

CASE COMMENT

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EPO TECHNICAL BOARD OF APPEAL APPLIES G2/21 “PLAUSIBILITY” TEST

In a well-reasoned decision, the referring Technical Board of Appeal has applied the principles set out in the G2/21 decision. In T-0116/18, it was ruled that the patentee, Sumitomo, could rely on the reformulated purported technical effect directed against a species of moths, even though the application as originally filed did not contain an express positive verbal statement or experimental proof to that effect.

In the case at hand, the TBA had to decide on Syngenta’s appeal to the Opposition Division’s rejection of its opposition to a patent held by Sumitomo. The appeal lodged by Syngenta led the Board to refer the case to the Enlarged Board of Appeal so as to provide clarity regarding the allowability of post-published evidence and the EPO’s position on plausibility. It is this referral that led to decision G2/21, which T-0116/18 now applies.

The disputed patent related to a new combination of known insecticides, and contains data demonstrating an inventive, synergistic effect of the combination of the insecticides against two species of moths. Syngenta claimed this was not the case for one of the exemplified moth species at certain weight ratios. Sumitomo reacted by submitting additional, post-published data to show that the invention did have a synergistic effect, however, against another species of moth. Sumitomo further tried to redefine the objective technical problem to be solved as the provision of an improved insecticide against this third moth species. Whereas the application as originally filed contained some experimental data on the synergistic effect of the insecticides combination, this effect was directed to different moth species than identified in the redefined objective technical problem.

G2/21 held that a patentee can rely on a particular technical effect to show inventive step if, having the common general knowledge in mind and based on the application as filed, the skilled person would derive that effect as being (i) encompassed by its technical teaching, and (ii) embodied by the same originally disclosed invention.

To meet the requirement under (i), the TBA in T-0116/18 rules that *“the purported technical effect together with the claimed subject-matter need only be conceptually comprised by the broadest technical teaching of the application as filed”*. It further explains that this entails that *“the skilled person, having the common general knowledge in mind, and based on the application as filed, recognizes that said effect is necessarily relevant to the claimed subject-matter.”* The Board adds to this that a positive verbal statement, or experimental proof of the purported technical effect, is not necessarily required in the application as filed. It concludes that the broadest technical teaching of the application concerned *“a synergistic effect against insects”*, thus also including the third species of moths.

To assess whether the requirement under (ii) is met, the Board examines whether *"the skilled person, having the common general knowledge on the filing date in mind, and based on the application as filed, [would] have legitimate reason to doubt that the purported technical effect can be achieved with the claimed subject-matter"* . In T-0116/18, this question was answered negatively, so the condition under (ii) was also deemed to be met.

HRM TAKE-AWAY

The TBA re-affirms and applies the principles set out in the landmark decision G2/21 of the Enlarged Board. Reading G2/21 and T-0116/18 together, we can conclude that the G2/21 decision has not created a major shift in EPO practice on post-published evidence and plausibility. It has just steered away from using the term itself, sticking to the two requirements as set out above (see in this regard also T-1989/19).

