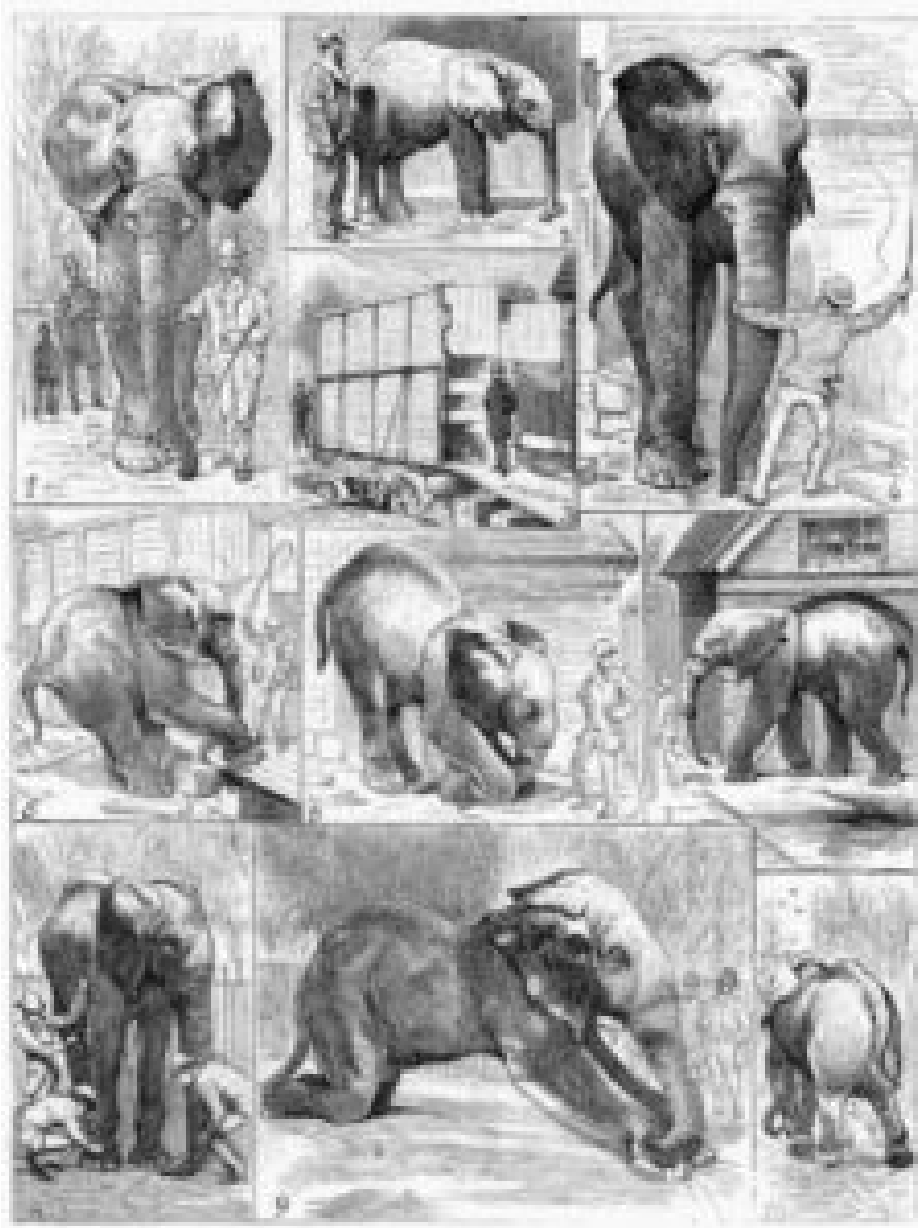

Kluwer Patent Blog

Trying to Make Sense of the Oracle of G 2/21: T 116/18 vs. T 681/21

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Following the issuance of G 2/21 last year, we asked [whether the plausibility elephant had left the room](#). Our Kluwer colleague and friend Miquel Montaña discussed this issue more recently [here](#). Several decisions have meanwhile been issued applying the new “test” in G2/21, the lucidity of which may have reminded readers of the oracle of Delphi. Among these decisions, T 116/18 is by far the most valiant attempt to show the elephant the door. Yet comparison of this case with T 681/21 begs the question of whether we are already starting to see divergence on this important topic.



