Referrals to the Enlarged Board of Appeal

In 2022, the IP Federation submitted two *amicus curiae* briefs to the Enlarged Board of Appeal (EBA) of the European Patent Office in relation to pending referrals to the Board.

The first brief, submitted in April 2022, was in relation to the G 2/21 "Plausibility" referral. The second, submitted in July 2022, was in relation to the G 1/22 and G 2/22 "Entitlement to Priority" referrals. Decisions have now been issued for each of these referrals .

In addition, there is a new referral now pending before the EBA, G 1/23 "Solar Cell", which the IP Federation is considering.

G 2/21 - Plausibility

G 2/21 related to the filing of post-published evidence to support plausibility of an invention. The three questions referred to the Enlarged Board of Appeal in G2/21 can be summarised as:

1. Should there be an exception to the principle of free evaluation of evidence (see e.g., G 3/97, Reasons 5, and G 1/12, Reasons 31) in that post published evidence of a technical effect must be disregarded if the only proof of that effect is exclusively within the post published evidence?
2. If the answer to question 1 is yes, can the new evidence be taken into consideration if, based on the information in the patent and the common general knowledge, the skilled person would have considered the effect plausible at the filing date (*ab initio* plausibility)?
3. If the answer to question 1 is yes, can the post published evidence be taken into account if there was no reason at the filing date to consider the technical effect implausible (*ab initio* implausibility)?

IP Federation submission

The IP Federation's submission was that post filed evidence should be admissible to support a technical effect that the skilled addressee would have not considered the invention implausible, having regard to the teachings of the patent application and the common general knowledge available at the filing date. This is because the role of plausibility should be limited to preventing speculative patenting.

The IP Federation's position was that this would be in line with 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 present post-filed data as necessary to support the scope of the claims.

Decision

In the decision, the EBA clarified that, according to the principle of free evaluation, examiners must now consider post-filed evidence, stating:

1. *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.*

2. *A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.*

Therefore, the EPO may *not* reject an invention just because data was not available at the time of the patent application. Rather, Examiners and the Opposition Division will need to consider the data carefully to make a decision on whether a technical effect is made out (or at least set out) based on the application as originally filed.

Although welcome, the general view is that this decision has not provided the certainty as to when a technical effect can be considered, compared to the previous 'plausibility' tests . It is still not entirely clear whether the patentee plainly claiming that there is a technical effect without providing any further basis for its existence is enough, as long as subsequently that technical effect is found to exist. Future decisions on this matter should therefore be followed closely. At this point, however, a significant change in approach by the EPO based on this judgment is not expected.

It is worth also noting the EBA's discussion on sufficiency of disclosure. Their comments suggest a higher and more objective bar is to be cleared when a therapeutic effect is claimed (and that post-filing data cannot cure any defects in that respect). As before, a patent application relying on such a therapeutic effect without at least some supporting data or detailed scientific reasoning may still be expected to struggle, especially if challenged in opposition.

G 1/22 and G 2/22 - Entitlement to Priority

These referrals related to the question of the EPO's joint application approach to priority for PCT(EP) applications. Article 118 EPC states that, where the applicants for a European patent are not the same for different contracting states of the EPO, they shall be regarded as joint applicants, and that unity of the application will thus not be affected. The issues in this case boiled down to whether this principle can be extended to PCT joint applicants, where named applicants for a PCT application are different for different designated states.

The questions referred to the Boars are summarised as:

1. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

2. If question I is answered in the affirmative: Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where:

a. a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States including regional European patent protection, and
b. the PCT-application claims priority from an earlier patent application that designates party A as the applicant. and
c. the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

IP Federation submission

The IP Federation submitted that question 1) should be answered in the negative: the EPO does not have jurisdiction to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b). Further, even if the EPO did have such jurisdiction, question 2) should then be answered in the affirmative: the established joint-applicant approach to assessing priority would be the correct one to adopt. This is because a PCT application should be considered as a single, indivisible application until it exits the international phase and applicants should be considered as joint applicants, irrespective of designations for different states. Priority rights cannot be split for different designations, depending on which applicant has been named for each designation.

