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More on G 0002/21: has the Robin Redbreast been freed from its cage?

Miquel Montañá (Clifford Chance) · Monday, February 26th, 2024

As William Blake put it in *Auguries of Innocence*, written in 1803 but not published until 1863, "A Robin Redbreast in a cage, puts all heaven in a rage". So did the ill-crafted concept of *plausibility* with the case law of the EPO's Technical Boards of Appeal (TBA). It introduced an artificial cage that trapped several TBAs – except those that were savvy enough to remain outside the cage (i.e. *No plausibility*) – causing a profound state of disarray in the TBAs' case law. The cage was not only artificial but also, most likely, illegal. For no legal basis for this cage will be found in the text of European Patent Convention and/or its Implementing Regulations, let alone the text of the TRIPS Agreement, although the EPO is of course not technically bound by the latter.

Against this background, it is a matter for celebration that Decision G 0002/21 did away with what the Enlarged Board of Appeal ("EBA"), in par. 58 of this decision, labelled a "generic catchword" (i.e. *plausibility*). As readers are well aware, this so-called "generic catchword" gave rise to three different lines of case law (*Ab initio plausibility*, *Ab initio implausibility* and *No plausibility*) and, down the road, it caused a lot of damage to legal certainty. In this regard, in par. 72 of the decision, the EBA wrote that "[…] 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." Whilst it is understandable that an organ whose job is to keep things harmonized may not easily accept, even implicitly, that things were indeed disharmonized, it stands to reason that the EBA would not have responded to the questions sent by TBA 3.3.02 so carefully if the application of one line of case law or another would not have affected the conclusion reached in each individual case. Of course, it did. So, as mentioned above, it is a matter for celebration that *plausibility* has been consigned to history. As TBA 3.3.02 noted in par. 11.3.2 of its Decision T 0116/18, that is, the decision published after receiving the responses from the EBA:

> "*In formulating order no. 2 in this way, the Enlarged Board did not refer to any of the plausibility standards identified by the board in its referring decision, either by mentioning these standards specifically or by using wording reflecting terminology underlying these standards. On the contrary, it used new legal terminology that had not been applied so far in the context of inventive step. The Enlarged Board may have chosen to do so for two reasons, namely either because it considered all three plausibility standards to be wrong and wanted them to be replaced with the requirement(s) of order no. 2, or because it considered all three standards to reflect the same requirement and wanted to condense this requirement by that (or those) defined in its order no. 2. The actual reason why the Enlarged Board formulated order no. 2 as it did may, however, be left unanswered. What matters is that when deciding*

> *whether a patent applicant or proprietor may rely on a purported technical effect for inventive step, it is the requirement(s) defined by the Enlarged Board in order no. 2 that has (have) to be applied, rather than simply using any rationale developed in the previous plausibility case law.*"

So, moving forward, TBAs will have to manoeuvre within the contours of the new test introduced by G 0002/21:

> "*1. Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.*
>
> *2. 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 derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.*"

Although it would have been preferable, instead of introducing a new test, to let the articles of the EPC do their job, the new test, as shown by the TBAs' decisions following G 0002/21 to date, has shed more light. As the EBA pointed out in par. 95 of Decision G 0002/21, it is a rather abstract test. But this abstractness is precisely what it makes it capable of being of service to TBAs in resolving very diverse cases on their desk.

The Robin Redbreast is an absolutely beautiful bird that is not shy of humans and produces incredibly beautiful birdsong. The beauty of its singing is comparable to the beauty of the reasoning of Interlocutory Decision of 11 October 2021 from TBA 3.3.02 where, struggling to escape from the cage, after developing a thorough review of the three different lines of case law, it begged the EBA to put to an end what was a clear state of disarray. This author would not like to finish this entry without praising the diligence and sense of responsibility of TBA 3.3.02 for having flagged the dimension of a legal debate among various TBAs that had placed legal certainty at bay. Also, the legal grounds of Decision T 0116/18 of 28 July 2023 constitute an enlightening roadmap to navigate the certainly abstract waters of G 0002/21. In spite of its abstractness, to date, TBAs and most national courts have felt at ease charting waters under the new test.

All in all, notwithstanding the good intentions of the TBA that introduced the *plausibility* concept in Decision T 1329/04 (John Hopkins), an example of the *Ab initio plausibility* line of case law, experience has proven the damage that deviating from the text of the EPC can cause legal certainty. Time will confirm whether G 0002/21 has freed the Robin Redbreast from its cage.

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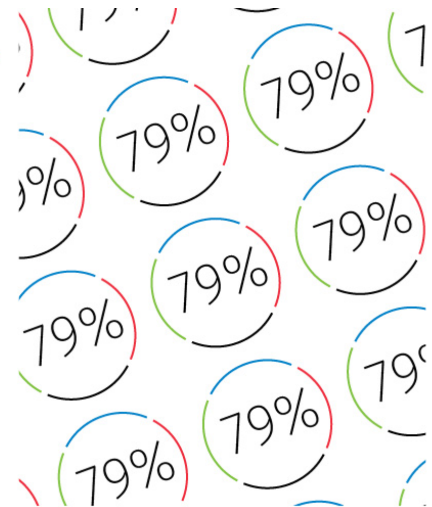

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