Kluwer Patent Blog

AIPPI conference report day 2: Sufficiently Plausible

Annsley Ward (Bristows) · Wednesday, October 18th, 2017

Plausibility has been a hot topic for a couple years, so it was no surprise the issue graced the roster for the Pharma Day series of panels at the AIPPI World Congress. Moderating the session, Juergen Meier (Vossius), explained that EPO examiners were increasingly probing a patent beyond the standard novelty and inventive step requirements to ask whether the patent was plausible or credible.

The mischief the plausibility requirement is seeking to cure, explained Dominic Adair (Bristows), is the allowance of speculative or "armchair" inventing, but Adair also cautioned against prohibiting all forms of "armchair inventions" if there is a good invention behind it. Adair reinforced the "very low" threshold for plausibility adopted by the English courts (see Carr J in **Actavis v Lilly** [2015] EWHC 3294) – this was different to the "fair expectation of success" in the inventive step inquiry. There remain unanswered questions including how plausibility can be appropriately assessed where technology is rapidly moving and where the technical field in question may alter the nature of the question.

In Canada there has been has been a sea change in this area following the recent Supreme Court decision in **AstraZeneca** abandoned the requirement that the claims satisfy the "promise of the patent" (although intentionally over claiming may still be a basis for invalidity). Charles Boulakia (Ridout & Maybee) explained that if a person could make a "prophetic example" work on the basis of the specification, then the claim would be sufficient but if it required a research project, just like under English law, it would not. In terms of support, in order to claim a general principle, the patent must contain examples and an explicit statement outlining the reasoning to arrive at the claimed principle. Post-prioirty data is almost always refused.

Post-priority data is admissible and prophetic examples are allowable (under certain conditions) in the US. Following the decision in **Amgen v Sanofi/Regeneron** (2017), Michelle Wales (InHouse Patent Counsel) noted that it will likely be easier for an infringer to adduce evidence of its own difficulties in reaching the invention in order to invalidate the patent which caused the AIPPI audience to mutter a few alarms.

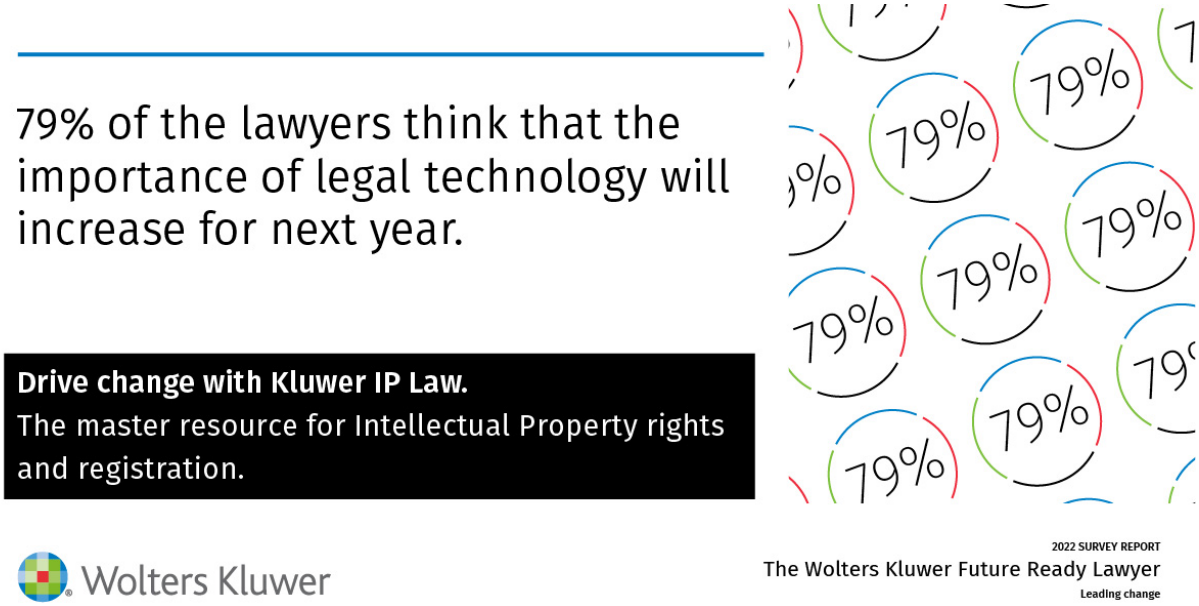
In China, Judge Xia Luo (Supreme Court of China) explained that the Supreme Court was prepared to accept post-priority data as long as the data did not support a technical effect not found in the original application. However, caution was exercised in accepting post-priority data as it ran contrary to the patentee obtaining a monopoly in exchange of disclosing sufficient information to work the invention.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.



This entry was posted on Wednesday, October 18th, 2017 at 4:32 pm and is filed under Conference, Plausibility
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.