



Amicus curiae briefs at the European Patent Office (EPO)

In 2022, the IP Federation submitted two *amicus curiae* briefs to the Enlarged Board of Appeal of the EPO in relation to pending referrals.

The first, submitted in April 2022, was in relation to the G 2/21 “plausibility” referral. The Board issued a preliminary opinion on this matter in October 2022, and held a hearing in November 2022 with the final decision still being awaited. The second brief, submitted in July 2022, related to the G 1/22 and G 2/22 “Entitlement to priority” referrals. The Board is yet to provide anything of substance on this matter, but they are expected to do so in 2023.

G 2/21 - Plausibility

G 2/21 relates to the filing of post-published evidence to support the plausibility of an invention. The three questions referred to the Enlarged Board of Appeal in G 2/21 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 demonstrating 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

In summary, the IP Federation’s submission was that post filed evidence should be admissible to support a technical effect that the skilled reader of the patent would not have considered implausible. This is because the role of plausibility should be limited to preventing speculative patenting.

Furthermore, this would be in line with policy considerations underlying the first-to-file system in the European Patent Convention (EPC). Unlike a first-to-invent system, the EPC approach encourages patentees 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 then file post-filed data as necessary to support the scope of the claims.

Preliminary Opinion

In the preliminary opinion, regarding question 1, the Board indicated that post published evidence should not, as a matter of principle, be disregarded as doing so would deprive the party submitting

and relying on it of their 'right to be heard' in Article 113(1) EPC and their rights in relation to the 'means and taking of evidence' in Article 117(1) EPC.

While this suggests that the first referred question is to be answered "no", the Board nevertheless went on to consider some of the issues raised by questions (2) and (3). The Board indicated that this guidance is to be limited to the question of plausibility in the assessment of inventive step (and not sufficiency).

The Board's preliminary indication was that post published evidence showing a technical effect may be taken into account where there would have been no significant reason for the skilled person to doubt the effect (i.e., where the claimed effect was *not implausible*) provided that the technical effect relied upon is encompassed by the technical teaching of the patent and embodies the same invention. The Board therefore currently is favouring the more lenient "allowable if not implausible" standard with slight modifications to prevent a patentee from relying on a completely unrelated technical effect from that of the original disclosure.

It appears, therefore, that the Board's initial view is in line with the IP Federation's position.

G 1/22 and G 2/22

These referrals relate 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 Board 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 1 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

In summary, the IP Federation's submission was that question 1) should be answered in the negative: the EPO does not, and should 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: it would be the case that 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, and that the priority rights cannot be split for different designations, depending on which applicant has been named for each designation.

The submission in relation to question 1 centred on three key points:

- 1) the contracting states of the EPC have not delegated this authority to the EPO (as is clear from the *travaux préparatoires*);
- 2) drawing on the analogy to the provisions of the EPC relating to entitlement (Art. 61 EPC) highlights that no jurisdiction in respect of such disputes is given by the EPC, and that instead this is a matter for national courts; and
- 3) the determination of such national law questions by the EPO raises a number of practical difficulties given its composition and expertise.

The submissions in relation to question 2) focussed on the principle of equal treatment which requires application of the same rules and practice to Euro-PCT applications unless there are specific prevailing PCT provisions (see Article 150 EPC). It was submitted that there are, however, no PCT provisions excluding the application of the joint-applicants approach to Euro-PCT applications, but rather there are stipulations supporting the approach that during the international phase international applicants are to be regarded as joint applicants even if they are not the same in respect of the different designated States.

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 filing strategies at the EPO. Briefs submitted by other industry groups also reflect this point and it is hoped that the Board will consider the implications of this in their opinion.

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