“Jumbo’s pitiful refusal to leave London Zoo tugged at the nation’s heartstrings”, Public domain, via Wikimedia Commons

T 116/18 – 3.3.02’s interpretation of G 2/21

To briefly recap, the relevant test in G2/21 is:

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

- i) encompassed by the technical teaching and*
- ii) embodied by the same originally disclosed invention.*

TBA 3.3.02 interpreted this as follows:

- i) means 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 – **no literal disclosure of the effect is required**, it is enough that the skilled person recognises the effect is **necessarily relevant** to the claimed subject matter (reason 11.10);
- ii) requires asking: would the skilled person, having the common general knowledge on the filing date in mind, and based on the application as filed, have **legitimate reason to doubt that the purported technical effect together with the claimed subject-matter**, is an embodiment of the originally disclosed invention, i.e. the broadest technical teaching of the application as filed (reason 11.11)? If the answer is no, the effect can be relied upon and again no experimental proof or positive verbal statement is required in the application as filed (reasons 11.12 and 11.13).

Much ink has already been spilled analysing this decision. For us the key point is that this is by far and away the clearest and most detailed interpretation of G 2/21. If adopted by other Boards, it could provide much needed legal certainty for parties concerning the reliance on post-published data to support technical effects for inventive step. However, as the following analysis of T 681/21 shows, the early indications that T116/18 will become the generally accepted interpretation of G 2/21 are not good.

T 681/21 – background

To give a brief overview of the facts behind this case:

1. The main request related to a fabric treatment composition comprising (inter alia) silicone and a specific polymer “CPP”;
2. The applicant relied on the technical effect of improved softness and in particular a synergy due to the combination of silicone and CPP (reason 1.2.1);
3. The description did not contain any examples;
4. The description generally stated that the invention related to a composition including silicone which displays improved softening due to being a separate composition to the detergent;
5. A polymer was essential, and CPP was the preferred polymer, though no reason for this preference was given.

The question before the Board was whether the effect 2. could be relied upon in assessing inventive step.

T 681/21 main request – the deadly side of G 2/21?



Topsy, the elephant who killed a man, Public domain, via Wikimedia Commons

Unlike in T 116/18, no detailed analysis of G 2/21 was given. Instead, at reason 1.2.3 the Board held that:

*In the present case it is not in dispute that the application as filed does not relate to a synergistic effect arising from the combination of a silicone with CPP or any other component. Also the fact that the application as filed (page 2, lines 7-8) indicates the CPP to be a preferred cationic polymer without explaining the reason for this preference cannot foreshadow that the claimed combination would provide any type of synergism. The respondents **did also not file any evidence that it was common general knowledge that silicone and cationic polymers may provide a synergism in terms of improved softness.***

*Therefore, it follows from the above reasons that the alleged synergistic effect would **not** have been considered by the skilled person as being **encompassed by the technical teaching** of the application as filed and has to be disregarded.*

Although the underlying situations are not the same, it is difficult to reconcile this approach with that of T 116/18. After all, for this same element of the test i) “*encompassed by the technical teaching*”, T 116/18 held that the purported technical effect together with the claimed subject-matter “*need only be conceptually comprised by the broadest technical teaching*” – no “*literal*

disclosure” is required, and the effect must instead merely be “*necessarily relevant*”. Arguably the broadest teaching in T 681/21 (i.e. that the invention related to a composition including silicone and a polymer which displays improved softening) encompasses the specific technical effect of improved softness and in particular a synergy with the claimed combination of silicone and the preferred polymer CPP. While the effect was not explicitly disclosed as in T 116/18, surely it would at least be understood to be necessarily relevant?

