

G2/21 OR RATHER WHEN THE ABSTRACT FOREST PREVENTS YOU FROM SEEING THE TREES

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For weeks now, patent practitioners have been discussing the content of the G2/21 decision, which should have shed light on whether or not to accept post-published evidence to defend the inventive step of a European patent.

In our opinion, the outcome of G2/21 was as expected, since taking a clear stand on either of the two alternatives (ab initio plausibility or ab initio implausibility), as defined by the referral in questions 2 and 3, would lead to truly unfair situations. The consequences of this decision, regarding the analysis of the sufficiency of disclosure requirement, will not be discussed in this article.

On the one hand, a strict application of ab initio plausibility could have left patentees with little flexibility in reformulating the technical problems that inventions may solve. On the other hand, a strict application of ab initio implausibility would contravene the spirit of the patent system by allowing the protection of inventions before they have been made, or by simply exempting patentees from providing the relevant information for third parties to exploit the invention without undue effort once the patent ceases to have effect.

Taking this into consideration, the EBA seems to have opted for a commitment decision in which none of the options are rejected, but rather left to the examiners' and BoAs' criterion to decide whether the post-published evidence should be accepted or not, on a case-by-case basis.

It seems hence difficult to draw clear and general conclusions from the EBA decision. The two most relevant points on the acceptance of post-published evidence are to be found in the following two paragraphs of the decision:

93 The relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involves an inventive step concerns the question of what the skilled person, with the common general knowledge in mind, would understand at the filing date from the application as originally filed as the technical teaching of the claimed invention. The technical effect relied upon, even at a later stage, needs to be encompassed by that technical teaching and to embody the same invention, because such an effect does not change the nature of the claimed invention.

94. Hence, 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 consider said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

It is clear from these paragraphs that the analysis of the appropriateness of accepting post-published evidence must be made based on the application as originally filed and the common general knowledge. What is meant by "said effect as being encompassed by the technical teaching

and embodied by the same originally disclosed invention" will be subject to interpretations of the BaAs, national Courts and UPC.

In fact, the EBA already points out in its decision that there is no concrete solution to the above question, by acknowledging in paragraph 95 that "*The Enlarged Board is aware of the abstractness of some of the aforementioned criteria*".

However, we cannot rely on abstract concepts and must try to draw practical conclusions from this decision.

We believe paragraph 72 is very important in this respect:

72 Applying this understanding to the aforementioned decisions, not in reviewing them but in an attempt to test the Enlarged Board's understanding, the Enlarged Board is satisfied that the outcome in each particular case would not have been different from the actual finding of the respective board of appeal. Irrespective of the use of the terminological notion of plausibility, the cited decisions appear to show that the particular board of appeal focussed on the question whether or not the technical effect relied upon by the patent applicant or proprietor was derivable for the person skilled in the art from the technical teaching of the application documents.

Although the EBA does not say *verbatim* that it agrees with the decisions of cases cited above (paragraphs 66-69), by indicating that the EBA's lessons would have led to the same conclusions as the decisions, it has the same effect. Thus, in practice, the EBA indicates that these decisions are correct. And not only does it mention them, but it also provides a brief description of each of them, referring to the arguments which would be valid to accept or reject the post-published evidence. The teachings of these decisions are the important trees that may be perceived in the abstract forest defined by the EBA.

Hence, if some of the lessons validated by the EBA, in the form of previous BoA decisions, are applicable to the particular case to be judged after the G2/21 decision, one may have a reasonably clear idea if the post-published evidence will be accepted or not.

It is not the purpose of this short article to review each of these decisions and the arguments highlighted by the EBA, although studying them is highly interesting.

As a last point, there is further interesting information to be extracted from the decision on the inventive step analysis (paragraph 95):

...it is the pertinent circumstances of each case which provide the basis on which a board of appeal or other deciding body is required to judge, and the actual outcome may well to some extent be influenced by the technical field of the claimed invention.

The EBA already indicates that the technical field may influence the outcome of the analysis. After looking at some of the BoA decisions mentioned by the EBA, one deduces that the admission of post-published evidence in the therapeutic and biotech fields may be stricter than in other fields, probably due to their unpredictability.

Conclusion

Decision G2/21 should not bring about a radical change in the EPO's current practice in analysing inventive step. It has basically reinforced some BoA decisions, which can serve as a guide to decide, on a case-by-case basis, whether or not to admit post-published evidence for analysing inventive step. Thus, the EPO, as well as the courts, must ensure that patentees fulfil the commitment required by the patent system to make inventions public in order to obtain, in exchange, a monopoly against third parties. Granting speculative patents without any experimental data should be avoided. However, patentees should benefit from some flexibility when providing new experimental data if unexpected prior art is found during patent prosecution.