

London Study Question – 2019 – Explanatory Note

Plausibility

The requirement for plausibility is not based in legislation and is absent from TRIPS, PCT, EPC and other patent legislation. Yet a body of case law has developed to distinguish those patents and applications which demonstrate a technical effect, from purely speculative patents and applications which contain only prophetic examples. The plausibility of the alleged technical effect as set out in the patent can also affect the patentee’s ability to rely on post-filing experimental results.

This “plausibility requirement” is multifaceted as it also covers aspects of credibility of the invention, sound predictability of the utility, prohibition against speculative filing and restrictions regarding prophetic examples. It is also invoked in relation to several patentability requirements such as sufficiency, inventive step, clarity and utility.

AIPPI dedicated a panel session to plausibility in Sydney 2017. This session highlighted the global emergence of plausibility as a requirement, along with certain differences in approach between the USA, Europe and China. Even within Europe, the requirement is not applied consistently: France, the UK and the Netherlands have, for some time now, routinely deployed plausibility as a threshold test for challenging patent validity, but other EU jurisdictions, such as Germany, have been hesitant to use plausibility as a separate requirement, let alone as a routine test, when assessing patent validity.

Reviewing this emerging “plausibility requirement” and identifying its limits is crucial to patent applicants and holders in view of its increasing relevance to the validity of their patents across multiple jurisdictions. This is particularly so in the life sciences sector where claimed technical effects are often not self-evident.

In view of the above, examples of issues that may be considered in this potential Study Question include:

- (a) whether the technical effect of the invention must be mentioned in the application and made plausible;
- (b) whether all the promises of the patent must be plausible and/or achievable;
- (c) whether the plausibility requirement must be assessed in relation to clarity, sufficiency, inventive step or utility requirement;

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- (d) what test is applied to assess plausibility in relation to different types of claims (pure product / compound claims without functional feature, product claims including functional feature, second medical use claims, etc);
- (e) whether the applicant must have conducted analysis to ensure that the technical effect is plausible when plausibility is not self evident;
- (f) whether prophetic examples in the specification are sufficient to satisfy enablement / sufficiency requirement and whether there is any presentation / wording requirement for such examples;
- (g) whether post-filing data can be used to demonstrate that a patent filing is not purely speculative, and/or that the technical effect is plausible or achievable.