

EIP



G2/21 – Enlarged Board Rules that Plausibility is Not the Answer

Before the European Patent Office, applicants frequently wish to rely on experimental evidence obtained after the filing date of the patent application (“post-filed evidence”) in order to support an inventive step. This may be, for example, because the claims are regarded as prima facie obvious based on the available prior art, but where an inventive step could be acknowledged if evidence of a surprisingly improved effect, or a synergistic effect, were provided.

The question then arises – to what extent must the effect in the post-filed evidence relate to what is already disclosed in the patent application? This was the question confronting the Enlarged Board of Appeal in G2/21.

The Enlarged Board answered by essentially restating the existing position – such post-filed evidence may be relied on **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.**

The question was answered at a high level of abstraction, and there remains much room for argument as to how explicit the teaching in the original application needs to be to meet the requirement articulated by the Enlarged Board.

In reaching this conclusion, the Enlarged Board rejected a suggestion by the Board of Appeal that made the reference that the relevant criterion might be whether the application as filed made the effect plausible, or at least not implausible. Thus, plausibility plays no part in the test set out by the Enlarged Board.

Over recent years, plausibility (whether the application as filed renders plausible the technical effect relevant to the claimed invention) has become prominent especially in UK patent cases. It has been treated almost as a free-standing patentability requirement (even though the term does not appear in any patent statute), whereas it is best understood as the standard of proof to be applied to the basic question – does the original application demonstrate that the invention works? The application does not, for example, have to prove beyond any doubt that the invention works, but it does have to show that the relevant technical effect is plausible.

While rejecting plausibility as relevant for inventive step, G2/21 has reaffirmed that it remains the criterion for assessing enablement, that is, whether the application discloses the invention sufficiently for it to be carried out. For the purposes of enablement, the application **does** have to make plausible that a claimed technical effect is achieved. Although, confusingly, the Enlarged Board has refrained from using the term “plausible” in this context and has substituted the synonym “credible”, it does not appear that this is intended to change the standard.

So, the plausibility standard is rejected for inventive step but affirmed for sufficiency.

[Read the full decision](#)

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