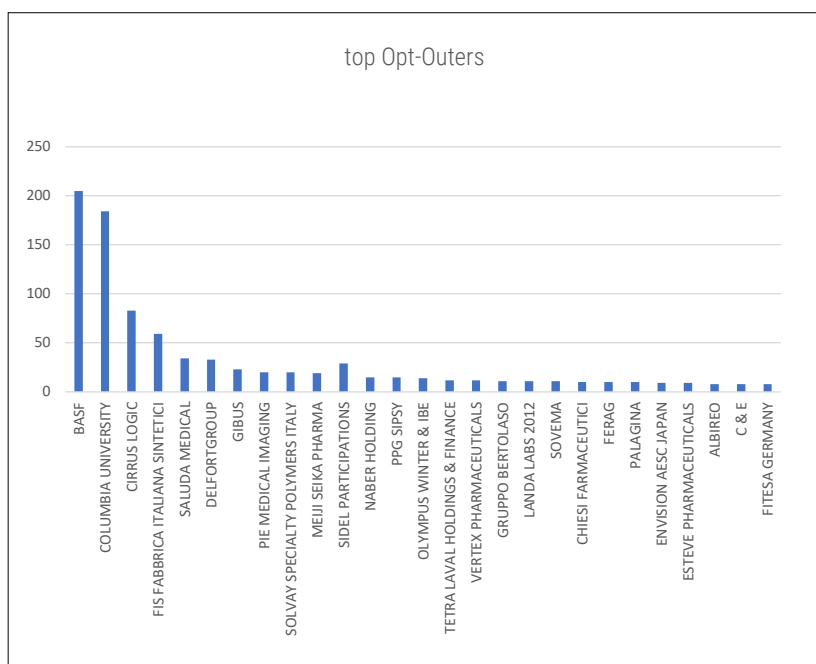


fig. 3: top Opt-Outers

Figure 4 shows Opt-Out Dynamics within the first 15 days of the sunrise period. Obviously, requests are seldomly filed over the weekend.

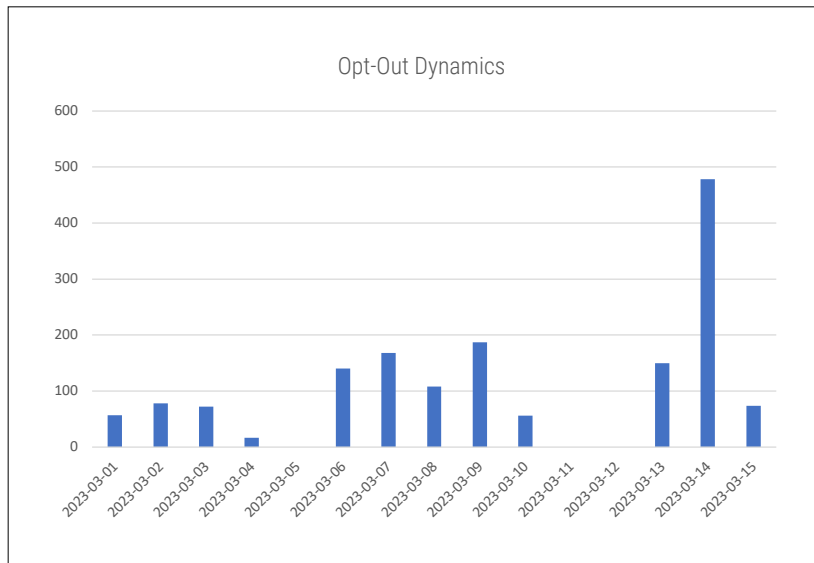


fig. 4: Opt-Out Dynamics

Figure 5 shows the ratio between opted-out patents and opted-out patent applications (yes, you can do that, too!).

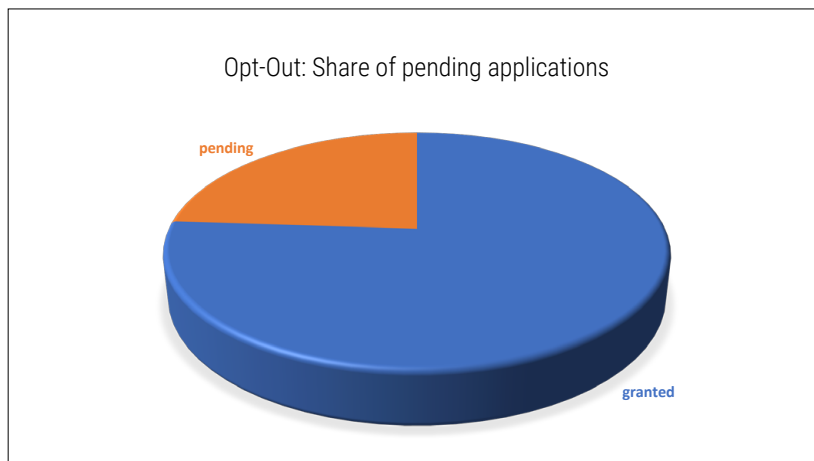


fig. 5: Opt-Out: Share of pending applications

And last but not least, Fig 6 shows the priority dates of opted-out patents.

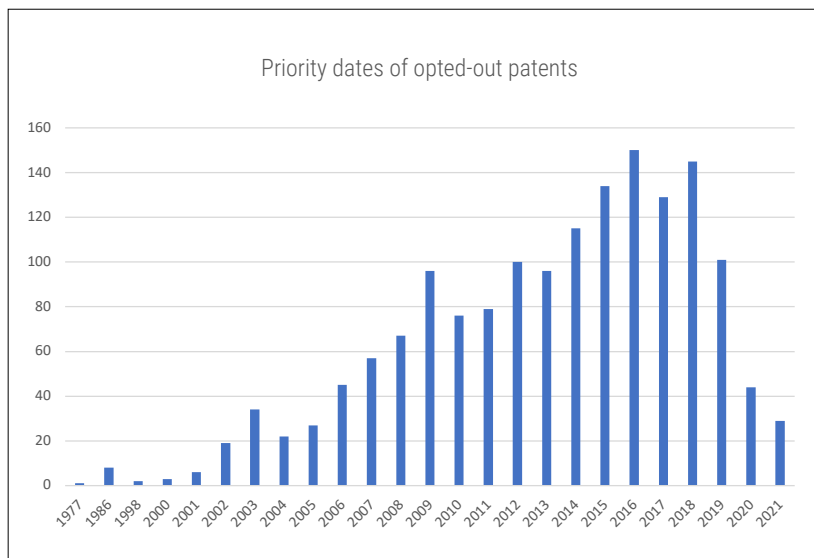


fig. 6: Priority dates of opted-out patents

Technically, an Opt-Out declared for a patent that has expired by June 1, 2023, is invalid. This however does not seem to have kept applicants from declaring Opt-Out for some such patents. Maybe they wanted to be on the safe side.

So far the first impression of who is using Opt Out, for which IPC classes is it used, and what the dynamic looks like.

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