The objection in T 681/21 that patentee didn’t file evidence of the common general knowledge about synergism and improved softness is reminiscent of the *ab initio plausibility* approach, which was not endorsed by the EBA (but also not explicitly rejected – remember that G 2/21 rather resembles an oracle than a clear-cut opinion). It doesn’t sit too easily with T 116/18 either, which if anything adopted the opposite *ab initio implausibility* approach in holding that the opponent must demonstrate that there is a legitimate reason to doubt that the technical effect applies to the claimed subject-matter.

T 681/21 auxiliary request 4 – the cuddly side of G 2/21?



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Things get even more complicated when we turn to section 5.2.1 of T 681/21 discussing auxiliary

request 4, in which the silicone has been further specified as a preferred anionic type. For this request, patentee relied on the effect that the *combination of anionic silicone with CPP provided unexpectedly better softening than a similar combination comprising a cationic polymer which was not a CPP*. Once again, this effect is not supported by any data in the application as filed, and nor is it expressly identified. Nevertheless, the Board found that this effect **could** be relied upon under G 2/21:

*In the board's view, a skilled person reading the application as originally filed and having the common general knowledge in mind would derive therefrom as a technical teaching that the addressed **improved silicone softness is especially obtained by using a combination with the components indicated as preferred, such as a CPP and an anionic silicone** (page 2, lines 7-8 and 16). Therefore, said alleged technical effect can be considered to be encompassed by the technical teaching and embodied by the same originally disclosed invention and may thus be considered in view of G 2/21.*

This more patentee-friendly outcome is much easier to reconcile with T 116/18. Concerning the different outcomes for the main and auxiliary requests in T 681/21, the Board in the passage above emphasised the preferred nature of the CPP and anionic silicone. But it is difficult to understand why the preferred nature of the anionic silicone in the auxiliary request would be a game changer allowing for consideration of post-published evidence in the absence of any data in the application. At the very least, T 681/21 seems to take a different approach to T 116/18 on this point, where it was sufficient that the purported technical effect together with the claimed subject-matter be conceptually comprised by the broadest technical teaching of the application as filed.

Another difference was the specific reference to “synergy” for the main request. If this was the reason that the effect was disregarded for the main request, it wouldn't fit well with T 116/18 either. After all, synergy is a specific type of improvement, so one might expect that synergistically improved softness would be “*encompassed by the technical teaching*” of improved softness. Certainly 17.4.3 of T 116/18 suggests that synergistic effects do not require a special approach:

A synergistic effect, however, does not deserve a special position compared with other effects on which patent applicants or proprietors regularly rely for inventive step.

Conclusion

Unfortunately, our borrowed African proverb

“When the EBA fights the plausibility elephant, it is legal certainty that suffers”

holds as true at the time of writing as it did when G 2/21 was issued last year. While the cases reviewed above relate to different underlying facts and cannot be directly compared, the fact remains that applying the approach of T 116/18 to T 621/21 would point to a different conclusion to that reached in the latter decision for the main request. It is difficult to see how this issue will be resolved until more Boards follow T 116/18 in clearly explaining what they think this test means.



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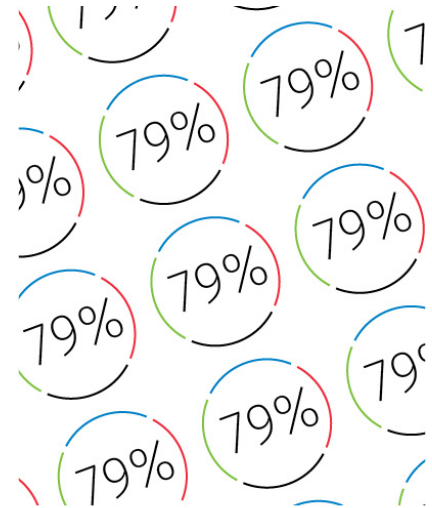
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