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## What's the legal basis for plausibility?

Miquel Montaña (Clifford Chance) · Friday, April 28th, 2017

In the past decade, a new character of the patent theatre has made inroads into the case law of some EU Member States, “imported” from the so-called “EPO case law”. Its name is “plausibility”.

The origin of the plausibility concept can be traced to Decision T 939/92 (*AgrEvo*), where the EPO's Board of Appeals held a patent was invalid for lack of inventive step because it considered that it was not credible (i.e. plausible) that all the compounds claimed had herbicidal properties. The origin of the term (“plausibility”) is found in Decision T 1329/04 (*John Hopkins*). Confronted with a somewhat similar situation, the EPO's Board of Appeal found that the patent application had to contain sufficient information to make it “at least plausible” that a solution to the technical problem had really been found.

In 2008, the House of Lords (as then called) of England and Wales, in the *Conor Medsystems Inc v. Angiotech Pharma, Inc.* case, “importing” the concept from *AgrEvo*, applied this concept as a first “threshold” within a two-tier analysis of inventive activity (1. Plausible? 2. Obvious?). In England, our new character spread around like a drop of oil, to infuse other nullity grounds such as insufficiency (*Regeneron Pharma, Inc. & Bayer Pharma AG v. Genentech Inc.*), industrial applicability (*HGS v. Eli Lilly & Co.*) and even novelty (*Dr. Reddy's Laboratories (UK) v. Eli Lilly & Co.*).

The plausibility character has travelled so far and wide in England and Wales that, as Lord Sir Christopher Floyd recently noted, the latest edition of the *Terrell on the Law of Patents* treatise has a new chapter on “plausibility”. But when looking from the continent at what's happening on the island, one wonders what the legal basis is for applying a new alleged ground for invalidity and, furthermore, for applying it retroactively. Owners of patent applications filed 20 years ago could hardly have foreseen that 20 years later some national courts would read into Article 138 EPC a new revocation ground (lack of “plausibility”) that is simply not there, or that *Terrell on the Law of Patents* would have a new chapter on “plausibility.”

It is commonly understood that speculative applications or a claim that extends its scope of protection to matter that grossly exceeds the technical contribution to the art should not be allowed, regardless of the label used to reject it, as there might not be an invention in the first place. But until (i.e. if and when) the relevant laws and conventions are amended to delimit the precise contours of this new character (e.g. there is no trace of “plausibility” in TRIPS, which, for example, does mention the US's “best mode” requirement), it would be prudent to cast this “plausibility” character with caution.

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This entry was posted on Friday, April 28th, 2017 at 6:56 pm and is filed under [Plausibility](#), [Scope of protection](#), [Spain](#)

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