The IP Federation also noted, on a practical level, that the joint applicant approach has been adhered to for many years and has historically been relied upon by a number of applicants in their overall fling strategies at the EPO. Briefs submitted by other industry groups also reflected this point and it was hoped that the Board would consider the practical implications of this in their opinion.

Decision

The answers from the Enlarged Board were:

1. *The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.*

   There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

2. *The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).*

   In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

On 1), despite a number of *amicus curiae* briefs arguing against it, the EBA was unlikely to give up their authority to assess whether a party is entitled to claim priority under Article 87(1) EPC. The decision states *"Since the creation, the existence and the effects of the priority right are governed only by the EPC (and by the Paris Convention through its relationship with the EPC), priority rights are autonomous rights under the EPC and should be assessed only in the context of the EPC, regardless of any national laws"*.

On question 2), the EBA found that there is a *"rebuttable presumption"* that the applicant claiming priority is entitled. In the PCT joint applicant situation, it was held *"the joint filing implies an agreement between parties A and B"* such that party B can rely on the priority, even if there is no formal assignment of the priority right beforehand. However, there is a caveat: *"unless there are substantial factual indications to the contrary"*.

This decision represents a substantial deviation from some of the previous case law. In T 205/14, the Board had found that *"an assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract"* was required to establish transfer of the priority right. T 1201/14 stated that proof of a valid transfer of the priority right must be "beyond reasonable doubt".

This new rebuttable presumption of valid priority will likely have a significant impact on opposition proceedings. The need to provide prove substantial facts to contrary will make it difficult for opponents to attack the validity of priority claims under similar situations. This decision should therefore be a relief to many patentees, especially those who have used the PCT joint applicants approach in the past. It can perhaps be seen as a more pragmatic assessment of entitlement to priority by the EPO.

G 1/23 - Solar Cell

On 29 June 2023, the EPO announced that the Technical Board of Appeal had, by decision T 438/19, referred three questions to the EBA. The referral arises from the question of whether a commercially available product should be excluded from the state of the art if its composition could not be analysed and reproduced without undue burden by the skilled person.

The referral originates from proceedings relating to European patent 2626911. A decision as to whether the subject-matter of the claims involved an inventive step ultimately depended on the question of whether a commercially available product had been made "available to the public" before the priority date of the patent.

Until now, the approach of the EPO has followed G1/92, which set out:

1. *The chemical composition of a product is state of the art [i.e. already known] when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition.*
2. *The same principle applies mutatis mutandis to any other product.*
3. *In other words, where a skilled person can analyse and reverse engineer an available product without undue burden, then the composition can be considered as known.*

The opponent argued that a commercially available product was publicly available and so part of the state of the art, and provided evidence that the product was disclosed in leaflets before the priority date of the patent. The patentee argued the opposite - that the polymer could not be reproduced by the skilled person without knowledge of the synthesis conditions, such as the specific catalysts and reaction conditions and that this would necessitate an extensive research programme that place undue burden on the skilled person.

In considering inventive step, the Board in T 438/19 noted that the test set out in G1/92 was applied inconsistently in historic cases. In particular, the interpretation of "available to the public" has varied and has led to either: a) the exclusion of a product itself from the state of the art; or b) the exclusion

of only the chemical composition/internal structure of a product from the state of the art. In addition, the subjective criteria of the degree of detail required for the analysis of a product and the requirements for reproducibility have been applied differently. Because of this apparent divergence and resulting legal uncertainty, the Board has sought clarification on the following questions from the EBA.

1. *Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?*

2. *If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?*

3. *If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?*

These questions could have significant impact on pending and future proceedings. The decision will hopefully clarify under which circumstances and to what extent certain properties of a non-reproducible entity may be held to be prior art, if at all.

One aspect that that referring decision has not addressed but which will hopefully also be clarified by the EBA is the question who carries the burden of proof that a prior art product is (or is not) reproducible.

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